

## **ADMINISTRATIVE PANEL DECISION**

Fenix International Limited v. GMO-Z.com RUNSYSTEM JSC / LE van anh  
Case No. D2022-0214

### **1. The Parties**

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

The Respondent is GMO-Z.com RUNSYSTEM JSC, Viet Nam / LE van anh, Viet Nam.

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

The disputed domain name <chiaseonlyfan.club> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 21, 2022. On January 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 25, 2022 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 in English on January 26, 2022.

On January 25, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 26, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on February 1, 2022. In accordance with

the Rules, paragraph 5, the due date for Response was February 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 23, 2022.

The Center appointed Keiji Kondo as the sole panelist in this matter on March 2, 2022. 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 owns and operates the website located at the domain name <onlyfans.com> and has used its domain name for several years in connection with the provision of a social media platform that allows users to post and subscribe to audiovisual content on the World Wide Web.

In 2022, <onlyfans.com> is a popular website, having more than 180 million registered users. According to Alexa Internet, it is the 428th most popular website on the World Wide Web, and it is the 264th most popular website in the United States.

In the European Union and United Kingdom, the Complainant has registrations in multiple classes for the ONLYFANS word and design marks. In the United States, the Complainant has registrations in International Class 35 for the ONLYFANS and ONLYFANS.COM word marks and registrations in multiple classes for the ONLYFANS word mark ("Mark"), and design mark ("Logo") (collectively, the "Marks"). Representative trademark registrations of the Complainant are as follows:

- ONLYFANS, European Union Trade Mark No. 017912377, registered on January 9, 2019 in Classes 9, 35, 38, 41, and 42; and
- ONLYFANS, US Registration No. 5,769,267, registered on June 4, 2019 in Class 35.

The disputed domain name was registered on July 10, 2021.

The website at the disputed domain name has a link that automatically redirects the viewers to a third party website, which offers adult entertainment services.

#### **5. Parties' Contentions**

##### **A. Complainant**

Firstly, the disputed domain name is identical or confusingly similar to the Complainant's Marks.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." In the present case, the disputed domain name consists of the Complainant's exact Mark with the only difference being the insertion of the descriptive term "chiase" (the Vietnamese word for "share") before the Complainant's Mark without the letter "s", which does nothing to avoid confusing similarity. See *Sharman License Holdings Limited v. Mark Jackson and ProxyOne Domain Trust*, WIPO Case No. [D2004-0965](#) (transferring <kazaa-file-sharing-downloads.com> to the owner of the KAZAA trademark).

The use of the ".com" Top-Level Domain ("TLD") does not change the result. According to the [WIPO Overview 3.0](#), section 1.11.1, "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

Given that the disputed domain name is legally identical – or, at the very least, confusingly similar to the Complainant’s Marks, the Complainant easily demonstrates that it has satisfied Policy Paragraph 4(a)(1).

Secondly, the Respondent has neither rights nor legitimate interests in the disputed domain name.

The Respondent has no connection or affiliation with the Complainant and has not received any authorization, license, or consent, whether express or implied, to use the Marks in the disputed domain name or in any other manner. The Respondent is not commonly known by the Marks and does not hold any trademarks for the disputed domain name. All are evidence that the Respondent has no rights or legitimate interests in the disputed domain name.

According to [WIPO Overview 3.0](#), section 2.5.1, the disputed domain name comprising the complainant’s trademark and certain additional terms cannot constitute fair use, when doing so effectively impersonates or suggests sponsorship or endorsement by the complainant. See *Fenix International Limited v. Leon Key, Key International enterprises LLC*, WIPO Case No. [D2021-0836](#) (the additional term “xxx” in <onlyfansxxx.com> “carries a risk of implied affiliation”).

The Respondent cannot claim that it has a right to use the disputed domain name under fair use, since it includes the Mark and the additional term “chiasé” (the Vietnamese word for “share”) which creates a risk of implied affiliation, for it refers to the social media act of “sharing” content – which is part of the Complainant’s registered services.

The website at the disputed domain name offers links to adult entertainment services (including content pirated from the Complainant’s users) in direct competition with the Complainant’s services, including “providing entertainment services ... in the nature of a website featuring non-downloadable video, photographs, images, audio, and ... in the field of adult entertainment.” Using a disputed domain name to host commercial websites that advertise goods and services in direct competition with the trademark owner does not give rise to rights or legitimate interests.

The Respondent registered and used the disputed domain name not because it refers to or is associated with the Respondent, but because the disputed domain name is identical or confusingly similar to the <onlyfans.com> domain name and Marks used by the Complainant in association with the Complainant’s services.

