

ADMINISTRATIVE PANEL DECISION

FIX DESSERT CHOCOLATE L.L.C. v. Terry Blanco

Case No. D2024-4904

1. The Parties

The Complainant is FIX DESSERT CHOCOLATE L.L.C., United Arab Emirates (the “UAE”), represented by DLA Piper Middle East LLP, UAE.

The Respondent is Terry Blanco, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fixchocolates.shop> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 27, 2024. On November 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 27, 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 (Holder of the disputed domain name, REDACTED FOR PRIVACY, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 28, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant informed the Center that it does not wish to amend the Complaint on December 6, 2024.

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 December 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default December 30, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on January 8, 2025. 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 developed a novel concept of dessert chocolates and launched its products in 2022 under the FIX DESSERT CHOCOLATIER figurative mark.

The Complainant owns trademark filings and registrations for or including FIX DESSERT CHOCOLATIER, such as the following:

- the UAE Trademark Registration number 421638 for FIX DESSERT CHOCOLATIER (figurative), filed on April 29, 2024, registered on July 10, 2024, covering goods in International Class 30; and
- the United Kingdom Trademark Registration number UK00004064666 for FIX DESSERT CHOCOLATIER (figurative), filed on June 17, 2024, registered on October 11, 2024, covering goods and services in International Classes 7, 11, 21, 29, 30 and 35.

The Complainant promotes its goods on the social media platforms, such as Instagram.

The disputed domain name was registered on July 23, 2024, and, at the time of filing of the Complaint, it was not actively used.

According to Annex 5 to the Complaint, before filing the Complaint, the disputed domain name was used in connection with a website designed to look like the official website of the Complainant, which prominently displayed the Complainant's FIX DESSERT CHOCOLATIER trademark and logo on the top of the home page, displayed similar product pictures as posted by the Complainant's official Instagram account, made various references to the Complainant's marks and products and was purported to offer for sale FIX DESSERT CHOCOLATIER branded products.

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, since its launch, the Complainant's FIX DESSERT CHOCOLATIER branded chocolate products have become extremely popular via social media platforms, and due to immediate and unprecedented levels of success it has enjoyed, the brand and its products have "gone viral", with many consumers around the world hailing it as the "Viral Dubai Chocolate"; the disputed domain name is confusingly similar to its trademark since the distinctive part of the disputed domain name is comprised of the word "fix" which is the most distinctive word element of its trademarks, and the word "chocolates" directly describes the products for which the Complainant's brand is well-known; also, by adding the generic Top-Level Domain ("gTLD") ".shop", the disputed domain name as a whole would be, in the consumers' minds, easily comprehended to be owned or operated as an official online shopping site of the Complainant for its well-known branded FIX DESSERT CHOCOLATIER chocolates; the Respondent has no rights or legitimate interests in the disputed domain name; the Respondent registered and is using the disputed domain name in bad faith; even if the website under the disputed domain name is inaccessible from the UAE at the time of filing the Complaint, according to the web pages archived by the Wayback Machine, in August 2024, the disputed domain name was used in connection with a website deliberately designed to look like the official

website of the Complainant, displaying the Complainant's registered trademarks and copyrighted product pictures, as well as offering for wholesale of FIX DESSERT CHOCOLATIER branded chocolates; the Respondent has caused actual confusion amongst Internet users as the Complainant received complaints from consumers that they were misled by the domain name and the website and, mistakenly believing it is the Complainant's website, placed orders with the website under the disputed domain name, but never received any products; the Complainant also reported the website under the disputed domain name to the UAE administrative authority; it is clear that the disputed domain name was registered in bad faith, not only to take unfair advantages of the reputation of the Complainant and its brand name, but also with the intention of committing fraud for illegal commercial gain.

B. Respondent

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

6. Discussion and Findings

The Complaint initially cited a privacy service as the Respondent. After the identification details provided by the registrant were disclosed to the Center by the Registrar, the Complainant was invited to amend the Complaint accordingly and was informed that "the Respondent identity determination is at the Panel's discretion upon appointment". The Complainant informed the Center that it does not wish to amend the Complaint. Paragraph 1 of the Rules defines a respondent as "the holder of a domain-name registration against which a complaint is initiated". Accordingly, the Panel deems the registrant, Terry Blanco, to be the Respondent.

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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.

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.

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 removal of the terms "dessert" and "chocolatier" from the Complainant's trademark and the addition of the term "chocolates", may bear on assessment of the second and third elements, the Panel finds that the deletion and/or addition of such terms do 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.

The Panel notes that the content of the website connected to the disputed domain name confirms the Panel's finding on confusing similarity. [WIPO Overview 3.0](#), section 1.15.

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 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.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain name in connection with a website promoting and offering for sale goods identical to those of the Complainant, reproducing the Complainant’s trademarks and copyrighted product images, without providing any disclaimer or clear information regarding the disputed domain name holder. Furthermore, the Complainant claims that the Respondent has caused actual confusion amongst Internet users which ordered goods from the website under the disputed domain name and did not receive any goods. Panels have held that the use of a domain name for illegitimate activity (e.g., the sale of counterfeit goods or impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 registered the disputed domain name in bad faith because it is confusingly similar to the Complainant’s earlier trademark registration, incorporating the most dominant word element in the Complainant’s trademark, i.e., the word “fix”, along with the term “chocolates” which directly related to the Complainant’s goods under the mark. Furthermore, the use of the disputed domain name enhances such finding.

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.

According to the evidence provided in Annex 5 to the Complaint, the disputed domain name resolved to a webpage suggesting it is the Complainant’s official website, by displaying goods very similar to the Complainant’s products, and copying the Complainant’s marketing images, trademark and logo.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt “to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the

respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name includes the beginning of the Complainant's trademark together with a non-distinctive term related to the Complainant's signature goods, and the website operated under the disputed domain name suggests to be one of the Complainant's official websites, by promoting goods very similar to Complainant's own chocolate products, displaying the Complainant's marketing images, reproducing its logo, and without providing a disclaimer or clear information on the owner, indeed in this Panel's view, the Respondent has intended to attract unsuspecting Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

Furthermore, according to Complainant's assertions, by using the disputed domain name, the Respondent has caused actual confusion and defrauded Internet users. Panels have held that the use of a domain name for illegitimate activity (e.g., impersonation/passing off, selling counterfeits, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

At the time of filing the Complaint, the disputed domain name was not connected to an active website.

UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel notes the composition of the disputed domain name (i.e., the dominant word element of the Complainant's mark together with a descriptive term related to the Complainant's goods); the Respondent's failure to respond to the present proceedings; the Respondent's provision of inaccurate contact details in the WhoIs (since the Written Notice by the Center could not be delivered), and finds that, in the circumstances of this case, the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy. [WIPO Overview 3.0](#), section 3.3.

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, `<fixchocolates.shop>`, be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: January 17, 2025