

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. Alex Moris

Case No. DIO2023-0007

### **1. The Parties**

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

The Respondent is Alex Moris, Republic of Moldova.

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

The disputed domain name <igram.io> is registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 6, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 2023, 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 and contact information in the Complaint (Registration Private Domains By Proxy, LLC). The Center sent an email communication to the Complainant on February 9, 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 February 10, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .IO Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .IO 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 February 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 6, 2023. An informal late Response was filed with the Center on March 6, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on March 8, 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 an online photo- and video-sharing social-networking application. The Instagram application was launched in 2010, it was acquired by Facebook, Inc. (now Meta Platforms, Inc.) in 2012, and today it is one of the world's fastest growing photo- and video-sharing and editing software and online social network, with more than 2 billion monthly active accounts worldwide. Instagram is currently the 2nd most downloaded app worldwide, according to Forbes.

The Complainant is the exclusive owner of a number of registered trademarks consisting of or including INSTAGRAM, GRAM and IG including:

- International trademark registration No. 1129314 for INSTAGRAM, registered on March 15, 2012;
- European Union trademark registration No. 14493886 for INSTAGRAM, registered on December 24, 2015;
- European Union trademark registration No. 015868797 for GRAM, registered on January 12, 2017;
- European Union trademark registration No. 017946393 for IG, registered on January 31, 2019.

The Complainant is the owner of numerous domain names consisting of or including its INSTAGRAM trademark, such as <instagram.com>.

The disputed domain name was registered on May 30, 2020. It resolves to a website that purports to provide a tool for downloading photo and video content from the Complainant's Instagram platform. It displays the INSTAGRAM trademark and it states on the main page:

"Instagram Downloader  
Download Instagram Videos and Photos".

#### **5. Parties' Contentions**

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

The Complainant argues that the disputed domain name comprises the Complainant's GRAM trademark in its entirety, together with the prefix "i", and it also comprises the Complainant's IG trademark in its entirety as its leading element, followed by the letters "ram". As per the Complainant, the inclusion of the Complainant's GRAM and IG trademarks in the disputed domain name is sufficient to demonstrate confusing similarity between the disputed domain name and the Complainant's trademarks. The Complainant further submits that its trademark INSTAGRAM is recognizable within the disputed domain name, as it comprises an abbreviated form of the Complainant's INSTAGRAM trademark, from which the letters "nsta" have been omitted. In addition, the Complainant argues that the content of the Respondent's website makes it clear that the Respondent has sought to target the Complainant's trademarks as the Respondent's website makes extensive reference to Instagram and elements of the Respondent's website closely resemble elements of the Complainant's Instagram platform, including the colour scheme and favicon in the browser tab, which is similar to the Instagram favicon. The Complainant concludes that the disputed domain name is confusingly similar to its trademarks.

With respect to the second element, the Complainant argues that the Respondent is not a licensee of the Complainant, that the Respondent is not affiliated with the Complainant in any way and that the Complainant has not granted any authorization for the Respondent to make use of its INSTAGRAM, GRAM, or IG

trademarks, in a domain name or otherwise. The disputed domain name resolves to a website that purports to provide a tool for downloading content from the Complainant's Instagram platform. The Complainant argues that the tool for downloading Instagram content offered on the Respondent's website goes beyond the limits that the Complainant has placed on the functionality of its own Instagram product and is clearly in breach of the Complainant's Facebook Developer Policies. The Complainant further argues that the mentioned activity is also placing the privacy and security of Instagram users at risk, as content downloaded from the Instagram platform may be stored and later used for unauthorised purposes by third parties. Further, the Complainant argues that the Respondent is not commonly known by the disputed domain name. Moreover, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name as the website at the disputed domain name contains commercial banners from which the Respondent presumably derives click-through revenue.

As regards the third element, the Complainant contends that its trademarks are inherently distinctive and well known throughout the world in connection with its online photo-sharing social network. The Respondent could not credibly argue that it did not have knowledge of Instagram or its INSTAGRAM trademark when registering the disputed domain name. The Respondent's intent to target the Complainant when registering the disputed domain name may be inferred from the contents of the website to which the disputed domain name resolves, which makes explicit reference to "Instagram" and "IG" and promotes the downloading of content from Instagram, in violation of the Complainant's Terms of Use. Moreover, the disputed domain name is being used to point to a website using the same distinctive gradient colour palette, thereby creating a misleading impression of association with the Complainant. The Complainant further submits that the Respondent's address as disclosed by the Registrar does not appear to exist and the use of incomplete, inaccurate, false, or fictitious contact information in the Whois records may constitute evidence of bad faith.

## **B. Respondent**

The Respondent has submitted an informal late response. In his correspondence, the Respondent indicates that Igram is a village and municipality in western Slovakia and that the Complainant cannot register that trademark due to restrictions prohibiting using the exact match name of the geographical locations as a trademark. It also states "Anyway, we won't use it anymore". The Respondent also mentions that the "gradient was removed to avoid miss perception. Note that the example shown does not have a blue color, which is reversed. The website gradient goes from blue to red via pink, Instagram gradient from red to purple." It also indicates that "Our website used to work only with public data, which is legal activities in Europe and other countries. Also, no law makes public data scraping similar to criminal activities. The GDPR doesn't state that web scraping is illegal. We do not collect names, phones, emails, or addresses. The tool access data like a regular user does in the web browser, which is a legal activity, and the tool cannot access data from private pages. Instagram, as a data host, has the responsibility for data protection. The conclusion is supported by recent case law; the courts in *HiQ v LinkedIn* confirmed that scraping publicly available data is legal".

