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November 20, 2020

**BY EMAIL (whoisrequest@rr-facebook.com,
enf.fbinstagram.197195@ad-facebook.com,
enf.fbinstagram.200636@ad-facebook.com)**

Re: Domain name dontuseinstagram.com

Dear Instagram IP & DNS Enforcement Group:

We are writing in response to your emails to Paul Kruczynski (domains@kruczynski.com), dated January 9, September 23, and September 30, 2020, concerning the registration and use of the domain name dontuseinstagram.com. The Cyberlaw Clinic at Harvard Law School will be representing Paul Kruczynski in all further communications regarding this matter. Mr. Kruczynski's use of the domain name dontuseinstagram.com does not constitute an infringing use of the Instagram trademark. Accordingly, your claims are entirely without merit.

Background

On September 1, 2016, Mr. Kruczynski purchased the website URL dontuseinstagram.com with the vision to host articles and stories that discuss instances in which Instagram violates user privacy. Although Mr. Kruczynski still owns the website URL, he has not launched the website as of this date.

On January 9, 2020, Mr. Kruczynski received a cease-and-desist letter from Instagram IP & DNS Enforcement Group (whoisrequest@rr-facebook.com), claiming that Mr. Kruczynski's registered domain name dontuseinstagram.com infringes on Instagram's trademark. Instagram expressed that it "has an obligation to its users and the public to police against the registration and/or use of domain names that may cause consumer confusion as to affiliation with

or sponsorship by Instagram, dilute the distinctiveness of its INSTAGRAM mark, or otherwise tarnish the mark.” It demanded that Mr. Kruczynski “immediately cease using and . . . either delete or transfer to Instagram any site available at [dontuseinstagram.com].”

Mr. Kruczynski received a second set of emails from Instagram IP & DNS Enforcement Group on September 23 (enf.fbinstagram.197195@ad-facebook.com) and September 30 (enf.fbinstagram.200636@ad-facebook.com), 2020. The two emails received in September were essentially of the same content, with the one sent on September 23 titled “dontuseinstagram.com – Notice of Instagram Trademark Infringement” and the one sent on September 30 titled “dontuseinstagram.com – 2nd Notice of Instagram Trademark Infringement.” In these two emails, Instagram again claimed that Mr. Kruczynski’s registered domain name dontuseinstagram.com infringes on Instagram’s trademark. In addition, Instagram brought to attention that the domain name is resolving to a parked page, pay-per-click advertising or sponsored links, and demanded that Mr. Kruczynski “disable the servers so they do not connect to a page with content.” Prior to receiving the email on September 23, 2020, Mr. Kruczynski had not been aware of the existence of a parked page on the domain dontuseinstagram.com. The parked page displayed a message that the domain name has been registered with Gandi.net. Parts of the texts were linked to two different websites (<https://whois.gandi.net/en/results?search=dontuseinstagram.com> and <https://shop.gandi.net/en/domain/suggest?search=dontuseinstagram.com&source=parking>).

Trademark Infringement Claim

The legal claims that your letters make are frivolous. Even worse, your overreach imperils Mr. Kruczynski’s First Amendment rights. Mr. Kruczynski’s domain name is not likely to cause consumer confusion, which Instagram would be required to prove in order to succeed on a trademark infringement claim. *See Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 12 (1st Cir. 2008) (citing *Borinquen Biscuit*, 443 F.3d 116 (1st Cir. 2006)).

To establish likelihood of confusion, a trademark owner “must show more than the theoretical possibility of confusion.” *Int’l Ass’n of Machinists & Aero. Workers, AFL-CIO v. Winship Green Nursing Ctr.*, 103 F.3d 196, 198 (1st Cir. 1996). For courts to find a likelihood of confusion, it has to be shown that there is “a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care.” *Id.* Given that Mr. Kruczynski’s domain has not even been launched, Instagram cannot show more than a theoretical possibility of confusion. Moreover, as Mr. Kruczynski’s website dontuseinstagram.com currently resembles nothing like the Instagram website, it is inconceivable that any reasonably prudent purchaser exercising ordinary

care would confuse the two websites.

