

## ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Van Nam Tran, University  
Case No. D2024-1576

### 1. The Parties

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

Respondent is Van Nam Tran, University, Viet Nam.

### 2. The Domain Names and Registrar

The disputed domain names <downloadgram.pro> (“disputed domain name No. 1”) and <instaviewers.net> (“disputed domain name No. 2”) are registered with Name.com, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 11, 2024. On April 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, 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) and contact information in the Complaint. The Center sent an email communication to Complainant on April 22, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 26, 2024.<sup>1</sup>

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 Respondent of the Complaint, and the proceedings commenced on May 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 22, 2024.

---

<sup>1</sup> Complainant removed one domain name from the proceeding upon receipt of the Center’s notice of multiple underlying registrants.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on May 28, 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

Complainant is a company organized under the laws of the United States which operates the well-known online photo and video-sharing social-networking service and mobile application "Instagram".

Complainant has provided evidence that it is the registered owner of numerous trademarks worldwide relating to its INSTAGRAM company name and brand and its GRAM and INSTA brands, including, but not limited, to the following:

- word mark GRAM, European Union Intellectual Property Office, registration number: 017642729, registration date: March 23, 2019, status: active;
- word mark INSTA, United States Patent and Trademark Office ("USPTO"), registration number: 5061916, registration date: October 18, 2016, status: active;
- word mark INSTAGRAM, USPTO, registration number: 4146057, registration date: May 22, 2012, status: active.

Moreover, Complainant has evidenced to own various domain names relating to its INSTAGRAM company name and brand and its GRAM and INSTA brands, inter alia, since 2004 the domain name <instagram.com>, used to run the "Instagram" social network application.

Respondent, according to the Registrar's verification, and to the disclosed Whols information for both disputed domain names, is located in Viet Nam.

The disputed domain name No. 1 was registered on May 30, 2022. Complainant has demonstrated that, at some point before the filing of the Complaint, the disputed domain name No. 1 resolved to an active website titled "DownloadGram", which purported to provide a free tool for downloading content from Complainant's Instagram platform and which featured a black-and-white version of Complainant's official INSTAGRAM logo and figurative trademark without any authorization to do so. Such website, moreover, contained at the bottom in small red font the following text:

"Disclaimer: DownloadGram.Pro is new version of DownloadGram.Com does not host any pirated or copyright content on its server, and all the videos that you download are downloaded to your system directly from their respective CDN servers. All Instagram TM logos and trademarks displayed on this application are property of Instagram."

In the footer of such website, the text appeared:

"2014-2024 DownloadGram by Ayesh".

The disputed domain name No. 2 was registered on June 20, 2022. Complainant has demonstrated that, at some point before the filing of the Complaint, the disputed domain name No. 2 resolved to an active website titled "InstaViewers.Net/Insta Story Viewer", which purported to provide a free tool for downloading stories from Complainant's Instagram platform (thus, effectively enabling Internet users to "anonymously" watch Instagram stories) and which featured a similar version of Complainant's official INSTAGRAM logo and figurative trademark as well as commercial advertising banners without any authorization to do so.

Such use of the disputed domain names to provide tools to download content and/or stories from Complainant's Instagram platform, which goes beyond the technical limits placed on the platform by Complainant itself, is in violation of the Meta Developer Policies.

Complainant requests that the disputed domain names be transferred to Complainant.

## 5. Parties' Contentions

### A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names. Notably, Complainant contends that its social network application "Instagram" is worldwide renowned as the world's fastest growing photo/video-sharing and editing software and online social network, with more than 2.4 billion monthly active accounts worldwide and constantly ranked amongst the top "apps" for mobile devices.

Complainant submits that the disputed domain names are confusingly similar to its GRAM and INSTA trademarks, as they comprise the latter in full, preceded by the term "download" or followed by the term "viewers", respectively.

Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain names since (1) Respondent is not a licensee of Complainant, is not affiliated with Complainant in any way, and has not been authorized to make any use of Complainant's GRAM, INSTA and/or INSTAGRAM trademarks in a domain name or otherwise, (2) Respondent cannot be viewed as a bona fide service provider as it did not provide sales or repairs in relation to a product provided by Complainant, but rather made unauthorized use of Complainant's GRAM, INSTA and INSTAGRAM trademarks to market its own ancillary services, namely providing tools that enable Internet users to download content from Complainant's Instagram platform, (3) even if one is to apply the *Oki Data* criteria (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), Respondent does not satisfy them, since (a) the wording featured in small font at the bottom of the website to which the disputed domain name No. 1 resolved, neither accurately nor prominently disclosed Respondent's lack of relationship with Complainant, but rather, by making specific reference to "Instagram" and featuring an image that is very similar to Complainant's official logo, suggested that Respondent was affiliated with Complainant, which is not the case, and (b) similarly, the website to which the disputed domain name No. 2 previously resolved did not feature any wording in relation to the lack of relationship between Respondent and Complainant, (4) further, Respondent's previous use of the disputed domain names violates the Meta Developer Policies by going beyond the limits placed on the functionality of the Instagram platform, and facilitates breach of the Instagram Terms of Use, (5) Respondent is not commonly known by the disputed domain names, and there is no evidence of Respondent having acquired or applied for any trademark registrations for "gram", "insta" or any variation thereof, as reflected in the disputed domain names, and finally (6) Respondent has used the disputed domain names to exploit the goodwill and reputation associated with Complainant's GRAM and INSTA trademarks by creating a false impression of association with Complainant, and so has misleadingly diverted Internet users to its websites.

