

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. Protection of Private Person / Yurii Shemetilo / Olha Shostak

Case No. D2022-2832

### **1. The Parties**

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

The Respondents are Protection of Private Person, Russian Federation / Yurii Shemetilo, Ukraine / Olha Shostak, Ukraine.

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

The disputed domain names <anon-instastories.online> (the “Domain Name 1”) and <insta-stories.online> (the “Domain Name 2”) (jointly referred to as the “Domain Names”) are registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

### **3. Procedural History**

The Complaint in English 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 Domain Names. On August 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names 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 Complainant filed an amended Complaint on August 10, 2022.

On August 8, 2022, the Center sent an email to the Parties in both English and Russian regarding the language of the proceedings. On August 8, 2022, the Complainant reconfirmed its request that English be the language of the proceedings referring to the respective arguments contained in the Complaint in support of its request. The Respondents did not provide any comments regarding the language of the proceedings.

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 Respondents of the Complaint in both English and Russian, and the proceedings commenced on August 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on September 16, 2022.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on September 22, 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 company operating an online photo and video-sharing social-networking application called Instagram. The Complainant's application was launched in 2010. Currently, it has over 1 billion monthly active users.

The Complainant is the owner of numerous INSTA and INSTAGRAM trademark registrations, including:

- the United States Trademark Registration INSTA No. 5061916 registered on October 18, 2016;
- the European Union Trade Mark Registration INSTA No. 014810535 registered on May 23, 2018;
- the United States Trademark Registration INSTAGRAM No. 4146057 registered on May 22, 2012;
- the European Union Trade Mark Registration INSTAGRAM No. 014493886 registered on December 24, 2015;
- the International Trademark Registration INSTAGRAM No. 1129314 registered on March 15, 2012.

The Complainant's primary domain name incorporating its INSTAGRAM trademark is <instagram.com>.

The Domain Name 1 was registered on December 23, 2021. The Domain Name 2 was registered on December 2, 2020.

The Complaint contains evidence that at the time the Complaint was filed, the Domain Name 1 redirected to the Domain Name 2. Both Domain Names resolved to a website providing a tool to download and anonymously view the content from the Complainant's application Instagram (the "Website"). As of the date of this Decision, the Domain Names redirect to the domain name <in-stories.online> which resolves to the Website.

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

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

The Complainant requests that the Domain Names be transferred to the Complainant. According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Names are confusingly similar to the INSTA and INSTAGRAM trademark registrations of the Complainant.

Second, the Complainant argues that the Respondents have neither rights nor legitimate interests in the Domain Names.

Third, the Complainant submits that the Domain Names were registered and are being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondents have no rights or legitimate interests in the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

### **A. Consolidation of the Respondents**

The Complainant has submitted the amended Complaint against multiple Respondents.

Paragraph 3(c) of the Rules provides that the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. Moreover, pursuant to section 4.11.2 of the [WIPO Overview 3.0](#), where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

In the present case, the Panel accepts that various commonalities between the Domain Names provide sufficient evidence that the Domain Names are owned and/or controlled by a common individual/entity.

Firstly, the Panel notes that both Domain Names resolve to the same Website. At the time of submitting the Complaint, the Domain Name 1 redirected to the Domain Name 2. As of the date of this Decision both Domain Names redirect to the domain name <in-stories.online> which resolves to the Website.

Secondly, the Panel acknowledges that both Domain Names were registered using the same privacy service and registrar. Both Respondent are also based in the same country (Ukraine).

Finally, the Panel notes the similarity of the content of the Domain Names. The Domain Names include either the term "instastories" or "insta-stories" together with ".online" generic Top-Level Domain ("gTLD").

Accordingly, the Panel finds that the Domain Names are subject to a common control for the purposes of these proceedings. The Respondents have not denied these assertions, thus the Panel permits the consolidation of the proceedings and refers to all the registrants of the Domain Names as the "Respondents".

## **B. Further Procedural Considerations**

In accordance with paragraph 10 (b) of the Rules in all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

In the present case, the Respondents' disclosed location appears to be in Ukraine, which is subject to an international conflict at the date of this Decision. Given that this circumstance may impact case notification, the Panel shall consider whether the proceeding should continue. Having considered all the circumstances of the case, this Panel finds that the present proceeding should continue.

First, the Panel notes that the Center has notified the Respondents of the Complaint in both English and Russian. The Center sent the Notification of Complaint by email to the Respondents at the email addresses registered with the Registrar and to the postmaster email addresses as specified by the Rules.

Second, the Panel notes that the Domain Names continue to be actively used, and that such use changed after the Notification of the Complaint. These circumstances indicate the Respondents are capable of continuing to control the Domain Names, and further suggests the Respondents are likely aware of the present proceedings and would have been able to formulate and file a Response in this proceeding had they wished to do so.

Third, the Panel notes that, for the reasons which are set out later in this Decision, the Panel has no doubt that the Respondents registered and have used the Domain Names in bad faith.