Even in the scenario that Mr. Kruczynski's domain dontuseinstagram.com becomes live and operates in a way Mr. Kruczynski originally intended it to, Instagram will not be able to establish that there is likelihood of confusion in Mr. Kruczynski's registration and use of dontuseinstagram.com under the First Circuit's eight-factor test. *See Oriental Fin. Grp., Inc. v. Cooperativa De Ahorro Crédito Oriental*, 698 F.3d 9, 17 (1st Cir. 2012) (citing *Beacon Mut. Ins. Co. v. OneBeacon Ins. Grp.*, 376 F.3d 8, 15 (1st Cir. 2004)). Mr. Kruczynski did not intend to claim any associations with the Instagram mark and did not intend to compete with Instagram. In fact, Mr. Kruczynski's domain would serve as a platform to criticize Instagram's user privacy violations, not as a social media platform for users to share photos and accumulate followers. The goods or services provided by dontuseinstagram.com would be significantly different from those provided by Instagram, and the channels of trade and advertising would be very different as well. It is unimaginable that there would be evidence of actual confusion where Instagram users actually confuse Instagram with a website criticizing Instagram, starting from the domain name itself. Even assuming that Instagram has a strong mark that most people recognize, it is overreaching for Instagram to forbid others from registering or using *any* name that mentions Instagram without due regard of relevant laws.

Even in the unthinkable case that Instagram could demonstrate likelihood of confusion, Mr. Kruczynski's use would be valid under a fair use defense. Courts have recognized that it is fair use for one party to use another party's trademark for the purpose of referring to the trademark owner's products or services. *See, e.g., Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175 (9th Cir. 2010) (holding that a car manufacturer holding the trademarked name "Lexus" could not maintain a permanent injunction against auto brokers listing Lexus cars on the domains www.buy-a-lexus.com and www.buyorleaselexus.com). In this case, Mr. Kruczynski's domain name dontuseinstagram.com contains the word "instagram" clearly for the purpose of referring to Instagram's service. If it is in Instagram's position that domain owners cannot use the mark "Instagram" when discouraging use of the Instagram service, we look forward to seeing Instagram defend that position in court.

The existence of a parked page on Mr. Kruczynski's domain does not create trademark infringement where there previously was not any. *See, e.g., Acad. of Motion Picture Arts & Scis. v. GoDaddy.com, Inc.*, No. CV 10-03738 AB (CWx), 2015 U.S. Dist. LEXIS 120871 (C.D. Cal. Sep. 10, 2015) (holding that the plaintiff failed to meet its burden of proving that a domain name registrar who operates parked page programs acted with a bad faith intent to profit from the plaintiff's marks). In fact, the existence of the parked page is largely irrelevant to the discussion of trademark infringement here, and you are overstepping by

demanding Mr. Kruczynski remove the parked page on his own registered domain.

Conclusion

Your claim of Mr. Kruczynski's alleged trademark infringement is ungrounded in law. The non-infringing nature of the use would have been obvious had an attorney even glanced at the name of the site.

To the extent that these emails were sent using an automated process that merely checks to see if a domain contains the word Instagram, and then automatically requests the transfer of a domain to you if it does, such behavior plays on the threat of litigation to suppress potentially lawful speech. I am aware that there may be many domains registered with the Instagram mark in them, some of which may be used for phishing or other nefarious purposes. But that does not justify a "spray and pray" strategy where you automatically send notices of infringement without any human review. Such notices may serve to unlawfully intimidate critics, requiring them to find legal counsel.

In terms of next steps, Mr. Kruczynski would appreciate the retraction of your letters and a clear statement that you do not intend to file suit over his ownership of dontuseinstagram.com. Ideally, such a retraction would also be accompanied by a discussion of what processes you will implement in order to ensure any messages you may send to domain owners will not attempt to intimidate lawful users of the Instagram wordmark.

Nothing herein shall be deemed an admission or waiver of any of Mr. Kruczynski's rights, remedies, defenses, and/or positions, all of which are expressly hereby reserved.

Very truly yours,

A handwritten signature in black ink, appearing to read "Kendra Albert", written in a cursive style.

Kendra Albert