Thirdly, the disputed domain name was registered and is being used in bad faith.

Paragraph 4(b) of the Policy outlines non-exhaustive examples of registration in bad faith, including (1) circumstances indicating that the person who registered the domain name did so for the purpose of selling the domain name to the complainant to whom the trademark belongs; (2) the person registered the domain name with the purpose of preventing the complainant from registering the trademark in a corresponding domain name; (3) the registrant intended to disrupt the business of a competitor; and (4) the registrant attempted to attract Internet users for commercial gain by creating a likelihood of confusion with the complainant’s trademark. Regardless of whether the Panel applies any of the factors or simply applies common sense, the Respondent’s conduct amounts to clear bad faith.

From all available evidence, the disputed domain name was registered on July 10, 2021, long after the Complainant attained registered rights in the Marks, and long after the Complainant had common law rights in the Marks which had acquired distinctiveness. This acquired distinctiveness was so strong that the Complainant’s website is among the Top 500 most popular websites in the world. Bad faith registration can be found where “the widespread use and numerous registrations of the Marks ... long predate Respondent’s registration.” See *Fenix International Limited v. c/o who is privacy.com / Tulip Trading Company, Tulip Trading Company Limited*, WIPO Case No. [DCO2020-0038](#).

Previous UDRP panels have consistently found that registration of a domain name that is confusingly similar to a widely-known trademark, as is the case here, creates a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Here, the Complainant's Marks have 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 Marks and likely registered the disputed domain name to target the Marks. See *Fenix International Limited c/o Walters Law Group v. WhoisGuard, Inc., WhoisGuard Protected / Marry Mae Cerna*, WIPO Case No. [D2021-0327](#).

Because there is no benign reason for the Respondent to have registered the disputed domain name, it is clear that the Respondent registered the disputed domain name to target the Marks.

Bad faith registration has also been found where the disputed domain name includes the complainant's mark and an additional word that enhances the likelihood of confusion with the complainant, and thereby suggests that the website at the disputed domain name is authorized by the complainant to provide access to the complainant's services. Here, bad faith registration should be found, since the Respondent used the Complainant's ONLYFANS mark and the additional term "chiasé" (the Vietnamese word for "share") within the disputed domain name enhances the likelihood of confusion.

Previous UDRP panels have found that the respondent was likely aware of the complainant's trademark rights when it registered a confusingly similar domain name and began operating a website that provides products and services in direct competition with the complainant. Here, the Respondent registered the confusingly similar disputed domain name to offer services in direct competition with the Complainant (including content pirated from the Complainant's users), "including providing entertainment services ... in the nature of a website featuring non-downloadable video, photographs, images, audio, and ... in the field of adult entertainment". This is especially true where the respondent pirates material from the complainant's website, as is the case here.

The Complainant sent a cease-and-desist letter to the Respondent on November 8, 2021, demanding that the Respondent stop using and cancel the disputed domain name. The Respondent did not respond, thus necessitating the filing of this Complaint. The Respondent's failure to respond to this correspondence is further evidence of bad faith.

As earlier UDRP panels have stated, "[t]he overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another." *Rockstar Games v. Tex. Int'l Prop. Assoc.*, WIPO Case No. [D2007-0501](#). Here, the Respondent clearly registered the disputed domain name to divert Internet traffic from the Complainant's site to a website offering adult entertainment content (including content pirated from the Complainant's users) in direct competition with the Complainant's website. Thus, the Complainant requests that the disputed domain name be cancelled pursuant to paragraph 4(i) of the Rules.

Given that the Complainant had well-recognized rights years before the Respondent registered the disputed domain name, bad faith use should be found.

Bad faith use is found where the disputed domain name directs users to a commercial website that offers goods and services in direct competition with the trademark owner. See *Guardant, Inc. v. Jeff Park*, WIPO Case No. [D2009-0631](#). Such use is an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, affiliation, or endorsement of the disputed domain name. [WIPO Overview 3.0](#), section 3.1.4.

Here, the disputed domain name directs to a commercial website that offers adult entertainment content (including content pirated from the Complainant's users) in direct competition with the Complainant's services, including "providing entertainment services ... in the nature of a website featuring non-

downloadable video, photographs, images, audio, and ... in the field of adult entertainment.” As such, the Respondent is using the disputed domain name in bad faith.

