

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Carolina Rodrigues, Fundacion Comercio Electronico

Case No. D2023-5228

1. The Parties

The Complainant is Fat Face Holdings Limited, United Kingdom, represented by SafeNames Ltd., United Kingdom.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <uscustomerservicefatface.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 15, 2023. On December 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 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 (Domains By Proxy, LLC, DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 28, 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 January 4, 2024.

The Center verified that the Complaint together with the amended 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 January 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 13, 2024.

The Center appointed Ahmet Akgüloğlu as the sole panelist in this matter on February 16, 2024. 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, Fat Face Holdings Limited, is a British clothing, accessories, and lifestyle company based in the United Kingdom. The FAT FACE brand was founded in 1988 and the company was established in 2000 and has continued to grow over the years. The Complainant has many stores in the United Kingdom and the United States of America ("United States").

The Complainant is the owner of several international trademark registrations, such as 848966 numbered "FAT FACE" International Trademark registered on December 15, 2004, and 001764760 numbered "FAT FACE" European Intellectual Property Office trademark registered on October 16, 2021. The Complainant also owns the 4934466 numbered "FATFACE" trademark registered in the United States on April 12, 2016 and several others as presented in Annex 9.

The Complainant also owns the <fatface.com> domain name registered on April 22, 1997.

The disputed domain name was registered by the Respondent on July 25, 2023.

The disputed domain name consists of terms "us", "customer", "service" and "fatface". As submitted by the Complainant, the disputed domain name resolves to a webpage that redirects users to an error webpage. Additionally, the disputed domain name was previously used to resolve a web page hosting "pay per click" (PPC) advertising links.

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

- (a) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant argues that there is a likelihood of confusion between the disputed domain name and the Complainant's "FAT FACE" trademarks. The Complainant claims that the goodwill and recognition that has been attained under the name "FAT FACE", which is a distinctive identifier associated with the Complainant's goods and services. The Complainant submits that the term "us" is referring to a geographic location of the "United States" for the provided goods and services. Additionally, the Complainant mentions that terms "customer" and "service" are also in connection with the Complainant considering its operations in the United States in the e-commerce and retail industries. Therefore, such terms are descriptive in their nature and should be eliminated during examination by the Panel. The Complainant also asserts that there is a common practice regarding ".com", which is a generic Top-Level Domain ("gTLD"), which should be disregarded under the first element evaluation as it is a standard requirement. The disputed domain name includes the exact copy of the Complainant's trademark with a geographic term and the top-level domain suffix ".com". Therefore, the Complainant contends that the usage of abovementioned terms in the disputed domain name is confusingly similar to the Complainant's earlier trademarks.

(b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant claims that the Respondent does not have any prior rights of interest to the term “Fat Face” which may justify the usage of the Complainant’s trademarks and the domain name. The Complainant highlights that the Respondent was not licensed or authorized by the Complainant to use domain names featuring the FAT FACE trademark. The Complainant stresses that the disputed domain name is held passively and redirects Internet users to an error webpage. Therefore, the Complainant affirms that the non-use of disputed domain name should be considered as not to be a bona fide offering of goods and services.

(c) The disputed domain name was registered and is being used in bad faith.

The Complainant submits that the Respondent registered the disputed domain name in bad faith, with the primary intention of taking advantage of the Complainant’s trademark as the Complainant’s trademark registrations predate the creation of the disputed domain name and replicates the trademark in its entirety. The Complainant also highlights that the disputed domain name was being used to direct Internet users to a webpage that displayed PPC hyperlinks to the Complainant’s competitors which constitutes an attempt to generate commercial gain by misleading online users. The Complainant also submits that the Respondent advertised the sale of the disputed domain name and put the disputed domain name up for sale on a domain name sale platform. Additionally, the Complainant underlines the Respondent’s activation of mail exchange (“MX”) records for the disputed domain name. The presence of MX records indicates that the Respondent is capable of engaging in phishing activity through email distribution. The Complainant also asserts that the disputed domain name, which leads Internet users to a nonresolvable website is bad faith use as it disrupts the Complainant’s operations considering that Internet users who would like to shop online and seek the Complainant’s online offerings will land on the Respondent’s webpage. Finally, the Complainant submits that the Respondent is a well-known serial cybersquatter who has been involved in more than 600 domain disputes, which shows the Respondent’s pattern of abusive conduct.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

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.

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 has provided evidence regarding its rights in registered “FAT FACE” trademarks. It is uncontested to the Panel that the Complainant also has rights to “FAT FACE” trademark as a result of goodwill and acquired reputation throughout the usage of the trademark globally.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The disputed domain name is composed of the terms “us”, “customer”, “service” and “fatface”. The disputed domain name includes the Complainant’s FAT FACE trademark in its entirety. When a domain name wholly incorporates a complainant’s registered mark that is sufficient to establish confusing similarity

for purposes of the Policy. (See *Mr. Price Group Limited v. Registration Private, Domains By Proxy, LLC / Mr Price*, WIPO Case No. [D2019-0878](#).)

The Panel also ignored the gTLD since it is viewed as a standard registration requirement and suggested as disregarded under the first element similarity test. (See [WIPO Overview 3.0](#), section 1.11).

Although the addition of the terms “us”, “customer,” and “service” may bear on the assessment of the second and third elements, the Panel finds the addition of such terms 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.

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.

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 was registered years later than the Complainant’s <fatface.com> domain name registration in 1997. A domain name that includes a known trademark is suggestive of the Respondent’s bad faith. (See *PJ Hungary Szolgáltató Korlátolt Felelősségű Társaság v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-1345](#).)

UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (See section 3.1.4 of the [WIPO Overview 3.0](#).)

In the present case, the Panel notes the disputed domain name currently resolves to a webpage that is unavailable. It is the Panel's view that such situation shows that the Respondent merely holds the disputed domain name with no intention of legitimate use which is an indicator of bad faith. According to section 3.3 of the [WIPO Overview 3.0](#), passive holding does not prevent a finding of bad faith.

According to the evidence provided by the Complainant, it is understood the by the Panel that the disputed domain name was used to resolve to PPC advertising webpages. Therefore, the Panel notes that the Respondent also registered the disputed domain name for the purpose of attracting users for commercial gain by creating a likelihood of confusion which is an indicator of bad faith according to the paragraph 4(b)(iv) of the Policy.

Additionally, the Panel notes that the MX records are set up for the disputed domain name, which would enable the Respondent to send emails under a domain name that is confusingly similar to the Complainant's mark. Such behavior may also amount to a use of the disputed domain name in bad faith. Although the record in this case contains no evidence of illegal behavior, the use of a domain name that is confusingly similar to a trademark in emails that do not originate with the trademark owner presents a risk to the reputation of a trademark and its owner. The Respondent has not rebutted that it may engage in this practice (See, *IPSOS v. Ipsos Market, ipsosmarketsurvey*, WIPO Case No. [D2023-2856](#).)

The Complainant submits, and the Respondent has not refuted that it is a well-known cybersquatter with many prior UDRP decisions finding against the Respondent. (See, *Sodexo v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-3132](#), *Calvin Klein Trademark Trust & Calvin Klein, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2018-2882](#)). The Panel notes the pattern of bad faith registrations, and the Panel finds that the disputed domain name was registered and is being used in bad faith.

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 <uscustomerservicefatface.com> be transferred to the Complainant.

/Ahmet Akgüloğlu/

Ahmet Akgüloğlu

Sole Panelist

Date: March 1, 2024