

## **ADMINISTRATIVE PANEL DECISION**

Fat Face Holdings Limited v. afgfrga  
Case No. D2023-4786

### **1. The Parties**

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

The Respondent is afgfrga, United States of America (“United States”).

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

The disputed domain name <fatfaceukdeals.shop> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 17, 2023. On November 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 17, 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 (PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 17, 2023, 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 20, 2023.

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 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 21, 2023.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on December 27, 2023. 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, with stores located in the United Kingdom, Ireland, United States, and other countries. The Complainant is the owner of registered trademarks in the marks FAT FACE and FATFACE, among which:

- European Union Trademark No. 001764760 for FAT FACE, registered on October 16, 2001, in International Classes 9, 18 and 25;
- European Union Trademark No. 004152005 for FAT FACE, registered on January 5, 2006, in International Classes 14 and 35;
- International Trademark No. 848966 for FAT FACE, registered on December 15, 2004, in International Class 35, and the designated countries being Australia, Norway, Russian Federation, and United States;
- United States Trademark No. 4934466 for FATFACE, registered on April 12, 2016, in International Classes 3, 9, 14, 16, 18, 25, and 35.

The Complainant also owns a domain name incorporating the marks FAT FACE and FATFACE: <fatface.com>. This domain name is used for its official website “www.fatface.com”, which provides e-commerce services and a blog informing customers on the Complainant’s products, fashion tips, and other stories.

The disputed domain name was registered on July 19, 2023, well after the Complainant secured rights in the marks FAT FACE and FATFACE. According to evidence submitted by the Complainant, the disputed domain name resolves to a parking page containing various Pay-Per-Click (“PPC”) advertisement links which are competing, unrelated, and redirecting to the Complainant’s own offerings.

The Complainant issued a cease and desist letter to the Respondent on August 14, 2023, however the Respondent did not respond.

#### **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 it has rights in the mark FAT FACE and that the disputed domain name is confusingly similar to these marks. They point out that the disputed domain name incorporates the FAT FACE mark in its entirety with the addition of the geographical identifier “uk” (for United Kingdom) and the term “deals”. In respect of the generic top-level domain (“gTLD”) “.shop”, which forms part of the disputed domain name, the Complainant requests that the Panel disregards it under the first element as it is a standard registration requirement.

Furthermore, the Complainant claims that the Respondent lacks a right or legitimate interest in the disputed domain name. The Complainant contends that, to the best of their knowledge, the Respondent does not have any trademark rights to the term FAT FACE and is not commonly known by FAT FACE or any similar term. In addition, the Complainant points out that there is also no evidence that the Respondent retains any unregistered trademarks to the term FAT FACE, nor any similar term. Moreover, the Complainant confirms

that the Respondent has neither received any license from the Complainant to use domain names featuring the FAT FACE trademark. Finally, the Complainant asserts that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant points to the fact that the disputed domain name is being used to direct Internet users to PPC advertisement links which are competing, unrelated, and redirecting to the Complainant's own offerings. The Complainant claims that such use does not confer a *bona fide* offering of services, since the disputed domain name utilizes the Complainant's FAT FACE mark to capitalize on the reputation and goodwill of the Complainant's mark.

Finally, the Complainant contends that the disputed domain name has been registered and is being used in bad faith by the Respondent in accordance with Paragraph 4(a)(iv) of the Policy. The Complainant points to the fact that the Complainant's trademark registrations predate the registration date of the disputed domain name and that the disputed domain name is confusingly similar to the Complainant's FAT FACE mark. Furthermore, the Complainant notes that the disputed domain name is being used to direct Internet users to a webpage that displays PPC hyperlinks to the Complainant's own offerings, its competitors, and unrelated links which, according to the Complainant, constitutes bad faith use since it is a clear attempt to generate commercial gain by misleading online users with the disputed domain name. Finally, the Complainant submits that a lack of reply to a cease and desist letter prior to commencing the proceeding infers bad faith behavior.

## **B. Respondent**

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

## **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.

Based on the available record, the Panel finds 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.

Based on the available record, the Panel finds the Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

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

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "uk" and "deals", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Finally, as for the applicable generic Top-Level Domain ("gTLD"), *i.e.*, the suffix ".shop", the Panel holds that this can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

Based on the available record, 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.

The Panel finds that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name. The Complainant has shown that the disputed domain name is being used to direct Internet users to PPC advertisement links, some of which compete with or capitalize on the reputation and goodwill of the Complainant’s marks in FAT FACE and FATFACE. This kind of use of the disputed domain name does not represent a bona fide offering and does not support rights or legitimate interests in the disputed domain name. [WIPO Overview 3.0](#), section 2.9.

In addition, the Complainant confirmed that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Finally, the Panel agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

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, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s marks (Paragraph 4(b)(iv) of the Policy). The disputed domain name is being used to direct Internet users to a webpage that displays PPC hyperlinks to the Complainant’s own offerings, its competitors, and unrelated links. These circumstances, in combination with the Respondent’s clear absence of rights or legitimate interests in the disputed domain name, are strong indicators of bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's FAT FACE and FATFACE trademarks. As demonstrated by the Complainant, such trademarks were registered many years before registration of the disputed domain name in several countries including the United States, the country of residence of the Respondent according to the WHOIS records. Furthermore, the disputed domain name incorporates the FAT FACE and FATFACE trademarks in their entirety and includes the terms "uk" and "deals" in its name as well as uses the gTLD ".shop". Moreover, as demonstrated by the Complainant, one of the PPC advertisement links on the website that the disputed domain name resolves to specifically mentions "Fatface Clothing". This suggests that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name since the Complainant operates in the UK, is active in the e-commerce and retail sectors, and sells clothing under its FATFACE brand. The Respondent's knowledge of the Complainant and its trademarks and therefore its registration in bad faith of the disputed domain name may accordingly be inferred from these circumstances. [WIPO Overview 3.0](#), section 3.2.2.

Moreover, the fact that the Respondent did not respond to the cease and desist letter which the Complainant sent to the Respondent on August 14, 2023 and failed to submit a response in these proceedings, further supports a finding of bad faith (see *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, WIPO Case No. [D2001-0210](#)). Finally, the fact that the Respondent used a privacy service can be used as an indication of bad faith. [WIPO Overview 3.0](#), section 3.6.

Based on the available record, 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 <fatfaceukdeals.shop> be transferred to the Complainant.

*/Benoit Van Asbroeck/*

**Benoit Van Asbroeck**

Sole Panelist

Date: January 10, 2024