

DISPUTE RESOLUTION SERVICE

D00022059

Decision of Independent Expert

Instagram, LLC

and

Mr Jake Kennedy

1. The Parties:

Lead Complainant: Instagram, LLC
1601 Willow Road
Menlo Park
California 94025
United States

Respondent: Mr Jake Kennedy
[full address redacted]
United Kingdom

2. The Domain Name(s):

instagram.org.uk (the “Disputed Domain”)

3. Procedural History:

I can 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 need be disclosed as being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

13 November 2019 17:18 Dispute received
15 November 2019 16:56 Complaint validated
15 November 2019 16:59 Notification of complaint sent to parties
04 December 2019 01:30 Response reminder sent
05 December 2019 15:23 Response received
05 December 2019 15:23 Notification of response sent to parties
10 December 2019 01:30 Reply reminder sent
12 December 2019 13:28 Reply received
12 December 2019 13:29 Notification of reply sent to parties
17 December 2019 15:47 Mediator appointed
17 December 2019 16:13 Mediation started
06 January 2020 15:06 Mediation failed
06 January 2020 15:07 Close of mediation documents sent
13 January 2020 12:19 Expert decision payment received

4. The Legal Framework

4.1 The complaint is brought under the Nominet DRS Policy which applies to all .uk registrations by virtue of the terms and conditions of registration. By clause 9.1 of those terms and conditions all registrants agree to be bound by the DRS Policy and by clause 13.6 that Policy forms part of the terms and conditions of registration of a .uk domain.

4.2 The DRS Policy applicable to this dispute is Version 4 in force since 1 October 2016. Paragraph 1 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”.

In the same paragraph Rights are defined as:

“rights, enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

4.3 Paragraph 2 of the DRS Policy provides as follows:

“2 Dispute to which the DRS applies

2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain name, in the hands of the Respondent, is an Abusive Registration.

2.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”

4.4 Paragraph 5 of the DRS Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration. They include the following factors which are relied upon by the complainants in the present case:

“5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated by, or otherwise connected with the Complainant.

5.1.6 The Domain Name is an exact match (with 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.”

4.5 Paragraph 5.1.1.1 is not expressly relied upon by the Complainant but is in the following terms:

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

5.1.1.1 for the purpose 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.”

I explain below why it seems to me that this provision is also relevant to the present complaint.

5. Factual Background

5.1 The Complainant, Instagram, LLC, is the well-known online photo and video sharing social networking application. It was launched in 2010. By December 2010, when it had been operating for two months, it had one million registered users. By September 2011 it had 10 million registered users. The Complainant was acquired by Facebook in April 2012 for US\$1 billion. By February 2013 it had reached 100 million monthly active users. It now has more than one billion monthly active users. Its website is hosted at www.instagram.com and is ranked by Alexa as the 14th most visited website in the world. Its apps consistently rank amongst the “top apps” for mobile devices. In 2011 it received the App of the Year award from Apple Inc.

5.2 The Complainant’s growth and rapidly increasing online presence have been widely documented in the technical press as well as the general press. The Complainant’s representatives have provided a range of examples to demonstrate this. The Complainant asserts, and it seems to me that this is not really open to challenge, that as a purely online business its domain names which comprise its trade mark are both the heart of its business and the primary mechanism for its users to use its services. The Complainant has registered many domain names which comprise or include the INSTAGRAM trade mark. I have been provided with a few examples in the material submitted in support of the complaint. These are instagram.com, instagram.net, instagram.com.br, instagram.org.in and instagram.net.ru.

5.3 The Complainant is the proprietor of trade mark registrations for the mark INSTAGRAM including US Trade Mark No. 4 146 057 registered on 22 May 2012, US Trade Mark No. 4 795 634 (for a stylised representation of the mark) registered on 18 August 2015 EU Trade Mark No. 14 493 886 registered on 24 December 2015 and International Registration No. 1 129 314 registered on 15 March 2012.

5.4 The Disputed Domain was registered on 24 July 2016. At the time of the Complaint, it was registered in the name of Identity Protect Limited of Hayes in Middlesex. The WHOIS lookup I have been given produced what is essentially a blank record, presumably for reasons related to the GDPR. On 11 February 2019 the Complainant’s representative sent a data release request to Nominet to obtain the Respondent’s contact details. The following day Nominet disclosed this information:

Registrant Name: Identity Protect Limited
Address: PO Box 786, Hayes, Middlesex, UB3 9TR
Contact Name: Identity Protection Services
Email address: Instagram.org.uk@identity-protect.org
Phone: +44.1483307527

Nominet also indicated that it had informed the registrant that the identity request had been made. On seeing this record, I confess that I do not understand why the registrant’s name is suppressed in the WHOIS lookup as the listed registrant is not an individual and no personal data is contained in the information given above.