Finally, Complainant argues that Respondent has registered and is using the disputed domain names in bad faith since (1) Complainant's GRAM and INSTA trademarks are well-known throughout the world in connection with Complainant's Instagram platform, and Respondent could not credibly argue that it did not have knowledge of Instagram or Complainant's related trademark registrations when registering the disputed domain names between May 30, 2022, and June 20, 2022, (2) Respondent's intent to target Complainant when registering the disputed domain names may be inferred from the contents of Respondent's websites, which made explicit reference to Complainant's INSTA and INSTAGRAM trademarks and featured images that are very similar to Complainant's figurative trademarks and Instagram logo, and finally (3) Respondent has used the disputed domain names to purport to provide tools to download content from Complainant's Instagram platform, which goes beyond the technical limits placed on the platform by Complainant, and, thus, is in violation of the Meta Developer Policies.

## B. Respondent

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

### A. Identical or Confusingly Similar

First, 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 Complainant's GRAM and INSTA trademarks and the disputed domain names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of its GRAM and INSTA trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Also, the entirety of those trademarks is reproduced within the disputed domain names, simply added by the terms "download" and "viewers". Accordingly, the disputed domain names are confusingly similar to Complainant's trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Although the addition of such other terms (here, "download" and "viewers") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and Complainant's GRAM and INSTA trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel, therefore, finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

Second, paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names. Respondent has not rebutted

Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

In particular, Respondent has not been authorized to use Complainant's GRAM, INSTA, or INSTAGRAM trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain names and Respondent does not appear to have any trademark rights associated with the terms "gram" and/or "insta" and/or "Instagram" on its own. To the contrary, both disputed domain names at some point resolved to websites which purported to provide a free tool for downloading content and/or stories from Complainant's Instagram platform, thereby going beyond the technical limits placed on the platform by Complainant, and also prominently displaying some variations of Complainant's official logo, without any authorization to do so. Such making use of the disputed domain name neither qualifies as bona fide nor as legitimate noncommercial or fair within the meaning of the Policy (not even so under the so-called "Oki Data" principles which would have required Respondent e.g. to accurately and prominently disclose on such websites the nonexistent relationship between Respondent and Complainant as the GRAM, INSTA and INSTAGRAM trademark holder, which Respondent obviously and quite to the contrary did not, see [WIPO Overview 3.0](#), section 2.8). Moreover and in this context, panels have also long held that the use of a domain name for illegal activity (here: circumventing Complainant's technical measures) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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

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

Finally, 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.

The circumstances in this case leave no doubt that Respondent was fully aware of Complainant's worldwide renowned social network application "Instagram" and its rights in the GRAM, INSTA and INSTAGRAM trademarks when registering the disputed domain names and that they clearly are directed thereto. Moreover, using the disputed domain names to run websites which purport to provide a free tool for downloading content and/or stories from Complainant's Instagram platform, thereby prominently displaying some variations of Complainant's official logo, without any authorization to do so, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own websites by creating a likelihood of confusion with Complainant's GRAM, INSTA and INSTAGRAM trademarks as to the source, sponsorship, affiliation or endorsement of Respondent's websites. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In this context, panels have also long held that the use of a domain name for illegal activity (here: circumventing Complainant's technical measures) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Last, it also carries weight in the eyes of the Panel that Respondent obviously provided incorrect or incomplete contact information at the time of registration of the disputed domain names, as the Written Notice on the Notification of Complaint dated May 1, 2024, could not be sent to Respondent by postal courier. This fact at least throws a light on Respondent's behavior which further supports the Panel's bad faith finding.

Having reviewed the record, the Panel, therefore, holds Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy, so that Complainant has established the third element of the Policy, too.

## 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 <downloadgram.pro> and <instaviewers.net> be transferred to Complainant.

*/Stephanie G. Hartung/*

**Stephanie G. Hartung**

Sole Panelist

Date: June 11, 2024