

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. Thomas Beich  
Case No. D2023-4767

### **1. The Parties**

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

The Respondent is Thomas Beich, United Kingdom.

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

The disputed domain name <igreelsvideodownloader.com> (the “Domain Name”) is registered with IONOS SE (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 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 November 27, 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 December 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 26, 2023.


The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on January 16, 2024. 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 the owner of an online photo and video sharing social networking application called Instagram, also known as IG. The Complainant was acquired by Meta Platforms, Inc. ("Meta") in 2012. On August 5, 2020, the Complainant launched a new feature called "Instagram Reels", enabling users to create and discover short, entertaining videos on Instagram.

The Complainant owns a number of trade mark registrations for IG and REELS, including (hereafter the "Trade Marks"):

- European Union Trade Mark No. 017946393, IG, registered on January 31, 2019
- Indian Trade Mark No. 4750300, REELS, registered on November 20, 2020
- Mexican Trade Mark No. 2203257, REELS, registered on February 10, 2021.

In addition, the Complainant owns United States Trade Mark No. 5299116,  (device mark) registered on October 3, 2017 (the "Device Mark").

The Domain Name was registered on September 26, 2022, and resolves to a website which purports to provide a tool to download content from Instagram (the "Website"). The Website is currently inactive.

Based on evidence provided by the Complainant, the Website at some point in time stated:

"IG REELS VIDEO

DOWNLOADER

INSTAGRAM STORY SAVER

PICTURE

DOWNLOADER

EXPLORE THE WORLD OF DOWNLOADER

The main purpose of making this tool is to help users that face issues in video downloading or some else from instagram. (sic.)"

In addition, the Website prominently displayed the Trade Marks and the Device Mark of the Complainant.

On September 28, 2023, the Complainant's lawyers sent a cease-and-desist letter to the Respondent to the email address displayed on the website to which the Domain name resolves, receiving a bounce back message. On the same day, the Complainant's lawyers also sent the cease-and-desist letter to the privacy email address displayed in the Whois record of the Domain Name asking the privacy service to forward their communication to the Respondent. The Complainant's lawyers then sent a follow up message to the privacy email address on October 5, 2023.

The Respondent did not reply to any of these communications.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name, as set out below.

The Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy. The Domain Name comprises the Trade Marks in their entirety as the leading element of the Domain Name, together with the descriptive terms "video" and "downloader" under the generic Top-Level Domain ("gTLD") ".com". The addition of the terms "video" and "downloader" to the Trade Marks does not prevent a finding of confusing similarity, while the gTLD ".com" may be disregarded for the purposes of assessment under paragraph 4(a)(i) of the Policy.

The Respondent has no rights or legitimate interests in the Domain Name, in accordance with paragraph 4(a)(ii) of the Policy. The Respondent is not using the Domain Name in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. The Respondent is not a licensee of the Complainant, is not affiliated with the Complainant in any way, while the Complainant has not granted any authorization for the Respondent to make use of the Trade Marks, in a domain name or otherwise.

The website to which the Domain Name resolves purportedly provides a tool for downloading content from Instagram. The Respondent is not providing sales or repairs in relation to a product provided by the Complainant, but is making unauthorized use of the Trade Marks to market its own ancillary services consisting of providing a tool for downloading of content from Instagram. The tool purportedly offered on the Website is in breach of the applicable Developer Policies, as the creation of a tool that facilitates the downloading of content from the Instagram platform goes beyond the limits that Instagram has placed on the functionality of its own product. Not only does the provision of such a tool violate the Complainant's Terms of Use and the Meta Developer Policies – it also places the privacy and security of Instagram users at risk, as content scraped from Instagram's platform may be stored and later used for unauthorized purposes by third parties. 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. The Domain Name was registered using a privacy service and there is no indication as to the Respondent's identity on the Website to which the Domain Name resolves. The Respondent's use of the Domain Name does not support any reasonable claim of being commonly known by the Domain Name, nor does it give rise to any reputation in the Domain Name itself, independent of the Trade Marks.

Nor is the Respondent making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers, within the meaning of paragraph 4(c)(iii) of the Policy, as it is used to provide a tool that allows Internet users to download content from Instagram.

