

BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

DECISION OF THE THIRD-PARTY DECIDER

INSTAGRAM LLC / ZHOU MURONG

Case no. 44383: instagram.be

1. The parties

1.1. Complainant: Instagram LLC, with registered office at CA 94025 Menlo Park, Willow Road, 1601;

Represented by:

Mr. Mr. David Taylor, Attorney at law, residing at 75008 Paris, avenue Matignon, 17;

1.2. Respondent: Mr. Zhou Murong, residing at 518000 SHEN ZHEN GUANGDONG; Nanshan longzhudadao road 11 hao;

2. Domain name

Domain name: "instagram.be"
Registered on: 14 January 2011

hereafter referred to as "the Domain Name".

3. Background to the case

On 29 May 2015, the Complainant filed a complaint with CEPANI under article 10 of the general terms and conditions of the domain name registration within the ".be" domain governed by DNS BE (hereafter referred to as "the Policy") and in accordance with the CEPANI rules for domain name dispute resolution (hereafter referred to as "the Rules").

On 1 July 2015, CEPANI appointed Mr. Geert Glas to act as third party decider pursuant to the Rules (hereafter referred to as "Third Party Decider"). The Third Party Decider accepted this instruction and provided CEPANI with the declaration of independence in accordance with article 7

CEPANI – NON-PROFIT ASSOCIATION

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of the Rules.

Pursuant to article 6.2 of the Rules, CEPANI formally appointed the Third Party Decider in an email dated 3 July 2015 and provided him with an electronic copy of the case file, consisting of the completed complaint form (hereafter referred to as "the Complaint").

On the same day, CEPANI informed the Complainant and the Respondent of the appointment of the Third Party Decider and notified them that deliberations would be closed on 10 July 2015, with the final decision being due on 24 July 2015.

The Respondent did not file any response to the Complaint.

4. Factual information

The Complainant, Instagram LLC, is an online photo and video sharing social networking application.

Its service was officially launched on 6 October 2010. One week after its launch, 100,000 people were using the Instagram app. In only two months (by December 2010), the Complainant had 1 million registered users. Currently, the Complainant has over 300 million monthly active users.

This exponential growth of the Complainants' services attracted wide media attention, from more specialized online technology publications such as *Tech Crunch* and *Mashable.com*, but also from mainstream media, in the U.S. and internationally (*The New York Times*, *The Guardian*, *People's Daily* (China). For instance, *The New York Times* published an article about Instagram reaching 1 million users on 21 December 2010).

The Complainant has been operating freely in China where Instagram has enjoyed a strong popularity. It is only recently, at the end of September 2014, that the use of Instagram has been blocked in China.

Instagram soon became popular in Belgium as well. It is now one of the most visited websites in Belgium (39th most visited website in Belgium as of 9 July 2015). Instagram has rapidly established a strong online presence by being active on the different social media forums available such as Facebook and Twitter.

The online photo and video sharing social networking application created by the Complainant consistently uses the word "Instagram" as its name. The Complainant originally launched its social networking website at www.instagram.am, and later moved its website to www.instagram.com.

Instagram being primarily, if not exclusively, online in nature, Complainant has registered numerous domain names consisting or including the term INSTAGRAM. In addition, the Complainant owns numerous trademark registrations consisting of the word INSTAGRAM, such as:

- International Trademark registration N° 1129314 registered on 15 March 2012, which registration covers several jurisdictions, including the European Community;
- US Trademark Registration N° 4146057 registered on 22 May 2012; and
- US Trademark Registration N° 4170675 registered on 10 July 2012; and

The Complainant has already been involved in several domain name disputes requesting the transfer of those domain names on the basis of the INSTAGRAM trademark, for instance:

- *Instagram, LLC v. Douglas Tarry / Statigram*, NAF Claim Number: FA1403001550202 (<instagramz.com>); and
- *eBay Inc. and Facebook Inc. v. Santosh Ghimire, Do Surf In P. Ltd. and Babin Manandhar*, WIPO Case No. D2014-1629 (<instagramloginsignin.com> et al.).

According to the DNS Belgium WHOIS record, the Respondent, who is based in China, has registered the Domain Name on 14 January 2011. The Domain Name gives access to a parking website displaying sponsored links, some of which make direct reference to the Complainant (Related links are for example "Instagram", "Instagram login", "Instagram Online Free", etc.). At this parking website the Domain Name is also offered for sale.

