

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. Taren YAM

Case No. D2023-1074

1. The Parties

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

The Respondent is Taren YAM, France.

2. The Domain Name and Registrar

The disputed domain name <onlybigassfans.org> is registered with Ligne Web Services SARL (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2023. On March 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 13, 2023, 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 (Registrant of onlybigassfans.org, Redacted for Privacy c/o Ligne Web Services SARL) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 20, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On March 20, 2023, the Center transmitted an email in English and French to the Parties regarding the language of the proceeding. The Complainant filed an amended Complaint on March 22, 2023. The Complainant confirmed its request that English be the language of the in its amended Complaint. The Respondent did not comment on the language of the proceeding.

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 both in English and French, and the proceedings commenced on March 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 17, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on May 4, 2023. 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 the registered owner of many trademarks for ONLYFANS, e.g. European Union trademark registration no. 017912377, registered on January 9, 2019 for goods and services in classes 9, 35, 38, 41, and 42.

The disputed domain name was registered on July 24, 2022, and resolved to a website offering adult entertainment services, displaying the Complainant's watermark.

The Complainant sent a cease-and-desist letter to the Respondent on December 6, 2022, demanding the Respondent stop using and cancel the disputed domain name. The Respondent did not respond.

5. Parties' Contentions

A. Complainant

It results from the Complainant's undisputed allegations that it operates the website "www.onlyfans.com" and has used its domain name for several years in connection with the provision of a social media platform that allows users to post and subscribe to audiovisual content on the World Wide Web. In 2023, the website "www.onlyfans.com" has more than 180 million registered users.

The Complainant contends that its trademark ONLYFANS is distinctive and well-known.

The Complainant further contends that the disputed domain name is identical or highly similar to the Complainant's earlier trademarks, since it reproduces the earlier trademark ONLYFANS, together with the generic term "big ass".

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent has no connection or affiliation with the Complainant and has not received any authorization, license, or consent, whether express or implied, to use the trademarks in the disputed domain name or in any other manner. The Respondent is not commonly known by the trademarks and does not hold any trademarks for the disputed domain name. In addition, the Respondent cannot claim it has a right to use the disputed domain name under fair use, since it includes the Complainant's trademark and the additional term "big ass" which is a term within the Complainant's industry and which creates a risk of implied affiliation, since the phrase "big ass" describes the models depicted in the content pirated from the Complainant's services and illegally redistributed by the Respondent. In addition, the website to which the disputed domain name resolves, offers adult entertainment services (including content pirated from the Complainant's users) in direct competition with the Complainant's services, including "providing entertainment services in the nature of a website featuring non-downloadable video, photographs, images, audio, and in the field of adult entertainment". The Respondent's website also includes a separate section devoted to publishing content associated with the Complainant's Mark and publishes content pirated from the Complainant's users (the Respondent's website content displaying the Complainant's watermark). Using a disputed domain name to host commercial websites that advertise goods and services in direct competition with the trademark owner does not give rise to legitimate rights or interests.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, bad faith registration should be found, since the Respondent used the Complainant's ONLYFANS mark and the additional term "big ass" within the disputed domain name, which enhances the likelihood of confusion given that "big ass" is a popular category of videos provided by the

Complainant's users. In addition, the Respondent registered the confusingly similar disputed domain name to offer services in direct competition with the Complainant (including content labeled with the Complainant's ONLY FANS Mark and content pirated from the Complainant's users), including "providing entertainment services [...] in the nature of a website featuring non-downloadable video, photographs, images, audio, and [...] in the field of adult entertainment". Finally, the Respondent's failure to respond to the C&D letter is further evidence of bad faith. The Respondent clearly registered the disputed domain name to divert Internet traffic from the Complainant's site to a website offering adult entertainment content (including content pirated from the Complainant's users and content labeled with the Complainant's ONLY FANS Mark) in direct competition with the Complainant's website. According to the Complainant, it is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name, since it is well-known worldwide.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a 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". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Language of the Proceedings

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

However, as noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case and that the proceeding takes place with due expedition (see *e.g. Carrefour SA v. Matias Barro Mares*, WIPO Case No. [D2020-3088](#); *Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack*, WIPO Case No. [D2015-0070](#)). Accordingly, account should be taken of the risk that a strict and unbending application of paragraph 11 of the Rules may result in delay, and considerable and unnecessary expenses of translating documents.

