

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. Robert Scean

Case No. D2022-4301

1. The Parties

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

The Respondent is Robert Scean, Netherlands.

2. The Domain Names and Registrar

The disputed domain names, <freeonlyfans.cc> and <onlyfanssolutions.com>, are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 11, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 14, 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 amended Complaint on November 14, 2022,

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 November 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 8, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on December 15, 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 a social media platform at <onlyfans.com> – registered on January 29, 2013 – that allows users to post and subscribe to audiovisual content worldwide.

The Complainant is the owner of several trademark registrations for ONLYFANS, including the following, as per trademark certificates submitted as annexes to the Complaint:

- European Union Trade Mark No. 017912377 for ONLYFANS (word mark), filed on June 5, 2018, and registered on January 9, 2019, in classes 9, 35, 38, 41, and 42;
- European Union Trade Mark No. 017946559 for ONLYFANS (figurative mark), filed on August 22, 2018, and registered on January 9, 2019, in classes 9, 35, 38, 41, and 42;
- United States Registration No. 5769267 for ONLYFANS (word mark), filed on October 29, 2018, and registered on June 4, 2019, in international class 35;
- United States Registration No. 5769268 for ONLYFANS.COM (word mark), filed on October 29, 2018, and registered on June 4, 2019, in international class 35.

The disputed domain names <freeonlyfans.cc>, registered on May 14, 2021, and <onlyfanssolutions.com>, registered on May 13, 2021, are pointed to adult content websites expressly citing ONLYFANS on the home pages.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name <freeonlyfans.cc> is confusingly similar to the trademark ONLYFANS in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term “free” and the country code Top-Level Domain (“ccTLD”) “.cc” and that similarly, the disputed domain name <onlyfanssolutions.com> is also confusingly similar to the trademark ONLYFANS as it reproduces the trademark in its entirety with the mere addition of the term “solutions” and the generic Top-Level Domain (“gTLD”) “.com”.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant states that the Respondent is in no way connected to, or affiliated with, the Complainant and has never received any authorization, license, or consent, whether express or implied, to use the disputed domain names.

The Complainant contends that the Respondent is also not commonly known by the disputed domain names and that, given the Complainant’s world renown, the Respondent must have undoubtedly been aware of the Complainant when registering the disputed domain names, especially considering that both correspondent websites include content taken from the Complainant’s website and in direct competition with the Complainant’s services.

Moreover, the Complainant highlights that the Respondent has previously been found to have targeted the Complainant’s trademarks in a prior case decided under the Policy, namely *Fenix International Limited v. Domain Administrator*, See *PrivacyGuardian.org / Kelly Smit, onlyfansleak and Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Robert Scean*,

WIPO Case No. [D2021-2706](#), concerning the domain names <onlyfansfreak.com> and <onlyfansleak.cc>.

Lastly, the Complainant contends that the Respondent registered and used the disputed domain names not because they refer to or are associated with the Respondent, but because the disputed domain names are confusingly similar to the <onlyfans.com> domain name and the trademarks used by the Complainant in association with the Complainant's services.

In addition, the Complainant states that the Respondent cannot claim a right to use the disputed domain names under fair use, since they include the trademarks ONLYFANS and the additional terms "free" and "solutions", which create a risk of implied affiliation.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, i) considering its registration of the trademark ONLYFANS long predates the Respondent's registration of the disputed domain names, ii) that the disputed domain names are confusingly similar to the Complainant's prior well-known trademark, and iii) that the Respondent published on its websites content pirated from the Complainant's users, the Respondent registered the disputed domain names to target the Complainant and its trademarks.

The Complainant underlines that the Respondent also clearly registered the disputed domain names and used the Complainant's contents to divert Internet traffic from the Complainant's website to its own websites.

Furthermore, the Complainant informs the Panel that it sent the Respondent a cease-and-desist letter on September 23, 2022, demanding that the Respondent stop using and cancel the disputed domain names, but the Respondent failed to respond to such letter, a circumstance which would be further evidence of bad faith.

Lastly, the Complainant highlights that paragraph 4(b)(ii) of the Policy is also applicable to the present case since the Respondent has engaged in a pattern of registering infringing domain names corresponding to registered trademarks.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "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". Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain names registered by the Respondent are identical or confusingly similar to a 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 names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark ONLYFANS based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as annex C to the Complaint.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain names to assess whether the trademark 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"](#))).

Moreover, where the relevant trademark is recognizable within a 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 (section 1.8 of the [WIPO Overview 3.0](#)). In addition, the applicable Top-Level Domain ("TLD") in a domain name is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

In the case at hand, the Panel notes that the disputed domain names <freeonlyfans.cc> and <onlyfanssolutions.com> entirely reproduce the trademark ONLYFANS with the sole addition of the terms "free" and "solutions", respectively, and the ccTLD ".cc" and the gTLD ".com", which do not prevent a finding of confusing similarity.

Therefore, the Panel finds that the Complainant has proven that the disputed domain names are confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent may establish a right or legitimate interest in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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."

It is well established that the burden of proof lies on the Complainant. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative circumstance can be difficult considering such information is often primarily within the knowledge or control of the Respondent.

Accordingly, in line with previous decisions rendered under the Policy, it is sufficient that the Complainant show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks. Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain names, or that the Respondent, whose name disclosed in the Registrar's WhoIs records for the disputed domain names is Robert Scean, might be commonly known by the disputed domain names.

The Panel finds that the Respondent's use of the disputed domain names to redirect users to websites offering adult entertainment services in direct competition with the Complainant and displaying also content published by the Complainant's users on the website "www.onlyfans.com", does not amount to *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain names were registered and are being used by the Respondent in bad faith.

In the case at hand, the Panel notes that, in light of the prior registration and use of the trademark ONLYFANS in connection with the Complainant's adult entertainment services, provided via the website at the domain name <onlyfans.com>, and considering the popularity reached in the recent years by the Complainant's website, the Respondent was more likely than not aware of the Complainant's trademark at the time of the registration of the disputed domain names, which occurred in May 2021. Moreover, the explicit reference made by the Respondent to the Complainant's trademark ONLYFANS on the websites to which the disputed domain names resolve supports the finding that the Respondent indeed registered the disputed domain names to target the Complainant's trademark.

As to bad faith use, the Panel finds that, in view of the pointing of the disputed domain names to websites offering adult entertainment services in direct competition with the Complainant and displaying also content published by the Complainant's users on the website "www.onlyfans.com", the Respondent intentionally attempted to attract Internet users to its websites, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its websites, according to paragraph 4(b)(iv) of the Policy.

The Panel also finds that the Respondent registered the disputed domain names in order to prevent the Complainant from reflecting its trademark in corresponding domain names and that the Respondent has engaged in a pattern of such conduct according to paragraph 4(b)(ii) of the Policy since the Respondent, besides having registered the disputed domain names, was involved in a prior case concerning two other domain names confusingly similar to the trademark ONLYFANS, *i.e. Fenix International Limited v. Domain Administrator*, See *PrivacyGuardian.org / Kelly Smit, onlyfansleak and Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Robert Scean*, WIPO Case No. [D2021-2706](#). As stated in section 3.1.2 of the [WIPO Overview 3.0](#), "UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner".

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain names in bad faith according to 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 names, <freeonlyfans.cc> and <onlyfanssolutions.com>, be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: December 29, 2022