A search in the WHOIS record carried out by the Complainant has shown that shortly after the launch of Instagram the Respondent registered several domain names that are either identical or confusingly similar to the Complainant's INSTAGRAM trademark.

The Respondent has been involved in several domain name disputes concerning the INSTAGRAM trademark, all of which have resulted in a decision to transfer the disputed domain name to the trademark holder, including the following:

- *Instagram, LLC v. Zhou Murong*, .SE Case No. 811 (<instagram.se>);
- *Instagram, LLC v. Zhou Murong*, WIPO Case No. D2014-1550 (<graminsta.com>, <insagram.com>, <instagam.com>, <instagra.com>, <instagram.co>, <instagram.net>, <instagran.com>, <instagr.com>, <instagrm.com>, <instangram.com>, <instaram.com>, <instargram.com>, <instegram.com>, <instagram.com>, <instragram.com>, <intagram.com>, <istagram.com>, <Instagram.com>, <minstagram.com>, <nstagram.com>, <winstagram.com> and <wwwinstagram.com>);

The Respondent has also registered several domain names which closely resemble third party trademarks (e.g. angribirds.om, airbnn.com, groopongood.com, mastecard.us). Several domain names registered by Respondent have given rise to domain name disputes and have resulted in orders to transfer such domain names to the complainants initiating the disputes.

