

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Kim Johnson
Case No. DCO2024-0024

1. The Parties

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

The Respondent is Kim Johnson, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <fatface-uk.co> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 20, 2024. On March 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 21, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details and contact information in the Complaint.

The Center verified that 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 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 19, 2024.

The Center appointed Jon Lang as the sole panelist in this matter on April 29, 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 brand founded in 1988. Its FAT FACE brand name derives from the famous skiing run in Val-d'Isère, named 'La Face'. The Complainant's brand is often stylized to "FATFACE", and the Complainant owns several registered trademarks for both "FAT FACE" and "FATFACE" including New Zealand trademark registration No 294292 (registration date: December 21, 1998), European Union trademark registration No 001764760 (registration date: October 16, 2001) and United Kingdom trademark registration No 00002448877 (registration date: August 31, 2007), all for FAT FACE.

By 2012, the Complainant had over 200 stores in the United Kingdom and Ireland. It has an international presence, and now has many stores in the United States of America and Canada. The Complainant had a revenue of GBP 270.9 million in 2023. Products sold under the FAT FACE brand include women's, men's and children's clothes, household items, accessories, and footwear.

The Complainant has had its official website at "www.fatface.com" since April 1997, receiving 42.8 million visits in 2023, with online sales accounting for 39.5% of revenue that year.

The Complainant has also established a social media presence and uses its FAT FACE trademark to promote its services, in particular on Facebook: "www.facebook.com/fatface"; Instagram: "www.instagram.com/fatface/"; Twitter: "twitter.com/fatface" and LinkedIn <https://uk.linkedin.com/company/fat-face>.

The domain name in dispute <fatface-uk.co> (the Domain Name) was registered by the Respondent on February 27, 2024 and used to resolve to an online shop website purporting to offer for sale products identical to the Complainant's.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy to secure a transfer of the Domain Name.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant holds registered trademarks for FAT FACE and therefore prima facie satisfies the threshold of having rights for the purposes of the UDRP. It also has goodwill and recognition in the name FAT FACE, which is a distinctive identifier of the Complainant's goods and services as recognised by previous UDRP panels.

The Domain Name is confusingly similar to the FAT FACE trademark. It encompasses the FAT FACE trademark in its entirety, with the addition of the geographical identifier "uk", separated by a hyphen. This addition does not negate confusing similarity, but reinforces the connection with the Complainant as a result of its operations in the United Kingdom. As to the country code Top-Level Domain (ccTLD) ".co" (for Colombia), this may be disregarded for comparison purposes, being a standard registration requirement.

The Respondent has no rights or legitimate interests in respect of the Domain Name

To the best of the Complainant's knowledge, the Respondent does not have any trademark rights in the term FAT FACE or similar term. It has not been licensed by the Complainant to use domain names featuring the FAT FACE trademark. Whilst the Policy provides some circumstances in which a Respondent may demonstrate a right or legitimate interest in a domain name, none apply here.

In particular, the Respondent has not used or prepared to use the Domain Name in connection with a bona fide offering of goods or services. It has in fact been previously used to host a site that impersonated the Complainant's offerings, and which displayed its FAT FACE logo and trademark. There was no disclaimer on the website accounting for its connection (or lack thereof) to the Complainant. The Respondent used visual indicia from the Complainant's website and purported to sell goods under the Complainant's name at discounted prices. The website also collected Internet users' sensitive information in the login, registration, and checkout processes. Such use can never confer rights or legitimate interests on a Respondent. The Registrar suspended the Domain Name and at present it does not resolve to any active webpage. As such, it is being passively held. Non-use of a domain name has been considered by panels not to be a bona fide offering of goods or services.

The Respondent has deliberately registered a domain name that is confusingly similar to the distinctive FAT FACE trademark, a phrase a trader would not legitimately choose unless seeking to create an impression of association with the Complainant.

