

## **ADMINISTRATIVE PANEL DECISION**

### **Meta Platforms, Inc., Instagram, LLC v. Tom Petropoulos Case No. D2022-2121**

#### **1. The Parties**

The Complainants are Meta Platforms, Inc., United States of America (“United States”) (formerly known as Facebook, Inc.), and Instagram, LLC, United States (a subsidiary of Meta Platforms, Inc.), represented by Hogan Lovells (Paris) LLP, France. The aforementioned Complainants will hereinafter collectively be referred to as the “Complainant”.

The Respondent is Tom Petropoulos<sup>1</sup>, United States.

#### **2. The Domain Name and Registrar**

The disputed domain name <instametagram.com> (the “Disputed Domain Name”) 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 June 10, 2022. On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 14, 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 June 21, 2022, 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 June 23, 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 June 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2022. The Respondent did not submit any response. Accordingly,

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<sup>1</sup> At the time of the filing of the Complaint, the Respondent’s identity was masked by a privacy service.

the Center notified the Respondent's default on August 5, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on August 15, 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 Meta Platforms, Inc. is a United States social technology company, which operates, among other companies, Facebook, Instagram, Meta Quest (formerly Oculus), Novi, Portal, and WhatsApp. Formerly known as Facebook, Inc., Meta Platforms, Inc. publicized its name change worldwide. The focus of the Complainant Meta Platforms, Inc. is to bring the metaverse to life and to help people connect, find communities, grow businesses, and do things together that they could not do in the physical world.

The Complainant Instagram, LLC is a famous online photo and video-sharing social-networking application launched in 2010 and acquired by the Complainant Meta Platforms, Inc. in 2012. Today, the Complainant Instagram, LLC is the world's fastest-growing photo and 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 META and INSTAGRAM, among others, in jurisdictions worldwide, including, but not limited to: META, United States Registration No. 5,548,121, registered on August 28, 2018 and assigned to the Complainant on October 26, 2021, in international classes 35 and 42; META, Andorran Trademark Registration No. 43626, registered on January 3, 2022, in international classes 9, 28, 35, 36, 38, 41, 42, and 45; META, Monaco Trademark Registration No. 22.00039, registered on February 8, 2022, in international classes 9, 28, 35, 36, 38, 41, 42, and 45; INSTAGRAM, United States Registration No. 4,146,057, registered on May 22, 2012, in international class 9; INSTAGRAM, European Union Trademark No. 014493886, registered on December 24, 2015, in international classes 25, 35, 38, 41 and 45; and INSTAGRAM, International Trademark Registration No. 1129314, registered on March 15, 2012, in international classes 9 and 42 (designating jurisdictions) (hereinafter collectively referred to as the "META and INSTAGRAM Mark").

The Disputed Domain Name was registered on October 28, 2021, and currently resolves to a pay-per-click landing page on which it hosts multiple hyperlinks to third-party websites and from which the Respondent presumably collects revenue for each click.

The Complainant's counsel, in an attempt to resolve the matter amicably, sent a domain holder contact request form to the Respondent on March 24, 2022, but received no reply.

#### **5. Parties' Contentions**

##### **A. Complainant**

The following are the Complainant's contentions:

- the Complainants should be consolidated;
- the Disputed Domain Name is confusingly similar to the Complainant's META and INSTAGRAM Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- the Disputed Domain Name was registered and is being used in bad faith.

The Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Consolidation of the Complainants**

The Complainants submitted a request for consolidation in this proceeding in their Complaint. Pursuant to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11, the consolidation of multiple complainants filing a joint complaint against one or more respondents is subject to the discretion of the appointed panel.

In assessing whether a complaint filed by multiple complainants may be brought against one or more respondents, the appointed panel should consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion; and (ii) it would be equitable and procedurally efficient to permit the consolidation.

Keeping this in mind, the Panel notes that the Complainants in the present administrative proceeding are affiliated since the Complainant Instagram, LLC is a subsidiary of the Complainant Meta Platforms, Inc., the parent company.

Additionally, the Complainants share a common legal interest in the trademark rights on which this Complaint is based. Specifically, each Complainant owns a registration for the META and INSTAGRAM Mark in several jurisdictions worldwide.

As noted in greater detail below, the Respondent appears to have engaged in conduct targeting the META and INSTAGRAM Mark held by the Complainants. As such, the Complainants have a specific common grievance against the Respondent. The Complainants have been the target of common conduct by the Respondent since the Respondent has engaged in bad faith registration and use of the Disputed Domain Name comprising the META and INSTAGRAM Mark. The Panel is not aware of any circumstances that would create prejudice to the Respondent by allowing the Complaint filed by multiple Complainants to proceed.

Therefore, the Panel considers that it is fair and equitable under the circumstances of the case to permit the consolidation, as the Complainants are not only affiliated companies as parent and subsidiary, but also have common interests.

Consequently, the Panel allows the Complainants to proceed with their Complaint.

### **6.2 Substantive Issues**

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Name 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 Disputed Domain Name; and

(iii) the Disputed Domain Name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry, a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the interspersed META and INSTAGRAM Mark.

It is uncontroverted that the Complainant has established rights in the META and INSTAGRAM Mark based on its fame as well as its registered trademarks for the META and INSTAGRAM Mark in the United States and other jurisdictions worldwide. The consensus view is that “registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive”. See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the META and INSTAGRAM Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See [WIPO Overview 3.0](#), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the META and INSTAGRAM Mark.