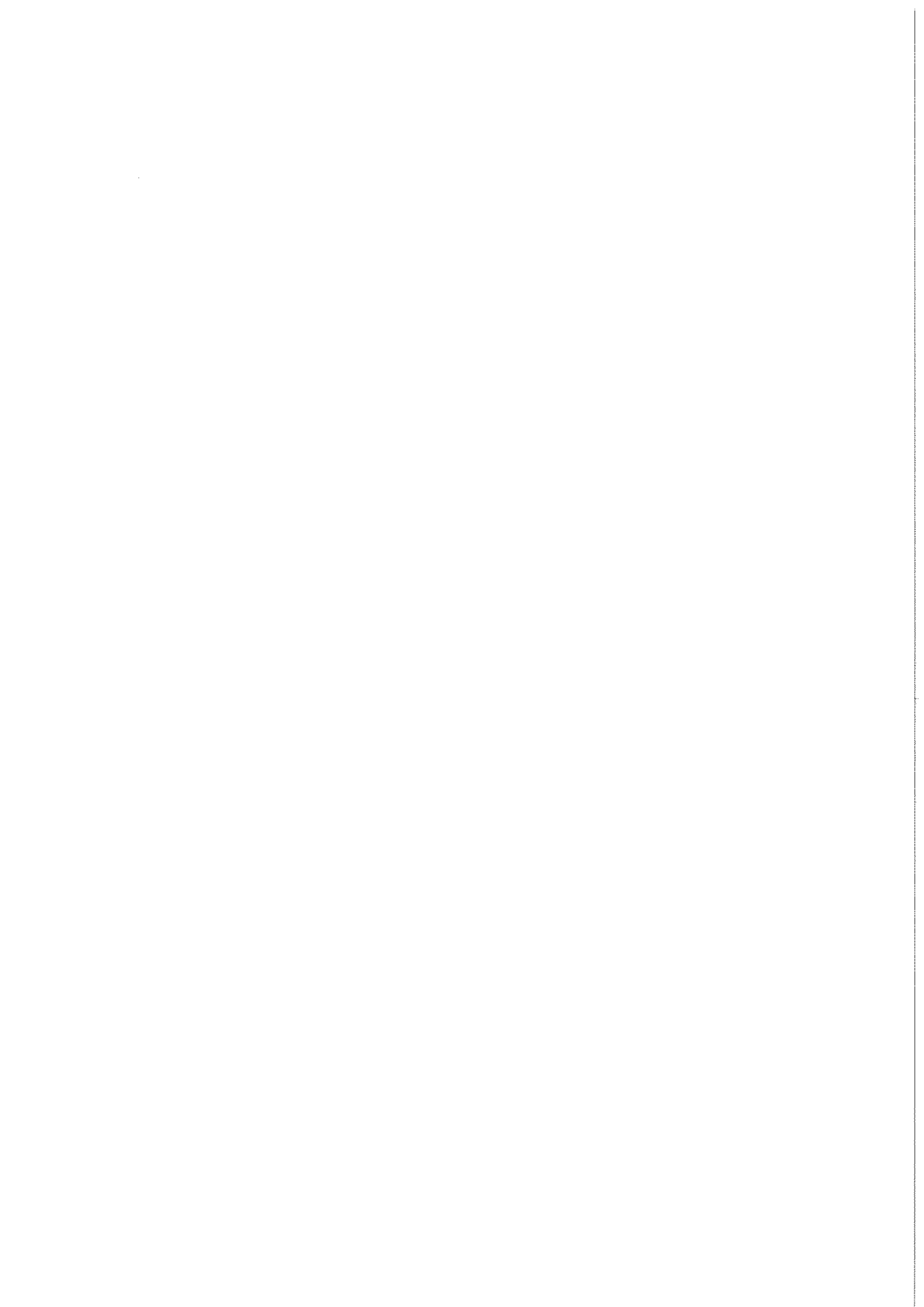
5. Position of the parties

5.1 Position of the Complainant

The Complainant requests that the Domain Name be transferred to it since, according to the Complainant, the conditions provided for under b) 1. i - iii of the Policy are clearly met.

- (A) the Respondent's Domain Name is identical or confusingly similar to a trademark, a trade name, a social name or corporation name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights.**

The Complainant indicates in its Complaint that the Domain Name registered by the Respondent is identical to the trademark INSTAGRAM to which Complainant has trademark rights.



In addition, the term INSTAGRAM is also the Complainant's company name and trade name.

(B) the Respondent has no rights or legitimate interests in the Domain Name.

The Complainant submits that the Respondent has no rights or legitimate interests in the Domain Name given that none of the circumstances mentioned under b) 3 of the Policy are applicable to the Respondent.

Also, Respondent is not a licensee of the Complainant, nor has he been otherwise allowed by Complainant to make any use of the Complainant's INSTAGRAM trademark, in a domain name or otherwise.

It appears that the Respondent cannot assert that he is using the Domain Name in connection with a *bona fide* offering of goods or services given that the Domain Name is used to provide access to a parking website containing commercial links directly related to the Complainant's goods and services and offering the Domain Name for sale.

Also, the Respondent cannot conceivably assert that he is commonly known by the Complainant's INSTAGRAM trademark.

Finally, there is no indication that the Licensee is making a legitimate and non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers given that the Domain Name is pointing to a website that is clearly commercial in nature, as evidenced most notably by the offer to sell the Domain Name and the presence of numerous commercial links directly related to the Complainant's goods and services and from which the Respondent is undoubtedly obtaining financial gain.

(C) the Respondent Domain Name has been registered or is being used in bad faith.

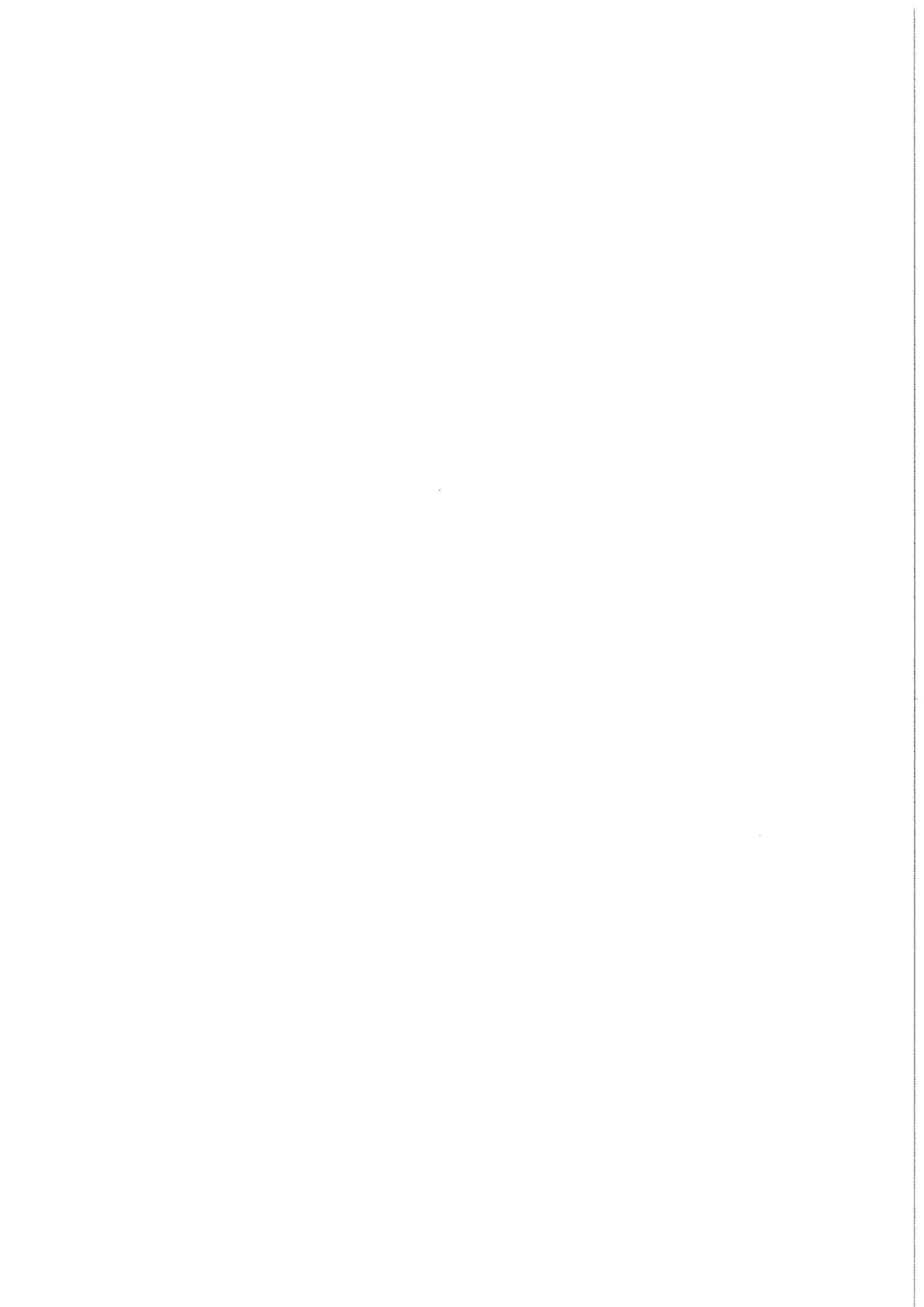
The Complainant submits that given the publicity surrounding Complainant's Instagram application and its explosive growth and popularity it is inconceivable that the Respondent did not have the Complainant's INSTAGRAM trademark in mind when he registered the disputed Domain Name.

