

## ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. 代振生 (Zhen Sheng Dai)  
Case No. D2024-0615

### 1. The Parties

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

The Respondent is 代振生 (Zhen Sheng Dai), China.

### 2. The Domain Name and Registrar

The disputed domain name <fatfaceuk.shop> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on February 9, 2024. On February 12, 2024, the Center transmitted by email, to the Registrar, a request for registrar verification in connection with the disputed domain name. On February 21, 2024, 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 (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 21, 2024, 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 in English on February 22, 2024.

On February 21, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On February 22, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese, and the proceeding commenced on February 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 20, 2024.

The Center appointed Francine Tan as the sole panelist in this matter on March 21, 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. By 2012, the Complainant had over 200 stores in the UK and Ireland. The Complainant also has many stores in the United States ("U.S."). Its revenue in 2022 was GBP 234.8 million.

In 2007, the Complainant was acquired by Bridgepoint Capital, the news of which was widely covered in financial media.

The Complainant is the owner of trademark registrations for FAT FACE and FATFACE, including the following:

- New Zealand registration No. 294292 for FAT FACE, registered on December 21, 1998;
- European Union ("EU") registration No. 001764760 for FAT FACE, registered on October 16, 2001;
- EU registration No. 004152005 for FAT FACE, registered on January 5, 2006;
- International registration No. 848966 for FAT FACE, registered on December 15, 2004;
- UK registration No. UK00002448877 for FAT FACE, registered on August 31, 2007;
- UK registration No. UK00912646659 for FATFACE, registered on October 14, 2014; and
- U.S. trademark registration No. 4934466 for FATFACE, registered on April 12, 2016.

The Complainant operates its official website at "www.fatface.com". The <fatface.com> domain name was registered on April 22, 2007. In 2022, the Complainant's website received over 37 million visits. Its online sales in 2022 accounted for 38.8% of its revenue.

The Complainant also has a social media presence on Facebook, Instagram, and X (formerly known as Twitter). The Complainant launched the Fat Face Foundation in 2009. In 2022, its charitable causes included the planting of 57,000 trees in partnership with the National Forest Company, a donation to the Red Cross for Ukraine, and support for the Prince's Trust.

The disputed domain name was registered on December 4, 2023, and resolves to an inactive webpage.

#### **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:

- 1) The disputed domain name is confusingly similar to the FAT FACE/ FATFACE trade mark in which it has rights. The disputed domain name consists of the FAT FACE/FATFACE trade mark with the addition of the term "uk", signifying "United Kingdom". The addition of the generic Top-Level Domain ("gTLD") ".shop"

does not negate a finding of confusing similarity under the first element of the Policy. It in fact has a significant relation to the Complainant's industry and offering of goods.

2) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no trademark rights to FAT FACE/FATFACE. The Respondent is not commonly known by the disputed domain name or any terms thereof. The Complainant has never granted any licence to the Respondent to use the FAT FACE/FATFACE trade mark or to register the disputed domain name. There is no evidence that the Respondent is using or preparing to use the disputed domain name in connection with any bona fide offering of goods or services. The disputed domain name does not lead to an active webpage. The mere ownership of the disputed domain name does not confer a right or legitimate interest on the Respondent.

3) The disputed domain name was registered and is being used in bad faith. The earliest registration of the Complainant's FAT FACE/FATFACE trade mark pre-dates the registration of the disputed domain name by 25 years. Substantial goodwill has been accrued in the Complainant's FAT FACE/FATFACE trade mark. If the Respondent had performed the simplest of due diligence checks, he would have been made aware of the Complainant's rights in the FAT FACE/FATFACE trade mark. The inclusion of the term "uk" and the gTLD ".shop" further reinforce that the registration of the disputed domain name was done in bad faith and the Respondent specifically targeted the Complainant. The passive use of the disputed domain name does not preclude a finding of bad faith use.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons:

- (i) The Complainant and its representatives are not familiar with the Chinese language.
- (ii) The disputed domain name includes the use of the geographical indicator "uk", and the gTLD ".shop". These suggest that the Respondent intended to target UK Internet users, which gives rise to the inference that the Respondent has knowledge of the English language.
- (iii) Requiring the Complaint to be translated into English would result in additional expense and unnecessary delay in the proceeding.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English. The Respondent selected terms and the gTLD for its domain name registration which are derived from the English language and relate to the UK. These are all indicators of the Respondent's familiarity with the English language, which he could have disputed but did not. Having been notified by the Center in Chinese of the proceeding, the Respondent could have requested to file his response in Chinese but did not do so. Hence, the Panel finds that there is no prejudice to the Respondent in its decision for English to apply as the language of the proceeding.

### **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 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trade mark 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. The Panel finds that the addition of the term "uk" 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. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy.

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 Respondent is not commonly known by the disputed domain name, and was not licensed by the Complainant to use the FAT FACE/FATFACE trade mark or to register a domain name incorporating the trade mark. The disputed domain name resolves to an inactive webpage, and there is no evidence that the Respondent is using or preparing to use it for any legitimate noncommercial or fair use. The fact that the Respondent did not file any response in this proceeding is also evidence of the Respondent's lack of any rights or legitimate interests in the disputed domain name. 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.

The disputed domain name incorporates the entirety of the Complainant's distinctive FAT FACE/FATFACE trade mark with the addition of the term "uk". The Complainant's FAT FACE/FATFACE trade mark has been registered for many years. Given that length of time of registration and the fame of the Complainant's FAT FACE/FATFACE trade mark, the Panel finds that the Respondent more likely than not, would have known of the Complainant and its FAT FACE/FATFACE trade mark at the time he registered the disputed domain name. Further, the addition of the term "uk" in the disputed domain name (taking into account the fact that the Complainant is a company incorporated in the UK) was clearly a deliberate attempt to impersonate the Complainant and confuse Internet users seeking to visit the Complainant's website. This is further exacerbated by the choice of gTLD, ".shop", which would likely confuse the Complainant's customers, a very significant percentage of which purchase the Complainant's goods online.

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.

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 <fatfaceuk.shop> be transferred to the Complainant.

*/Francine Tan/*

**Francine Tan**

Sole Panelist

Date: March 28, 2024