

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc. and Instagram, LLC v. Cu Thi Thuy
Case No. D2024-2690

1. The Parties

The Complainants are Meta Platforms, Inc., United States of America (“USA”) and Instagram, LLC, USA, represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Cu Thi Thuy, Viet Nam.

2. The Domain Names and Registrar

The disputed domain names <facebook-learn.com>, <igconverter.com>, <igdownloader.net>, and <igdown.net> are registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 1, 2024. On July 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 3, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of the disputed domain names and providing the contact details.

The Center verified that the 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 July 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2024. The Response was filed with the Center on July 24, 2024.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on September 11, 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

Description of the Parties

The Complainant Meta Platforms, Inc. (“Complainant 1”), until 2021 known as Facebook, Inc., is a social technology company operating, inter alia, the social media network Facebook. The Complainant 1’s Facebook platform was founded in 2004 and is a world renown provider of social networking services. People use Facebook to stay connected with friends and family and to share and express what matters to them. By September 2012, Facebook counted 1 billion users, and by December 31, 2023, there were 3.07 billion active users worldwide (Annex 6 to the Complaint).

The Complainant Instagram, LLC (“Complainant 2”), was acquired by the Complainant 1 in 2012 and operates the application Instagram, launched in 2010 and a likewise world-renown online photo and video sharing social-networking application with more than 2.4 billion monthly active accounts worldwide (Annex 11 to the Complaint). According to the online dictionaries Thesaurus.com and Dictionary.com, Instagram is, in a social media context, commonly addressed by the acronym IG (Annex 10 to the Complaint).

The Complainants own trademarks worldwide in the designations Facebook and IG, including the following (Annex 13 to the Complaint):

- USA trademark registration no. 3,041,791 FACEBOOK (word), for services in Classes 35 and 38, registered on January 10, 2006;
- European Union (“EU”) trademark registration no. 005585518 FACEBOOK (word), for services in Classes 35, 41, 42, and 45, registered on May 25, 2011;
- EU trademark registration no. 017946393 IG (word) for goods and services in Classes 9, 42, and 45, registered on January 31, 2019;
- Australian trademark registration no. 1950863 IG (word) for services in Class 45, registered on August 24, 2018.

The Complainants are, amongst others, owners of the domain names <facebook.com> and <instagram.com>, respectively, for their Facebook and Instagram websites (Annexes 7, 9 and 12 to the Complaint). As far as the Instagram website is concerned, it displays a logo/favicon in the form of a stylized camera in pink as well as a gradient colour scheme ranging from yellow via pink to purple, which is subject to trademark protection on behalf of the Complainant 2 as well.

The Respondent has registered the disputed domain names as follows: the disputed domain name <facebook-learn.com> was registered on December 3, 2020, <igconverter.com> on November 17, 2021, <igdownloader.net> on December 21, 2020, and <igdown.net> registered on December 17, 2020.

At the time of filing the Complaint, the disputed domain name <facebook-learn.com> resolved to the page <f2mp.com>, which is a website that purports to offer a tool to “download Facebook or Instagram videos”, including a step-by-step guide to use the tool. The website also featured commercial advertising banners (Annexes 14 and 15 to the Complaint). The disputed domain name <igconverter.com> resolves to a website, that purports to offer a tool to download content from the application Instagram, including photos, reels, videos and stories, featuring a step-by-step guide to do so. The website features the Complainant 2’s logo and figurative trademark on the homepage and as a favicon (Annex 16 to the Complaint). The disputed domain name <igdown.net> resolves to a website, that purports to offer a tool to download content from the application Instagram, including profile pictures, photos, reels, stories and videos as well as from the Facebook platform (Annex 17 to the Complaint). The disputed domain name <igdownloader.net> resolves to a website, that purports to offer a tool to download content from, including but not limited to, the application Instagram, including photos, reels, IGTV and videos (Annex 18 to the Complaint).

5. Parties' Contentions

The Parties contentions may be summarized below.

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

On the first element, the Complainants contend that they own trademark rights in the designations Facebook and IG. These trademarks are, so the Complainants, recognizable within each of the disputed domain names. Further, the addition of the respective terms "-learn", "converter", "down" and "downloader" does not change this finding, as these additions are merely descriptive and therefore do not prevent a finding of confusing similarity. Likewise, the generic Top-Level-Domains ("gTLDs") ".com" and ".net" are standard domain registration requirements and may therefore be disregarded.