The Complainant refers to the CEPANI Case n° 44038 in which the panel has held that awareness of a complainant's trademark, particularly a well-known trademark, at the time of registration of a domain name is a strong indication of bad faith.

The Complainant further submits that there is no indication that the Respondent has made any use of the Domain Name other than to offer it for sale on the associated website.

Also, given the Complainant's goodwill and renown worldwide, the Domain Name could simply not have been chosen for any reason other than to seek to trade on the value attached to the Complainant's trademark, which is strong evidence of bad faith registration.

Furthermore, given that the Respondent was undoubtedly aware of the Complainant's rapid growth and popularity, the Complainant submits that the Respondent registered the Domain Name anticipating that the Complainant would be interested in reflecting its trademark under the .BE cc TLD and thus registered the Domain Name in order to prevent the Complainant from reflecting its globally famous trademark in the corresponding .BE domain name.



Also, the fact that the Respondent has engaged in a pattern of registering numerous domain names which include the Complainant's INSTAGRAM trademark as well as well-known third party brands is strong evidence of the Respondent bad faith.

Finally, Complainant submits that the Respondent is intentionally using the Domain Name to attract, for commercial gain, internet users to its website by creating likelihood of confusion with the Complainant's trademark, company name and trade name as to the source, sponsorship, affiliation or endorsement of the website.

Consequently, the Complainant requests the transfer of the Domain Name registration.

5.2 Position of the Respondent

The Respondent has failed to respond to the Complaint.

6. Discussion and findings

Paragraph 15.1 of the Rules instructs the Third-Party Decider on the principles that the Third-Party Decider must use in determining the dispute: "*The Third-Party Decider shall decide on the Complaint in accordance with the Policy and these Rules.*"

In accordance with article 10 of the Policy, entitled "*Dispute resolution policy*" "*the complainant has to assert and to prove, in compliance with the rules of procedure, that :*

- (i) *the registrant's domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the complainant has rights; and*
- (ii) *the registrant has no rights or legitimate interests in the domain name; and*
- (iii) *the registrant's domain name has been registered or is being used in bad faith.*

It appears from this provision that three cumulative conditions must be met to order the transfer of the disputed Domain Name to the Complainant.

According to Article 5.4 of the Rules, because the Licensee did not submit a Response, the Third-Party Decider has decided the dispute on the basis of the Complaint and its exhibits.

6.1 The registrant's domain name is identical or confusingly similar to, *inter alia*, a trademark, a trade name, a company name in which the complainant has rights.