5.5 In order to ascertain the actual identity of the Respondent so as to notify him of the Complainant's complaint, the representative contacted the named registrant, Identity Protect Limited, by telephone on 12 February to ask for the identity of the person on whose behalf it held the registration. Identity Protect's response was that it would do so only if the registrar, 123-Reg was unwilling to provide the information. On 23 March 2019, the Complainant's representative emailed 123-Reg. 123-Reg did not respond and, on 9 April 2019, a reminder was sent. This provoked a response approximately 20 minutes later in the following terms:

"Thank you for contacting us.

I am afraid 123 Reg cannot take any legal decisions.

To claim ownership of this domain name Instagram.org.uk, I would recommend that you try to amend the registration data directly with the registry and request to transfer the ownership. Nominet has different procedures and they might be able to help you update the registrant data so you can claim it with 123-reg.

To contact Nominet, please check the following link:

<https://registrars.nominet.uk/contact>

There is an alternative where we could get in touch with the domain holder for you. To do so, please update this ticket with a copy of your photo ID such as a passport or driver's license and your contact details:

- Full name
- Email address
- Phone number

This is applicable only on accounts where the owner logged in recently.

As this information is intended to be provided to the other interested party, we will require your written consent on the present email that we, 123-Reg, are allowed to disclose the above contact information (except the photo ID copy) to the current domain holder.

Once this information is passed along it is up to the domain holder if and when he/she will contact you to settle the matter.

Within 5 business days of passing on the contact information, if we will no receive any updates from either party on the status of the situation, 123-Reg will consider the case closed.

Also, regardless of the outcome, please update this ticket once a decision has been reached (amicable resolution / stalemate / legal action / etc) so that we have a complete record of this action and its extent."

5.6 Armed with this refusal to act, the Complainant's representatives contacted Identity Protect Limited on 12 April 2019. This email referenced the previous telephone call and attached the above email from 123-Reg. It also pointed out that Identity Protect Limited's Privacy Policy contains the following statement:

"Compliance with legal, regulatory and law enforcement requests. We co-operate with government and law enforcement officials and private parties to enforce and comply with the law. We will disclose any information about you to government or law enforcement officials or private parties as we, in our sole discretion, believe necessary or appropriate to respond to claims and legal process (such as subpoena requests), to protect our property and rights the property and rights of a third party, to protect the safety of the public or any person, or to prevent or stop activity we consider to be illegal or unethical."

In the material provided to me there is no response to this request and, in particular, no explanation why Identity Protect Limited did not consider the present circumstances to be ones in which it was appropriate to disclose to the Complainant the registrant's identity.

5.7 A further email attempting to obtain the information from 123-Reg was met with the following response:

"Thank you for getting back to us.

The "Identity Protect Details" are used as a mask to cover the real registrant details.

That is used with the domain owner opts to purchase a Privacy service, to avoid any spammers getting their details.

Unfortunately, we cannot provide you with the registrant details as it would be a security breach.

Also, 123 Reg does not have the authority to deal with Trademark/Copyright infringement.

You would need to contact legal assistance or open a WIPO case which would help you gain access to the domain itself.

We apologise for any inconveniences this might have caused."

5.8 As the Complainant's representatives have pointed out, the Disputed Domain resolved to the registrar's website making it clear that the registrar has control of the domain despite its blanket refusal to provide any assistance in ascertaining the holder of the Disputed Domain. The second response appears to be pro forma (it contains a wholly inappropriate reference to WIPO) and does not engage with the reality that the Complainant has an apparently valid reason for wishing to challenge the registration of the Disputed Domain.

5.9 On 16 July 2019 the Complainant's representatives sent a cease and desist letter to the email address provided by Nominet and noted above, asserting the Complainant's rights in the INSTAGRAM trade mark and requesting transfer of the Disputed Domain to the Complainant. There was no response to this letter and the Respondent claims not to have received it.

5.109 The Complainant accordingly brought the present complaint naming Identity Protect Limited as the Respondent. The complaint finally provoked a response from the Respondent. He wrote a two paragraph letter date 4 December 2019 in which he denied receiving the cease and desist letter and said that he had received nothing until the complaint was sent to him on 15 November 2019. He asserted that he is not used to dealing with official correspondence and has had to ask unspecified family and friends to assist him. He did not explain what, if any, assistance had been provided.