## **6. Discussion and Findings**

### **6.1. Late Response**

Paragraph 14(a) of the Rules provides that, in the event of a late response, absent exceptional circumstances, panels shall proceed to a decision based solely on the complaint. On the other hand, paragraph 10(b) of the Rules requires panels to ensure that parties are treated with equality and that each party is given a fair opportunity to present its case. The Response was filed one day late. Based on the overall circumstances of the case, and also taking into account the fact that the Response was filed before the appointment of the Panel, and that the delay has not delayed the resolution of this proceeding – and also bearing in mind the Panel's obligations under paragraph 10(b) of the Rules – the Panel accepts the late filing of the Response.

## 6.2. Substantive matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

### A. Identical or Confusingly Similar

The Complainant has provided evidence of its rights over the INSTAGRAM, GRAM, and IG trademarks. Further, noting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element.

The trademark GRAM is reproduced in its entirety in the disputed domain name. The addition of the letter “i” does not prevent a finding of confusing similarity with the Complainant’s trademark, which is recognizable in the disputed domain name. The trademark IG is also reproduced in its entirety in the disputed domain name. The addition of “ram” (which also plainly invokes the ending of the INSTAGRAM mark) does not prevent a finding of confusing similarity with the Complainant’s trademark, which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).<sup>1</sup> The disputed domain name is also confusingly similar with the INSTAGRAM trademark of the Complainant as it comprises an abbreviated form of the Complainant’s INSTAGRAM trademark, from which the letters “nsta” have been omitted.

It is well accepted that a country-code Top-Level Domain (“ccTLD”), such as “.io”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent’s rights or legitimate interests in the disputed domain name:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

---

<sup>1</sup> Given the similarities between the .IO Policy and Rules and the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules, as has been the case in prior decisions under the Policy, the Panel finds UDRP precedent to be relevant to this case.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the [WIPO Overview 3.0](#), which states: “[...] 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

In the present case the Complainant claims that the Respondent has no rights or legitimate interest in the disputed domain name and argues that the Respondent is not a licensee of the Complainant, that the Respondent is not affiliated with the Complainant in any way, that the Complainant has not granted any authorization for the Respondent to make use of its INSTAGRAM, GRAM, or IG trademarks, that the Respondent is not known by the disputed domain name, and is not carrying out a *bona fide* use of the disputed domain name. According to the Complainant, the Respondent is using the disputed domain name for a website offering Internet users a tool for the unauthorized viewing and downloading of content on Instagram, circumventing the Complainant’s requirement of creating an account to access Instagram and the impossibility of downloading content from the Instagram platform. The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not reasonably explained why and for what purposes it has registered the disputed domain name. It has not submitted any contrary evidence to the Claimant’s allegations. In its informal late Response, the Respondent failed to address the allegation of the Complainant regarding the unauthorized use of a tool for the unauthorized viewing and downloading of content on Instagram. At the same time, the Respondent states that it has removed the gradient on the website at the disputed domain name to avoid misperception. In the Panel’s view, these statements mean that the Respondent accepts that the Complainant is right to object to the disputed domain name (and its particular use).

Given the circumstances of the case, it appears more likely to the Panel that the Respondent has registered the disputed domain name targeting the Complainant’s INSTAGRAM, GRAM, or IG trademarks to exploit their popularity to attract Internet users to the Respondent’s websites and to offer them its services likely for commercial gain or to somehow benefit the Respondent. The Panel therefore does not regard this conduct of the Respondent as a legitimate activity that may give rise to rights or legitimate interests of the Respondent in the disputed domain name under the Policy.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

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

To fulfil the third requirement of the Policy, the Complainant must prove that the disputed domain name was registered or is being used in bad faith.

The disputed domain name was registered many years after the Complainant has obtained registration of its INSTAGRAM, GRAM, and IG trademarks. The Respondent has not denied knowledge of the Complainant and its trademarks. The disputed domain name is confusingly similar with the Complainant’s trademarks. Moreover, the website at the disputed domain name provides a tool to view profile pictures and download content on Instagram, and displays the INSTAGRAM and IG trademarks of the Complainant. Therefore, the disputed domain name and the content of the website at the disputed domain name may well confuse Internet users that are affiliated to or authorized by the Complainant. Under these circumstances it is obvious that the Respondent was aware of the Complainant’s trademarks at the registration of the disputed domain name and targeted those trademarks. The Panel finds that the Respondent registered the disputed domain name in bad faith.

Even if the requirement for registration and use in bad faith is not cumulative under the Policy, the Panel will analyse the bad faith use of the disputed domain name as well. The Panel accepts the Complainant’s evidence, that the Respondent uses the disputed domain name for a website offering Internet users a tool for the unauthorized viewing and downloading of content on Instagram. The Respondent has not rebutted this

evidence. Such use is likely to mislead Internet users looking for the Complainant's services. Also, according to the unrebutted evidence in the case file, the disputed domain name resolves to a website displaying the INSTAGRAM and IG trademarks of the Complainant, without a disclaimer or indication that the Respondent's website is not operated by or affiliated with the Complainant. The Panel finds that the Respondent has registered the disputed domain name targeting the trademarks of the Complainant in an attempt to attract traffic to the disputed domain name creating a misleading impression of association with the Complainant.

In these circumstances, the Panel that the Complainant has also satisfied the requirement of 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 name, <igram.io> be transferred to the Complainant.

/Mihaela Maravela/

**Mihaela Maravela**

Sole Panelist

Date: March 22, 2023