

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Du-go Park
Case No. DME2023-0018

1. The Parties

The Complainant is Fat Face Holdings Limited, United Kingdom, represented by SafeNames Ltd., United Kingdom (“UK”).

The Respondent is Du-go Park, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <fatface.me> is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2023. On December 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 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 (Whois Privacy Private by Design, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On December 12, 2023, the Respondent informed the Complainant that he does not want to continue the dispute over the disputed domain name and requests the steps to transfer the disputed domain name. The Complainant replied on December 15, 2023, copying in the Center, that it does not want the proceedings to be suspended and on the same date filed an amended Complaint.

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 December 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 16, 2024.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on January 15, 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 following relevant facts are undisputed.

The Complainant is Fat Face Holdings Limited, a clothing and fashion accessories brand established in 1988 and owner of over 240 stores in the United Kingdom, Ireland and the United States of America. The Complainant is a successful and well known manufacturer and retailer of casual clothing sold under the brand name "fatface". The Complainant had a revenue of GBP 234.8 million in 2022.

The Complainant is the owner of multiple trademark registrations for FAT FACE, including for example European Union trademark registration No. 001764760 for FAT FACE (word mark), registered on October 16, 2001.

The Complainant is also the registrant of the domain name <fatface.com>, which was registered on April 22, 1997, and is used by the Complainant to link to its principal website where it promotes and offers for sale its products under the FAT FACE trademark. The principal website received 37 million visits in 2022.

The disputed domain name was registered on July 6, 2023. At the time of filing the Complaint and at the time of this decision, the disputed domain name resolves to a parked page. At the time of filing the disputed domain name was offered for sale on this parked page for USD5000.

The Complainant sent a cease and desist letter to the Respondent on August 11, 2023. The Respondent replied that it is the owner of the disputed domain name and that it is preparing AI-based web services business utilizing the disputed domain name which is unrelated to the Complainant. It communicates that it is open to discussions regarding the transfer of the disputed domain name if the Complainant would present a suitable proposal. The Complainant replied on August 21, 2023, that it does not want to negotiate. On the same day, the Respondent replied that he will put the disputed domain name on the open market as soon as possible. The Respondent replied that it is proposing the transfer the domain name for USD 200. The Complainant replied to that on August 22, 2023, that if the Respondent can provide the Complainant with the receipt (proof of expenditure) for the registration of the disputed domain name, that the Complainant may be willing to reimburse the Respondent those costs. On August 23, 2023, the Respondent replied that after consulting with his patent attorney, he concluded that the disputed domain name is not a "domain trademark infringement".

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 Respondent, before any notice to the Respondent of the dispute, did not use or make any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services", but is offering the disputed domain name for USD 5,000.

Furthermore, the Complainant's trademark registrations predate the creation date of the disputed domain name by at least 24 years. In addition, substantial goodwill has accrued since the Complainant's establishment in 1988 and the FAT FACE name has become synonymous with British lifestyle clothing and accessories. Finally, "FAT FACE" on popular Internet search engines such as Google list the Complainant's brand and services as the first result.

B. Respondent

Apart from communicating directly to the Complainant on December 12, 2023, that he does not want to continue the proceedings, but wishes to transfer the disputed domain name, the Respondent did not reply to the Complainant's contentions in these proceedings.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 the discussion before filing the Complaint, the Respondent indicated that it had registered the disputed domain name for services unrelated to the business of the Respondent. However, the Respondent has not provided any evidence of its plans. To the contrary during the following email discussion, it switched to

offering the disputed domain name for sale to the Complainant and after that threatening to put the disputed domain name on the “open market”. On a balance and certainly lacking a Response, the Panel finds that the correspondence between the Complainant and the Respondent would not indicate any legitimate interests on the part of the Respondent.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel refers to its considerations under 6.B.

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, based on the record before it and in particular the emails exchange between the Complainant and the Respondent, the Panel finds that the Respondent has registered and used the disputed domain name with the intention to sell the disputed domain name to the Complainant at a profit.

In addition, apart from offering 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.

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.me> be transferred to the Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: January 29, 2024