5.11 He admitted registering the Disputed Domain and being its legal holder. He then made the following statement:

"I can inform you that this was and never will be used in abusive manner that could effect [sic] the supposed claimant. I have purchased a number of domains with the intention of adding them to my collection. If the complainant wishes to transfer the name from me to themselves I would be willing to enter into mediation to ensure both parties can reach an agreeable solution. ... I look forward to hearing from your mediator so this can be resolved to both parties satisfaction."

5.12 In its Reply the Complainant says that it has since, using the information provided by the Respondent, ascertained that he does appear to have at least one other domain, xbox.wales, and that his registration of domains including well-known trade marks gives the impression that he has a disregard for the rights of others.

6. Parties' Contentions

6.1 The Complainant says that the Disputed Domain is abusive. The Respondent must have been aware of Instagram when he registered the domain, he has no legitimate use for it and its presence on the internet as a webpage bearing an advertisement for 123-Reg's services is (at least as a matter of initial interest) confusing to the public as it indicates a connection with the Complainant. The Complainant also says that simply holding the Disputed Domain without using it constitutes a threat by the Respondent to use it in a confusing manner. Consequently the Complainant says that paragraphs 5.1.2 and 5.1.6 of the DRS Policy are engaged and breached.

6.2 The Respondent's justification for registering the Disputed Domain is set out in full in the quotation in paragraph 5.11 above.

7. Discussions and Findings

Rights

7.1 The first question in any DRS dispute is whether the Complainant has “Rights” as defined by the DRS Policy. This is a threshold test and is readily satisfied. In the present case there no doubt that the Complainant has rights in the name and mark INSTAGRAM. Moreover, it is clear that the Complainant’s mark INSTAGRAM has a substantial reputation. It is the name of a very well-known and extremely widely used photo and video sharing service which is used by many millions of people all over the world. In my view it is reasonable to infer that almost everyone who uses the internet and many people who do not will have heard of it. As I explain below I have no doubt that the Respondent was aware of INSTAGRAM when he registered the Disputed Domain and that he did so despite that knowledge.

Abusive registration

7.2 The core questions in the present case are concerned with the issue of abusive registration and in particular whether the Disputed Domain falls within the scope of paragraphs 5.1.2 and 5.1.6 of the DRS Policy. The use by the Respondent of an identity concealment service is relevant in considering the appropriate responses to those questions. Perhaps even more important are the impact of that use both on the difficulties experienced by the Complainant in ascertaining who the Respondent is and on the inferences I am prepared to draw from the primary facts.

7.3 I have set out in full the responses given by the registrar 123-Reg to the enquiries made by the Complainant in seeking to identify the Respondent because they appear to me to indicate a deliberate refusal to engage constructively with a problem over which the registrar has complete control. The events set out above also demonstrate the unnecessary difficulty that a prospective Complainant encounters both as a result of the way in which registries have responded to GDPR and the use of identity protection services.

7.4 The use of identity protection services makes it very difficult to find out to whom a complaint should properly be addressed. In the present case it is clear, because the complaint is addressed to the protection service, that the Complainant was unable to identify the Respondent before launching the complaint. That difficulty was caused by the behaviour of both Identity Protect Limited, who appear to have refused to act, and 123-Reg, whose responses to the enquiries from the Complainant’s representatives were obstructive and condescending as well as being inappropriate. Having re-read them several times, I have formed the view that they are deliberately unhelpful and designed to make a Complainant’s life as difficult as possible. I do not consider that this contributes to the effective functioning of the domain name system and it seems to me that registries should give very careful thought to whether it is appropriate to permit the use of identity protection services for domains for which they are responsible without imposing a requirement that they must reveal the true identity of the registrant on receipt of a prima facie

justified request and ensuring that that requirement is complied with, if necessary by imposing sanctions on defaulting registrars and identity protection services. In my view a request from a person who asserts identified trade mark rights in a name similar to the disputed domain should be considered to be such a request. Despite the terms of Identity Protect Limited Privacy Policy which I have quoted in paragraph 5.6 above, it seems that this service does not disclose registrant identity information when faced with a prima facie valid request, or even condescend to explain why not. This seems to me to be a wholly unsatisfactory position for an identity protection service to adopt and in these circumstances the case for registries to act so as to ensure that information is disclosed when necessary is strengthened.

