

## **ADMINISTRATIVE PANEL DECISION**

Fenix International Limited v. LAWRENCE CALAZANS

Case No. D2023-4712

### **1. The Parties**

The Complainant is Fenix International Limited c/o Walters Law Group, United States of America ("United States").

The Respondent is LAWRENCE CALAZANS, Brazil.

### **2. The Domain Name and Registrar**

The disputed domain name <novinhasonlyfans.com> is registered with Dynadot Inc (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 13, 2023. On November 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 16, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on November 16, 2023.

The Center verified that the Complaint, together with the amendment to the Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2023. The Respondent sent an informal email communication to the Center on November 17, 2023. The Center sent a possible settlement email to the Parties on November 17, 2023. The Complainant did not request for a suspension of the proceedings. Accordingly, the Center proceeded with the commencement of panel appointment process on December 8, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on December 13, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant provides a social media platform at “www.onlyfans.com” through which users pay to upload their own content and also to view others’ content. Much of the content uploaded is what is described as adult entertainment.

According to the Complaint, in 2023 the Complainant’s website counts more than 180 million registered users and is one of the most visited websites in the world. In 2023 Similarweb ranked the Complainant’s website as the 94<sup>th</sup> on the World Wide Web and the 53<sup>rd</sup> most popular website in the United States.

The Complainant owns the domain name <onlyfans.com> which was registered in 2013.

The Complainant also owns multiple trademark registrations incorporating the term ONLYFANS throughout the world, including the following:

- United States trademark registration No. 5,769,267 ONLYFANS (word mark), registered on June 4, 2019 in class 35, claiming first use in commerce on July 4, 2016;
- United States trademark registration No. 5,769,268 ONLYFANS.COM (word mark), registered on June 4, 2019 in class 35, claiming first use in commerce on July 4, 2016;
- European Union trademark registration No. 017912377 ONLYFANS (word mark) registered on January 9, 2019 (application filed June 5, 2018) in classes 9, 35, 38, 41 and 42; and
- European Union trademark registration No. 017946559 ONLYFANS & device, registered on January 9, 2019 in classes 9, 35, 38, 41 and 42.

In addition to its registered trademark rights, the Complainant claims common law trademark rights in respect of the term “ONLYFANS”. In support of its claim to common law trade mark rights, the Complainant cites *Fenix International Limited v. c/o whoisprivacy.com / Tulip Trading Company, Tulip Trading Company Limited*, WIPO Case No. [DCO2020-0038](#) in respect of the domain name, <onlyfans.co> which was registered on May 30, 2017, prior to the filing of any of the Complainant’s trade mark applications and *Fenix International Limited v. WhoisGuard Protected, WhoisGuard Inc. / Samuel Walton*, WIPO Case No. [D2020-3131](#) reaffirming finding of the previous panel in *Tulip Trading*.

The Respondent registered the disputed domain name on June 26, 2023.

As per the evidence submitted in the Complaint, the disputed domain name resolved to an active website offering adult entertainment services in direct competition with the Complainant’s services, including content reproduced from the Complainant’s official website. The Respondent’s website contained an “OF” logo that is similar to the Complainant’s registered OF logo.

On September 12, 2023, the Complainant’s representative sent a cease-and-desist letter to the privacy service used by the Respondent in respect of the disputed domain name. The letter set out the Complainant’s trademark rights and sought *inter alia* cancellation of the disputed domain name.

Failing a response from the Respondent, on November 13, 2023, the Complainant filed the Complaint.

On November 17, 2023, the Respondent sent the Center the following informal communication in Portuguese: “O site já foi retirado do ar” (loose translation: The site has now been removed from the air). While drafting the decision, the disputed domain name merely points to a webpage stating “Account Suspended - Please contact your hosting provider to correct issues causing your website to be offline”.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- the disputed domain name is confusingly similar to the Complainant trademark ONLYFANS in which the Complainant has rights, since it consists of the Complainant's exact mark preceded by the descriptive term "novinhas", which does nothing to avoid confusing similarity. Indeed, "novinhas" is Portuguese slang for "young girls" (see *WhatsApp inc. v. Super Privacy Service LTD c/o Dynadot*, WIPO Case No. [D2019-2519](#)).
- The Respondent has no rights or legitimate interests in the disputed domain name since: (i) the Complainant has not authorized or somehow given consent to the Respondent to register and use the disputed domain name, (ii) the Respondent is not commonly known by the disputed domain name, and (iii) the Respondent's use of the disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. The Respondent's purpose and use of the disputed domain name is to impersonate or suggests sponsorship or endorsement by the Complainant. In this connection the Complainant points out that the Respondent's website includes an OF logo that is similar to the Complainant's registered OF logo.
- The disputed domain name was registered in bad faith. The Complainant's trademark ONLYFANS has been recognized in numerous previous UDRP proceedings as "internationally well-known" amongst the relevant public, such that the Respondent either knew or ought to have known of the Complainant's mark.
- The disputed domain name is being used in bad faith by the Respondent to intentionally create a false affiliation, and likelihood of confusion, with the Complainant and its mark.
- The Respondent's failure to respond to a cease-and-desist letter sent by the Complainant and attempt to hide its identity by using a privacy service are further evidence of bad faith.

Based on the above the Complainant requests the disputed domain name be transferred to the Complainant.

### B. Respondent

The Respondent did not file a formal response to the Complainant's contentions. The Respondent sent an email communication to the Center stating that the website at the disputed domain name had been removed.

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Complainant owns trademark registrations for the ONLYFANS mark.

The Panel finds the Complainant's mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (see section 1.11.1 of the Overview 3.0).

Although the addition of other terms (here, novinhas, meaning young girls in Portuguese) may bear on assessment of the second and third elements, the Panel finds the addition of such term, placed before the Complainant's mark ONLYFANS, does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, given the composition of the disputed domain name, wholly incorporating the Complainant's trademark with the addition of the term "novinhas", meaning young girls in Portuguese, and the absence of any relationship between the Respondent and the Complainant, the Respondent's use of the disputed

domain name carries a risk of implied affiliation with the Complainant, and can constitute neither a *bona fide* use nor a legitimate noncommercial or fair use of the disputed domain name. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The disputed domain name fully incorporates the ONLYFANS mark which is distinctive and well-known to the relevant public (as recognized by prior panels in a number of UDRP proceedings duly cited in the Complaint, amongst others: *Fenix International Limited v. c/o whoisprivacy.com / Tulip Trading Company, Tulip Trading Company Limited*, WIPO Case No. [DCO2020-0038](#); *Fenix International Limited v. Domains By Proxy, LLC, Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-3048](#)). In the Panel's view it is not conceivable that the Respondent would not have actual notice of the Complainant's mark when registering the disputed domain name.

As per the uncontested evidence submitted with the Complaint, the Respondent's website included an "OF" logo that is similar to the Complainant's registered OF logo, and offers adult entertainment content (including content reproduced from the Complainant's official website) in direct competition with the Complainant's services. This suggests that the Respondent targeted the Complainant when registering the disputed domain name and used it in the intentional attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

Having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Each of the above considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically: (i) the Complainant's trademark is distinctive and well known to the relevant public; (ii) the Respondent has failed to submit any claims or evidence of good-faith use; (iii) there is no relationship between the Respondent and the Complainant; (iv) the Respondent has failed to respond to the Complainant's cease and desist letter; and, (v) given the confusing similarity to the Complainant's trademark, there is no conceivable good faith use to which the disputed domain name could be put by the Respondent, that would not result in creating a misleading impression of association with the Complainant.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <novinhasonlyfans.com> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: December 27, 2023