

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. Roman

Case No. D2022-0336

1. The Parties

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

The Respondent is Roman, Spain.

2. The Domain Name and Registrar

The disputed domain name <onlyfans-free.com> is registered with Acens Technologies, S.L.U. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2022. On February 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 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 February 8, 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 on February 8, 2022. On February 8, 2022, the Center informed the parties in English and Spanish, that the language of the registration agreement for the disputed domain name is Spanish. On February 8, 2022, the Complainant confirmed its request that English be the language of the proceeding as set forth in the Complaint. The Respondent did not submit any comment on the Complainant’s submission request.

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 March 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 6, 2022.

The Center appointed Martin Michaus Romero as the sole panelist in this matter on April 12, 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

- 1) 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.
- 2) In providing services, the Complainant has made extensive use of the ONLYFANS trademark.
- 3) The Complainant has registered rights in the mark with the European Union Intellectual Property office ("EUIPO"), the United Kingdom Intellectual Property Office ("UKIPO"), the United States Patent and Trademark Office ("USPTO"), and the Complainant has developed extensive common law rights throughout the world.
- 4) In the European Union and United Kingdom, the Complainant has registrations in multiple Classes for the ONLYFANS word and figurative marks, *inter alia*, European Union Trade Mark No. 017912377 registered on January 9, 2019. In the United States, the Complainant has registrations in International Class 35 for the ONLYFANS and ONLYFANS.COM word marks, *inter alia*, the United States trademark registration 5,769,267, registered on June 4, 2019 (collectively referred as the "Marks").
- 5) The Complainant registered the <onlyfans.com> domain name on January 29, 2013, and has extensive common law rights in the ONLYFANS mark since at latest July 4, 2016, which is before the Respondent registered the disputed domain name on July 18, 2021.
- 6) In 2022 "onlyfans.com" is one of the most popular websites in the world, with more than 180 million registered users. According to Alexa Internet it is 428th most popular website on the World Wide Web and it is that 264th most popular website in the United States.
- 7) "onlyfans.com" is one of the most visited websites in the world, it has become a prime target for cybersquatters wishing to profit from the goodwill that the Complainant has garnered in the marks.
- 8) The Complainant's unregistered common law rights have been recognized in previous WIPO decisions as having accrued and acquired distinctiveness by no later than May 30, 2017. See *Fenix International Limited v. c/o who is privacy.com / Tulip Trading Company, Tulip Trading Company Limited*, WIPO Case No. [DCO2020-0038](#) (October 5, 2020) (recognizing the Complainant's unregistered rights to the Marks by this date); *Fenix International Limited v. WhoisGuard Protected, WhoisGuard, Inc. / Samuel Walton*, WIPO Case No. D2020- 3131 (January 3, 2021) (reaffirming finding of the previous panel in *Fenix International Limited v. c/o who is privacy.com / Tulip Trading Company, Tulip Trading Company Limited, ut supra*).
- 9) The Complainant's trademark rights were recognized in in over forty previous UDRP decisions, resulting in the cancellation or transfer of the corresponding domain names to the Complainant.
- 10) The Respondent registered the disputed domain name on July 18, 2021. The disputed domain name resolves to a website that purports to allow users to gain unauthorized access to the Complainant's services in an apparent phishing attempt to collect users' email addresses. The website at the disputed domain name

reproduces the Complainant's trademark.

5. Parties' Contentions

A. Complainant

The Complainant states in its Complaint that the Respondent:

- 1) Registered the disputed domain name, which is confusingly similar to the Complainant's trademark ONLYFANS without the Complainant's knowledge or authorization.
- 2) Registered the disputed domain name, which included the ONLYFANS trademark, to create confusion in Internet users that the disputed domain name <onlyfans-free.com> is affiliated with the Complainant.
- 3) Has no rights or legitimate interests in the disputed domain name.
- 4) Likely intended to confuse the Complainant's customers or potential customers, considering the complete reproduction of the ONLYFANS trademark.

Accordingly, the disputed domain name was selected, registered and used by the Respondent in bad faith and not for a *bona fide* offering of goods or services, nor any fair use, but rather to mislead Internet users, disrupt the Complainant's business, and affect the reputation of the ONLYFANS trademark.

B. Respondent

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

6. Discussion and Findings

Language of proceedings

The Complainant filed an amendment to the Complaint on February 8, 2022. The language of the registration agreement for the disputed domain name is Spanish, the Complaint was submitted in English.