Thus, taking these circumstances into account, the Panel finds that the Parties have been given a fair opportunity to present their case and the Panel will proceed to rendering a Decision accordingly.

## **C. Language of the Proceeding**

The language of the Registration Agreement for the Domain Names is Russian. Paragraph 11(a) of the Rules provides that "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". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#)).

The Complainant has submitted a request that the language of the proceeding be English.

The Complainant contends, *inter alia*, that the Domain Names consist of Latin letters and English terms, such as "stories". Furthermore, the Complainant notes that the Website associated with the Domain Names is accessible by default in English until the Internet users choose to view it in a different language. Lastly, the Complainant submits that it would be disproportionate to require the Complainant to translate and submit the Complaint in Russian as this would result in additional expenses and unnecessary delay for the Complainant.

The Panel agrees that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondents did not comment on the language of the proceeding, even though they were notified in English and Russian regarding the language of the proceeding.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

#### **D. Identical or Confusingly Similar**

The first element that the Complainant must establish is that the Domain Names are identical or confusingly similar to the Complainant's trademark in which it has rights.

The Complainant holds valid INSTA and INSTAGRAM trademark registrations, which precede the registration of the Domain Names.

The Domain Names incorporate the Complainant's INSTA trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of such terms as "anon" or "stories" in the Domain Names does not prevent a finding of confusing similarity between the Domain Names and the Complainants' trademark. UDRP panels have consistently held that 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. See section 1.8, [WIPO Overview 3.0](#).

The gTLD ".online" in the Domain Names is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Names are confusingly similar to the Complainant's trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

#### **E. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondents have no rights or legitimate interests in the Domain Names.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it intends to make a legitimate, noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondents have not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant's INSTA and INSTAGRAM trademark registrations predate the Respondents' registrations of the Domain Names. There is no evidence in the case file that the Complainant has licensed or otherwise permitted the Respondents to use the INSTA or INSTAGRAM trademarks or to register the Domain Names incorporating these trademarks. There is also no evidence to suggest that the Respondents have been commonly known by the Domain Names.

Moreover, it results from the evidence in the record that the Respondents do not make use of the Domain Names in connection with a *bona fide* offering of goods or services, as well as they do not make a legitimate,

noncommercial or fair use of the Domain Names without intent for commercial gain.

On the contrary, the Domain Names are used to attract Internet users to the Website providing a tool to download and anonymously view the content from the Complainant's application Instagram without the need for an Instagram account. Moreover, the Panel notes that the Website contains sponsored links to third-party products and services. In sum, such use of the Domain Names does not confer rights or legitimate interests on the Respondents.

Given the above, the Respondents have failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Names. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

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

The third requirement the Complainant must prove is that the Domain Names have been registered and are being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name were registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the INSTA and INSTAGRAM trademarks predate the registration of the Domain Names. This Panel finds that the Respondents were or should have been aware of the Complainant's trademarks at the time of registration of the Domain Names. This finding is supported by the content of the Website which makes reference to and use of the Complainant's trademarks. Also, it has been proven to the Panel's satisfaction that the Complainant's INSTA and INSTAGRAM trademarks are well known and unique to the Complainant. Thus, the Respondents could not reasonably ignore the reputation of products and services under these trademarks. In sum, the Respondents in all likelihood registered the Domain Names with the expectation of taking advantage of the reputation of the Complainant's INSTA and INSTAGRAM trademarks.

Moreover, the Complainant presented evidence that the Domain Names are used in bad faith by the Respondents to attract Internet users to the Website providing a tool for anonymously viewing and downloading content from Instagram as well as sponsored links to third-party products and services.

Thus, this Panel finds that the Respondents use the Domain Names in an attempt to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion with the INSTA and INSTAGRAM trademark as to the source, sponsorship, affiliation, or endorsement of the websites or the activity carried out through the websites by the Respondents.

While a clear and sufficiently prominent disclaimer could lend support to circumstances suggesting the Respondents' good faith, where the overall circumstances of a case point to the Respondents' bad faith, the mere existence of a disclaimer cannot cure such bad faith. Rather, panels have held that in such cases a respondent's use of a disclaimer could be considered as an admission by the respondent that users may be confused. See section 3.7 of the [WIPO Overview 3.0](#).

In the present case, the Website contains the disclaimer stating that "InstaStories is not connected with Instagram. We do not host Instagram Stories on our servers, all rights belong to their owners". In the Panel's view, such disclaimer cannot be considered clear and sufficiently prominent. The mere indication that the Respondents are not connected with Instagram at the bottom of the Website does not prove the Respondents' good faith, but does indicate clear knowledge of the Complainant and suggests that Internet users may be confused.

Finally, in these circumstances, the Respondents' attempt to conceal their identity using a privacy protection service constitutes an additional indication of the Respondents' bad faith.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements 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 Domain Names, <anon-instastories.online> and <insta-stories.online>, be transferred to the Complainant.

*/Piotr Nowaczyk/*

**Piotr Nowaczyk**

Sole Panelist

Date: October 5, 2022