

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Jianlan Cheng
Case No. D2023-3748

1. The Parties

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

The Respondent is Jianlan Cheng, Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <fashionsfatface.com> and <stylefatface.com> are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 11, 2023. On September 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 27, 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, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 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 September 28, 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 October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 24, 2023.

The Center appointed Theda König Horowicz as the sole panelist in this matter on November 2, 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, Fat Face Holdings Limited, is a British clothing, accessories and lifestyle brand founded in 1988. Products sold under the FAT FACE brand include women's, men's and children's clothes, household items, accessories and footwear. The brand FAT FACE comes from the famous black mountain skiing run in Val d'Isère, named "La Face". The Complainant's brand is often stylized to FATFACE. The Complainant commercializes its products through Fat Face stores notably in the United Kingdom and Ireland. The Complainant has also an international presence, with many stores in the United States of America ("United States"). Additionally, the Complainant uses its official website, "www.fatface.com", for a blog and to offer e-commerce services. The Complainant's website was registered in April 1997. The Complainant has also established a social media presence and uses the FAT FACE trademark to promote its services, notably on Facebook, Instagram and X (formerly Twitter).

The Complainant owns registered trademarks rights in both FAT FACE and FATFACE in many countries including the United Kingdom, the United States and the European Union, in particular:

- United States Trademark Registration No. 4934466 for FATFACE, registered on April 12, 2016;
- European Union Trademark Registration No. 004152005 for FAT FACE, registered on January 5, 2006. These trademark registrations are predating the disputed domain names which were registered on January 5, 2023.

At the time of filing of the Complaint, the disputed domain name <stylefatface.com> resolved to an online store purportedly offering for sale the Complainant's products at discounted prices. As an online shop, users were requested to enter sensitive payment information upon checkout. The disputed domain name <fashionsfatface.com> was not used.

The Complainant's representatives sent to the Respondent a cease and desist letter on January 19, 2023, through the Registrar's online contact form and the Registrar, in order to put the Respondent on notice of the Complainant's trademarks and rights, and with the demand to transfer the disputed domain names to the Complainant. No answer was given.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain names based on the following grounds:

Firstly, the Complainant alleges to own registered trademarks for FAT FACE and FATFACE and submits that the disputed domain names are confusingly similar to the Complainant's trademarks. The disputed domain names contain the Complainant's FAT FACE/FATFACE trademarks, with the addition of the words "style" and "fashions" which have clear connotations with the fashion and clothing industry, in which the Complainant's marks operate. The generic Top-Level Domain ("gTLD") ".com" featured in the disputed domain names does not negate a finding of confusing similarity under the first element, as it is a standard registration requirement.

Secondly, the Complainant submits that the Respondent lacks rights or legitimate interests in the disputed domain names. To the best of the Complainant's knowledge, the Respondent does not have any trademark rights to the term "Fat Face" or any other term used in the disputed domain names. There is also no

evidence that the Respondent retains unregistered trademark rights to the term “Fat Face” or any other term used in the disputed domain names. Neither has the Respondent received any license from the Complainant to use the disputed domain names featuring the FAT FACE trademark. Paragraph 4(c) of the Policy stipulates some circumstances where the Respondent can demonstrate a right or legitimate interest in a domain name. The Complainant submits that none of the circumstances apply in this case. Furthermore, the Respondent has used the disputed domain name <stylefatface.com> to display an online store impersonating the Complainant. This impersonation consists of using the official FAT FACE branding (i.e., logo) and official product images. The Complainant’s products are advertised as being heavily discounted. As an online shop, users are requested to enter sensitive payment information upon checkout. There is also evidence of harvesting personal details from online users where the user is requested to sign in to an account. This activity clearly does not confer a right or legitimate interest. The current non-use of the disputed domain name <fashionsfatface.com> is not a *bona fide* offering of goods or services.

Thirdly, the Complainant submits that the Respondent has both registered and used the disputed domain names in bad faith. In particular, the Complainant’s earliest trademark registration predates the creation date of the disputed domain names by 25 years and searching Fat Face on popular Internet search engines shows the Complainant’s brand and services as the first result. Furthermore, the Respondent chose to ignore the warning letter sent by the Complainant’s representative. The mere registration of a domain name that is confusingly similar (particularly the disputed domain names incorporating the mark plus a descriptive term) to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith which is the case in the present matter. Additionally, the disputed domain name <stylefatface.com> has been used to resolve to a site which illegitimately copies the FAT FACE logo and product images, offering to sell heavily discounted goods under the Complainant’s FAT FACE brand. Such conduct is clearly calculated to give online users the false impression that such resolving site’s content is controlled and authorised by the Complainant, when this is not the case. The Respondent has not made any attempt to prominently disclaim its relationship (or lack thereof) to the Complainant on the website associated with this disputed domain name. In regards to the disputed domain name <fashionsfatface.com>, the Complainant claims that the circumstances around this case show that its passive use amounts to bad faith use.

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 trademark rights in FAT FACE and FATFACE in several countries.

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 names are confusingly similar to the Complainant’s registered trademarks FAT FACE and FATFACE since the disputed domain names contain both of these marks in entirety. The addition of the words “fashions” or “style” at the beginning of the disputed domain names do not prevent a finding of confusing similarity. See section 1.8. of the [WIPO Overview 3.0](#).

The gTLD “.com” is viewed as 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 names.

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 respondent’s use of the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent being commonly known by the domain name; or
- (iii) the respondent’s 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 element, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has provided sufficient evidence in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain names. In particular, the Complainant has not licensed or otherwise permitted the Respondent to use its trademarks. There is no evidence showing that the Respondent would be commonly known by the disputed domain names or that a legitimate business would be run by the Respondent under the disputed domain names.

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 names 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 names on the part of the Respondent in these proceedings.

The Panel notes that at the time of filing of the Complaint, the disputed domain name <stylefatface.com> displayed to an online store which used without authorization the official FATFACE branding (i.e., logo) and official product images. Even if the disputed domain name <fashionsfatface.com> was not used, nothing is contained in the case file which would show that the disputed domain names have been legitimately noncommercial or fairly used by the Respondent or that the Respondent would have any rights or legitimate interests in the disputed domain names.

Furthermore, the composition of the disputed domain names, incorporating the Complainant's trademarks FAT FACE and FATFACE in their entirety, together with the terms related to the nature of the Complainant's business, carries a risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

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

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, including the fact that the disputed domain names identically reproduce the Complainant's FAT FACE and FATFACE trademarks and that the disputed domain name <stylefatface.com> displayed an online store using the Complainant's FATFACE trademarks without the latter's authorization, it is inconceivable to the Panel that the Respondent registered the disputed domain names without prior knowledge of the Complainant's trademarks and business which is widely promoted by the Complainant notably on the Internet and through social media.

The disputed domain name <fashionsfatface.com> has apparently been inactive since its registration. Considering the failure to respond to the Complainant's notice and the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use of this inherently misleading disputed domain name, the Panel finds that the non-use of this disputed domain name does not prevent a finding of bad faith in this case. See [WIPO Overview 3.0](#), section 3.3.

The disputed domain name <stylefatface.com> has been used for an online store purportedly offering for sale the Complainant's products at discounted prices. The Panel finds such use constitutes bad faith under paragraph 4(b)(iv) of the Policy.

Indeed, the Respondent has not contested the allegations made by the Complainant and its silence in these proceedings is an additional evidence of bad faith in these circumstances. The Panel therefore finds that the disputed domain names were registered and are being used in bad faith.

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

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 names <fashionsfatface.com> and <stylefatface.com> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: November 27, 2023