The Third-Party Decider has noted that the Complainant is, at the time the Complaint was filed, the owner of several trademark registrations consisting of the term INSTAGRAM. These trademarks are sufficient for the purposes of Article 10(b)(1) of the Policy, although they were filed in 2012 and as a result do not predate the registration of the Domain Name. Indeed, previous panels have found that registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity. The Policy makes no specific reference to the date of which the owner of the trade or service mark acquired rights (see for example CEPINA case 12 November 2002, *NAPSTER Inc. v. TheInternetOne C.V.*, no. 4021: "*The Third-Party Decider is notwithstanding of the opinion that the fact that the Complainant filed its trademark after the Respondent had registered the Domain Name is irrelevant when assessing whether or not the first condition is fulfilled. The Policy merely states that the Complainant must*

prove that it has rights in a trademark, not that it had rights in a trademark at the moment of the registration of the Domain Name”).

It follows from the above that the disputed Domain Name is identical to the Complainant trademarks in which the Complainant has registered rights. It is generally admitted that country code top-level domains (ccTLDs) such as “.be” (domain suffixes) are irrelevant in order to assess identity or similarity of a domain name to a trademark. (see CEPINA case 5 March 2001, *Vlaamse Radio en Televisieomroep nv / Securax bvba*, no. 4002 and CEPINA case 11 April 2001, *Pernod Ricard sa. / Worldsites Internet Networks bv*, no. 4003).

Furthermore, according to Belgian law, a trade name is the name which a commercial entity uses to engage in business affairs and to distinguish itself from other commercial entities. The right to use a trade name is accorded to whoever has the first visible, public and continuous use of said name (see *inter alia* D. Kaesmacher, *Les droits intellectuels*, Larcier, 2007, p.207, nr. 95).

In the case at hand, Complainant clearly shows that it uses the name "INSTAGRAM" to refer to its commercial entity which provides an online photo and video sharing social networking application. The evidence submitted supports that statement.



Hence, the Third Party Decider is of the opinion that INSTAGRAM is used as Complainant's company name and trade name.

Undoubtedly, the Complainant's trademarks, company name and trade name are identical to the Domain Name.

For these reasons, the Third Party Decider finds that the first condition of Article 10(b)(1) of the Policy is satisfied.

6.2 The registrant has no rights or legitimate interests in the domain name

In order to meet the second condition of Article 10(b)(1) of the Policy, Complainant must prove or at least make it plausible that the Licensee has no rights or legitimate interests in respect of the Domain Name.

None of the listed circumstances in Article 10(b)(3) of the Policy appears to be present in the case at hand.

First, the Respondent does not appear to be a licensee of the Complainant or to be allowed to use the Complainant's trademark in any way.

Second, there are no indications that the Respondent is making a legitimate and non-commercial or fair use of the Domain Name. Indeed, it appears that the disputed Domain Name leads a parking website containing commercial links directly related to the Complainant's goods or services and is offering the Domain Name for sale. In view of the above, the Panel finds that the use made by the Respondent of the Domain Name clearly indicates that the Respondent's primary intention is to unfairly exploit the goodwill of the Complainant's INSTAGRAM trademark, and that such use cannot be considered to be a "legitimate and non-commercial or fair use of the domain name" in accordance with Article 10b) 3.

Third, no evidence is available showing that the Respondent would have been commonly known by the Domain Name.

Finally, the Respondent did not file any reply to the Complaint. The Respondent hence fails to demonstrate that these circumstances, or other circumstances that would demonstrate the existence of any rights or legitimate interests of Respondent in the Domain Name, would be present in the case at hand.

The Third Party Decider therefore concludes that Respondent has no rights or legitimate interests in the Domain Name and that the second condition of Article 10(b)(1) of the Policy is also fulfilled.

6.3 The registrant's domain name has been registered or is being used in bad faith

In order to meet the third condition of Article 10(b)(1) of the Policy, the Complainant must prove that the Licensee registered or used the Domain Name in bad faith.

(a) Registration in bad faith

As evidenced by the Complainant, the INSTAGRAM trademark is highly distinctive and well-known, including in China and Belgium. Some panels have in certain circumstances found bad faith registration based in part on proof that the respondent "knew or should have known" about the existence of the complainant's trademark. Circumstances in which panels have made such finding have included those in which the complainant's trademark was shown to be well-known or in wide use on the Internet or otherwise at the time the domain name was registered (see *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. D2001-1092; *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. D2009-0320, <backberry.com> and *GUINNESS UDV NORTH AMERICA Inc. v. Monsieur Olivier Noel CEPANI* Case n° 44038 (<ermenegildozegna.be>).

