

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. matiaus gaonzalez
Case No. D2023-1289

1. The Parties

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

The Respondent is Matiaus Gaonzalez, Argentina.

2. The Domain Name and Registrar

The disputed domain name <onlyfansfree.website> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 24, 2023. On March 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 28, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 28, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. By email of March 30, 2023, the Complainant indicated his wish to add the registrant to the Complaint.

The Center verified that the Complaint and 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 March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 21, 2023.

The Center appointed Theda König Horowicz as the sole panelist in this matter on May 12, 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 owner and operator of the website connected to the domain name, <onlyfans.com> (registered on January 29, 2013), which offers subscriptions to online content, including adult entertainment under the name “OnlyFans”.

The Complainant is the owner of several trademark registrations of trademarks incorporating the “OnlyFans” name, including the following registrations:

- European Union Trade Mark Registration No. 017912377 ONLYFANS (word mark) registered on January 9, 2019 (application filed June 5, 2018) for a variety of goods and services in classes 9, 35, 38, 41 and 42.
- United States Trademark Registration No. 5769267 ONLYFANS (word mark) registered on June 4, 2019 (application filed on October 29, 2018) in class 35 for arranging subscriptions of the online publications of others. The registration incorporates a first use in commerce claim of July 4, 2016.
- United States Trademark Registration No. 5769268 ONLYFANS.COM (word mark) registered on June 4, 2019 (application filed on October 29, 2018) in class 35 for arranging subscriptions of the online publications of others. The registration incorporates a first use in commerce claim of July 4, 2016.

In addition to its registered trademark rights, the Complainant claims common law trademark rights in respect of the name “OnlyFans” which has been recognized by at least May 30, 2017 in previous WIPO decisions.

The disputed domain name was registered on October 4, 2022. It redirects to adult entertainment services.

On December 8, 2022, the Complainant’s representative sent a cease and desist letter to the privacy service used by the Respondent in respect of the disputed domain name. No answer was given to the said letter.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to its mark ONLYFANS which is contained in entirety in the disputed domain name with the only difference being the insertion of the descriptive term “free” after ONLYFANS. The use of the “website” generic top level domain (“gTLD”) does not change the result.

The Complainant alleges that the Respondent has neither rights nor legitimate interests in the disputed domain name since (i) the Respondent has no connection or affiliation with the Complainant (ii) the Respondent is not commonly known by the marks and does not hold any trademarks for the disputed domain name. Furthermore, the Respondent cannot claim a right to use the disputed domain name under fair use, since it includes the mark of the Complainant and the additional term “free” which creates a risk of implied affiliation as it wrongly gives the impression that the Complainant is offering its paid services free of charge. In addition, the website at the disputed domain name offers adult entertainment services (including content pirated from the Complainant’s users) in direct competition with the Complainant’s services.

The Complainant further alleges that the disputed domain was registered in bad faith and is being used in bad faith. Firstly, the disputed domain name was registered long after the Complainant attained rights in the mark ONLYFANS which is a widely-known trademark thus creating a presumption of bad faith. Secondly,

bad faith registration should be found since the Respondent used the Complainant's ONLYFANS mark and the additional term "free" within the disputed domain name, which enhances the likelihood of confusion. Thirdly, the Respondent offers services in direct competition with the Complainant and uses pirated material to this end. Fourthly, the Respondent did not react to the Complainant's warning letter.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

- (i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Complainant has shown to have obtained registered and common law trademark rights over ONLYFANS in the United States. ONLYFANS is also registered as a trademark in the European Union.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing 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 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, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark ONLYFANS since it contains this mark in entirety. The addition of the term "free" in the disputed domain name does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

Furthermore, the gTLD ".website" is a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the conditions in paragraph 4(a)(i) of the Policy are fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made sufficient statements in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant has not licensed or otherwise permitted the Respondent to use its trademark. There is no evidence showing that the Respondent would be commonly known by the disputed domain name or that the Respondent would own trademarks for the disputed domain name. Furthermore, the Respondent has no connection or affiliation with the Complainant.

The Panel therefore finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent who has chosen not to reply.

The Respondent has not rebutted the Complainant's *prima facie* case, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in the proceeding.

As already stated before, nothing is contained in the case file which would show that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or that the Respondent has any rights or legitimate interests in the disputed domain name. To the contrary, the website at the disputed domain name which contains the Complainant's trademark in entirety offers adult entertainment services in direct competition with the Complainant's services.

Furthermore, the disputed domain name combines the trademark ONLYFANS in entirety with the additional term "free" which carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the conditions in paragraph 4(a)(ii) of the Policy are fulfilled in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of the domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has 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 the holder's documented out-of-pocket costs directly related to the domain name; or

- (ii) the respondent has 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 the holder has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 holder's respondent's website or location or of a product or service on the holder's respondent's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain names were registered and are being used in bad faith.

Given the circumstances of the case, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark ONLYFANS.

The Panel therefore finds that the disputed domain names were registered in bad faith.

The disputed domain name resolves to a website offering exactly the same type of services than the Complainant. The addition of the term "free" within the disputed domain name obviously enhances the likelihood of confusion with the Complainant's ONLYFANS mark and misleads the Internet user into believing that the services are offered free of charge by the Complainant.

The silence of the Respondent in the proceeding is additional evidence of bad faith in these circumstances.

The Panel therefore finds that the conditions in paragraph 4(a)(iii) of the Policy is fulfilled in relation to the disputed domain name.

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 <onlyfansfree.website> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: June 5, 2023