

DISPUTE RESOLUTION SERVICE

D00022225

Decision of Independent Expert

Instagram, LLC

and

Zhang Hao

1. The Parties:

Complainant:

Instagram, LLC
1601 Willow Road
Menlo Park
California
94025
USA

Respondent:

Zhang Hao
Mmingzhoulujilihuayuan4-401
Ningbo
Zhejiang
315000
China

2. The Domain Name:

instagram.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that they need be disclosed as might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

13 January 2020: Dispute received
14 January 2020: Complaint validated
14 January 2020: Notification of complaint sent to parties
31 January 2020: Response reminder sent
5 February 2020: No Response Received
5 February 2020: Notification of no response sent to parties
12 February 2020: Expert decision payment received

4. Factual Background

The Nominet records show that the Domain Name was registered on 8 December 2010.

Based on the Complainant's submissions (see section 5 below), which are unchallenged by the Respondent, I set out below the main facts which I have accepted as being true in reaching a decision in this case:

- a. The Complainant owns trade mark registrations for INSTAGRAM.
- b. The Complainant has made extensive use of the Instagram name since 2010. The Complainant has thereby established substantial goodwill in the name.
- c. The Respondent has not been authorised by the Complainant to use the Domain Name.
- d. The website to which the Domain Name resolves offers to sell the Domain Name for \$10,000.
- e. The Respondent also owns other domain names which contain third party trade marks.

5. Parties' Contentions

Complaint

The Complainant's contentions are as follows:

The Complainant has rights in respect of a name and mark which is identical or similar to the Domain Name:

- (1) The Complainant is a world-renowned online photo and video sharing social networking application. After it was launched in October 2010, Instagram rapidly developed considerable goodwill and renown worldwide, with 100,000 users in only one week, 1 million registered users in only two months (by 21 December 2010) and over 10 million registered users by September 2011, less than a year after it was launched. Acquired by Facebook in April 2012, Instagram reached over 100 million monthly active users by February 2013, 400 million monthly active users by September 2015 and 800 million monthly active users by September 2017. Currently, Instagram has more than 1 billion monthly active users.
- (2) Instagram's website www.instagram.com is ranked the 29th most visited website in the world, according to web information company Alexa. Instagram has consistently ranked amongst the top "apps" for mobile devices and has also consistently ranked amongst the top apps available for mobile devices, including for iOS and Android operating systems, and has been the recipient of numerous awards, including "App of the Year" in 2011 from Apple Inc.
- (3) Instagram's exponential growth and explosive popularity has been widely reported by specialized technology publications including Tech Crunch and Mashable.com as well as the mainstream media, including major international publications, such as the New York Times and The Washington Post (United States), The Telegraph and The Guardian (United Kingdom).
- (4) Currently inaccessible in mainland China, Instagram is however far from an unknown name to the Chinese public, particularly taking into account numerous Chinese press articles (including China's state media People's Daily) on its success and popularity worldwide and the blogs and forums that diffuse information on how to access Instagram from China. Furthermore, all the search results obtained by typing the term INSTAGRAM in China's leading search engine Baidu are exclusively associated with the Complainant and its business.
- (5) Given the exclusive online nature of the Complainant's business, the Complainant's domain names consisting of its trade mark are not only the heart of its entire business but also the main way for its millions of users to avail themselves of its services. The Complainant is the registrant of numerous domain names consisting of or including the INSTAGRAM trade mark under a wide range of generic Top-Level Domains (gTLDs) as well as under numerous country code Top-Level Domains (ccTLDs).
- (6) The Complainant has also made substantial investments to develop a strong presence online by being active on various social media forums, including Facebook, Twitter and LinkedIn. For instance, Instagram's official Facebook page has over 60 million Facebook "likes" and almost 37 million followers on Twitter.

- (7) The term "instagram" is highly distinctive and is exclusively associated with the Complainant. All search results obtained by typing the term "instagram" into Google's search engine refer to the Complainant.
- (8) The Complainant's valuable reputation offline and online is not only crucial to maintain the value and distinctiveness of the Instagram brand, but also vital to the success, integrity and protection of its business and consumers. Accordingly, the Complainant devotes significant resources to protect its trade mark rights and its goodwill in forums such as this administrative proceeding.
- (9) The Complainant owns numerous trade mark registrations for INSTAGRAM in jurisdictions throughout the world. Such trade mark registrations include but are not limited to the following:
 - United States trade mark registration no. 4,146,057, INSTAGRAM, registered on 22 May 2012;
 - China trade mark no. 10614690, for INSTAGRAM, registered on 14 June 2013;
 - European Union trade mark registration no. 014493886, INSTAGRAM, registered on 24 December 2015; and
 - International registration no. 1129314, INSTAGRAM, registered on 15 March 2012.
- (10) The Domain Name is identical to the INSTAGRAM name in which the Complainant has Rights.

