

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. shuaixi yang
Case No. D2023-1607

1. The Parties

The Complainant is Fat Face Holdings Limited, United Kingdom (“UK”), represented by SafeNames Ltd., UK.

The Respondent is shuaixi yang, China.

2. The Domain Name and Registrar

The disputed domain name <fatface.life> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 13, 2023. On April 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 14, 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 (DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 14, 2023 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 amended Complaint on April 14, 2023.

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, and the proceedings commenced on April 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 11, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on May 22, 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 a British clothing, accessories, and lifestyle brand founded in 1988 by Tim Slade and Jules Leaver who sold t-shirts at ski resorts under the FAT FACE and FATFACE trademarks.

The Complainant opened 50 FAT FACE stores by 2002, having reached over 200 stores in the United Kingdom and Ireland by 2012 and presently also counting with an international presence in the United States of America (Annex 4 to the Complaint), in addition to its website available at <fatface.com> (registered in April 1997) which receives an average of 3.7 million visits a month and is ranked No. 22 in the Top Fashion and Apparel websites in the UK (Annex 8 to the Complaint).

In September 2021, the Complainant launched the MADE FOR LIFE brand, celebrating the adventures, memories, and moments that customers have experienced while wearing FAT FACE clothing (Annex 9 to the Complaint).

The Complainant is the owner of the following, amongst other, trademark registrations:

- New Zealand trademark registration No. 294292, for the word mark FAT FACE, filed on June 24, 1998, registered on December 21, 1998, subsequently renewed, in class 25;
- European Union trademark registration No. 001764760, for the word mark FAT FACE, registered on July 19, 2000, subsequently renewed, in classes 9, 18, and 25;
- International trademark registration No. 848966, for the word mark FAT FACE, registered on December 15, 2004, successively renewed, in class 35;
- United States of America trademark registration No. 4,934,466, for the word mark FATFACE, registered on April 12, 2016, in classes 3, 9, 14, 16, 18, 25 and 35;
- United Kingdom trademark application No. UK00003651752, for the word mark FAT FACE MADE FOR LIFE, filed on June 6, 2021, in class 25; and
- European Union trademark application No. 018487191, for the word mark FAT FACE MADE FOR LIFE, filed on June 7, 2021, in class 25.

The disputed domain name was registered on May 8, 2022 and presently resolves to a parked webpage displaying pay-per-click ("PPC") links. In addition to that, mail exchange ("MX") records have been configured in connection with the disputed domain name (Annex 15 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant asserts that its FAT FACE trademark was coined after the famous black mountain skiing run in Val d'Isère, named "La Face", having the Complainant's brand often been stylized to FATFACE or FAT FACE, applied to women's, men's, and children's clothes, in addition to accessories and footwear and that it has become a leading clothing and accessory retailer, with wide scale consumer recognition.

The Complainant further asserts to be a highly successful business, with a turnover of GBP 164.7m in May 2021 and its e-commerce sales continue to rise by 21 per cent year on year, and by 62 per cent compared to the COVID-19 pandemic period (Annex 5 to the Complaint). The Complainant also points out that in 2007 its control was acquired by Bridgepoint Capital, who then paid GBP 360 million for the Complainant.

Under the Complainant's view, the disputed domain name is identical to the Complainant's FAT FACE trademark whose distinctive value has been found to solely relate to the Complainant's services, as recognized in past UDRP decisions such as *Fat Face Holdings Limited v. Yixian Wen*, WIPO Case No. [D2021-1656](#); and *Fat Face Holdings Limited v. DOMAIN ADMINISTRATOR, DOMAIN IS FOR SALE AT WWW.DAN.COM*, WIPO Case No. [D2021-2945](#).

Moreover, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the Respondent has not registered any trademark for the term FAT FACE and there is no evidence that the Respondent holds any unregistered rights to that term;
- (ii) the Respondent has not received any license from the Complainant to use a domain name that features the FAT FACE trademark;
- (iii) the Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services; rather resolving the disputed domain name to a webpage displaying PPC advertisement links;
- (iv) the Respondent is not commonly known by the disputed domain name; and
- (v) the Respondent's activation of mail exchange (MX records) for the disputed domain name indicates that the Respondent is likely using the disputed domain name to carry out fraudulent activity.

Furthermore, the Complainant submits that the Respondent both registered and is using the disputed domain name in bad faith in accordance with paragraph 4(a)(iii) of the Policy, having clearly registered the disputed domain name to target the Complainant's trademark intentionally. In addition to that, the Respondent has chosen to ignore a cease-and-desist letter sent by the Complainant's representatives on November 10, 2022 (Annex 18 to the Complaint) what corroborates the Respondent's bad faith behaviour. Lastly, the Complainant notes that the Respondent's activation of MX records for the disputed domain name which could at some point be used in phishing activity, given the evidently implied affiliation of the disputed domain name with the Complainant's FAT FACE trademark.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

A. Identical or Confusingly Similar

The Complainant has established its rights in the registered FAT FACE trademark.

The Panel finds that the disputed domain name incorporates the Complainant's trademark in its entirety. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". The Panel finds that the disputed domain name is identical to the Complainant's trademark. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent, as an individual, business, or other organization, has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondent.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent that the Respondent has not been commonly known by the disputed domain name, and neither has registered any trademark for the term FAT FACE nor has received any license from the Complainant to use a domain name that incorporates the FAT FACE trademark.

In addition to that, the use of the disputed domain name in connection with PPC advertisement links does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

The second element of the Policy has therefore been established.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the complainants who are the owner of a trademark relating to the disputed domain name or to a competitor of the Complainants, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other location, by creating a likelihood of confusion with the complainants' 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.

The registration and use of the disputed domain name in bad faith can be found in the present case in view of the following circumstances:

- (i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, not having submitted a response;
- (ii) the well-known status of the Complainant's trademark;
- (iii) the nature of the disputed domain name (not only reproducing the entirety of the Complainant's trademark but using the ".life" Top Level Domain to play off the FAT FACE MADE FOR LIFE mark), and the Respondent's likely intention to unduly profit from the value of the Complainant's trademark, suggest rather a clear indication of the Respondent's registration and holding of the disputed domain name in bad faith, with the implausibility of any good faith use to which the disputed domain name may be put;
- (iv) the Respondent's choice to retain a privacy protection service to conceal its true identity;
- (v) the lack of reply to the cease-and-desist letter sent prior to this procedure; and
- (vi) the indication of what appears to be false contact details.

For the reasons stated above, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The third element of the Policy has therefore been established.

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, <fatface.life> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: June 5, 2023