On the second element, the Complainants argue that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainants assure that they have never authorized, permitted, or allowed the Respondent in any way to use their trademarks as part of the disputed domain names or for any other purpose. Besides that, there is also no other possible link between the Respondent and the disputed domain names, and the Respondent is not commonly known by the disputed domain names. Furthermore, the Complainants submit that the Respondent cannot be viewed as a bona fide service provider and thus does not have a legitimate interest in such disputed domain names. The Complainants argue that the Respondent does not provide legitimate sales or repairs in relation to a product or service provided by the Complainants. Rather, the Respondent markets its own ancillary services, namely illegitimately providing tools enabling Internet users to download content from Facebook and Instagram and other third-party social-media platforms and is therefore misusing the Complainant's trademarks in an unauthorized manner. In particular, the download services offered by the Respondent from each of the websites, to which the disputed domain names resolve, violate the Meta Developer Policies, and they also facilitate breach of the Instagram Terms of Use and the Meta Terms of Service. They circumvent the requirement to create an account and place the security and privacy of Facebook and Instagram users at risk, as content scraped from the platforms may be stored and later used for unauthorized uses by third parties. In addition, the Complainants assert and refers to case law that previous UDRP panels have held that "such use of a Domain Name does not constitute use of the Domain Name in connection with a *bona fide* offering of goods and services".

Lastly, the Complainants claim that the disputed domain names have been registered and are being used in bad faith. They argue and puts forth evidence that the Facebook trademark is well-known and reputed worldwide (Annexes 6 and 8 to the Complaint). Furthermore, the Complainants argue that the application Instagram is commonly referred to as "IG", which is also registered as a trademark. Accordingly, the Respondent must have been aware of the Complainants and their brands when registering the disputed domain names. The Respondent, so the Complainants, also use the disputed domain names in bad faith in that it offers – by making use of the trademarks within the disputed domain names – tools to download content in particular from the Facebook and Instagram platforms which go beyond the technical limits put in place by the Complainants and facilitate unauthorized downloads. The use of the trademarks Facebook and IG as well as related imagery of the Complainants are likely to add to confusion on the side of Internet user as to whether the services are related to, or may have been permitted by, the Complainants, which is not the case.

B. Respondent

The Respondent comments on certain points of the argumentation of the Complainants as follows:

Firstly, the Respondent submits that it has, upon receipt of the Complaint, either added a disclaimer to the relevant websites stating that the website is not affiliated with Facebook or Instagram and does not claim

ownership on any trademarks of logos which are owned by the Complainants, or, as applicable, has made existing disclaimer language more prominent. Further, the Respondent has removed the Instagram logo and favicon where that was displayed on the relevant websites.

With respect to the use of the term IG the Respondent points to various other domain names with “ig” that are still active and that using “ig” as such does not necessarily imply trademark infringement, especially when there is a disclaimer and the logos have been removed.

Finally, it argues that it has previously contacted the relevant contact regarding this matter and explained that its websites do not violate trademark laws.

6. Discussion and Findings

6.1 Preliminary Issue: Consolidation

The Panel notes that the present Complaint has been filed by multiple Complainants who have submitted a request for consolidation of their respective complaints. On this subject, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.1 provides as follows:

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

In order for the filing of a single complaint brought by multiple complainants which meets the above criteria to be accepted, such complaint would typically need to be accompanied by a request for consolidation which establishes that the relevant criteria have been met. The onus of establishing this falls on the filing party/parties, and where the relevant criteria have not been met, the complaint in its filed form would not be accepted.

The Panel is satisfied that the Complainants each have rights in the Facebook and IG mark, respectively, as set out in the Factual Background section above. The Panel notes that the Complainants assert that they have been the target of common conduct by the Respondent and that as there is a common grievance on the part of each of them and each of the disputed domain names, it would be procedurally efficient to deal with all matters in the one proceeding, given the almost identical facts. The Respondent has filed a Response but has remained silent on this particular issue and not introduced arguments against the requested consolidation.

The Panel finds that the Complainants have established that they have a common grievance against the Respondent which would affect their individual rights on substantially the same basis. The Respondent has not indicated that it would suffer any prejudice from consolidation of the Complaint and no potential prejudice is apparent to the Panel. The Respondent has not otherwise contested the request for consolidation. In all of these circumstances, the Panel considers that it is procedurally efficient to allow the Complainants to proceed with the single Complaint as filed and is content that such consolidation is fair and equitable to all of the Parties. With regard to the remedy sought by the Complainants, the Panel notes that, if the Complaint succeeds, the Complainants have specifically requested that the disputed domain name <facebook-learn.com> be transferred to the Complainant 1, and the disputed domain names <igconverter.com>, <igdown.net> and <igdownlaoded.net> to the Complainant 2.

