

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / jose dominguez
Case No. D2022-3147

1. The Parties

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

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / jose dominguez, United States.

2. The Domain Name and Registrar

The disputed domain name <metaversoinstagram.com> (the “Disputed Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 25, 2022. On August 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 29, 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 the same date, 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 31, 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 September 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 21, 2022. The Respondent sent an email communication to the Center on September 2, 2022, stating that it was willing to transfer the Disputed Domain Name to the Complainant, but did not submit a formal response. Accordingly, the Center proceeded to Panel Appointment on September 26, 2022.

On September 21, 2022, the Respondent sent an email to the Complainant, expressing its desire to settle the dispute by transferring the Disputed Domain Name to the Complainant. The Complainant responded on September 23, 2022, stating that it did not want to settle given that the proceeding was in progress and the Respondent did not respond when the Complainant's lawyers contacted the Respondent through the Registrar's contact form the previous year, as explained below in Section 4.

The Center appointed Lynda M. Braun as the sole panelist in this matter on September 30, 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 world-renowned online photo and video sharing social networking application. Since its launch in 2010, the Complainant has rapidly acquired and developed considerable goodwill and renown worldwide. Acquired by Meta Platforms, Inc. (formerly known as Facebook, Inc.) in 2012, the Complainant today is the world's fastest growing photo and video sharing and editing software and online social network, with more than one billion monthly active accounts worldwide. Given the exclusive online nature of the Complainant's business, the Complainant's domain names incorporating its trademark are not only the heart of its business but also a primary way for its millions of users to avail themselves of its services.

The Complainant owns numerous trademarks in jurisdictions worldwide, including but not limited to the following: INSTAGRAM, United States Registration No. 4,146,057, registered on May 22, 2012, in international class 9; INSTAGRAM, European Union Trade Mark No. 014493886, registered on December 24, 2015; in international classes 25, 35, 38, 41, and 45; and INSTAGRAM, International Trademark No. 1129314, registered on March 15, 2012, in international classes 9 and 42 (hereinafter collectively referred to as the "INSTAGRAM Mark").

The Disputed Domain Name was registered on October 29, 2021 and initially resolved to a landing page comprised of pay-per-click ("PPC") hyperlinks.¹ On April 19, 2022, the Complainant's lawyers, in an attempt to resolve this dispute amicably, submitted the Registrar's registrant contact form to reach out to the Respondent. The Respondent never responded to the message sent by the Complainant's lawyers.

5. Parties' Contentions

A. Complainant

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's 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.

¹ As of the writing of this Decision, however, the landing page states: This site can't be reached. metaversoninstagram.com's server IP address could not be found.

B. Respondent

The Respondent submitted an informal communication to the Center via email on September 2, 2022, stating that it agreed to transfer the Disputed Domain Name to the Complainant, but did not submit a formal response. On September 21, 2022, the Respondent sent an email to the Complainant, expressing its desire to settle the dispute by transferring the Disputed Domain Name to the Complainant. The Complainant responded on September 23, 2022, stating that it was not interested in settling.

6. Discussion and Findings

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 INSTAGRAM Mark.

It is uncontroverted that the Complainant has established rights in the INSTAGRAM Mark based on its fame as well as its registered trademarks for the INSTAGRAM Mark in the United States and other jurisdictions worldwide. The registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”. Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the INSTAGRAM Mark.

The Disputed Domain Name consists of the INSTAGRAM Mark in its entirety, preceded by the term “metaverso” (Spanish for metaverse), and then followed by the generic Top-Level Domain (“gTLD”) “.com”. The Disputed Domain Name is confusingly similar to the INSTAGRAM Mark since the trademark is incorporated in its entirety in the Disputed Domain Name. It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms [...] would not prevent a finding of confusing similarity under the first element”. For example, numerous UDRP decisions have reiterated that the addition of a term to a trademark does not prevent a finding of confusing similarity. See *Instagram, LLC v. Laremy Wade*, WIPO Case No. [D2022-1710](#) (holding that the disputed domain name incorporates the INSTAGRAM mark in its entirety followed by the term “metaverse”, and thus, remains sufficiently recognizable for a showing of confusing similarity under the Policy).

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 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant’s 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 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 initially resolve to a landing page displaying PPC 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 comprised of PPC 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 sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

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 contains the INSTAGRAM Mark in its entirety preceded by the term "metaverso", the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith to target the Complainant's 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 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 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 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 INSTAGRAM Mark worldwide, it strains credulity to believe that the Respondent had not known of the Complainant or its INSTAGRAM Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its INSTAGRAM Mark additionally suggests that the Respondent's objective in registering the Disputed Domain Name was to cause confusion with the Complainant's INSTAGRAM Mark. Moreover, the Complainant submits that the Respondent could not credibly argue that it did not have knowledge of the Complainant or its INSTAGRAM Mark when registering the Disputed Domain Name in 2021, by which time Instagram had amassed over 2 billion monthly active users. See *Instagram, LLC v. Bozulma Artik, hayat*, WIPO Case No. [D2021-4121](#) ("Given the popularity of the products and services offered by the Complainant and the reputation of the Complainant's INSTAGRAM trademark, it would be inconceivable that the Respondent registered the disputed domain name without knowledge of the INSTAGRAM trademark at the time of the registration.").

Fourth, the Respondent attracted users for commercial gain by displaying third party PPC links on the landing page to which the Disputed Domain Name initially resolved. 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 relationship to the Complainant or to the 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 registrant contact form sent by the Complainant's lawyers supports a finding of bad faith. Past UDRP panels have held that failure to respond to a demand letter or registrant contact form may be considered a factor in finding bad faith registration and use of a domain name. See *Facebook Inc. v. Yumei Luo*, WIPO Case No. [D2020-2306](#).

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 <metaversoinstagram.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: October 14, 2022