

ADMINISTRATIVE PANEL DECISION

Instagram, LLC, Meta Platforms, Inc. v. Pedro Sandoval orta
Case No. D2022-2870

1. The Parties

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

The Respondent is Pedro Sandoval orta, Spain.

2. The Domain Names and Registrar

The disputed domain names <facebookmetaverso.com>, <instagrammetaverso.com>, and <metaverseinstagram.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 4, 2022. On August 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names 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 August 23, 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 26, 2022, with an added disputed domain name. On September 6, 2022, the Registrar confirmed that the same Respondent was listed as the registrant and also provided the same contact details.

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 September 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 20, 2022.

The Center appointed Taras Kyslyy as the sole panelist in this matter on November 2, 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 Complainants in this administrative proceeding are Meta Platforms, Inc. (formerly Facebook, Inc.) (the "Complainant 1"), together with its subsidiary Instagram, LLC (the "Complainant 2").

The Complainant 1 is a United States social technology company, and operates Facebook, Instagram, and WhatsApp. The Complainant's 1 focus, is to bring the metaverse to life and to help people connect, find communities and grow businesses. Founded in 2004, the Complainant's 1 Facebook platform is a leading provider of online social-media and social-networking services with its main website currently ranked as the 3rd most visited website both in the world and in Spain (where the Respondent is reportedly based), according to information company Alexa, respective mobile application being the 2nd most downloaded mobile application worldwide, as per Data.ai's (formerly App Annie) Top Apps Worldwide Rankings in 2022.

The Complainant 1 owns registrations for its FACEBOOK trademark in various jurisdictions, including, for instance, the European Union trademark registration No. 004535381, registered on June 22, 2011.

The Complainant 2 is one of the world renowned online photo and video sharing social networking applications. Since its launch in 2010, it has rapidly acquired and developed considerable goodwill and renown worldwide and today is one of the world's fastest growing photo and video sharing and editing software and online social networks, with more than 1 billion monthly active accounts worldwide. The Complainant's website available at "www.instagram.com" is ranked the 6th most visited website in the world and 10th in Spain (where the Respondent appears to be based), according to web information company Alexa.

The Complainant 2 owns registrations for its INSTAGRAM trademark in various jurisdictions, including, for instance the European Union trademark registration No. 14493886, registered on December 24, 2015.

The Complainant 1 and the Complainant 2 are respectively the registrants of numerous domain names consisting of or including their FACEBOOK or INSTAGRAM trademark under a wide range of generic Top-Level Domains (the "gTLDs") as well as under numerous country code Top-Level Domains (the "ccTLDs"). The Complainant 1 and the Complainant 2 respectively have also made substantial investments to develop a strong presence online by being active on various social media platforms, including Facebook, Twitter, and LinkedIn. For instance, the Complainant's 2 official Facebook page has over 59 million Facebook "likes" and over 34 million followers on Twitter.

The disputed domain name <metaverseinstagram.com> was registered on October 11, 2021. The disputed domain names <facebookmetaverso.com> and <instagrammetaverso.com> were registered on October 18, 2022. The disputed domain names resolve to blank webpages and are associated with the same IP address (34.102.136.180) and the same ASN (AS396982 GOOGLE, US).

On March 16, 2022, the Complainants in an attempt to resolve this dispute amicably, submitted the registrar's registrant contact forms for the disputed domain names <instagrammetaverso.com> and <metaverseinstagram.com> to reach out to the Respondent, however the Respondent never responded

5. Parties' Contentions

A. Complainants

The disputed domain names are identical or confusingly similar to the Complainants' trademarks. The disputed domain name incorporate the Complainants' FACEBOOK or INSTAGRAM trademarks in its entirety with the addition of the descriptive term "metaverse" or its Spanish version "metaverso", under the gTLD ".com". FACEBOOK or INSTAGRAM trademarks are immediately recognizable in the disputed domain name as the leading element, and the addition of the descriptive term "metaverse" or its Spanish version "metaverso" to the Complainants' trademarks does not prevent a finding of confusing similarity. The addition of the ".com" may be disregarded for the purposes of assessing confusing similarity, as it is a standard requirement of registration

The Respondent has no rights or legitimate interests in the disputed domain names. The Respondent is not a licensee of the Complainants. The Respondent is not affiliated with the Complainants in any way. The Complainants have not granted any authorization for the Respondent to make use of its trademark in a domain name or otherwise. The disputed domain names do not resolve to an active website. Such use of the disputed domain names amounts to passive holding and does not amount to their use with any *bona fide* offering of goods or services. There is no evidence to suggest that the Respondent is commonly known by the disputed domain names. The Respondent's name for the disputed domain names <instagrammetaverso.com> and <metaverseinstagram.com> bears no resemblance to the Complainants' FACEBOOK or INSTAGRAM trademarks. Furthermore, the identity of the registrant for the disputed domain name <facebookmetaverso.com> is concealed by the privacy registration shield. The Respondent's passive holding of the disputed domain names does not support any reasonable claim of being commonly known by the disputed domain names, nor does it give rise to any reputation in the disputed domain names themselves, independent of the Complainants' trademark rights. The passive holding of the disputed domain names cannot amount to any legitimate noncommercial or fair use of the disputed domain names.

