

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. James Gaston

Case No. D2023-1144

1. The Parties

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

The Respondent is James Gaston, United States.

2. The Domain Name and Registrar

The disputed domain name <instagramnft.org> 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 March 14, 2023. On March 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 2023, 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 (Registration Private, Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 2023, 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 March 23, 2023.

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 March 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2023. The Respondent did not submit a formal response. The Respondent communicated by email to the Center on April 4, 2023, and on April 6, 2023, denying wrongdoing but asserting that the Respondent would cancel the registration of the disputed domain name.

The Center appointed William F. Hamilton as the sole panelist in this matter on April 28, 2023. 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, Instagram, LLC (“Instagram”), is an internationally renowned online photo and video sharing social-network application. Instagram has more than 1 billion monthly active accounts worldwide. Instagram’s principal website is “www.instagram.com”. Among other trademark registrations for the trademark INSTAGRAM, the Complainant owns United States Trademark Registration No. 4,146,057, dated May 22, 2012.

The disputed domain name was registered on March 29, 2022. The disputed domain does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name adopts the Mark entirely and merely adds the expression or abbreviation “nft”, meaning non-fungible token, as a suffix to the Mark. The Complainant asserts that the Complainant never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, never operated a business under the disputed domain name, has not advertised the disputed domain name, and never engaged in any *bona fide* commercial activity in connection with the disputed domain name. The Complainant asserts that the Respondent knew or should have known of the Mark with reasonable investigation and registered and used the disputed domain name in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant’s contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s Mark.

The disputed domain name is composed of the Mark which is immediately followed by the commonly used abbreviation “nft” rendering the disputed domain name confusingly similar to the Mark. *Giorgio Armani S.p.A Milan Swiss Branch Mendrisio v. Mage Enterprises Inc.*, WIPO Case No. [D2011-1172](#). A domain name which wholly incorporates a complainant’s registered mark is sufficient to establish confusingly similarity for

the purposes of the Policy, the addition to the Mark of a dictionary term does not prevent a finding of confusing similarity. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7; *Nomura International Plc / Nomura Holdings, Inc. v. Global Domain Privacy / Nicolas Decarli*, WIPO Case No. [D2016-1535](#) (transferring <nomura-bank.com>). See also [WIPO Overview 3.0](#), section 1.8 ("where the relevant trademark is recognizable with the disputed domain name, the additions of other terms (whether descriptive, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element"); *Nomura International Plc and Nomura Holdings, Inc. v. Whois Privacy Protection Service, Inc. / PUK SERVICES*, WIPO Case No. [D2015-2036](#) (transferring <nomuralabuan.com>); *Nomura International Plc. v. Name Redacted*, WIPO Case No. [D2021-0654](#).

The Top-Level Domain of the disputed domain name, in this case ".org", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. [D2016-1759](#).

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel finds on the evidence presented that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. The Complainant has established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent.

The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name. The disputed domain name does not resolve to an active website, and the disputed domain name will likely confuse unsuspecting Internet users into believing the disputed domain name should resolve to a website associated, sponsored, or affiliated with the Complainant.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following non-exhaustive scenarios:

- (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 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.

The Panel finds on the evidence presented that the disputed domain name was registered and is being used in bad faith.

The Mark is famous in the United States where the Respondent resides. It strains credulity to believe that the Respondent innocently and unknowingly composed the disputed domain name composed of the Complainant's Mark and the common abbreviation "nft". On balance, the Panel finds that the Respondent was aware of the Complainant's well-known Mark when registering and using the disputed domain name to attract unsuspecting Internet users interested in purchasing or obtaining non-fungible tokens sponsored or affiliated with the Complainant.

The disputed domain name does not resolve to an active website. However, "the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity". [WIPO Overview 3.0](#), section 3.4.

The circumstances of this case require the conclusion that the disputed domain name was registered in bad faith. The Mark is well-known; the disputed domain name is an obvious attempt to attract unsuspecting internet users; the Respondent did not formally respond to the Complaint, and did not provide any reasonable explanation for the registration of the disputed domain name; and the Respondent agreed to cancel the registration of the disputed domain name after the filing of the Complaint.

The Panel finds that the Respondent specifically targeted the Complainant and its Mark and registered the disputed domain name with the intent to divert Internet traffic and benefit commercially from unsuspecting Internet users seeking out the Complainant. The Complainant has met its burden 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 <instagramnft.org> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: May 12, 2023