The bad faith allegations set out in the paragraphs above, combined with the Respondent’s lack of interest or rights in the disputed domain name, should lead the Panel to the inevitable conclusion that there is no plausible circumstance under which the Respondent could legitimately register or use the disputed domain name and that, thus, the disputed domain name was registered and is being used by the Respondent in bad faith.

Under Paragraph 4(i) of the Policy, for the reasons described above, the Complainant requests the Panel order that the disputed domain name be cancelled, though the Complainant is aware that the disputed domain name can potentially be re-registered after cancellation.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Language of the Proceeding**

In its verification email transmitted to the Center on January 25, 2022, the Registrar confirmed that the language of the Registration Agreement is Japanese. The Complainant requested that English be the language of the proceeding on January 26, 2022. Considering the following circumstances, the Panel, exercising its authority to determine the language of the proceeding under paragraph 11(a) of the Rules, has decided English as the language of the proceeding:

- the Complaint was filed in English;
- the Complainant is a US entity, and represented by a US attorney;
- the Respondent’s address is in Viet Nam;
- on January 25, 2022, the Center sent a communication to the Parties, in English and Japanese, regarding the language of the proceeding, but the Respondent did not comment on the language of the proceeding;
- the word “club”, which is an English word, is used as part of the title of the Respondent’s webpage, the URL of which does not include “.club”, the generic Top-Level Domain (“gTLD”) of the disputed domain name, and the remainder of the language on the webpage being Thai or English (and not Japanese); and
- ordering the translation of the Complaint would only result in extra delay of the proceeding and additional cost for the Complainant.

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

The Complainant owns trademark registrations for ONLYFANS. The disputed domain name consists of “chiase”, “onlyfan”, and the gTLD “.club”. The disputed domain name substantially incorporates the Complainant’s trademark ONLYFANS, only eliminating “s”, which is a usual plural ending in English.

Because the Complainant’s trademark ONLYFANS remains clearly recognizable in the disputed domain name, elimination of the “s” does not prevent finding of confusing similarity. The addition of the word “chaise”, which means “share” in Vietnamese, does not prevent finding of confusing similarity. It is well established that the gTLD should typically be disregarded in finding of confusing similarity.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark within the meaning of paragraph 4(a)(i) of the Policy.

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

According to the Registrar, the Respondent is LE van anh, whose name has no similarity to the Complainant's trademark ONLYFANS. Moreover, the Respondent concealed its identity by using a privacy registration service. Therefore, the Panel finds that the Respondent has never been commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

The disputed domain name resolves to a webpage that automatically redirects the viewers to another webpage offering adult entertainment services, the contents provided by which includes content pirated from the Complainant's users. On the other hand, the Respondent has no connection or affiliation with the Complainant. The Complainant has not granted the Respondent any authorization, license, or consent, whether express or implied, to use the Marks in the disputed domain name or in any other manner. In addition, the services offered by the Respondent are in direct competition with the services offered by the Complainant. Therefore, the Respondent's use of the disputed domain name cannot be considered as a use in connection with a *bona fide* offering of goods and services under paragraph 4(c)(i) of the Policy. Nor can it be considered as noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

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

The disputed domain name was registered on July 10, 2021, while the Complainant's European Union trademark was registered on January 9, 2019. Moreover, according to the Complainant, the first use in commerce of the Complainant's trademark took place on July 4, 2016. Accordingly, when the disputed domain name was registered, the Complainant's trademark had been used for five years.

Considering that the Respondent offers services similar to those offered by the Complainant, it is inconceivable that the Respondent was not aware of the Complainant's trademark. On the contrary, the Respondent most likely has intentionally chosen the disputed domain name in an attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the services provided by the Respondent.

In addition, although it is well established that the meaning of a gTLD is not relevant under the first element, in this particular case, the Respondent's selection of the gTLD ".club" supports a finding of bad faith registration. The gTLD "club", in combination with the title of the Respondent's website being "Onlyfans club", strengthens the likelihood of confusion because it suggests knowledge of the Complainant's trademark and falsely suggests endorsement by the Complainant.

Therefore, the Panel finds that the disputed domain name was registered in bad faith.

As mentioned in the previous subsection, the disputed domain name resolves to a webpage that automatically redirects the viewers to another webpage offering adult entertainment services that are in direct competition with services offered by the Complainant. The disputed domain name is being used to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the services provided by the Respondent. Therefore, the Panel finds that the disputed domain name is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) 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 <chiaseonlyfan.club> be cancelled.

*/Keiji Kondo/*

**Keiji Kondo**

Sole Panelist

Date: March 16, 2022