

## ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. rokibul islam  
Case No. D2024-3293

### 1. The Parties

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

Respondent is rokibul islam, India.

### 2. The Domain Name and Registrar

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

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 14, 2024, 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 (DATA REDACTED) and contact information in the Complaint. The Center sent an email communication to Complainant on August 16, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. On August 21, 2024, Complainant asked for a one-week extension through August 28, 2024, to submit an amendment to the Complaint which has been granted by the Center the next day. Complainant filed an amended Complaint on August 26, 2024. Respondent sent two email communications to the Center on August 29, 2024.

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 September 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2024. Respondent did not submit any formal Response. Accordingly, the Center notified the parties of the Commencement of Panel Appointment Process on September 25, 2024.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on October 3, 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 as well as its INSTA brand, including, but not limited, to the following:

- word mark INSTA, United States Patent and Trademark Office (USPTO), registration number: 5,061,916, registration date: October 18, 2016, status: active;
- word mark INSTA, Intellectual Property India (IPI), registration number: 3101498, registration date: November 19, 2015, status: active.

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

Respondent, according to the disclosed Whois information for the disputed domain name, is located in India. The disputed domain name was registered on November 11, 2019. By the time of the rendering of this Decision, the disputed domain name does not resolve to any active content on the Internet. Complainant, however, has demonstrated that at some point before the filing of the Complaint, the disputed domain name resolved to a website at "www.captureinsta.com", which was titled "CaptureInsta" and purported to offer a tool to view and download content from Complainant's Instagram platform, including profile pictures, photos, videos, reels and IGTV; moreover, the website displayed the following wording in the website footer:

"CaptureInsta is not affiliated with Instagram. CaptureInsta doesn't host any of the Instagram properties of its users. All media contents are downloaded from Instagram's trademarks, including Instagram, the Instagram logo, the Instagram glyph and app logos, Insta, Gram, IG, IGTV and IGTV logo. Direct and Direct logo, Reels and Reels logo used in this site are all owned by Instagram."

The "CaptureInsta" logo on that website under the disputed domain name used a font very similar to the custom font used by Complainant for its INSTAGRAM figurative trademark and logo.

A cease-and-desist letter sent by Complainant to Respondent on July 3, 2024 remained unanswered.

Complainant requests that the disputed domain name 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 name. 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 2.3 billion monthly active accounts worldwide and constantly ranked amongst the top "apps" for mobile devices.

Complainant submits that the disputed domain name is confusingly similar to its INSTA trademark, as it comprises the latter, preceded by the term “capture”. 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 INSTA trademark 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 INSTA trademark 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, Respondent does not satisfy them, since the wording featured at the footer of the website under the disputed domain name neither accurately nor prominently disclosed Respondent’s lack of relationship with Complainant, but rather, by making specific reference to “Instagram” and featuring a logo in a font very similar to Complainant’s official logo, suggested that Respondent was affiliated with Complainant, which is not the case, (4) further, Respondent’s previous use of the disputed domain name 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 “insta” or any variation thereof, as reflected in the disputed domain name, and finally (6) Respondent has used the disputed domain name to exploit the goodwill and reputation associated with Complainant’s INSTA trademark by creating a false impression of association with Complainant, and so has misleadingly diverted Internet users to its website.

Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) Complainant’s INSTA trademark is inherently distinctive and 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 name in November 2019, (2) Respondent’s intent to target Complainant when registering the disputed domain name may be inferred from the content of Respondent’s website, which made explicit reference to Complainant’s INSTA trademark and used a very similar font to the custom font used by Complainant for its INSTAGRAM figurative trademark and logo, thereby seeking to target Complainant’s trademark to create an impression of association with Complainant, and finally (3) Respondent has used the disputed domain name 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 formally reply to Complainant’s contentions, but sent two email communications to the Center on August 29, 2024, offering that the disputed domain name could be taken back and stating that the website thereunder had been shut down over a month ago.

## **6. Discussion and Findings**

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

- (i) that the disputed domain name is 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 name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent’s formal 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 INSTA trademark and the disputed domain name. 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 INSTA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Also, the entirety of such trademark is reproduced within the disputed domain name, merely preceded by the term "capture". Accordingly, the disputed domain name is confusingly similar to Complainant's INSTA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the term "capture") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and Complainant's INSTA trademark 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 name. 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 name such as those enumerated in the Policy or otherwise.

In particular, Respondent has not been authorized to use Complainant's INSTA 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 name and Respondent does not appear to have any trademark rights associated with the term "insta" on its own. To the contrary, the disputed domain name at some point resolved to a website at "www.captureinsta.com", which was titled "CaptureInsta" and purported to offer a tool to view and download content from Complainant's Instagram platform, including profile pictures, photos, videos, reels and IGTV, thereby going beyond the technical limits placed on the platform by Complainant, thus, violating the Meta Developer Policies, and also prominently displaying a "CaptureInsta" logo which used a font very similar to the custom font used by Complainant for its INSTAGRAM figurative trademark and 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 only offer on its website under the disputed domain name the goods and services trademarked under INSTA, which Respondent obviously and quite to the contrary did not, but instead offered own ancillary services, namely providing tools that enable Internet users to download content from Complainant's Instagram platform; see [WIPO Overview 3.0](#), section 2.8).

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

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

Third, 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 INSTA trademark when registering the disputed domain name and that the latter clearly is directed thereto. Moreover, using the disputed domain name to run a website which was titled "CaptureInsta" and purported to offer a tool to view and download content from Complainant's Instagram platform, including profile pictures, photos, videos, reels and IGTV, thereby going beyond the technical limits placed on the platform by Complainant, thus, violating the Meta Developer Policies, and also prominently displaying a "CaptureInsta" logo which used a font very similar to the custom font used by Complainant for its INSTAGRAM figurative trademark and 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 website by creating a likelihood of confusion with Complainant's INSTA trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website. 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.

Having reviewed the record, the Panel, therefore, holds Respondent's registration and use of the disputed domain name 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 name, <captureinsta.com>, be transferred to Complainant.

*/Stephanie G. Hartung/*

**Stephanie G. Hartung**

Sole Panelist

Date: October 15, 2024