

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. Whois Privacy, Private by Design, LLC /
KHALID ZAROUAL, SMART TECH ELEC
Case No. D2022-2931

1. The Parties

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

The Respondent is Whois Privacy, Private by Design, LLC, United States / KHALID ZAROUAL, SMART TECH ELEC, Morocco.

2. The Domain Name and Registrar

The disputed domain name <megaonlyfans.com> is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 8, 2022. On August 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 9, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 10, 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 August 10, 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 August 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 1, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on September 5, 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 owns and operates a website at <onlyfans.com> that provides a social media platform that allows Internet users to post and subscribe to audiovisual content, and has made extensive use of the trademark ONLYFANS in that regard. The Complainant has United States registrations in International Class 35 for the word marks ONLYFANS and ONLYFANS.COM (Registration No. 5769267 and 5769268, respectively, both registered on June 4, 2019) and United States registrations in multiple classes for the ONLYFANS word mark (or 'logo'; Registration No. 6253455). The Complainant also owns two European Union trademark registrations for the ONLYFANS mark and logo, and for two identical United Kingdom registrations resulting automatically from that country's exit from the European Union: European Union Trade Mark No. EU017912377 and EU017946559 and United Kingdom Trade Mark No. UK00917912377 and UK00917946559, all of them registered on January 9, 2019.

The Complainant has pursued trademark registrations across the world in other countries and asserts that it also benefits from extensive common law rights in <onlyfans.com> since that domain name was registered on January 29, 2013.

The disputed domain name was registered on December 29, 2021. It resolves to a commercial website that offers adult entertainment content, including content pirated from the Complainant's users.

5. Parties' Contentions

A. Complainant

The Complainant says that <onlyfans.com> resolves to one of the most popular websites in the world, with more than 180 million registered users in 2022. The Complainant points out that the ONLYFANS mark is immediately recognizable in the disputed domain name. The only difference with the disputed domain name concerns the insertion of the descriptive term "mega" before the Complainant's ONLYFANS mark, which does nothing to avoid confusing similarity, or so the Complainant contends.

The Complainant says that the Respondent has no connection or affiliation with it and has not received any authorization, license, or consent, whether express or implied, to use its trademarks in any manner. The Respondent is not commonly known as "onlyfans" and according to the Complainant, does not hold any trademarks relevant to the disputed domain name. All these alleged facts indicate that the Respondent has no rights or legitimate interests in the latter.

Because of the global fame and success of the Complainant, the Respondent is said to have been aware of the Complainant's marks at the time of registration, and that the Respondent had no rights in relation to them at that time. The Complainant says there can be no fair use, if the use of the Complainant's marks effectively impersonates or suggests sponsorship or endorsement by the Complainant. The addition of the term "mega" creates a risk of implied affiliation, because, according to the Complainant, that term means "of the highest level of rank, excellence, or importance", thus suggesting that the site shows the Complainant's top "creators". The website to which the disputed domain name resolves provides adult entertainment services in direct competition with the Complainant. This does not cause rights or legitimate interests to vest in the Respondent. The Complainant maintains that this is especially true where, as here, content previously published at the Complainant's website is offered free of charge by the Respondent, without remunerating the Complainant or the respective creators.

The Complainant points out that the disputed domain name was registered long after the Complainant's trademarks were registered, and long after they acquired common law protection, due to their high level of acquired distinctiveness (with the website being ranked amongst the top 500 in the world). Registering a domain name that is confusingly similar to a trademark with a wide-spread reputation amounts to bad faith registration, the Complainant points out. There is no benign reason for the Respondent to have registered the disputed domain name, and the Complainant therefore maintains that it was registered for the sake of 'targeting' the Complainant's marks. The Complainant also says inclusion of the term "mega" within the disputed domain name enhances the likelihood of confusion as it references the Complainant's top creators. Including pirated content from the Complainant's platform further indicates bad faith registration. The cease-and-desist letter sent to the Respondent on May 31, 2022, remained unanswered, a failure that constitutes further evidence of bad faith, according to the Complainant.

The Complainant asserts that bad faith use should be found where the disputed domain name directs users to a commercial website that offers goods and services in direct competition with the trademark owner, as is the case here. Such use is said to be an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, affiliation, or endorsement of the disputed domain name. The Respondent never responded to the Complainant's cease-and-desist letter and hid behind a privacy shield, all factors that further support a finding of bad faith use, according to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is not identical to the Complainant's mark, but that mark is immediately recognizable within it. The addition of the term "mega" does nothing to detract from the conclusion that the disputed domain name is confusingly similar to the ONLYFANS trade mark. That mark is both registered by the Complainant in a number of jurisdictions, and a distinctive sign in which the Complainant has common law rights.

Therefore the Panel holds that the disputed domain name is confusingly similar to the ONLYFANS trademark of the Complainant.

B. Rights or Legitimate Interests

The Complainant has not authorized any use of its distinctive trademarks by the Respondent in any form. There is no evidence that the Respondent has registered ONLYFANS or anything similar as a trademark in any jurisdictions or is known by that concocted term. The Respondent did not answer any of the contentions of the Complainant nor did it respond to the letter of demand of the latter. The website to which the disputed domain name resolves offers competing material, some of which is apparently pirated from the Complainant's own platform. There is thus nothing before the Panel that supports an inference or conclusion that the Respondent has rights or legitimate interests in the disputed domain name. The reality is that the Respondent has registered the disputed domain name so as to take advantage of its widely established reputation, to its own financial advantage, and that without any valid reason or consent from the Complainant.

Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

When the disputed domain name was registered by the Respondent, the Complainant had used the terms “onlyfans” and “onlyfans.com” in the course of business to such a very large extent. In 2022, it had 180 million registered users for its “www.onlyfans.com” website. That figure alone suggests that the Respondent must have been aware of the Complainant’s use and rights in the ONLYFANS mark at the time of registration. The mark has been in use for a considerable amount of time in relation to a web platform that has a very large number of users, and thus benefits from ample acquired distinctiveness. The fact that the Respondent offers competing services via the disputed domain name, and some contents are pirated from the Complainant, further indicates that the Respondent was very likely aware of the Complainant’s use of the term “onlyfans” in commerce and of the reputation it possessed in that term at registration of the disputed domain name. The use the Respondent put the disputed domain name to indicates bad faith. As said, the site to which it resolves includes content derived from the Complainant’s platform without consent, and otherwise competing content. It is clear that the Respondent set out to benefit from the consumer confusion engendered by its website name, that is, the disputed domain name, to attract Internet users to the Respondent’s website. The Respondent set out to benefit from deceiving unsuspecting Internet users by registering the disputed domain name. This is the essence of bad faith use.

Therefore, the Panel holds that the disputed domain name was registered and is being used in bad faith.

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 <megaonlyfans.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: September 19, 2022