

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. 方智强 (fang zhi qiang)
Case No. D2024-0481

1. The Parties

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

The Respondent is 方智强 (fang zhi qiang), China.

2. The Domain Name and Registrar

The disputed domain name <fatface-uk.shop> is registered with Alibaba Cloud Computing Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on February 1, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2024, 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 (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 2024, 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 amended Complaint in English on February 5, 2024.

On February 2, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On February 5, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese the Respondent of the Complaint, and the proceedings commenced on February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 29, 2024.

The Center appointed Andrew Sim as the sole panelist in this matter on March 6, 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 is a British clothing, accessories and lifestyle company founded in 1988, which offers a wide-range of products including women's, men's and children's clothes, as well as household items, accessories and footwear to customers internationally. The Complainant operates its business on e-commerce platforms, as well as in brick-and-mortar locations.

The Complainant is the owner of a number of trademarks consisting FAT FACE or FATFACE (the "Mark"), with registrations in various jurisdictions, including the following:

- (a) FATFACE in classes 3, 9, 14, 16, 18, 25 and 35, United Kingdom trademark registration No. UK00912646659, registered on October 14, 2014;
- (b) FATFACE in classes 3, 9, 14, 16, 18, 25 and 35, United States of America trademark registration No. 4934466, registered on April 12, 2016; and
- (c) FAT FACE in class 25, New Zealand trademark registration No. 294292, registered on December 21, 1998.

The Complainant uses the Mark in connection with its clothing and accessory products and incorporates the Mark as part of its brand logo. The Complainant also maintains its official website at "www.fatface.com" to provide e-commerce services and operates a blog to inform customers about its products, fashion tips and other stories. Furthermore, it establishes the presence of its Mark by promoting its products under that name on various social platforms and launching the *Fat Face Foundation* in 2009.

The disputed domain name was registered on September 2, 2023. Prior to the Complaint, the disputed domain name redirected online users to the website "www.young-lauk.shop", which hosted an online clothing store. Currently, at the time of the Complaint and this decision, the disputed domain name does not resolve to any content.

On September 22, 2023, the Complainant sent a cease and desist letter to the Respondent through the Registrar. The Respondent did not reply to the letter.

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 (i) the disputed domain name is identical or confusingly similar to the Mark in which the Complainant has rights as it entirely incorporates the Mark; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and the Respondent's use of the disputed domain name does not relate to a bona fide offering of goods and services or for any legitimate

noncommercial or fair purpose, as the disputed domain name is currently inactive and was previously used to redirect online users to a third-party store offering competing goods; and (iii) the disputed domain name was registered and is being used in bad faith as the Respondent's registration and use of the disputed domain name is intended to confuse users as to the source of goods for commercial gain.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) neither the Complainant nor its representatives are familiar with Chinese; (ii) the website to which the disputed domain name previously redirected was entirely in English and purported to advertise sales in GBP; (iii) the inclusion of "uk" in the disputed domain name suggests that the Respondent intended to target English online users; (iv) the Respondent has registered other domain names which consist of English language words; and (v) translation would result in additional expenses for the Respondent and cause unnecessary delays.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

In this case, the Panel accepts the Complainant's submissions regarding the language of the proceeding. The Complainant may be unduly disadvantaged by having to conduct the proceeding in Chinese. The Panel further notes that the Center has notified the Respondent in both Chinese and English of the language of the proceeding and commencement of the proceeding. The Respondent chose not to comment on the language of the proceeding nor respond to the Complaint in either English or Chinese.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 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 entirety of the mark is reproduced 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.

Although a generic Top-Level Domain (“gTLD”) extension (“.shop”) is added to the disputed domain name, as a standard requirement of domain name registration, the gTLD may be disregarded in the comparison between the disputed domain name and the Mark. Accordingly, “.shop” is disregarded for the present purpose. [WIPO Overview 3.0](#), section 1.11.

Also, the addition of a hyphen and the term “uk” here may bear on assessment of the second and third elements. However, 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.

In particular, the Panel considers that the current inactive status of the disputed domain name does not comprise a bona fide offering of goods and services. See *Accenture Global Services Limited v. Marc Diks*, WIPO Case No. [D2021-1383](#). Additionally, the Panel takes note of the fact that the disputed domain name was previously used to redirect online users to a third-party store, which offers directly competing products with the Complainant. Given that the disputed domain name does not have any connotations related to the offering of clothing, except in association with the Complainant’s established retail business, the Respondent’s previous use is also not in connection with bona fide offering of goods or services, nor is it a legitimate noncommercial or fair use.

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.

In the present case, noting that the Complainant has proven an established reputation in its FAT FACE Mark and brand, the fact that the Respondent previously utilized the disputed domain name to redirect online users to a third-party store which offers competing goods with the Complainant, indicates an intentional attempt by the Respondent to confuse users as to the source of goods provided by the third-party store and therefore make use of the commercial value and goodwill of the Complainant’s brand for its profit.

See *Philip Morris Products S.A. v. Domains By Proxy, LLC* / \u5049Li Li, Xin Li Feng You Xian Gong Si, WIPO Case No. [D2022-1886](#).

As to the current non-use of the disputed domain name, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the 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. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Further, the Panel notes that the Complainant has sent a cease and desist letter to the Respondent prior to the Complaint through the registrar of the disputed domain name, but did not receive any reply from the Respondent. This reinforces the interference of bad faith registration and use.

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 <fatface-uk.shop> be transferred to the Complainant.

/Andrew Sim/

Andrew Sim

Sole Panelist

Date: March 20, 2024