

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Nguyen Vu
Case No. D2023-1690

1. The Parties

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

The Respondent is Nguyen Vu, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <niceinsta.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2023. On April 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 18, 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 (Redacted for Privacy Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 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 April 25, 2023.

The Center verified that the Complaint together with 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 April 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 24, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on June 9, 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 operates the Instagram social networking service and mobile application (“app”), presently having more than two billion active accounts and being the second most downloaded app globally and the second most downloaded app in the United States, according to Forbes magazine.

The Complainant is the owner, amongst numerous others, of the following trademark registrations:

- International trademark registration No. 1129314, for INSTAGRAM, registered on March 15, 2012;
- United States trademark registration No. 4,146,057, for INSTAGRAM, registered on May 22, 2012;
- United States trademark registration No. 5,061,916, for INSTA, registered on October 18, 2016;
- European Union trademark registration No. 014810535, for INSTA, registered on May 23, 2018; and
- Chinese trademark registration No. 28459139, for INSTA, registered on December 14, 2018.

The disputed domain name was registered on November 2, 2019, and presently does not resolve to an active webpage. It has been used in connection with a website purportedly offering for sale “Instagram followers” as well as “Instagram Likes” and “Instagram Comments” stating that “If you want visibility in Instagram’s world, you will need more followers”. (Annex 10 to the Complaint).

5. Parties’ Contentions

A. Complainant

The Complainant asserts to be one of the world’s leading providers of online social networking services and applications, actively promoting and using its INSTAGRAM trademark throughout the world.

According to the Complainant, the disputed domain name resolved to a website that purportedly offered for sale as monthly subscription services, the sale of Instagram followers, likes and comments, having the Respondent chosen a very similar color scheme at the website to the one used at the Complainant’s webpage and logo (Annex 10 to the Complaint).

The Complainant further states to have sent a cease and desist letter to the Respondent (Annex 13 to the Complaint) but received no reply.

The disputed domain name <niceinsta.com> is, according to the Complainant, confusingly similar to the Complainant’s INSTA and INSTAGRAM trademarks, creating a likelihood of confusion given the reproduction of its trademark preceded with the addition of the descriptive term “nice”, what does not prevent a finding of confusing similarity.

Moreover, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the Respondent is not a licensee of the Complainant, nor has he been otherwise allowed by the Complainant to make any use of the INSTA or INSTAGRAM trademarks, in a domain name or otherwise;
- (b) the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy given that the Respondent is making unauthorized use of the Complainant’s INSTA and INSTAGRAM trademarks to market its own ancillary services in relation to the Complainant;

- (c) the Respondent fails to accurately and prominently disclose the Respondent's relationship with the Complainant, in spite of having placed a small disclaimer at the bottom of the Respondent's website;
- (d) the Respondent's website makes explicit reference to "Instagram" and uses a very similar color scheme to that used by the Complainant as described above, with the effect that Internet users are misled into believing that the Respondent is affiliated with the Complainant, what is not true;
- (e) the services offered via the Respondent's website, as described above, violate the Complainant's Terms of Use and Facebook's Developer Policies, which apply to Instagram, having automated Instagram activities and user actions such as comments the effect of misleading Instagram users and fake or "automated" likes and followers and related actions give the false impression of genuine interest in the relevant content posted, what cannot be considered a legitimate noncommercial or fair use of the disputed domain name or a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy; and
- (f) there is no evidence to suggest that the Respondent is commonly known by the Domain Name, as contemplated by paragraph 4(c)(ii) of the Policy.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that the Respondent knew or should have known of the Complainant's trademark rights at the time of the registration of the disputed domain name considering that it has acquired considerable goodwill and renown worldwide. Further, the Respondent's intent to target the Complainant can easily be inferred from the content of the website at the disputed domain name, which makes explicit reference to Instagram.

The Complainant further submits that the Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the website purportedly offering the creation of fake Instagram accounts, or hacking into existing accounts, which is also clearly illegitimate and constitutes an additional indication of the Respondent's bad faith (*Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Yan Jiang and Whois Domain Admin / Li Dan*, WIPO Case No. [D2020-2092](#)). Furthermore, the Complainant contends that the lack of adequate disclaimer on the Respondent's website clarifying the Respondent's relationship (or lack thereof) with the Complainant further adds to the confusion caused by the disputed domain name and constitutes additional evidence of the Respondent's intentional bad faith conduct. Lastly, the Complainant indicates that the Respondent's failure to reply to the Complainant's cease and desist letter may also be considered an additional indicator of the Respondent's bad faith, as well as the choice to retain a privacy protection service to conceal the Respondent's identity.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 has been registered and is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established its rights in the INSTA and INSTAGRAM trademarks.

The Panel finds that the disputed domain name reproduces the Complainant's trademark in its entirety. The addition of the terms "nice" does not avoid a finding of confusing similarity under the Policy which, as recognized by past UDRP panels, involves a "comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name". (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.)

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In the present case, the Respondent used the disputed domain name in connection with a website that clearly offered services such as the creation of fake Instagram accounts, or false likes and comments, which clearly cannot be considered a *bona fide* offering of goods or services.

In addition to that, the absence of any indication that the Respondent has been commonly known by the disputed domain name, or that it has acquired any registered trademarks or trade names corresponding to the disputed domain name, as well as the Complainant's statement that no authorization, license or permission has been given for the Respondent to register and use the disputed domain name corroborate with the indication of the Respondent's lack of rights or legitimate interests in the disputed domain name.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) of the Policy that bad faith registration and use can be found in respect of the disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, the use of the disputed domain name in connection with a website that purportedly offered the

creation of fake Instagram accounts, likes and comments characterizes the Respondent's intent of commercial gain by misleadingly diverting the Complainant's consumers.

Three other elements that corroborate the finding of the Respondent's bad faith conduct in this case are: (i) the Respondent's lack of reply to the cease and desist letter sent by the Complainant prior to this procedure; (ii) the Respondent's choice to retain a privacy protection service to conceal its identity; and (iii) the indication of what it appears to be false or incomplete contact details, not having the Center fully been able to deliver communications to the Respondent.

For the reasons above, the Panel finds that the Respondent's conduct amounts to bad faith registration and use of the disputed domain name pursuant to paragraph 4(b)(iv) 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 <niceinsta.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: June 23, 2023