The Panel considers that the wide publicity surrounding the Complainant's explosive growth and its strong online presence made it almost impossible for the Respondent to ignore the rights of the Complainant. This knowledge of the Complainant's rights prior to the registration of the Domain Name is indicative of bad faith.

Also, the fact that the parking page to which the disputed Domain Name resolves, displays direct links to the Complainant's services, only reinforces this impression: it is (highly) unlikely that the Respondent does not or did not have any knowledge of the Complainant's trademark, while the

Domain Name – which incorporates the Complainants' trademark – is being used to advertise pages directly linked to the Complainants' services.

Furthermore, businesses of social networking sites such as that of the Complainant's are primarily, if not exclusively, online in nature and it is customary for such sites to be accessible through domain names consisting of or including their trademark, trade name or company name. The Panel finds that given the Respondent was most likely aware of the Complainant's rapid growth and popularity it is highly unlikely that the Respondent did not register the disputed Domain Name anticipating that the Complainant would be interested in reflecting its trademark under the .BE ccTLD and thus registered the Domain Name to prevent the Complainant from reflecting its INSTAGRAM trademark in the corresponding .BE domain name.

Moreover, previous panels have held that a pattern of conduct of preventing a trademark holder from reflecting the mark in a corresponding domain name constitutes a finding a bad faith registration. A pattern of conduct can involve multiple UDRP cases with similar fact situations or a single case where the respondent has registered multiple domain names which are similar to trademarks (see *Home Interiors & Gifts, Inc. v. Home Interiors*, WIPO Case No. D2000-0010; *Playboy Enterprises International, Inc. v. Tom Baert*, WIPO Case No. D2007-0968 and *GUINNESS UDV NORTH AMERICA Inc. v. Monsieur Olivier Noel CEPANI* Case n° 44038 (<ermenegildozegna.be>).

In the case at hand, considering that the Respondent provides no proof to the contrary, and given the evidence submitted, it seems reasonable to assume the Respondent registered the Domain Name for this purpose and has engaged in a pattern of such conduct, not only concerning the Complainant's trademark, but also concerning the trademarks of other well-known products or services.

Finally, it would seem that the term INSTAGRAM does not – or at least did not – exist in the English language, nor in any other language and in particular not in Chinese, Dutch, French or German. The term appears to be coined by and for the Complainant exclusively. As such, the Panel is of the opinion that it is highly improbable that the registration by the Respondent of several domain names, including the disputed Domain Name, that incorporated this term, shortly after the publication of the surge in popularity of the Complainant's business (also in China), was a mere coincidence.

(b) Use in bad faith

Moreover, Complainant submits that the Domain Name is being used in bad faith.

It is generally acknowledged that a failure to respond to the allegations of the infringing nature of a domain name indicates bad faith. In the case at hand, the Respondent has failed to respond to the Complainant's allegations.

Paragraph 10b) 2 provides that a domain name is being used in bad faith when it is "*intentionally used to attract, for commercial gain, Internet users to the registrant's web site or other on-line location, by creating confusion with the complainant's trademark (...) or endorsement of the registrant's web site or location or of a product or service on his web site or location*".

In the case at hand, considering the Domain Name resolves to a parking page containing sponsored links to other webpages offering services or goods directly or indirectly related to the Complainant's services, and considering the Respondent could not reasonably have ignored the Complainant's well-known and highly distinctive trademark, it seems reasonable to assume that

the Respondent wanted to obtain financial gain by unduly profiting from the Complainant's goodwill and reputation. The offering for sale of the Domain Name only strengthens this assumption. Thus, the Panel is of the opinion that the Respondent is using the Domain Name in bad faith.

The Third-Party Decider concludes that the third condition of Article 10b) 1 is fulfilled.

Based upon the circumstances as explained in the Complaint and based upon the evidence supplied by the Complainant, the Third-Party Decider holds that the three cumulative conditions of Article 10 b) 1 of the Policy are met.

Hence, as the Third-Party Decider finds that the three conditions of Article 10b) 1 have been fulfilled, the Complaint is founded.

7. Decision

Consequently, in accordance with Article 10 (e) of the Policy, the Third Party Decider orders that the Domain Name "**instagram.be**" is to be transferred to the Complainant.

Brussels, 24 July 2015.



Geert Glas

The Third Party Decider