7.5 I also find it odd that a registry should withhold the name and address of an identity protection service where it is named as the registrant. As I have pointed out above, to list this would not involve revealing any personal data and it is difficult to see why the provisions of the GDPR do not permit this to be done. Then at least the prospective complainant would be aware of the use of the service from the outset.

DRS Policy paragraph 5.1.2

7.6 The first issue under this paragraph is whether the Disputed Domain, if put into use, is likely to confuse members of the public into believing that it is associated or connected with the Complainant. The second issue is whether the Respondent's behaviour either has resulted in such use or constitutes a threat to engage in such conduct.

7.7 It seems to me that the answer to the first question is clear. It is difficult to see how use of the domain name Instagram.org.uk to host an active website could fail to cause some form of confusion. As the Complainant has pointed out in its submissions, the name of the domain is likely to cause it to receive more traffic than would otherwise be the case as internet users happen upon it because of the name. In such circumstances, it matters not that they may be disabused of their initial misconception that there is a connection with the Complainant as soon as they visit the website, the site is taking advantage of the Complainant's well-known name to attract traffic. That advantage is self-evidently unfair because it has no justification.

7.8 The answer to the second question is not so straightforward. The Disputed Domain is not hosting an active website. It currently resolves to an advertisement for 123-Reg's website builder software. It would in my view require a particularly unsophisticated internet user to think that this was something being offered by or associated with the Complainant.

7.9 Does the holding by the Respondent of the Disputed Domain without putting it to active use constitute a threat to use it in a confusing manner? The Respondent says not. He asserts that he would never use it in an abusive manner. But, in that case, what would he do with it? It seems from his response that he would like to negotiate its transfer to the Complainant, presumably for a fee. I have no difficulty in inferring that the fee he would wish to charge would bring him a profit over the

cost of registration. Such conduct is not a breach of paragraph 5.1.2 of the DRS Policy but it is in my view a breach of paragraph 5.1.1.1. Even though the Complainant does not expressly invoke that paragraph, it seems to me that the Respondent is caught between a rock and a hard place. If his assertion that he would not use the Disputed Domain abusively is true, then his only justification for registration is to sell the domain to the Complainant (or possibly to a competitor of the Complainant). The proposition that he acquired it to “add to his collection” is nonsensical and close to meaningless. There is no point in having a registered domain unless there is at least a contingent intention to exploit it in some way. You cannot put it on display and show it to your friends. On the other hand, if the Respondent’s assertion that he would not use the Disputed Domain is untrue, then holding it constitutes a threat to use it in breach of paragraph 5.1.2 (because it could only ever be used confusingly). Either way the domain is an Abusive Registration.

DRS Policy paragraph 5.1.6

7.10 There can be no dispute that the Disputed Domain is an exact match for the Complainant’s registered trade mark and therefore for a name in which the Complainant has Rights. As noted in the previous paragraph, the Respondent’s purported justification for registering the Disputed Domain makes little or no sense. It seems to me that this makes the justification unreasonable. Furthermore, his justification leads to the inference that he was aware of Instagram because that is the only reason that he would wish to have that name in his domain name “collection”. If you don’t know who or what Instagram is, a made-up word with no meaning should have no interest as a collector’s item. I therefore deduce that the Respondent knew of the Complainant and its reputation when he registered the Disputed Domain.

7.11 In addition, the fact that the Respondent has chosen to hide his identity behind an identity protection service indicates to me that he is not quite the ingénue that he would like to suggest in his response. One has to understand the purpose of such a service in order to wish to take it up. The extreme difficulty that the Complainant encountered in trying (and failing) to find out who the Respondent was so that it could notify him of its complaint demonstrates the value of such a service to someone who does not wish to be found. A person who is aware of this is also aware that someone such as the Complainant might wish to find him. I deduce from this that the Respondent had some motive for concealing his identity and that that motive was more likely than not related to concealing his identity from the Complainant as well as third parties. His claim that he did not receive the cease and desist letter, despite the fact that it was sent to the same email address as the complaint in this dispute, which he did receive, supports that conclusion. By having no direct contact details available, a registrant is able to deny receipt of communications intended for him without there being any realistic prospect of challenging the denial.

7.12 In these circumstances I do not believe the Respondent's purported justification for registering the Disputed Domain and I conclude that the registration is abusive under paragraph 5.1.6 of the DRS Policy.

8. Decision

8.1 I find that the Disputed Domain is an Abusive Registration and I direct that it be transferred to the Complainant.

Signed Michael Silverleaf **Dated** 5 February 2020