UDRP Paragraph 11(a), states unless otherwise agreed by the Parties, or specified otherwise in the registration agreement the language of the administrative proceeding should be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The language of the Registration Agreement is in Spanish. The Complainant requested that this proceeding should be conducted in English, considering to avoid additional expenses and delay would likely be incurred by it if it has to submit the Complaint in Spanish, the Respondent's website is in English, and the disputed domain name includes the trademark ONLYFANS along the English word "free". The Respondent did not object the Complainant's request and did not raise any objection about the language of the proceeding.

Considering the arguments provided by the Complainant, the no objection of the Respondent and according to paragraph 10 of the Rules that it should be an expeditious procedure, the Panel determines that the language of the proceeding shall be English.

Substantive elements of the Policy

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in

accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

In order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has submitted evidence of its rights in the ONLYFANS trademark. The disputed domain name is confusingly similar to the Complainant’s ONLYFANS trademark. The disputed domain name reproduces the Complainant’s trademark ONLYFANS, adding the term “free” separated by a hyphen “-” and the generic Top-Level Domain (“gTLD”) “.com”

The Complainant’s trademark is included in the disputed domain name, and the gTLD, “.com”, and the term “free” do not prevent a finding of confusing similarity between the disputed domain name and the ONLYFANS trademark.

The Panel finds that the Complainant satisfies paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent has not received permission or authorization to use the Complainant’s trademark. The Respondent did not substantively reply to the Complainant’s contentions, as well as the cease and desist letter sent to him on November 18, 2021, demanding to stop using and cancel the disputed domain name and therefore has not provided any evidence to demonstrate anything to the contrary. It should be pointed out that nothing in the available record indicates that the Respondent is an individual, business, or corporation known by the name ONLYFANS.

Furthermore, the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services, nor for a legitimate or noncommercial fair use that might give rise to rights or legitimate interests in the disputed domain name.

There is no evidence that the Respondent is commonly known by the disputed domain name or owned a trademark or is making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent has chosen not to respond to the Complaint or to take any steps to counter the *prima facie* case established by the Complainant. The disputed domain name redirects Internet users to a website that purports to allow users to gain unauthorized access to the Complainant’s services in an apparent phishing attempt to collect users’ email addresses, and such situation does not qualify as a right or legitimate interest under the Policy.

The Panel finds that the Complainant satisfies paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

According to the evidence submitted by the Complainant, it is clear to the Panel that the registration and the use of the disputed domain name has been in bad faith, by including the ONLYFANS trademark, to intentionally attract Internet users for commercial gain. The inclusion of the term “free” separated by a hyphen “-” in the disputed domain name along with the Complainant’s trademark, attempts to deceive or lead

Internet users to believe that the disputed domain name is operated by the Complainant, or at least to take unfair advantage of its similarity with the Complainant's trademark, and domain name <onlyfans.com>.

The Respondent has demonstrated, by registering the disputed domain name an intent to capitalize on the goodwill of the Complainant's trademark. Furthermore, the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's website or other online location by creating a likelihood of confusion with the Complainant's ONLYFANS trademark. These activities constitute, in view of the Panel, clear evidence of registration and use of the disputed domain name in bad faith.

The Complainant's ONLYFANS trademark registrations and common law rights predate the registration date of the disputed domain name and the Respondent knew or should have known of the Complainant's trademark rights, considering the notoriety and worldwide reputation of the Marks. Therefore, it is unlikely that the Respondent was not aware of the Complainant's rights.

Considering that: 1) The disputed domain name is confusingly similar to the well-known trademark ONLYFANS; 2) The Respondent was fully aware of the Complainant's business activities, and its ONLYFANS mark at the time of registration, including the Complainant's logo; 3) The Respondent did not reply to the cease and desist letter sent to him on November 18, 2021; 4) The disputed domain name directs to a website purporting to offer access to Complainant services in what appears to be a phishing attempt to collect users email addresses; and 5) The statements and the evidence provided by the Complainant. The Panel finds that registration and use of the disputed domain name were in bad faith.

The Respondent seeks to attract for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation and/or endorsement of the Respondent's website. This also negatively affects the Complainant's online presence and disrupts the Complainant's business. See paragraphs 4(b)(iv) and 4(b)(iii) of the Policy.

The Panel finds that the Complainant satisfies 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, <onlyfans-free.com> be cancelled.

/Martín Michaus/

Martín Michaus

Sole Panelist

Date: April 26, 2022