To the best of the Complainant's knowledge, the Respondent is not commonly known by the distinctive term FAT FACE, nor any similar term and therefore there is no plausible reason for the registration and use of the Domain Name other than to take advantage of the goodwill and reputation attached to the FAT FACE trademark.

Mere ownership of the Domain Name does not confer a right or legitimate interest on the Respondent.

The Complainant's FAT FACE trademark is a distinctive term used to represent the Complainant's goods and services. There is no evidence that the Respondent has intended to use the Domain Name other than to target the Complainant. The Respondent was exploiting the FAT FACE trademark by creating increased traffic to its website and generating profit from purchases made on its website. A respondent's use of a complainant's mark to direct users to an impersonation site, does not support a claim to rights or legitimate interests in an identical or confusingly similar domain name.

The Respondent is not making a legitimate non-commercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the FAT FACE trademark. The Respondent has impersonated the Complainant's offerings through its previous use, to host a fraudulent online shop, and has thus attempted to misleadingly divert consumers for the purpose of deriving commercial gain. The Respondent's conduct has been illegitimate and so cannot constitute either legitimate non-commercial or fair use.

The Domain Name was registered and is being used in bad faith.

The Complainant submits that the Respondent has both registered and is using the Domain Name in bad faith.

The Complainant's trademark registrations pre-date the creation date of the Domain Name by at least 24 years. Substantial goodwill has accrued since the Complainant's establishment in 1988. Searching "FAT FACE" on popular internet search engines such as Google produces the Complainant's brand and services as the first entry. Internet users have access to FAT FACE trademark registrations on public trademark databases.

Mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity, can of itself create the presumption of bad faith. Such is the case here, given that the Domain Name replicates the FAT FACE trademark in its entirety, with the only addition being a geographical identifier for the United Kingdom ("uk"), separated by a hyphen. Such addition only reinforces the connection with the Complainant, given its operations in the United Kingdom. Moreover, the Respondent is based in the United Kingdom, where the Complainant is headquartered. It would be difficult for the Respondent to deny knowledge of the Complainant and its FAT FACE operations.

In all the circumstances, the Complainant submits that the Respondent registered the Domain Name in bad faith, with the primary intention of taking advantage of the Complainant's brand.

The Complainant also asserts that the Respondent has used the Domain Name in bad faith. It has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with its trademark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service thereon.

In particular, as described earlier, the Domain Name was previously used to host a fraudulent online shop purporting to offer for sale products identical to the Complainant's. Such use constituted a clear attempt to generate a commercial gain, by misleading online users into believing that the Respondent's offerings were associated with the Complainant, and subsequently profiting from purchases made on the website. Moreover, such use demonstrates the Respondent's awareness of the Complainant and its offerings.

Furthermore, using a confusingly similar domain name to lead Internet users to a non-resolving website is bad faith use as it disrupts the Complainant's operations. Such use may cause frustration among Internet users seeking the Complainant's online offerings and lead them to utilise alternative offerings instead. Moreover, a domain name's webpage not being functional has been recognised as "a real threat of consumer confusion that could lead to online users believing the Complainant's services to be inoperable, damaging consumer trust".

Passive use does not preclude a finding of bad faith. There are circumstances that can lead to such a finding, notwithstanding a passive holding. The overall circumstances of the case must be considered.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove that a respondent has registered a domain name which is: (i) identical or confusingly similar to a trademark or service mark in which a complainant has rights; and (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant is the owner of the FAT FACE trademark and thus clearly has rights in that long-established and world famous trademark.

