

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Domain Admin, Privacy Protect LLC
PrivacyProtect.org and Eric Schafer
Case No. D2024-3549

1. The Parties

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

The Respondents are Domain Admin, Privacy Protect LLC PrivacyProtect.org, United States of America (“United States”), and Eric Schafer, Germany.

2. The Domain Names and Registrar

The disputed domain names <fatt-face.com> and <fattface.com> are registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 2, 2024. On September 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 4, 2024, 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 (Domain Admin, Privacy Protect LLC PrivacyProtect.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 4, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all disputed domain names are under common control. The Complainant filed an amended Complaint on September 4, 2024.

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 Respondents of the Complaint, and the proceedings commenced on September 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 30, 2024. The Respondents did not submit any Response. Accordingly, the Center notified the Respondents' default on October 1, 2024.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on October 2, 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 company founded in 1988, which offers a wide-range of products including women's, men's and children's clothes, as well as household items, accessories and footwear to customers internationally. The Complainant has an international presence and also operates its business on ecommerce platforms.

The Complainant is the owner of a number of trademarks for FAT FACE or FATFACE (the "Mark"), with registrations in various jurisdictions, including the following:

- FAT FACE in class 25, New Zealand trademark registration No. 294292, registered on December 21, 1998;
- FAT FACE in classes 9, 18, 25, European Union trademark registration No. 001764760, registered on October 16, 2001;
- FATFACE in classes 3, 9, 14, 16, 18, 25 and 35, United States trademark registration No. 4934466, registered on April 12, 2016.

The Complainant uses the Mark in connection with its clothing and accessory products and incorporates the Mark as part of its brand logo. The Complainant also owns a domain name <fatface.com> registered on April 22, 1997, which leads to the Complainant's official website at "www.fatface.com", providing e-commerce services and operating a blog to inform customers about its products, fashion tips and other stories. Furthermore, it establishes the presence of its Mark by promoting its products under that name on various social platforms and launching the Fat Face Foundation in 2009.

The disputed domain names were registered on July 22, 2024. At the time of the Complaint, the disputed domain name <fattface.com> did not resolve to an active website, and the disputed domain name <fatt-face.com> redirects to a third party website displaying the message "Sorry, This store is currently unavailable". At the time of this decision, the disputed domain names are both inactive.

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 names.

Notably, the Complainant contends that:

1) The disputed domain names are confusingly similar to the Complainant's Mark in which it has rights. The disputed domain names are distinguishable from the FAT FACE Mark only by the inclusion of an additional "t", which duplicates the "t" present in the FAT FACE Mark. Addition of a hyphen in the domain name <fatt-face.com> does not negate finding a confusing similarity. The addition of the generic Top-Level Domain ("gTLD") ".com" 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 Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondents have no trademark rights to FAT FACE/FATFACE. The Respondents are not commonly known by the disputed domain names or any terms thereof. The Complainant has never granted any licence to the Respondents to use the FAT FACE/FATFACE Mark or to register the disputed domain names. There is no evidence that the Respondents are using or preparing to use the disputed domain names in connection with any bona fide offering of goods or services. The disputed domain names do not lead to active webpages. The mere ownership of the disputed domain names does not confer a right or legitimate interest on the Respondents.

3) The disputed domain names were registered and are being used in bad faith. The earliest registration of the Complainant's FAT FACE/FATFACE Mark pre-dates the registration of the disputed domain names by 26 years. Substantial goodwill has been accrued in the Complainant's Mark. If the Respondents had performed the simplest of due diligence checks, he would have been made aware of the Complainant's rights in the FAT FACE/FATFACE Mark. The Respondents have registered the disputed domain names in order to rely on their visual similarity as a deliberate misspelling of the Complainant's Mark and so to clearly target the Complainant in its registration of the disputed domain names. The passive holding of the disputed domain names does not preclude a finding of bad faith use.

B. Respondents

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

6. Discussion and Findings

6.1. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that:

(i) the disputed domain names target the same Mark and share an almost identical pattern of composition, involving the FAT FACE Mark with the addition of the extra letter "t" only with the use of a hyphen for the disputed domain name <fatt-face.com>;

(ii) the disputed domain names were registered on the same date (July 22, 2024) through the same Registrar;

(iii) the disputed domain names both resolve or redirect to inactive websites or webpages.

The Center has discharged its duties to notify the persons listed as registrants of the disputed domain names. The Respondents have not submitted a formal Response or objected to the Complainant's consolidation request or to its arguments in support of such request.

As regards to fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as “the Respondent”) in a single proceeding.

6.2. Substantive issues

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) that the disputed domain names 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 were registered and are being used in bad faith.

The onus of proving these elements is on the Complainant even though the Respondent failed to submit a Response.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

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 Mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the evidence submitted by the Complainant, the Panel finds that the Complainant has shown rights in respect of its FAT FACE/FATFACE Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the Complainant’s Mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The disputed domain name <fattface.com> incorporates the Complainant’s Mark in its entirety, with the only difference being the additional letter “t”, which duplicates the “t” present in the FAT FACE Mark. The repetition of a single character in this way is a demonstration of “typosquatting”, which constitutes a common misspelling, satisfying the test for confusing similarity. See [WIPO Overview 3.0](#), section 1.9.

Same can be found with regard to the disputed domain name <fatt-face.com>, whereas the addition of the hyphen does not prevent the finding of confusing similarity either. See [WIPO Overview 3.0](#), sections 1.8 and 1.9.

The Panel further notes that the gTLD “.com” is required only for technical reasons and is generally ignored for the purposes of comparison of the Complainant’s Mark to the disputed domain names. [WIPO Overview 3.0](#), section 1.11.1.

In light of the above, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s Mark and that the first element of paragraph 4(a) of the Policy is satisfied.

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.

Based on the available record, the Panel finds that the Respondent has no trademark rights related to the disputed domain names. The Panel also has finds that the Respondent has not been commonly known by the disputed domain names.

The Complainant has not licensed, authorized, or permitted the Respondent to register the disputed domain names incorporating the Complainant’s FAT FACE/FATFACE Mark. The Panel also takes into account that the Respondent is not sponsored by or legitimately affiliated with the Complainant in any way.

The disputed domain names resolve or redirect to inactive webpages, and there is no evidence that the Respondent is using or preparing to use them for any legitimate noncommercial fair use.

Therefore, the Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

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.

The Complainant’s Mark was used and registered by the Complainant almost 26 years before the time of the disputed domain names registration. Moreover, the Complainant’s online presence including via the official website goes back to 1997. In the circumstances, the Panel finds it more likely than not that the Respondent had the Complainant’s FAT FACE/FATFACE Mark in mind when registering the disputed domain names (*Fat Face Holdings Limited v. Stephe Cox, fatface*, WIPO Case No. [D2024-0922](#)).

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 names 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. All of these conditions seem to have been met in the current proceedings.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's Mark, the composition of the disputed domain names (a misspelling version of the Complainant's Mark), and the employment of the privacy service in relation to one of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names do not prevent a finding of bad faith under the Policy.

Further, the Respondent has not participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use of the disputed domain names.

In light of the above, 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 names <fatt-face.com> and <fattface.com> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: October 8, 2024