The disputed domain names were registered and are being used in bad faith. The Complainants' trademarks are inherently distinctive and well known throughout the world in connection with its online photo sharing social network, and were continuously and extensively used well before the disputed domain names were registered in 2021, and have rapidly acquired considerable reputation and goodwill worldwide, including in Spain. The terms "facebook" and "instagram" are highly distinctive and exclusively associated with the Complainants. The Respondent could not credibly argue that he did not have knowledge of the Complainants or its trademarks when registering the disputed domain names. The Respondent has engaged in a pattern of conduct by registering the disputed domain names and the domain name <twittermetaverso.com> targeting third party trademarks for the purpose of preventing trademark owners from reflecting their trademarks in corresponding domain names. The Respondent chose to entirely conceal his identity by using a privacy registration service further to the messages sent by the Complainants, which is another indication of the Respondent's bad faith and his intent to use the disputed domain names in a way, which may be abusive or otherwise detrimental to the Complainants and their rights. The Respondent has never used the disputed domain names to point to an active website, and such passive holding of the disputed domain names would not preclude a finding of bad faith given the overall circumstances of the case. In light of the nature of the disputed domain names themselves, *i.e.*, the combination of the the Complainants' FACEBOOK or INSTAGRAM trademarks together with the descriptive term "metaverse" or its Spanish version "metaverso", the disputed domain names carry with them a high risk of implied affiliation with the Complainants. The Complainants cannot conceive of any *bona fide* use that the Respondent could make of the disputed domain names that would not result in creating a misleading impression of association with the Complainants. The presence of the disputed domain names in the hands of the Respondent represents an abusive threat hanging over the head of the Complainant (*i.e.*, an abuse capable of being triggered by the Respondent at any time) and therefore constitutes a continuing abusive use.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

A. Preliminary Issues – Consolidation

The Complainants request the Panel hear the present dispute – brought by two Complainants – as a consolidated, “unitary” complaint.

Section 4.11.1 of the [WIPO Overview 3.0](#) summarizes the consensus view of UDRP panels on the consolidation of multiple complainants, in part, as follows:

“In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at 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.”

The Complainants assert they are related corporate entities and have a common legal interest sufficient to justify consolidation. The Complainants have been the target of common conduct by the Respondent who has engaged in bad faith registration and use of the disputed domain names comprising their trademarks. Moreover, the Respondent will not suffer any prejudice, and consolidation will not affect the Respondent's rights in responding to the Complaint.

The Panel accepts these arguments in favor of consolidation and grants the request to consolidate.

B. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (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 <facebookmetaverso.com> incorporate the entirety of the Complainant's 1 FACEBOOK trademark and the disputed domain names <instagrammetaverso.com> and <metaverseinstagram.com> incorporate the entirety of the Complainant's 2 INSTAGRAM 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 in the present case the addition of descriptive word “metaverso” to the disputed domain names <facebookmetaverso.com> and <instagrammetaverso.com>, and descriptive word “metaverse” to the disputed domain name <metaverseinstagram.com> would not prevent finding of confusing similarity with the Complainants' trademarks FACEBOOK and INSTARGAM respectively.

Considering the above the Panel finds the disputed domain names are confusingly similar to the Complainants' respective trademarks, therefore, the Complainants have established its case under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainants have established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain names.

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

The available evidence confirms that the Respondent is not commonly known by the disputed domain names, 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 Complainants 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 names could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The Panel also finds that The Respondent has no right or legitimate interests in the disputed domain names resolving to inactive websites (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 names and the confusingly similar well-known trademarks of the Complainants, the Panel finds that there is no plausible fair use to which the disputed domain names could be put that would not have the effect of being somehow connected to the Complainants (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 names. Therefore, the Complainants have 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 Complainants' trademarks FACEBOOK and INSTAGRAM are well established through long and widespread use and the Complainants have acquired a significant reputation and level of goodwill in its trademarks both in the United States and internationally. Thus, the Panel finds that the disputed domain names confusingly similar to the Complainants' respective trademarks were registered in bad faith.

According to section 3.1 of the [WIPO Overview 3.0](#), bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the complainant, paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, 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.

According to section 3.1.2 of the [WIPO Overview 3.0](#), a pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners. In the present case, the Respondent registered three trademark abusive disputed domain names targeting the Complainant 1 and the Complainant 2 within a short period of time, and the Panel considers such actions as a pattern of conduct preventing the Complainants to reflect its trademarks in corresponding domain names, which confirms 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 in the present case the Panel takes into account (i) the high degree of distinctiveness and reputation of the Complainants' trademarks, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the failure of the Respondent to react to the Complainants' attempt to settle amicably in regard of the disputed domain names <instagrammetaverso.com> and <metaverseinstagram.com>, (iv) the Respondent's concealing its identity while registering the disputed domain name, (v) the Respondent's pattern of bad faith conduct as expressed above, and (v) the implausibility of any good faith use to which the disputed domain name may be put. Thus, the Panel finds that the disputed domain names are used in bad faith.

Considering the above, the Panel finds the disputed domain names were registered and are being used in bad faith. Therefore, the Complainants have 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, <facebookmetaverso.com> be transferred to the Complainant 1, and the disputed domain names <instagrammetaverso.com> and <metaverseinstagram.com> be transferred to the Complainant 2.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: November 17, 2022