

WIPO Arbitration and Mediation Center
Case No.: DNL2021-0026
Date: 4 July 2021

1. The Parties

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

Respondent is Whois Privacy Protection Foundation, the Netherlands / [X], instagam, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <instagam.nl> (the “Domain Name”) is registered with SIDN through Registrar.eu.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2021. On May 6, 2021, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On May 7, 2021, SIDN transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details. On May 10, 2021, the Registrar in its turn transmitted by email to the Center further information. The Center sent an email communication to Complainant on the same day, 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 May 14 and 18, 2021. The Center verified that the Complaint together with the Amended Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 18, 2021. In accordance with the Regulations, article 7.1, the due date for Response was June 7, 2021. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 8, 2021.

The Center appointed Dinant T. L. Oosterbaan as the panelist in this matter on June 20, 2021. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

Complainant is an online photo and video sharing social networking application. Complainant’s application is available in over 31 languages and has over 1 billion monthly active users.

According to the evidence submitted by Complainant, Complainant has obtained multiple registrations for the trademark INSTAGRAM, including:

- European Union Trade Mark INSTAGRAM number 014493886, filed on August 20, 2015, and registered on December 24, 2015;

- International trademark INSTAGRAM number 1129314, registered on March 15, 2012.

In addition, Complainant has multiple domain names consisting of or containing the INSTAGRAM mark.

SIDN informed the Center that the Domain Name was registered by Respondent on August 16, 2020. The Domain Name currently does not resolve to an active webpage. The Domain Name previously pointed to a web page entitled “Instagam” displaying graphics containing the camera logos of Complainant.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name is confusingly similar to Complainant's INSTAGRAM trademark. The Domain Name incorporates a misspelling of Complainant's INSTAGRAM trademark. The only difference between the Domain Name and Complainant's trademark is the deletion of the letter “r” of the trademark.

Complainant submits that Respondent has no rights to or legitimate interests in the Domain Name. According to the information provided by Complainant, the Domain Name used to point to a webpage entitled “Instagam” under which it was stated: “Allways online / stay connected”. Below the title, the website displayed graphics containing the camera logos of Complainant. The website contained three hyperlinks, including a hyperlink resolving to a page which was headed “instagam IGTV: Watch Instagram Videos”. However, none of the hyperlinks enabled the viewing of videos of Complainant. After Complainant's lawyers sent cease and desist letters in January and February 2021 to Respondent, the Domain Name stopped resolving to an active website.

Complainant submits that Respondent is not using the Domain Name in connection with a bona fide offering of goods or services. Respondent is not a licensee of Complainant, nor has it been otherwise authorized or allowed to make any use of Complainant's trademark, in a domain name or otherwise. Respondent is not commonly known by the Domain Name.

Complainant asserts that the Domain Name has been registered and is being used in bad faith. According to Complainant, considering the fact that Complainant's INSTAGRAM trademark is distinctive and well known throughout the world, Respondent could not reasonably argue that it did not have knowledge of Complainant's trademark at the time of registration of the Domain Name. In fact, it is clear from the content of the prior website of Respondent associated with the Domain Name that Respondent had Complainant in mind when registering the Domain Name, as Respondent sought to create a misleading impression of association with Complainant.

Complainant submits that Respondent's use of the Domain Name to impersonate Complainant was clearly in bad faith, especially as Respondent did not come forward with any explanation for such use. In addition, the fact that the Domain Name stopped resolving to an active website upon receipt of Complainant's cease and desist letter only highlights Respondent's bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Based on article 2.1 of the Regulations, a claim to transfer a domain name must meet three cumulative conditions:

- a. the domain name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the complainant has rights, or other name mentioned in article 2.1(a) under II of the Regulations; and
- b. the respondent has no rights to or legitimate interests in the domain name; and
- c. the domain name has been registered or is being used in bad faith.

As Respondent has not filed a Response, the Panel shall rule based on the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or in fact.

A. Identical or Confusingly Similar

Complainant has established that it is the owner of multiple trademarks, including the European Union Trade Mark INSTAGRAM.

The Domain Name incorporates almost the entirety of the INSTAGRAM trademark, the only difference being the omission of the letter "r" of the trademark. Decisions under the Regulations have found that a domain name is confusingly similar to a complainant's trademark where the domain name incorporates the distinctive part or entirety of such trademark. The omission of the letter "r" may thus be disregarded for this purpose. See also sections 1.7 and 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").¹

The country code Top-Level Domain ".nl" may also be disregarded for purposes of article 2.1(a) of the Regulations, see Roompot Recreatie Beheer B.V. v. Edoco LTD, WIPO Case No. DNL2008-0008.

The Panel finds that the Domain Name is confusingly similar to Complainant's INSTAGRAM trademark.

B. Rights or Legitimate Interests

As stated in the WIPO Overview 3.0, "while 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element".

In the Panel's opinion, Complainant has made out a prima facie case that Respondent lacks rights to or legitimate interests in the Domain Name.

According to the undisputed submission and evidence provided by Complainant, the Domain Name at the time of the Decision does not resolve to an active website. Prior to the cease and desist letter sent by Complainant's lawyers, the Domain Name resolved to a website containing the distinctive camera logos of Complainant, in an effort of impersonating Complainant.

The Panel does not consider such use a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. There is no evidence that Respondent has acquired any relevant trademark or service mark rights. In addition, there has never been any business relationship between Complainant and Respondent. There is also no indication that Respondent is commonly known by the Domain Name.

No Response to the Complaint was filed and Respondent has not rebutted Complainant's prima facie case.

The Panel finds that Respondent has no rights to or legitimate interests in the Domain Name.

C. Registered or Used in Bad Faith

The Panel finds that the Domain Name has been registered and is being used in bad faith.

Noting the well-known status of the INSTAGRAM marks and the overall circumstances of this case, the Panel finds it highly likely that Respondent knew or should have known Complainant's INSTAGRAM marks at the time of registration, especially in view of the fact that the Domain Name included almost the entirety of Complainant's INSTAGRAM marks, and that the Domain Name resolved to a website containing the characteristic camera logos of Complainant and non-working hyperlinks to videos of Complainant.

In light of these circumstances, the Panel concludes that Respondent has attempted or is attempting to attract Internet users, for commercial gain, to the website of Respondent through the likelihood of confusion which may arise with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of the website of Respondent, which constitutes registration and use in bad faith.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name, <instagam.nl>, be transferred to Complainant.

Dinant T. L. Oosterbaan
Panelist

¹ In view of the fact that the Regulations are to an extent based on the Uniform Domain Name Dispute Resolution Policy ("UDRP"), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore WIPO Overview 3.0, may be relevant to the determination of this proceeding (see, e.g., Aktiebolaget Electrolux v. Beuk Horeca B.V., WIPO Case No. DNL2008-0050).