The Domain Name, in the hands of the Respondent, is an abusive registration:

- (1) The Respondent is or used to be the registrant of a significant number of domain names containing third-party distinctive trademarks:
 - snapchat.at;
 - potteryvarn.com;
 - transferwire.co.uk;
 - wwwtransferwise.com; and
 - pinterest.de.
- (2) The Domain Name resolves first to www.instagram.co.uk, which is a web page stating that the Domain Name may be available for purchase for US\$10,000 and providing a link. After a couple of seconds, Internet users land on a web page www.instagram.co.uk/listing with a form advertising the Domain Name for sale for the previously mentioned amount of US\$10,000.
- (3) Paragraphs 5.1.3 and 5.1.6 of the DRS Policy are of particular relevance in the present case, although there are other factors not listed in paragraph 5 of the DRS Policy that also strongly indicate Abusive Registration.

- (4) The Complainant has not authorised, licensed or otherwise allowed the Respondent to use its INSTAGRAM trade mark in a domain name or otherwise. Indeed, the Respondent is not connected to the Complainant in any manner.
- (5) Given the Complainant's renown and goodwill worldwide, it would be difficult for the Respondent to argue that he did not have knowledge of the Complainant's INSTAGRAM trade mark at the time of registration of the Domain Name on 8 December 2010.
- (6) The Respondent registered the Domain Name with prior knowledge of the Complainant's rights. The Respondent has been the registrant of other domain names that include third party trade marks under several generic or specific country extensions. The Respondent has therefore engaged in a pattern of conduct by registering at least six domain names corresponding to a well-known trade mark in which the Respondent has no apparent rights, and the Domain Name is part of that pattern, in accordance with paragraph 5.1.3 of the DRS Policy.
- (7) Moreover, the Domain Name is an exact match for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name as per paragraph 5.1.6 of the DRS Policy.
- (8) The Domain Name was therefore registered in a manner which took unfair advantage of, and was unfairly detrimental to, the Complainant's rights, in accordance with paragraph 1(i) of the DRS Policy.
- (9) In addition, the Respondent is using the Domain Name in an abusive manner, in accordance with paragraph 1(ii) of the DRS Policy.
- (10) Paragraph 5.1.1 of the DRS Policy is of particular relevance. The Respondent has registered the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name. The Domain Name resolves to a website where the Domain Name is listed for sale for US\$10,000. There is no other apparent use being made of the Domain Name.
- (11) Furthermore, there are no circumstances to suggest that the Respondent's registration is not an Abusive Registration, as set out under paragraph 8 of the DRS Policy.
- (12) The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Response

The Respondent has not filed a Response.

6. Discussions and Findings

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the name and mark INSTAGRAM. These rights comprise the Complainant's trade mark registrations, together with substantial goodwill arising from its use of the name Instagram, such goodwill also being a legally protectable right.

Disregarding the hyphen and the generic .co.uk suffix, the Domain Name is identical to the INSTAGRAM name and mark in which the Complainant has Rights.

I therefore find that paragraph 2.1.1 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy defines an "Abusive Registration" as:

"A Domain Name which either:

- i was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The relevant factors under paragraph 5 on which the Complainant relies is as follows:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's

documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."

By way of preliminary comment, although the Respondent has not filed a Response, it is still necessary for the Complainant to prove its case. It is nevertheless relevant that the Respondent has not sought to provide any explanation for why it chose to register the Domain Name.

Dealing first with the factor under paragraph 5.1.6 of the Policy, that factor clearly applies in this case. Disregarding the .co.uk suffix, the Domain Name is an exact match for the INSTAGRAM name and mark in which the Complainant has Rights. In addition, given the very extensive use by the Complainant of its INSTAGRAM name, the name has become a household name and definitely therefore has a reputation for the purposes of paragraph 5.1.6. Finally, there is nothing to support any argument that the Respondent has any reasonable justification for having registered the Domain Name.

When a distinctive brand name is completely reproduced in a domain name, the normal presumption is that there is no bona fide reason for the registration of that domain name. I find that this presumption applies in this case. As already noted, the Respondent has chosen not to file a Response and has thereby failed to offer any explanation or justification for the choice of the Domain Name. The Respondent has therefore failed to rebut the presumption which applies.

In fact, the reason for the Respondent having registered the Domain Name can easily be inferred. Taking into account the wording of the website for the Domain Name, where the Domain Names is offered for sale for \$10,000, it is clear that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant or a competitor of the Claimant for a profit. In other words, the factor under paragraph 5.1.1.1 of the Policy also applies.

Having found that the Respondent intended to sell the Domain Name for a profit, I conclude that the registration of the Domain Name therefore took unfair advantage of and was unfairly detrimental to the Complainant's Rights. There is nothing in this case which could lead to a conclusion that such purpose could be anything other than unfair.

In addition, the Complainant makes submissions relating to other domain names registered by the Respondent which correspond to well-known trade marks in which the Respondent has no apparent rights. I am satisfied that these show a pattern of abusive registrations of which the Domain Name forms part. This reinforces my conclusion that the registration of the Domain Name therefore took unfair advantage of and was unfairly detrimental to the Complainant's Rights.

7. Decision

Having found that the Complainant has Rights in respect of a name and mark which is identical to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *instagram.co.uk* be transferred to the Complainant.

Signed
Jason Rawkins

Dated: 27 February 2020