

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. Nguyen Thanh Tai
Case No. D2022-3443

1. The Parties

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

The Respondent is Nguyen Thanh Tai, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <cliponlyfans365.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 16, 2022. On September 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 2022, 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 (Privacy Service Provided by Withheld for Privacy ehf, Iceland) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 20, 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 amendment to the Complaint on September 20, 2022.

The Center verified that the Complaint, together with the amendment to 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 September 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 20, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on November 7, 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 is a United Kingdom company that owns and operates one of the leading global social platforms OnlyFans, which was founded in 2016, and has more than 180 million users worldwide.

Since February 29, 2013, the Complainant owns the domain name <onlyfans.com>, which links to its principal website that is used by artists and content creators (more than 1,5 million) from all genres, allowing them to monetize their content, which is often adult-oriented.

According to an April 28, 2022 capture of the web traffic and ranking service Alexa Internet, the Complainant's "www.onlyfans.com" website was the 177th most popular website in the world.

Among others, the Complainant owns the European Union Trade Mark Registration ("EUTM") No. 017912377 for the word mark ONLYFANS, registered since January 9, 2019, for goods and services of classes 9, 35, 38, 41, and 42 of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks.

The disputed domain name, registered on January 28, 2022, was resolving to website in Vietnamese language offering adult entertainment services. At the time of rendering of this administrative decision the disputed domain name did not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name fully incorporates its ONLYFANS trademark and is therefore confusingly similar to it. The only difference between the disputed domain name and its trademark is the Respondent's addition of the term "clip" before and the numerals "365" after the trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain names and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the disputed domain name was registered and is being used in bad faith. The Respondent must have had knowledge of the Complainant's trademark at the time of registration of the disputed domain name, since the website at the disputed domain name featured the Complainant's signature logo. The Respondent also operated a website that provided services in direct competition with the Complainant, which is further indicative of bad faith.

The Complainant requests that the disputed domain names be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely 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 respect of 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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among previous UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the ONLYFANS trademark and for the purpose of this administrative proceeding the Panel finds that the EUTM No. 017912377 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights in the ONLYFANS trademark, the Panel next assesses whether the disputed domain name <cliponlyfans365.com> is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), 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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark the domain name is normally considered confusingly similar to that mark for purposes of UDRP standing.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable generic Top-Level Domain ("gTLD") in a domain name (*e.g.*, ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain name fully incorporates the Complainant's ONLYFANS trademark. The Respondent's addition of the term "clip" (commonly used to describe a section of filmed, videotaped or recorded material) before, and numerals "365" (a common reference to 365 days in a year) after the trademark is in view of the Panel does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

Accordingly, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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 the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the ONLYFANS trademark.

The Complainant has never authorized the Respondent to use its trademark in any way, and its prior rights in the ONLYFANS trademark precede the date of registration of the disputed domain name.

There is no evidence that the Respondent is commonly known by the disputed domain name or any similar name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

The Respondent’s use of the disputed domain name that is confusingly similar to the Complainant’s trademark for a website offering services in direct competition with the services offered by the Complainant and its users does not amount to use for a *bona fide* offering of goods and services (see section 2.5.3 of the [WIPO Overview 3.0](#)).

The Panel finds, also noting the circumstances described below as regards bad faith, that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The ONLYFANS trademark of the Complainant, which the disputed domain name incorporates in its entirety, is a term invented by the Complainant and therefore highly distinctive for the corresponding services. A basic Internet search against the disputed domain name returns solely the Complainant and its business.

Previous UDRP panels have established that the Complainant’s ONLYFANS trademark had acquired a considerable reputation, not least in the adult entertainment industry (see *Fenix International Limited v. Registration Private, Domains By Proxy LLC./Jason Douglas*, WIPO Case No. [D2021-0829](#)).

The Respondent defaulted and thus failed to provide any explanation for its inclusion of such trademark of the Complainant in the disputed domain name, as well as for using the Complainant’s signature logo on its website at the disputed domain name.

In absence of any such explanations, based on the evidence submitted by the Complainant the Panel finds that the Respondent knew of the Complainant’s business and its trademark and registered the disputed domain name to trade on the goodwill attached to it.

Also, the Respondent’s website at the disputed domain name offered adult entertainment video services in direct competition with the Complainant and the Panel finds that the Respondent has used the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s ONLYFANS trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website, which is evidence of bad faith set out in paragraph 4(b)(iv) of the Policy.

The fact that the disputed domain name at the time of rendering of the decision did not resolve to an active website does not alter the Panel’s conclusions. According to section 3.3 of the [WIPO Overview 3.0](#), passive holding of a domain name does not prevent a finding of bad faith. The Panel cannot conceive of any legitimate use of the disputed domain name by the Respondent other than targeting the Complainant’s business and its ONLYFANS trademark, which establishes bad faith.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

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 <cliponlyfans365.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: November 21, 2022