

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. Manager Gram

Case No. D2023-2049

### **1. The Parties**

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

The Respondent is Manager Gram, United States.

### **2. The Domain Names and Registrar**

The disputed domain names <managergram.com> and <managergram.net> are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 8, 2023. On May 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 9, 2023, 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 (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 May 11, 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 May 15, 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 May 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 13, 2023.

The Center appointed Evan D. Brown as the sole panelist in this matter on June 20, 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 social media platform Instagram, and owns the trademark INSTAGRAM, which is registered in a number of jurisdictions, including the United States (Reg. No. 4,146,057, registered on May 22, 2012).

According to the WhoIs records, the disputed domain names were registered on January 10, 2017. The Respondent has set the disputed domain names to display a website that purports to offer paid subscriptions including Instagram likes, followers, views, and comments, as well as “Instagram growth plans”. The disputed domain name <managergram.net> redirects to the disputed domain name <managergram.com> at which the mentioned-website is displayed. The Respondent offers different paid monthly subscription plans that cover different levels of Instagram engagement. The website displays a logo which is a modified version of the Complainant’s stylized trademark, using a similar font and color scheme. It also uses the Complainant’s INSTAGRAM logo and trademark and a similar color scheme or color gradient to the Complainant’s color gradient. The Respondent’s website also offers for sale services targeting various third parties including TikTok and Spotify.

On February 20, 2023, the Complainant’s lawyers sent a cease and desist letter to the registrant of the disputed domain names by email and sent a notice to the Respondent via the Registrar’s contact form in relation to the disputed domain name <managergram.com>. The Complainant received no response to these communications.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and that the disputed domain names were registered and are being used in bad faith.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are 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 names, and (iii) the disputed domain names have been registered and are being used in bad faith. The Panel finds that all three of these elements have been met in this case.

##### **A. Identical or Confusingly Similar**

This first element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. This element

requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain names are identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the INSTAGRAM mark by providing evidence of its trademark registrations.

This test under this element typically involves a side-by-side comparison of the disputed domain names and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain names. [WIPO Overview 3.0](#), section 1.7. In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain names to ascertain confusing similarity. *Id.*

Guided by these principles, the Panel finds that the disputed domain names are confusingly similar to the Complainant's INSTAGRAM mark. The disputed domain names both incorporate the "gram" portion of the mark. The Complainant's mark remains recognizable for a showing of confusing similarity under the Policy.

The content of the website associated with a domain name is usually disregarded by panels when assessing confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.15. In some instances, however, panels have taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears *prima facie* that the respondent seeks to target a trademark through the disputed domain name. Guided by these principles, the Panel takes note of the content of the Respondent's website - which purports to provide products relating to the Complainant and competing social media platforms using marks and colors similar to those of the Complainant—to confirm the confusing similarity between the disputed domain names and the Complainant's mark.

Based on the available record, the Panel finds the first element of the Policy has not been established.

## **B. Rights or Legitimate Interests**

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain names. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts, among other things, that: (1) the Respondent is not using the disputed domain names in connection with any *bona fide* offering of goods or services, (2) the Respondent is not commonly known by the disputed domain names, and (3) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names.

UDRP panels have recognized that website operators using a domain name containing a complainant's trademark to undertake sales related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "*Okidata test*", (*Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

The Panel has applied the *Oki Data* test to the facts of this case and finds that the circumstances do not warrant the finding of a *bona fide* offering of goods and services. In particular, the record shows the website associated with the disputed domain names was used to promote services other than the trademarked goods (*i.e.*, other than services relating to Instagram). For example, the Respondent’s website also offers for sale services targeting various third parties including TikTok and Spotify.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent’s favor.

Based on the available record, the Panel finds the second element of the Policy has not been established.

### **C. Registered and Used in Bad Faith**

Because the Complainant’s INSTAGRAM marks are well-known, and are registered in jurisdictions around the world, the Panel finds it likely that the Respondent was aware of those marks when it registered the disputed domain names. In the circumstances of this case, without the benefit of any explanation whatsoever from the Respondent as to a possible good faith use of the disputed domain names, such a showing is sufficient to establish bad faith registration of the disputed domain names.

The circumstances also demonstrate bad faith use of the disputed domain names in terms of the Policy. Where a disputed domain name is “so obviously connected with such a well-known name and products...its very use by someone with no connection with the products suggests opportunistic bad faith”. See, *Parfums Christian Dior v. Javier Garcia Quintas*, WIPO Case No. [D2000-0226](#). Bad faith use of the disputed domain names is shown from the commercial nature of the websites associated with the disputed domain names, *i.e.*, using the disputed domain names—which are confusingly similar to the Complainant’s mark—to purportedly offer services in exchange for money.

The Panel finds that the Complainants have succeeded under this third element.

## **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 <managergram.com> and <managergram.net> be transferred to the Complainant.

*/Evan D. Brown/*

**Evan D. Brown**

Sole Panelist

Date: July 7, 2023