

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Wilson Ren

Case No. D2022-4313

1. The Parties

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

The Respondent is Wilson Ren, China.

2. The Domain Name and Registrar

The disputed domain name <instagrammen.com> is registered with GMO Internet, Inc. d/b/a Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on November 12, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On November 15, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On November 15, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the 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 in English and Japanese of the Complaint, and the proceedings commenced on November 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 12, 2022.

The Center appointed Douglas Clark as the sole panelist in this matter on December 16, 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 a world-renowned online photo and video sharing social networking application. Its website “www.instagram.com” is ranked as the 5th most visited website in the world, according to web information company Alexa. Currently available in over 31 languages, the Instagram app is the most downloaded application in the world as per App Annie Top App rankings in 2022.

The Complainant owns numerous trade mark registrations for the term INSTAGRAM in many jurisdictions throughout the world, including in China. Such trade mark registrations include but are not limited to the following:

- Chinese Registration No. 10614690, INSTAGRAM, registered on June 14, 2013;
- United States Registration No. 4146057, INSTAGRAM, registered on May 22, 2012; and
- International Registration No. 1129314, for INSTAGRAM, registered on March 15, 2012.

The Respondent is an individual based in China.

The disputed domain name <instagrammen.com> was registered on November 19, 2021. At the date of the Complaint, the disputed domain name resolved to a website with pornographic pictures of men.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

(a) The disputed domain name is confusingly similar to its trade mark INSTAGRAM. The disputed domain name is identical to the Complainant's INSTAGRAM trade mark along with the addition of the word “men”. The use of the generic Top-Level Domain (“gTLD”) “.com” in the disputed domain name is typically irrelevant to the consideration of confusing similarity;

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Respondent has never been granted any authorization or license to use the Complainant's trade mark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The pornographic content of the website is not a *bona fide* offering of services; and

(c) The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name with knowledge of the INSTAGRAM mark. The Respondent is using the disputed domain name to confuse unsuspecting Internet users looking for the Complainant's services, and to mislead Internet users as to the source of the disputed domain name and website. The pornographic content is likely to tarnish the distinctiveness, image, and reputation of the Complainant. The Respondent's offer to sell the disputed domain name to the Complainant is indicative of bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions but in correspondence with the Complainant's counsel, prior to the Complainant's filing of the Complaint, stated the following in Chinese:

1. The fact that he successfully registered the disputed domain name in November 2021 proves the Complainant's negligence in duly protecting its trade mark rights;
2. He will not transfer the disputed domain name for free but is willing to sell it if an appropriate price is proposed by the Complainant;
3. Personally, he does not care much about the disputed domain name, which will expire soon (*i.e.*, November 19, 2022);
4. He will give the Complainant three working days to consider what to do next. After this period, he may consider transferring the disputed domain name to a third party company specialized in domain name transactions.

6. Discussion and Findings

6.1 Preliminary Issue

Language of the proceeding

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In this case, the language of the Registration Agreement for the disputed domain name is Japanese. There is no agreement between the Complainant and the Respondent regarding the language of the proceeding. The Respondent did not respond as to the language of the proceeding. The Complainant has filed its Complaint in English and has requested that English be the language for the proceeding under the following grounds:

- (i) Neither the Complainant or the Respondent is based in Japan;
- (ii) The disputed domain name is in Latin characters;
- (iii) The use of "men" in the disputed domain name suggests the Respondent has some knowledge of English;
- (iv) The website under the disputed domain name displays partial content in English;
- (v) The Respondent responded in Chinese to a cease and desist letter written in English; and,
- (vi) Translation of the complaint would be disproportionate and increase expense and delay.

In accordance with paragraph 11(a) of the Rules and taking into consideration paragraphs 10(b) and (c) of the Rules, the Panel hereby determines that the language of the proceeding shall be in English after considering the following circumstances:

- the Center has notified the Respondent of the proceeding in both English and Japanese;

- Japanese is not the preferred language of the Respondent who has correspondence with the Complainant in Chinese;
- the Respondent responded to a cease and desist letter written in English, albeit in Chinese;
- an order for the translation of the Complaint will result in significant expenses for the Complainant and an unwarranted delay in the proceeding.

Further, this Panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

6.2 Substantive Issues

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

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

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark. The disputed domain name reproduces the INSTAGRAM trade mark in its entirety along with the word "men". The gTLD ".com" is generally disregarded when considering the first element. (See section 11.1, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent has no business with and is in no way affiliated with the Complainant. The Respondent is not authorized nor licensed to use the Complainant's INSTAGRAM trade mark or to apply for registration of the disputed domain name. There is no evidence that the Respondent is commonly known by the disputed domain name or the name "instagram". The Respondent's use of the disputed domain name to display pornographic content does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use.

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Complainant has therefore satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Based on the given evidence, the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant registered the INSTAGRAM trade mark in China and internationally. The Panel notes that the disputed domain name is identical to the Complainant's trade mark INSTAGRAM save for the addition of the word "men". "Instagram" has no other meaning in English, which shows that the Respondent seeks to target the Complainant through the disputed domain name. The Panel finds that the Respondent has registered the disputed domain name to attract Internet users to the website at the disputed domain name for commercial gain in accordance with paragraph 4(b)(iv) of the Policy.

The pornographic material on the website that the disputed domain name resolves to establish the Respondent is making a commercial gain from the website by attracting users to generate click through revenue. Further, the pornographic materials on the website tarnish the INSTAGRAM trade mark. This has been found in previous UDRP cases to constitute evidence of registration and use of a domain name in bad faith. (See [WIPO Overview 3.0](#), section 3.12).

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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, <instagrammen.com>, be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: December 30, 2022