

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Hannah Birtwistle

Case No. D2022-2826

1. The Parties

The Complainant is Instagram, LLC, United States of America, represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Hannah Birtwistle, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <instagrammetaverse.com> is registered with 123-Reg Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 1, 2022. On August 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 8, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent an informal email communication to Center on August 9, 2022, requesting further information about the present proceeding. The Complainant filed an amended Complaint on August 10, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. The Respondent sent a further informal email communication on August 11, 2022, offering to cancel or transfer the disputed domain name. The Center sent a possible settlement email to the Parties on August 11, 2022. The Complainant confirmed on the same day that they did not want to suspend the proceeding for settlement discussions. The Center informed the Parties of the commencement of the Panel appointment process on September 7, 2022.

The Center appointed Anne-Virginie La Spada as the sole panelist in this matter on September 13, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an online photo and video sharing social networking service owned since 2012 by Meta Platforms, Inc. The Complainant's Instagram application is widely known throughout the world.

The Complainant owns the following trademark registrations for INSTAGRAM, among others:

- European Union Trademark registration No. 14493886, registered on December 24, 2015, in Classes 25, 35, 38, 41 and 45;
- International Trademark registration No. 1129314, registered on March 15, 2012, in Classes 9 and 42.

The Complainant has also registered the domain name <instagram.com> in 2004.

The disputed domain name <instagrammetaverse.com> was registered on October 18, 2021. At the time of filing of the Complaint, and on the date of the Panel's decision, it did not resolve to an active website.

On March 30, 2022, the Complainant sought to contact the Respondent by submitting a registrant contact form. No response was received.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark. The addition of the term "metaverse" in the disputed domain name does not change the overall impression of the designation as being connected to the Complainant's trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not authorized by the Complainant to use the disputed domain name, and there is no indication that the Respondent is known under the disputed domain name. The Respondent has not used the disputed domain name in connection with any *bona fide* offering of goods or services, nor is the Respondent making any legitimate noncommercial use of the disputed domain name.

The Complainant further contends that the disputed domain name was registered and used in bad faith, for the following reasons: (i) the Respondent registered the disputed domain name in full knowledge of the Complainant's rights with a view to capitalizing on the goodwill and reputation associated with the Complainant's trademark; and (ii) the Respondent has not been making any apparent substantive use of the disputed domain name. According to the Complainant, such non-use constitutes passive holding in bad faith, because the Complainant cannot conceive any *bona fide* use that the Respondent could make of the disputed domain name that would not result in creating a misleading impression of association with the Complainant.

B. Respondent

The Respondent did not file a proper response to the Complaint.

The Respondent sent two email communications to the Center. In the second one, she stated that she was “happy to cancel or transfer the disputed domain name.”

6. Discussion and Findings

According to paragraph 4(a) of the Policy, a complainant must assert and prove each of the following:

- (i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name registered by the respondent has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name reproduces the Complainant’s trademark INSTAGRAM in its entirety with no alteration, and combines this trademark with the term “metaverse”.

UDRP panels consider that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

In the present case, the trademark INSTAGRAM is clearly recognizable in the disputed domain name. The mere addition of the term “metaverse” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

UDRP panels accept that a generic Top-Level Domain (“gTLD”), such as “.com”, may be disregarded when assessing whether a domain name is identical or confusing similar to a trademark (see [WIPO Overview 3.0](#), section 1.11).

The Complainant has satisfied the condition set forth in paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the information submitted by the Complainant, the Respondent does not appear to have rights or legitimate interests in respect of the disputed domain name, nor has the Complainant granted to the Respondent any authorization to use the disputed domain name.

There is also no evidence that the Respondent has used or is planning to use the disputed domain name for a *bona fide* offering of goods or services. Moreover, the composition of the disputed domain name is such to carry a risk of implied affiliation, contrary to the fact, which cannot constitute fair use. ([WIPO Overview 3.0](#), section 2.5.1.)

The Respondent indicated in an informal communication to the Center that she was willing to transfer or cancel the disputed domain name.

Finally, the Respondent did not file a proper response to the Complaint. The Panel may draw from the lack of a Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b).

In view of the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Complainant has satisfied the condition set out in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

UDRP panels have recognized in past decisions the widespread use and renowned character of the Complainant's trademark INSTAGRAM (see *Instagram, LLC v. Bozulma Artik, hayat*, WIPO Case No. [D2021-4121](#); *Instagram, LLC v. lu xixi, PRIVATE*, WIPO Case No. [D2015-1168](#); and *Instagram, LLC v. Zhou Murong*, WIPO Case No. [D2014-1550](#)). The Panel accepts that the Complainant's trademark is well known and that the Respondent most probably knew of the Complainant's trademark when she registered the disputed domain name. Thus, the Panel finds that the disputed domain name was registered in bad faith.

The Respondent does not appear to have used the disputed domain name in connection with an active website.

In certain circumstances, UDRP panels have held that passive holding of a domain name could amount to use in bad faith within the meaning of paragraph 4(a)(iii) of the Policy. Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (section 3.3 of the [WIPO Overview 3.0](#)).

In the case at hand, the trademark INSTAGRAM is distinctive and well known. The Respondent failed to submit a proper response or to allege any actual or contemplated use of the disputed domain name. To the contrary, the Respondent was willing to transfer or cancel the disputed domain name. Also, it is difficult to imagine what legitimate use the Respondent could make of the disputed domain name, given the fact there is no relationship between the Respondent and the Complainant. If the disputed domain name was connected to an active website in the future, consumers would be likely to mistakenly assume that such website is operated or endorsed by the Complainant, when such is not the case.

On the other hand, the Respondent did not provide inaccurate contact details to the Registrar of the disputed domain name.

Weighing all the above factors, the Panel finds that the provision of accurate contact details to the Registrar is not, in itself, sufficient to avoid a finding of passive holding in bad faith. The Respondent was informed of the UDRP proceedings but chose to refrain from filing a formal response. This corroborates the implausibility of a good faith use of the disputed domain name by the Respondent.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has satisfied the condition set forth in paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <instagrammetaverse.com> be transferred to the Complainant.

/Anne-Virginie La Spada/

Anne-Virginie La Spada

Sole Panelist

Date: September 27, 2022