The Center notified both Parties of the potential language issue, inviting the Complainant to 1) either provide satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English; 2) either translate the complaint in French; or 3) submit a supported request for English to be the language of the administrative proceedings (*e.g.*, by reference to pre-Complaint correspondence between the Parties, Parties' identity and any other evidence of familiarity with the

requested language) and similarly providing the Respondent with an opportunity to comment on or object to a such language request that may be made by the Complainant. The Center specified to the Respondent that in case they had not heard from the Respondent by March 25, 2023, they will proceed on the basis that the Respondent has no objection to the Complainant's request that English be the language of proceedings.

On March 2, 2023, the Complainant submitted a request that English be the language of the proceedings affirming the following: substantial additional expense and delay would likely be incurred if the Amended Complaint must be submitted in French; there is evidence that the Respondent is capable of reading and writing in English, for example, the Respondent conducted business on the website – to which the disputed domain name resolved – solely in English, and the disputed domain name includes the English-words “only” “big” “ass” and “fans”; not a single word of French is visible within the disputed domain name or the website thereon. The Respondent did not comment on the language of the proceeding.

In the light of the above, the Center provided the Respondent in both English and French with the Notification of Complaint and Commencement of Administrative Proceeding.

In deciding whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all “the relevant circumstances”. The factors that the Panel should take into consideration include whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the Parties (see e.g. *Carrefour SA v. Matias Barro Mares*, WIPO Case No. [D2020-3088](#); *Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack*, WIPO Case No. [D2015-0070](#)).

In the case at issue, this Panel considers that conducting the proceedings in English would not be disadvantageous to the Respondent, since it results from the Complainant's undisputed allegations that the Respondent has demonstrated an ability to understand and communicate in English since the Respondent conducted business on the website – to which the disputed domain name resolved – solely in English, and the disputed domain name includes the English-words “only” “big” “ass” and “fans”.

The Panel is therefore prepared to infer that the Respondent is able to understand and communicate in English.

Furthermore, the Panel finds that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Spanish. The Panel is of the view that the language requirement should not cause any undue burden on the Parties or undue delay.

Finally, the Panel notes that the Respondent did neither object to the Complaint being in English nor to the request made that the proceedings be conducted in English. The Respondent was given a fair opportunity to present his case, to raise objections as to the request for English to be the language of proceedings or to inform the Center on his language preference. He has however chosen not to comment on any of these issues, (e.g. *Carrefour SA v. Matias Barro Mares*, WIPO Case No. [D2020-3088](#); *Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack*, WIPO Case No. [D2015-0070](#)).

Taking all these circumstances into account, this Panel finds that it is appropriate to exercise its discretion, according to paragraph 11(a) of the Rules and allow the proceedings to be conducted in English.

B. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various trademark registrations for ONLYFANS as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark ONLYFANS is fully included in the disputed domain name, with the addition of terms "big ass". Furthermore, it is the view of this Panel that the addition of the terms "bigass" in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the Top-Level Domain ".org" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1). In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and, in particular, did not authorize the Respondent's use of the trademark ONLYFANS, e.g. by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name is clearly constituted by the Complainant's registered trademark ONLYFANS and the term "big ass", which clearly refer to the Complainant's core business, tending to suggest sponsorship or endorsement by the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain name with the intent to attract Internet users for commercial gain (see e.g. *Wendel-Participations SE v. Host Master, 1337 Services LLC*, WIPO Case No. [D2022-4883](#)). This is also confirmed by the content of the website to which the disputed domain name resolved, offering adult entertainment services, displaying without authorization the Complainant's watermark.

Furthermore, the composition of the disputed domain name directly targeting the Complainant's field of activity enhances the false impression that the disputed domain name is somehow officially related to the Complainant and an official website promoting the Complainant's business. Such composition of the disputed domain name cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner, see section 2.5.1 of the [WIPO Overview 3.0](#).

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence

demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant’s documented allegations that the disputed domain name resolves to a website promoting similar services to those of the Complainant and reproducing without any authorization the Complainant’s trademark. For the Panel, it is therefore evident that the Respondent knew the Complainant’s mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant’s trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant’s registered trademark ONLYFANS with the addition of by the term “big ass”.

Finally, the further circumstances surrounding the disputed domain name’s registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant’s mark plus the addition of the term “big ass”);
- (ii) the content of the website to which the disputed domain name directs, promoting similar services to those of the Complainant and reproducing without any authorization the Complainant’s trademark;
- (iii) the Respondent did not reply to the C&D letter;
- (iv) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(iii) 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, <onlybigassfans.org> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: May 17, 2023