

ADMINISTRATIVE PANEL DECISION

Fenix International Limited v. Ali Joseph
Case No. D2023-3485

1. The Parties

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

The Respondent is Ali Joseph, Brazil.

2. The Domain Name and Registrar

The disputed domain name <nudesonlyfans.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 August 17, 2023. On August 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 17, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 23, 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 amendment to the Complaint on August 18, 2023.

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 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 20, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on September 27, 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 owns and operates a social media platform at the domain name <onlyfans.com> – registered on January 29, 2013 – that allows users to post and subscribe to audiovisual content worldwide.

The Complainant is the owner of several trademark registrations for ONLYFANS, including the following, as per trademark certificates submitted as annex C to the Complaint:

- European Union trademark registration No. 017912377 for ONLYFANS (word mark), filed on June 5, 2018, and registered on January 9, 2019, in classes 9, 35, 38, 41, and 42;
- European Union trademark registration No. 017946559 for ONLYFANS (figurative mark), filed on August 22, 2018, and registered on January 9, 2019, in classes 9, 35, 38, 41, and 42;
- United States trademark registration No. 5769267 for ONLYFANS (word mark), filed on October 29, 2018, and registered on June 4, 2019, in international class 35.

The disputed domain name <nudesonlyfans.com> was registered on January 7, 2023, and is pointed to a website publishing adult content and displaying on the top of the home page the indication “ONLYFANS LEAKED”.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to the trademark ONLYFANS in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term “nudes” and the generic Top-Level Domain “.com”, which do nothing to avoid confusing similarity.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant contends that the Respondent is in no way connected or affiliated with the Complainant nor has it ever received any authorization, license or consent, whether express or implied, to use the Complainant’s trademark in the disputed domain name or in any other manner.

The Complainant states that the Respondent is also not commonly known by the disputed domain name and does not hold any trademarks for the terms encompassed in the disputed domain name. The Complainant also states that the Respondent’s use of the disputed domain name does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use as the Respondent is pointing the disputed domain name to a website providing adult entertainment services in direct competition with the Complainant’s services, reproducing also contents pirated from the Complainant’s users.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering i) the disputed domain name was registered long after the Complainant attained registered rights in its ONLYFANS trademark, ii) the composition of the disputed domain name, incorporating the Complainant’s widely known trademark along with the term “nudes”, which only serves to increase the likelihood of confusion with the

Complainant, and iii) the Respondent is using the disputed domain name to provide services in direct competition with the Complainant, the Respondent was undoubtedly aware of, and intended to target, the Complainant and its trademark at the time of registering the disputed domain name.

The Complainant further submits that, by using the disputed domain name in connection with an adult content website competing with the Complainant's services and publishing also contents pirated from the Complainant's users, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of its website.

As an additional circumstance evidencing bad faith, the Complainant submits that it sent a cease-and-desist letter to the Respondent on March 3, 2023, to which the Respondent did not reply.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall 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 directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other term "nudes" may bear on assessment of the second and third elements, the Panel finds the addition of such term to the ONLYFANS mark does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Therefore, based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 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 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks. Moreover, there is no element from which the Panel could infer the Respondent’s rights and legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Panel also finds that the Respondent’s use of the disputed domain name to resolve Internet users to a website publishing the Complainant’s trademark and offering adult entertainment services in direct competition with the Complainant’s services without providing a clear and prominent disclaimer of non-affiliation with the Complainant on the home page, does not amount to *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

The Panel further finds that the disputed domain name, reproducing the Complainant’s trademark with the addition of a descriptive term which can be referred to models on the Complainant’s ONLYFANS website, is inherently misleading. Even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the case at hand, the Panel notes that, in light of the prior registration and use of the trademark ONLYFANS in connection with the Complainant’s adult entertainment services, provided via the website at the domain name <onlyfans.com>, and considering the popularity reached in the recent years by the Complainant’s website, the Respondent was more likely than not aware of the Complainant’s trademark at the time of the registration of the disputed domain name, which occurred only on January 7, 2023. Moreover, the explicit reference made by the Respondent to the Complainant’s ONLYFANS mark on the

website to which the disputed domain name resolves supports the finding that the Respondent indeed registered the disputed domain names having the Complainant's trademark in mind.

In addition, the Panel finds that, in view of the fact that the disputed domain name is pointed to a website offering adult entertainment services in direct competition with the Complainant, apparently publishing also content shared by users on the Complainant's website whilst failing to accurately and prominently disclose its lack of relationship with the Complainant, the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services provided therein, according to paragraph 4(b)(iv) of the Policy.

The Panel also notes that the Respondent's failure to respond to the Complainant's cease-and-desist letter and to file a Response are further evidence of the Respondent's bad faith.

Therefore, based on the available record, the Panel finds the third element of the Policy has 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 <nudesonlyfans.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: October 11, 2023