6.2 Substantive Issues

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 a Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainants' Facebook and IG trademarks, respectively, are reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. This applies even considering, that there may be other active domain names including "ig" and that, also according to the online dictionary sources provided by the Complainants, "IG" may have other meaning such as "I guess". Nevertheless, in the present case all website uses of the disputed domain names having "ig" as the first two letters, are targeted in particular at downloading content from the Instagram application and thus have a direct connection to Instagram, for which – insofar undisputed by the Respondent – IG is an acronym. Thus, in the given context the presence of the letters "ig" in the beginning of the disputed domain names gives rise to confusing similarity as required by paragraph 4(a)(i) of the UDRP.

Although the addition of other terms (here, -learn, converter, downloader and down) 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 the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Furthermore, the applicable gTLDs ".com" and ".net." are irrelevant when determining whether a disputed domain name is confusingly similar to trademarks because it is considered as a standard registration requirement.

Accordingly, this Panel finds that the disputed domain names are confusingly similar to the Complainants' trademarks FACEBOOK and IG, respectively. Consequently, the first element of the Policy has been established.

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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainants' 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.

As far as the disputed domain name <igdownloader.net> is concerned, panels have found that the use of a domain name to host commercial advertising banners does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Furthermore, the Panels have held that the use of a domain name for illegal activity here, claimed offering tools from all disputed domain names for unauthorized account access/hacking, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Considering the above, the Panel finds that the Complainants have established a prima facie case that the Respondent lacks any rights and/or legitimate interests in the disputed domain name.

Further the Panel agrees with the Complainants that the criteria set out in *Oki Data Americas, Inc. v. ASD, Inc.*, *supra* are not satisfied in the present case. In the present case the Respondent is offering illegitimate tools complimentary to the Complainants' social media services designed to facilitate downloads from Facebook or Instagram, making use of the Complainants' trademarks to attract the attention of Internet users and falsely giving the impression to be somewhat related to the Complainants. This in itself prevents the finding of a legitimate interest on behalf of the Respondent. To the extent there was, prior to the initiation of the present proceeding, a disclaimer, this disclaimer was not sufficiently prominent, and the Respondent has not undertaken reasonable steps to avoid unfairly passing itself off as related to the complainant, or to otherwise confuse users. To the extent that disclaimers are claimed to have been made more prominent, and logos removed, by the Respondent after the filing of the present Complaint, this does not retroactively legitimize an otherwise illegitimate use. Rather, the Panel counts this as an admission by the Respondent that users may have been confused.

Consequently, the Panel finds that the Respondent's response was not apt to refute the prima facie case made by the Complainants is sufficient to establish a lack of rights or legitimate interests of the Respondent in the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

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.

The Panel accepts the distinctive and well-known character of the Complainants' trademarks as well as the fact that "ig", in relation to social medial applications as relevant in the present case and circumstances, is an acronym of Instagram. Accordingly, the Panel agrees with the Complainants that the Respondent, upon creation of each of the disputed domain names, knew of the Complainants' trademarks and targeted them when it registered the disputed domain names. The Respondent therefore registered the disputed domain names in bad faith.

The Respondent's websites connected to the disputed domain names allowed Internet users to download photos, videos, profile pictures, reels, stories, specifically from the Complainants' Facebook and Instagram platforms. The Panel finds that in using the disputed domain names in connection with such websites, the Respondent intentionally created a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement its website and the services offered therein, in bad faith, within the meaning of paragraph 4(b)(iv) of the Policy.

Besides that, panels have held that the use of a disputed domain name for illegal activity may constitute bad faith. Here, the Respondent has, in using the disputed domain names, provided tools for illegitimate download of content from the Complainants' social media platforms Facebook and Instagram, circumvention the requirement of creating an account to access those platforms and place the security and privacy of the

platforms' users at risk, as content may be stored and used by unauthorized purposes by third parties. This amounts to unauthorized account access or hacking and constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

In addition, the Respondent's website at the disputed domain name <facebook-learn.com> displays a link to a third party website. What commercial gain the Respondent may have derived from such use of the disputed domain name is not known, but the Panel finds it likely that the Respondent received, or hoped to receive, pay-per-click fees or advertising commissions for redirecting the disputed domain name to such website.

Finally, with regard to the Respondent's pointing to adding new or emphasizing existing disclaimers, where the overall circumstances of a case point to the respondent's bad faith, the mere presence of a disclaimer is not sufficient to cure bad faith. In such cases, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused (see [WIPO Overview 3.0](#), section 3.7), which is the view the Panel takes in the case at hand.

The Panel finds that the Complainants have established the third element of the Policy and therefore that the disputed domain names have been used in bad faith.

For the reasons set out above, the Panel finds that the Complainants have satisfied the condition set forth in 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 names <facebook-learn.com> be transferred to the Complainant 1, and the disputed domain names <igconverter.com>, <igdownloader.net> and <igdown.net> be transferred to the Complainant 2.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: September 25, 2024