

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Alex King

Case No. D2023-0739

1. The Parties

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

The Respondent is Alex King, India.

2. The Domain Name and Registrar

The disputed domain name <instafinsta.com> is registered with GoDaddy.com, LLC. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2023. On February 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 20, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 22, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 23, 2023.

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 March 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 3, 2023.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on April 17, 2023. 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 develops Instagram, a web-based online and mobile application that enables users to share pictures and videos with their friends and others.

The Complainant's web-based mobile application is compatible with Apple iOS, Android, and Windows Phone devices. The company was incorporated in 2010 and is based in San Francisco, California. As of August 2012, Instagram, Inc. operates as a subsidiary of Meta Platforms, Inc. (formerly known as Facebook, Inc.).

Since its launch in 2010, the Complainant became a fast growing photo/video-sharing and editing software and online social network, with more than 2 billion monthly active accounts worldwide. The Complainant's application is currently the 4th most downloaded application for iOS phones worldwide, according to applications information company Data.ai (formerly App Annie).

The Complainant also registers domain names consisting of or including its INSTAGRAM trademark under a wide range of generic Top-Level Domains ("gTLDs") as well as under country-code Top-Level Domains ("ccTLDs"), including the following:

| Domain name | Registration date |
|--------------------|-------------------|
| <instagram.com> | June 4, 2004 |
| <instagram.net> | November 6, 2010 |
| <instagram.dk> | January 14, 2011 |
| <instagram.org.in> | November 13, 2012 |
| <instagram.in> | April 3, 2013 |

The Complainant holds accounts in social media forums, including Facebook, Twitter, and LinkedIn.

The Complainant owns numerous trademark registrations for the INSTAGRAM and INSTA trademarks in many jurisdictions around the world, including, for instance, the following trademark registrations:

- United States Trademark Registration No. 5061916 for INSTA, registered on October 18, 2016;
- European Union Trademark Registration No. 014810535 for INSTA, registered on May 23, 2018;
- United States Trademark Registration No. 4,146,057 for INSTAGRAM, registered on May 22, 2012;
- European Union Trademark Registration No. 014493886 for INSTAGRAM, registered on December 24, 2015; and
- International Registration No. 1129314 for INSTAGRAM, registered on March 15, 2012.

The disputed domain name was created on March 26, 2020 and as per the evidence submitted by the Complainant, at the time of filing of the Complaint, redirected to the website at "www.indown.io" which purportedly offers an Instagram photos and videos downloader tool. The website under the disputed domain name also included numerous commercial banners. At the time of this decision, the disputed domain name does not resolve to an active website.

On December 23, 2022, the Complainant sent cease-and-desist letters through the Registrar contact form and the form published on website at "https://indown.io/". No response followed.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant has established trademark rights in the INSTAGRAM and INSTA trademarks for the purposes of paragraph 4(a)(i) of the Policy by numerous trademark registrations for INSTAGRAM and INSTA valid in various jurisdictions.

The Complainant further contends that the disputed domain name contains the Complainant's INSTA trademark in its entirety, as well as an abbreviated version of the Complainant's INSTAGRAM trademark, with the addition of the term "finsta" under the gTLD ".com".

According to the Complainant's contentions, the INSTA trademark still remains clearly recognizable within the disputed domain name.

The Complainant further submits that the disputed domain name is confusingly similar to the Complainant's INSTA and INSTAGRAM trademarks, as the disputed domain name comprises the "insta" element being a distinctive abbreviation of the Complainant's INSTAGRAM trademark.

The addition of the descriptive term "finsta" in the disputed domain name does not prevent a finding of confusing similarity with the Complainant's INSTA and INSTAGRAM trademarks, which remain recognizable in the disputed domain name.

The Complainant submits that the applicable gTLD in the disputed domain name should be viewed as a standard registration requirement and as such should be disregarded under the first element confusing similarity test.

No rights or legitimate interests

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy that would demonstrate its rights or legitimate interests in the disputed domain name.

The Complainant submits that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. The Complainant further contends that redirection to a website that provides tool for downloading content from Instagram is not considered as a *bona fide* offering of goods and services.

The Complainant further asserts that the tools offered on the Respondent's website are in breach of Facebook's Developer Policies, as the creation of a tool that facilitates the downloading of content from the Instagram platform goes beyond the limits that Instagram has placed on the functionality of its own product.

The Respondent is not a licensee of the Complainant. The Respondent is not affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of its INSTA and INSTAGRAM trademarks, in a domain name or otherwise.

The Respondent's name bears no resemblance to the disputed domain name whatsoever. Furthermore, the disputed domain name is not being used in the promotion of any business or any other online service that might give rise to the Respondent being commonly known by the disputed domain name. There is no evidence of the Respondent having acquired or applied for any trademark registrations for "instafinsta".

The Complainant further submits that the provision of a tool that allows Internet users to download content from Instagram, does not amount to legitimate noncommercial or fair use in the form of a fan site or otherwise.

Thus, the Complainant contends that the Respondent is not commonly known under the disputed domain name and has no rights to or legitimate interest in the disputed domain name.

Registered and used in bad faith

The Complainant submits that the disputed domain name was registered and is being used in bad faith.