Ignoring the country code Top-Level Domain (ccTLD) ".co", the Domain Name comprises the FAT FACE trademark followed by a hyphen and the letters "uk" to form <fatface-uk.co>. The space between the words FAT and FACE is irrelevant to any analysis of similarity; a space cannot be replicated in a domain name and in any event, the Complainant clearly has rights in the merged form of the brand name. However, given the addition of the hyphen and the letters "uk", the FAT FACE trademark and Domain Name are not identical and thus the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves "a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide "...in cases where a domain name incorporates the entirety of a trademark, (...) the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The FAT FACE trademark is incorporated in its entirety within the Domain Name. It is clearly recognizable within the Domain Name. The addition of the letters “uk”, being the well known geographic indicator for the United Kingdom, and the hyphen separating those letters from the FAT FACE trademark, does not prevent a finding of confusing similarity between the Domain Name and trademark.

The Panel finds that the Domain Name is confusingly similar to the FAT FACE trademark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

Although the overall burden of proof in UDRP proceedings is on a 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 of the three part test shifts to the respondent to come forward with relevant evidence demonstrating that it does in fact have rights or legitimate interests in the domain name. The burden of proof however always remains on the complainant. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied this second element ([WIPO Overview 3.0](#), section 2.1).

The Panel here finds that, by its allegations, the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find this element of the three part test also proven. However, despite this, the Panel is entitled to consider whether there would be anything inappropriate in such an outcome.

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. Even where, as is the case here, it is not licensed by or affiliated with a complainant, a respondent may still be able to show that it has rights to or legitimate interests in the domain name in issue. For example, a respondent can show that it has been commonly known by the domain name or that it is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. A respondent can also show that it is using a domain name in connection with a bona fide offering of goods or services. If these circumstances are proven, a respondent will have an answer to the Complaint. Here, however, the Respondent is not known by the Domain Name. Moreover, it is alleged that the Respondent has used the confusingly similar Domain Name to engage in illicit activity – hosting a website site that impersonated the Complainant’s offerings using the FAT FACE logo and trademark and other visual indicia taken from the Complainant’s website. It is also alleged that the Respondent did this for commercial gain, and that the website collected Internet users’ sensitive information. These allegations, which are supported by evidence which has not been challenged, are accepted by the Panel. Such use can never confer rights or legitimate interests on a Respondent. The fact that the Domain Name does not at present resolve to any active webpage, does nothing to suggest rights or legitimate interests.

The Respondent clearly knew of the Complainant and its FAT FACE trademark. The very purpose in the Respondent choosing the (confusingly similar) Domain Name it did was to deliberately create a false impression of association with the Complainant. The Respondent’s behaviour cannot of course amount to a bona fide offering of goods or services, and demonstrates a lack of intention of using the Domain Name for any legitimate noncommercial or fair purpose.

There is no evidence before this Panel suggesting that the Respondent might have rights or legitimate interests in the Domain Name. Accordingly, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a number of non-exclusive scenarios which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it.

The Respondent has used the Domain Name to impersonate the Complainant. It has clearly intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion. Moreover, it seems clear that the Respondent did, or intended to use the Domain Name in a phishing scam.

The fact that the Domain Name no longer resolves to a website and might therefore be treated as being passively held does not prevent a finding of bad faith registration and use. Indeed, a passive holding of a domain name can support a finding of bad faith in certain circumstances (see Section 3.3 of the [WIPO Overview 3.0](#)) but the Panel need not consider this issue further here, given the clear bad faith use described above which no subsequent use (whatever its nature) could 'cure'.

The Domain Name is confusingly similar to the famous and distinctive FAT FACE trademark. No Response was filed or evidence of actual or contemplated good faith use provided. Indeed, any good faith use of this confusingly similar Domain Name by the Respondent would seem highly implausible.

The Domain Name has the hallmarks of bad faith registration and use. The Complainant has satisfied at least one of the non-exclusive scenarios under Paragraph 4(b) of the Policy (intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion) but in any event, it is clear that the Respondent has sought to take unfair advantage of the Complainant's FAT FACE trademark and/or to abuse it, and such behaviour is broadly understood to constitute bad faith for the purposes of the Policy regardless of the non-exclusive scenarios set out under Paragraph 4(b).

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

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 Domain Name <fatface-uk.co> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: May 10, 2024