

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Hannes Stiller

Case No. D2023-1436

1. The Parties

The Complainant is Instagram, LLC, United States of America United States of America (“United States”), represented by Tucker Ellis, LLP, United States.

The Respondent is Hannes Stiller, Germany.

2. The Domain Name and Registrar

The disputed domain name <instagram-nft.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 April 3, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 4, 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 April 11, 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 April 14, 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 April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent sent three informal communications to the Center on April 24, May 5, 2023 and May 9, 2023. The Respondent did not submit any formal response.

The Center appointed Taras Kyslyy as the sole panelist in this matter on May 22, 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 is an online photo and video-sharing social networking application. Since its launch in 2010, it became a fast growing photo/video sharing and editing software and online social network, with more than 1 billion monthly active accounts worldwide.

The Complainant owns numerous trademark registrations for INSTAGRAM in many jurisdictions around the world, including, for instance, International trademark registration No. 1129314, registered on March 15, 2012.

In addition to the <instagram.com> domain name, the Complainant owns and operates numerous other domain names consisting of its trademark in combination with various generic and country code top-level domain extensions, including <instagram.net> and <instagram.org>.

The Complainant recently began testing a feature that allows Instagram users to buy and sell non-fungible tokens, also known as NFTs. Although the disputed domain name was registered prior to the Complainant launching its NFT wallet feature, the Complainant's parent, Meta Platforms, Inc., has been a leader in the development of the metaverse and Web3 (technologies that enable and utilize NFTs) for many years prior to the registration of the disputed domain name.

The disputed domain name was registered on May 4, 2021 and a landing web-page informing that the disputed domain name is available for sale.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's trademark.

The disputed domain name, which adds the descriptive term "nft" to the Complainant's trademark, is confusingly similar to the Complainant's trademark. The disputed domain name plainly misappropriates sufficient textual components from the Complainant's trademark, such that an ordinary Internet user who is familiar with the Complainant's trademark would, upon seeing the disputed domain name, think an affiliation exists between the disputed domain name and the Complainant and/or its trademark. The Respondent has added the descriptive term "nft" to the Complainant's trademark to form the disputed domain name. Accordingly, the disputed domain name reproduces the Complainant's exact trademark, and the addition of the term "nft" does not remove the confusing similarity between the disputed domain name and the Complainant's trademark, especially as the term relates to a feature offered by the Complainant. The inclusion of a hyphen does not change that the disputed domain name is confusingly similar to the Complainant's trademark. The addition of a generic Top-Level Domain ("gTLD") has no distinguishing value in the Policy.

The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has neither licensed nor authorized the Respondent to use the Complainant's trademark, nor does the Respondent has any legal relationship with the Complainant that would entitle the Respondent to use the Complainant's trademark. Further, neither the Whois data for the disputed domain name nor the Respondent's use of the disputed domain name support that the Respondent is known by the disputed domain name. The disputed domain name is listed on one or more block lists, indicating that it has been used in connection with spam, malware, or other domain name abuse. The use of the disputed domain name to direct to a landing page offering the domain name for sale or indicating the domain name may be for

sale, is not a *bona fide* offering of goods or services. The Respondent's registration of the disputed domain name and use of the Complainant's trademark within the disputed domain name is a violation of the Complainant's brand guidelines.

The disputed domain name was registered and is being used in bad faith.

The Respondent's bad faith is evidenced by the fact that the disputed domain name has been flagged as malicious by at least one security vendor. Generalized offer to sell the disputed domain name, such as stating that the domain name may be for sale, is indicative of bad faith. The Respondent has registered the disputed domain name that is confusingly similar to the Complainant's trademark. The Respondent registered the disputed domain name on May 4, 2021, which postdates the registration and use of the Complainant's trademark by many years. Because the Complainant's trademark is so obviously connected with the Complainant and its well-publicized mobile application, and the disputed domain name clearly references this trademark, the registration of the disputed domain name by the Respondent, who has no connection with the Complainant, supports a finding of bad faith. Given the fame of the Complainant's trademark, and the Respondent's unauthorized incorporation of the Complainant's trademark into the disputed domain name, there are no circumstances under which the Respondent's use of the disputed domain name could plausibly be in good faith.

B. Respondent

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

However, the Respondent sent three informal communications to the Center on April 24, 2023 containing the following wording "I was not aware that I have a domain with a protected name in my domain portfolio. I assign my rights to this domain and will inevitably transfer it. I do not want to proceed the case and apologize for the inconvenience."

On May 5, 2023, the second communication stated : "I just wanted to ask for an update on the case. Do I still have to submit anything or send anything anywhere? Or is my e-mail from 24.04.23 enough that I simply hand over the domain "instagram-nft.com"? So is there anything I have to do to avoid cost and stress?."

And the third communication in response to the default notice stating " Dear [...]., what does this mean for me?" was sent on May 9, 2023.

6. Discussion and Findings

A. Consent to Remedy

According to section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)"), "[w]here parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the 'standard settlement process' described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent". However, "a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits". *Id.* Accordingly, noting that the Parties' were unable to settle as suggested by the Respondent, the Panel finds a broader interest in recording a substantive decision on the merits and will proceed to do so.

B. Identical or Confusingly Similar

According to section 1.11.1 of the [WIPO Overview 3.0](#) the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first

element confusing similarity test. Thus, the Panel disregards gTLD “.com” for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant’s trademark.

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 Panel finds that the addition of “nft” term and a hyphen in the disputed domain name would not prevent finding the disputed domain name confusingly similar to the Complainant’s trademark.

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant’s trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence do not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The Respondent has no right or legitimate interests in the disputed domain name resolving to an inactive or landing website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

Noting the risk of implied affiliation between the disputed domain name and the confusingly similar well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant (see, e.g., *Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / Zayed*, WIPO Case No. [D2019-2897](#)).

Considering the above the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

D. 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 trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in the United States and internationally. Thus, the Panel finds that the disputed domain name confusingly similar to the Complainant’s trademark was registered in bad faith.

According to section 3.3 of the [WIPO Overview 3.0](#) from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. In this regard, the Panel takes into account (i) the high degree of distinctiveness and reputation of the Complainant’s trademark, (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 while registering the disputed domain name, and (iv) the implausibility of any good faith use to which the disputed domain name may be put.

Furthermore, the disputed domain name is listed on one or more blacklists indicating that it had previously been used in connection with spam, malware, or other domain name abuse activities, which confirms the bad faith use (see *e.g.*, *Instagram, LLC v. yusuf polat, schowix*, WIPO Case No. [D2021-2791](#)).

The disputed domain name resolves to a landing webpage where it is mentioned that the disputed domain name may be for sale, which is an indication that the Respondent passively holds the disputed domain name aiming at a potential commercial gain, which is bad faith (see *e.g.* *Whatsapp LLC v. Kenneth Chow*, WIPO Case No. [D2021-2917](#)).

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 <instagram-nft.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: May 24, 2023