The Complainant contends that prior UDRP panels have recognized the strength and renown of the Complainant's INSTAGRAM and INSTA trademarks.

Thus, the Complainant claims that the disputed domain name was not used for any legitimate purpose and was registered with full knowledge of the Complainant's trademarks.

The Complainant claims that the Respondent attempted to take commercial advantage of the Complainant's trademarks and reputation, as well as to trade off the Complainant's goodwill.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to that trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the [WIPO Overview 3.0](#). The Complainant submitted evidence that the INSTAGRAM and INSTA trademarks enjoy protection under regional and international trademark registrations. Thus, the Panel finds that the

Complainant's rights in the INSTAGRAM and INSTA trademarks have been established pursuant to the first element of the Policy.

The disputed domain name consists of the Complainant's INSTA trademark followed by the element "finsta" followed by the gTLD ".com".

The element "insta" in the disputed domain name also constitutes the dominant feature for the Complainant's INSTAGRAM trademark.

Furthermore, the addition of the element "finsta" in the disputed domain name does not prevent a finding of confusing similarity.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term may however bear on assessment of the second and third elements.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the gTLD, see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that it is readily apparent that the Complainant's trademarks remain recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the INSTAGRAM and INSTA trademarks in which the Complainant has rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the present case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. (See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#)).

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its INSTAGRAM and INSTA trademarks.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use, of the same.

The Complainant contends that the disputed domain name resolved to a website which redirected Internet users to a website which provided a tool to download content from Instagram. Prior panels have held that a respondent's use of a complainant's mark to redirect users to another commercial website would not support a claim to rights or legitimate interests, particularly here given the risk of implied affiliation found in the composition of the disputed domain name. In this regard, the element "finsta" in the disputed domain name may be interpreted as the short for "Finstagram", or "fake Instagram", referring to an account made so that a user can post images and interact with other accounts in a more private way, usually reserving the account's followers to close friends.¹

Based on the records of the present case the Panel finds that that the Respondent, who has failed to respond or contest this matter, was aware of the Complainant's trademark rights when it registered the disputed domain name. As there is no evidence showing that the Respondent has made any *bona fide* or legitimate use of the disputed domain name, it is likewise likely, on the balance of the probabilities, that the Respondent registered and used the disputed domain name primarily for purposes of exploiting the Complainant's established rights in the INSTAGRAM and INSTA trademarks and as a pretext for commercial gain or other such purposes inhering to the Respondent's benefit. Which factors cannot support the findings of fair use.

Therefore, the use of the disputed domain name cannot convey any rights or legitimate interests on the Respondent.

Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

According to section 3.1.4 of the [WIPO Overview 3.0](#), the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant's trademarks are well established through long and widespread use and the Complainant has acquired a significant reputation and goodwill in its trademark near worldwide.

Because the Complainant's INSTAGRAM and INSTA trademarks have a high degree of awareness among the public, and taking into account that the tool to download content from Instagram advertised on the website to which the disputed domain name redirected Internet users, it is implausible to believe that the Respondent was not aware of that mark when he registered the disputed domain name. Furthermore, the nature of the disputed domain name, comprising the Complainant's widely-known INSTA trademark and which also constitutes the short form of the Complainant's INSTAGRAM trademark, and the term "finsta" which is associated with the Complainant's Instagram platform, affirms a finding of bad faith registration.

The Registrar has confirmed that the disputed domain name was registered on March 26, 2020, *i.e.* long after the Complainant first used and registered the INSTAGRAM and INSTA trademarks.

The fact that the disputed domain name is currently inactive does not prevent a finding of bad faith.

The totality of the circumstances as shown by the evidence submitted, none of which is contradicted or contested by the Respondent, makes clear that the Respondent registered the disputed domain name after Complainant had established rights in the INSTAGRAM and INSTA trademarks, and has, since that time, used the disputed domain name for the benefit of the Respondent as a redirect to a third-party website distributing a tool to download content from the Complainant's platform. Thus, the Panel holds that such use of the disputed domain name is evidence of bad faith.

Moreover, by fully incorporating the INSTA trademark into the disputed domain name and by using such domain name to redirect Internet users to a website advertising third-party products, the Respondent was, in

¹ See, e.g. "<https://www.merriam-webster.com/words-at-play/what-does-finsta-mean-fake-instagram>"

all likelihood, trying to divert traffic intended for the Complainant's website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy.

In light of the aforesaid, the Panel establishes that, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Although at the time of this Decision the disputed domain name resolves to inactive webpage, the current passive holding of the disputed domain name does not prevent a finding of bad faith. Under section 3.3 of the [WIPO Overview 3.0](#), the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Previous UDRP panels have held that the passive holding of a domain name that incorporates a well-known trademark may also confirm the bad faith use of a disputed domain name. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Respondent also failed to respond to the Complainant's cease-and-desist letter, and did not provide any good reason to justify this, which supports a finding of its bad faith (see, e.g., *Compagnie Generale des Etablissements Michelin v. Vaclav Novotny*, WIPO Case No. [D2009-1022](#)).

Considering the above, the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under 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 <instafinsta.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: May 12, 2023