

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Sebastian Boender

Case No. D2022-2984

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Sebastian Boender, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <instagram.com> [xn--instagrm-tx0d.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 August 12, 2022. On August 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 15, 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 August 19, 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 22, 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 August 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2022. On September 1, 2022, the Respondent sent an email to the Center, indicating possible settlement, but did not submit any formal response. The Center sent

an email regarding possible settlement to the Complainant on September 12, 2022. On September 20, 2022, the Complainant requested to continue the proceeding. On September 21, 2022, the Center informed the parties that it will proceed to panel appointment.

The Center appointed Andrew F. Christie as the sole panelist in this matter on October 3, 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 operates the Instagram social networking service and mobile application. Instagram 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.

The Complainant is the owner of United States Registration No. 4146057 (registered on May 22, 2012), and European Union Trade Mark No. 014493886 (registered on December 24, 2015), both for the word trademark INSTAGRAM.

In addition to the domain name <instagram.com>, the Complainant owns and operates numerous other domain names consisting of the INSTAGRAM trademark in various generic Top-Level Domains (“gTLDs”) and country-code Top-Level Domains (“ccTLDs”), including <instagram.net> and <instagram.org>.

The disputed domain name was registered on June 1, 2017. The Complainant has provided an undated screenshot showing that the disputed domain name does not resolve to an active website. The Complainant provided a second undated screenshot of a punycode converter, which shows that <instagram.com> is represented by <xn--instagrm-tx0d.com> in punycode. The Complainant provided a third undated screenshot from a virus detecting website, stating in relation to the disputed domain name that “2 security vendors flagged this domain as malicious”. At the time of this decision, the disputed domain name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The disputed domain name is the internationalized domain name (“IDN”) <instagram.com>, which translates as <xn--instagrm-tx0d.com> in punycode. The disputed domain name plainly misappropriates sufficient textural components from the Complainant’s INSTAGRAM trademark, such that an ordinary Internet user who is familiar with the INSTAGRAM trademark would, upon seeing the disputed domain name, think an affiliation exists between the disputed domain name and the Complainant and/or its INSTAGRAM trademark. The disputed domain name features the Complainant’s entire INSTAGRAM trademark and merely replaces the second letter “a” with the character “ā”, which is nearly visually identical to the letter “a”. Such use of internationalized characters constitutes typosquatting and has consistently been found to satisfy the confusingly similar requirement of the Policy, paragraph 4(a)(i). The addition of a gTLD, has no distinguishing value in the paragraph 4(a)(i) analysis of the Policy.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not licensed or authorized the Respondent to use the Complainant’s INSTAGRAM trademark, and the Respondent does not have any legal relationship with the Complainant that would entitle the Respondent to use the INSTAGRAM trademark.

Neither the Whois data for the disputed domain name, nor the location to which the disputed domain name resolves, supports that the Respondent is known by the disputed domain name. The Respondent has no legitimate reason for using the INSTAGRAM trademark within the disputed domain name, and instead, is using it for abusive activity. The disputed domain name does not currently resolve to an active website. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent's registration and use of the disputed domain name is a violation of the Complainant's brand guidelines. The disputed domain name has been flagged for use in connection with phishing or other domain name abuse, and such use cannot amount to a legitimate noncommercial or fair use.

The Complainant made the following contentions to establish that 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 for use in connection with phishing and other suspicious activity. Registration of a confusingly similar domain name that is obviously connected with a particular trademark owner, by someone with no connection with the trademark owner, suggests bad faith. The Respondent registered the disputed domain name on June 1, 2017, which postdates the registration and use of the INSTAGRAM trademark by many years. Because the INSTAGRAM 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 and use 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 INSTAGRAM trademark and the Respondent's unauthorized incorporation of it 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 formally reply to the Complainant's contentions. However, on September 1, 2022, the Respondent submitted an email communication in which he, *inter alia*, indicated that he had never used the disputed domain name and offered to transfer the disputed domain name to another owner upon request.

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is an IDN – *i.e.*, a domain name that contains at least one label displayed in software applications (*e.g.*, an Internet browser) in a non-latin script or alphabet. An IDN is stored in the Domain Name System ("DNS") as an ASCII string using punycode transcription. In this case, the punycode transcription is <xn--instagrm-tx0d.com>, which displays in an Internet browser as <instagṛam.com>.

Once the gTLD ".com" is disregarded (which is appropriate in this case), the disputed domain name consists of the Complainant's registered word trademark INSTAGRAM, with the second "a" replaced with "ṛ". The Complainant's trademark is clearly recognizable within the disputed domain name. The substitution of the second "a" with "ṛ" does not avoid a finding of confusing similarity of the disputed domain name with the trademark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its INSTAGRAM trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name.

The evidence provided by the Complainant shows that the disputed domain name has been flagged by security vendors as malicious, for likely use in connection with phishing. Given the confusing similarity of the disputed domain name to the Complainant's trademark and the absence of any relationship between the Respondent and the Complainant, any use of the disputed domain name by the Respondent would be neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The disputed domain name was registered several years after the Complainant first registered its INSTAGRAM trademark. It is inconceivable that the Respondent registered the disputed domain name ignorant of the existence of the Complainant's trademark, given the renown of the Complainant's trademark, and that the disputed domain name consists of the trademark with merely the second "a" replaced by the almost identical "ā". Given the Respondent's lack of rights or legitimate interests in the disputed domain name and the confusing similarity of the disputed domain name to the Complainant's trademark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain name in these circumstances is a bad faith registration.

The fact that it is not clear whether the Respondent has used the disputed domain name does not preclude a finding of bad faith. As section 3.3 of the [WIPO Overview 3.0](#) explains, since inception of the UDRP panels have found that the non-use of a domain name does not prevent a finding of use in bad faith under the doctrine of passive holding. The factors that panels have considered relevant in determining if a passive holding of a domain name amounts to use in bad faith include the degree of distinctiveness or reputation of the complainant's mark, the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the domain name might be put. In this case, the Complainant's INSTAGRAM trademark has a very high degree of distinctiveness and reputation, the Respondent has not provided any evidence of actual or contemplated good faith use (rather, he indicated the disputed domain name has not been used), and the Panel is unable to conceive of a realistic good faith use to which the Respondent could put the disputed domain name.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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.com> [xn--instagrm-tx0d.com], be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: October 17, 2022