

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Adam Lee
Case No. D2022-2908

1. The Parties

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

Respondent is Adam Lee¹, United States.

2. The Domain Names and Registrar

The disputed domain names <instagransnft.com>, <instagransnfts.com>, <nftinstagrans.com> and <nftsinstagram.com> are all 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 6, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 9, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on August 10, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 16, 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”).

¹ The original Complaint identified Registration Private, Domains By Proxy, LLC as the Respondent. After the Registrar verified the underlying customer data, the Complaint was amended to list only the name of the underlying registrant (*i.e.*: Adam Lee), whom the Panel understands to be the proper Respondent.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2022. Respondent did not submit any response. Accordingly, the Center notified the Parties of Respondent's default on September 7, 2022.

The Center appointed Ingrīda, Kariņa-Bērziņa as the sole panelist in this matter on September 10, 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

Complainant operates the Instagram social networking service and mobile application. Complainant is the proprietor of numerous registrations for its INSTAGRAM mark ("INSTAGRAM Mark"), including the following:

- United States Trademark Registration No. 4146057 for INSTAGRAM (word mark), registered on May 22, 2012, for goods in class 9;
- International Trademark No. 1129314 for INSTAGRAM (word mark), registered on March 15, 2012, for goods and services in classes 9 and 42;
- European Union Trademark No. 012111746 for INSTAGRAM (device mark), registered on March 6, 2014, for goods and services in classes 9, 38, 41, 42, and 45.

The disputed domain names were all registered on July 11, 2021. Each of them redirects users to a parking page indicating that the disputed domain name may be available for sale and indicating a telephone number for purchase queries.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it has used the INSTAGRAM mark since 2011. The Instagram application enables its users to create their own personal profiles, post photos and videos, and connect with each other on their mobile devices. Instagram has more than five hundred million daily active accounts and more than one billion monthly active users from all over the world. According to Forbes magazine, the Instagram application is the second most downloaded app globally and the second most downloaded app in the United States. Complainant recently began testing a feature that allows Instagram users to buy and sell non-fungible tokens, also known as NFTs. The disputed domain names plainly misappropriate all of the textual components from Complainant's INSTAGRAM Mark.

Under the second element, Complainant states that it has neither licensed nor authorized Respondent to use the INSTAGRAM Mark, nor does Respondent have any legal relationship with Complainant that would entitle Respondent to use the INSTAGRAM Mark. Respondent is not known by the disputed domain names. Respondent is using each of the disputed domain names to redirect to a third-party commercial landing page that invites users to contact a phone number to verify that the domain name is for sale and to facilitate the purchase process.

Under the third element, Complainant states that Respondent has registered the disputed domain names that are confusingly similar to Complainant's INSTAGRAM Mark. The registrations postdate the registration and use of Complainant's Instagram Mark by many years. The INSTAGRAM Mark enjoys widespread

recognition and is obviously connected with Complainant and its well-publicized services, and the disputed domain names clearly reference these marks. Complainant is using the marks for commercial purposes by offering them for sale.

Complainant requests transfer of the disputed domain names.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the disputed domain names; and

(iii) Respondent has registered and is using the disputed domain names in bad faith.

Under paragraph 15(a) of the Rules, "[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".

A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the INSTAGRAM Mark through registrations in the United States, European Union, and international registrations. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

In comparing Complainant's marks with the disputed domain names, the Panel finds that the disputed domain names are confusingly similar to Complainant's mark. Each disputed domain name reflects Complainant's INSTAGRAM Mark. Two of the disputed domain names begin with the INSTAGRAM Mark, followed by the terms "nft" and "nfts." The other two disputed domain names begin with the terms "nft" and "nfts", followed by the INSTAGRAM Mark. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain names, 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 [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that the generic Top-Level Domain, in this case ".com", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names. Respondent is not authorized by Complainant and has no rights in the INSTAGRAM Mark. The disputed domain names comprise Complainant's INSTAGRAM Mark together with the dictionary terms "nft" or "nfts". Even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. In this case, noting the nature of the disputed domain names, and the well-established character of Complainant's INSTAGRAM Mark, the Panel finds that the disputed domain names carry a high risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names.

Respondent has not provided any rebuttal of Complainant's *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain names. There is no evidence that Respondent is commonly known by the disputed domain names or that any of the exceptions for noncommercial fair use would apply. The disputed domain names are used to redirect users to websites through which they are offered for sale. The Panel finds that Respondent has registered the disputed domain names primarily for the purpose of selling them, which is a commercial activity of a nature that does not confer rights or legitimate interests on Respondent. See [WIPO Overview 3.0](#), section 2.5.3.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain names. Complainant's rights in its INSTAGRAM Mark predate by approximately a decade the registration of the disputed domain names. The disputed domain names reflect Complainant's INSTAGRAM mark in its entirety, together with the dictionary terms "nft" or "nfts". The circumstances indicate that Respondent registered the disputed domain names likely in anticipation of Complainant's incorporating non-fungible tokens into its business offering. See [WIPO Overview 3.0](#), section 3.8.2 and cases cited thereunder. UDRP panels have consistently found that 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 on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

In this case, the record shows that Respondent deliberately targeted Complainant in incorporating Complainant's marks in the disputed domain names. The disputed domain names resolve to websites offering them for sale. The Panel finds that the circumstances, in particular, the distinctiveness and visibility of the INSTAGRAM Mark, together with the anticipatory incorporation of reference to non-fungible tokens and the absence of any good-faith indicia, indicate that Respondent registered the disputed domain names in bad faith for the purpose of selling them for valuable consideration probably in excess of the Respondent's costs related to the disputed domain names. See [WIPO Overview 3.0](#), section 3.1.1.

Respondent has provided no evidence of actual or contemplated good-faith use of the disputed domain names and the Panel does not find any such use plausible.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) 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 names, <instagransnft.com>, <instagransnfts.com>, <nftinstagrans.com> and <nftsinstagram.com> be transferred to Complainant.

/Ingrīda, Kariņa-Bērziņa/

Ingrīda, Kariņa-Bērziņa

Sole Panelist

Date: September 27, 2022