The Disputed Domain Name consists of the META and INSTAGRAM Mark in its entirety, although interposed, and then followed by the generic Top-Level Domain (“gTLD”) “.com”. The Disputed Domain Name is confusingly similar to the META and INSTAGRAM Mark since the trademarks are interspersed in the Disputed Domain Name. Prior UDRP panels have found disputed domain names consisting of interspersed trademarks or trademarks interspersed with other terms to be confusingly similar to the trademarks at issue. See *Andrey Ternovskiy dba Chatroulette v. Lloyd Ales*, WIPO Case No. [D2018-0648](#) (<chatsexroulette.com>). See also *Facebook, Inc., Instagram, LLC v. Rafael Cuellar, FacebookforAnimal.cop, youpupy llc*, WIPO Case No. [D2021-1651](#) (“With respect to the Domain Names <faceandbookpizza.com> and <faceandbookforanimal.com>, the Panel finds that the famous trademark FACEBOOK is clearly recognizable within these Domain Names, notwithstanding the additional words 'pizza' and 'for animal', and notwithstanding the interposition of the word 'and' between 'face' and 'book'.”).

Finally, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant’s the META and INSTAGRAM Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

### **B. Rights or Legitimate Interests**

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant’s META and INSTAGRAM Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name.

Further, the Complainant does not have any business relationship with the Respondent and based on the use made of the Disputed Domain Name to resolve to a parking page that contains pay-per-click links, the

Panel finds that the Respondent was not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name. Applying the principles under paragraph 4(c) of the Policy, panels have found that the use of a domain to host a parked page comprising pay-per-click links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of a complainant's mark or otherwise mislead Internet users. See [WIPO Overview 3.0](#), section 2.9. In this instance, the Disputed Domain Name resolves to such parked pages, including a link to file sharing websites and other similar services associated with those of the Complainant. The Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

### **C. Registered and Used in Bad Faith**

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, the registration of a domain name that reproduces a widely-known trademark in its entirety (being identical or confusingly similar to such trademark) by an individual or entity that has no relationship to that mark, without any reasonable explanation on the motives for the registration, can by itself create a presumption of bad faith. Based on the circumstances here, where the Disputed Domain Name interposed the two trademarks, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith to target the Complainant's META and INSTAGRAM Mark.

Second, the Panel concludes that the Respondent registered and used the Disputed Domain Name in bad faith in an attempt to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's META and INSTAGRAM Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name's resolving landing page. The Respondent's registration and use of the Disputed Domain Name indicate that such registration and use had been done for the specific purpose of trading on the name and reputation of the Complainant and its META and INSTAGRAM Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Third, the Panel finds that the Respondent had actual knowledge of the Complainant's META and INSTAGRAM Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the use made by the Complainant of the META and INSTAGRAM Mark worldwide, it strains credulity to believe that the Respondent had not known of the Complainant or its META and INSTAGRAM Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its META and INSTAGRAM Mark additionally suggests that the Respondent's objective in registering the Disputed Domain Name was to cause confusion with the Complainant's META and INSTAGRAM Mark. Moreover, the Complainant submits that the Respondent could not credibly argue that it did not have knowledge of the Complainant's trademarks when registering the Disputed Domain Name on October 28, 2021, given that the META and INSTAGRAM Mark form a distinctive combination in the Disputed Domain Name and that the registration of the Disputed Domain Name by the Respondent took place on the same day as the Complainant's name change from Facebook, Inc. to Meta Platforms, Inc. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith. Thus, the Panel finds that the Respondent had actual knowledge of the META and INSTAGRAM Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith.

Fourth, the Respondent attracted users for commercial gain by displaying third-party pay-per-click links on the landing page to which the Disputed Domain Name resolves. The use of a confusingly similar domain name to display third-party sponsored hyperlinks and allegedly collect click-through fees is evidence of bad

faith under paragraph 4(b)(iv) of the Policy. As such, the Respondent was not only trading on consumer interest in the Complainant in order to generate Internet traffic and to commercially benefit from the links that appeared on the landing page, but the Respondent also purportedly derived commercial advantage in the form of referral fees. In the Panel's view, this constitutes bad faith. See *Fox News Network, LLC v. Warren Reid*, WIPO Case No. [D2002-1085](#); *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. [D2005-0556](#); *Lewis Black v. Burke Advertising, LLC*, WIPO Case No. [D2006-1128](#). Moreover, given that the Disputed Domain Name redirected users to third-party sites that had no apparent relationship to the Complainant or to the META and INSTAGRAM Mark, the Panel may reasonably infer that the Respondent was redirecting traffic to these third-party websites in exchange for a fee. See *Pfizer Inc. v. lipidor.com DNS Services*, WIPO Case No. [D2003-1099](#) (drawing "reasonable inference" that respondent was redirecting traffic in exchange for fee).

Finally, the lack of response by the Respondent to the domain holder contact request form sent by the Complainant's attorneys to the Respondent supports a finding of bad faith. Past UDRP panels have held that failure to respond to a demand letter or contact request form may be considered a factor in finding bad faith registration and use of a domain name. See *WhatsApp LLC v. Bulk Whatsapp Software*, WIPO Case No. [D2021-0564](#) (respondent's failure to reply to the cease and desist letter was a circumstance pointing to bad faith registration and use of the disputed domain name); *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/k/a Country Walk a/k/a Cupcake Party*, WIPO Case No. [D2000-0330](#) (failure to respond to a demand letter provides "strong support for a determination of 'bad faith' registration and use").

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## 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 <instametagram.com> be transferred to the Complainant.

/Lynda M. Braun/

**Lynda M. Braun**

Sole Panelist

Date: August 24, 2022