The Domain Name was registered and is being used in bad faith for reasons that go beyond the scope of the examples listed at paragraph 4(b) of the Policy.

The Trade Marks are inherently distinctive and well known throughout the world in connection with the Complainant's online photo-sharing social network. When the Respondent registered the Domain Name in September 2022, Instagram had amassed over 2 billion monthly active users. The term "IG Reels" is highly distinctive and exclusively associated with the Complainant, as all search results obtained by typing this term into the Google search engine refer to the Complainant. Taking also into account the nature of the Domain Name (i.e., confusingly similar to the Trade Marks) and the fact that it was registered more than two years after the Complainant's official launch of its short-video feature "Instagram Reels", the Respondent could not credibly argue that it did not have knowledge of the Trade Marks when registering the Domain Name. The Respondent's intent to target the Complainant when registering the Domain Name may be inferred from the contents of the website to which the Domain Name points, which makes prominent use of the Trade Marks. It may be inferred from the above that the Respondent registered the Domain Name with a view to attracting

Internet users to the Website resulting from a perceived association between the Domain Name and the Trade Marks.

The Domain Name is used by the Respondent to point to a website which offers tools for the unauthorized downloading of content on Instagram, going beyond the technical limits that have been placed on the platform, in violation of the Meta Developer Policies. Such tools may place the privacy and security of Instagram users at risk, given that such content may be stored and later used for unauthorized purposes by third parties. In light of the similarity between the Domain Name and the Trade Marks, and further noting the extensive mention of the Complainant on the Respondent's website, as well as the Respondent's use of the Device Mark and its modified version on the Website, Internet users are likely to be misled into believing that the Website is affiliated with or otherwise endorsed by the Complainant.

The Respondent's failure to respond to the Complainant's cease-and-desist letter is an additional indication of the Respondent's bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Trade Marks and the Domain Name (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7).

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates both the Trade Mark IG and the Trade Mark REELS in their entirety. The addition of the terms "video" and "downloader" does not prevent a finding of confusing similarity between the Domain Name and the Trade Marks (see [WIPO Overview 3.0](#), section 1.8; see also, inter alia, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The gTLD ".com" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11.1). Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent is not affiliated with the Complainant and the Complainant has not granted any license or other authorization for the Respondent to make use of the Trade Marks, in a domain name or otherwise. The Respondent is not using the Domain Name in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy since it is making unauthorized use of the Trade Marks and the Domain Name to market on the Website its own ancillary services consisting of a tool for downloading content from Instagram. The Respondent thereby also misleadingly suggests a non-existent connection or relationship with the Complainant, without properly disclosing this circumstance on the Website. Nor is such use a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers, within the meaning of paragraph 4(c)(iii) of the Policy. Furthermore, 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.

Furthermore, the composition of the Domain Name, incorporating both Complainant's Trade Marks in their entirety combined with related terms to the Complainant's activity, carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Based on the undisputed information and evidence provided by the Complainant, the Panel finds that the registration is in bad faith. At the time of registration of the Domain Name, the Respondent was or should have been aware of the Complainant and the Trade Marks, since:

- the Respondent's registration of the Domain Name occurred three years after the registration of the earliest of the Trade Marks;
- the Respondent has incorporated in the Domain Name both the Trade Mark IG and the Trade Mark REELS in their entirety, and this combination is not a name that it is likely that a registrant would spontaneously think of when registering a domain name;
- a simple trade mark register search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks.

With regard to bad faith use, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the Domain Name:

- the use on the Website of the Trade Marks, as well as the Device Mark, to offer services competing with those of the Complainant, thereby misleadingly suggesting a connection or relationship with the Complainant which does not exist.
- the Respondent was more likely than not aware of the Complainant's rights in the Trade Marks;
- the lack of a response to the cease-and desist letters;
- the failure to submit a Response;
- the use of a fake address upon registration of the Domain Name.

The Panel finds that the Complainant has established the third element 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 <igreelsvideodownloader.com> be transferred to the Complainant.

*/Wolter Wefers Bettink/*

**Wolter Wefers Bettink**

Sole Panelist

Date: January 30, 2024