

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. 李亚峰 (Li Ya Feng)

Case No. D2024-0919

1. The Parties

The Complainant is Fat Face Holdings Limited, United Kingdom, represented by SafeNames Ltd., United Kingdom.

The Respondent is 李亚峰 (Li Ya Feng), China.

2. The Domain Name and Registrar

The disputed domain name <shopfatface.top> is registered with Leascend Technology Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 1, 2024. On March 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 4, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On March 4, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On March 5, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

The Center verified that 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 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 5, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on April 17, 2024. 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 clothing, accessories, and lifestyle brand established in the United Kingdom and founded in 1988, with stores located in the United Kingdom, Ireland, United States of America (“United States”), and other countries. The Complainant is a highly successful business, with a revenue of GBP 270.9 million in 2023 (an increase in revenue from 2022, which was GBP 234.9 million). The Complainant is majority-owned by Next PLC, who paid GBP 115.2 million for the Complainant in 2023, an acquisition widely covered across news media.

The Complainant owns an international portfolio of registered trademarks in the marks FAT FACE and FATFACE, among which:

- European Union Trademark No. 001764760 for FAT FACE, registered on October 16, 2001, in International Classes 9, 18, and 25;
- European Union Trademark No. 004152005 for FAT FACE, registered on January 5, 2006, in International Classes 14 and 35;
- International Trademark No. 848966 for FAT FACE, registered on December 15, 2004, in International Class 35, and the designated countries being Australia, Norway, Russian Federation, and United States;
- United States Trademark No. 4934466 for FATFACE, registered on April 12, 2016, in International Classes 3, 9, 14, 16, 18, 25, and 35.

The Complainant also proves that it has a strong online presence, including through social media platforms and that it owns a number of domain names incorporating the marks FAT FACE and FATFACE, including <fatface.com>. This domain name is used for its official website “www.fatface.com”, which provides e-commerce services and a blog informing customers on the Complainant’s products, fashion tips, and other stories.

The disputed domain name was registered on August 5, 2023, i.e., decades after the Complainant secured rights in the marks FAT FACE and FATFACE. According to evidence submitted by the Complainant, the disputed domain name only ever resolved to an inactive, blank webpage.

The Complainant also states that the Respondent did not respond to the cease-and-desist letter sent regarding the disputed domain name.

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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered trademarks as it incorporates the FAT FACE AND FATFACE marks entirely with the mere addition of the generic word “shop”. The Complainant also states that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is not a licensee of the Complainant, and the Complainant has not given the Respondent any permission to register the trademark as a domain name, nor is there any evidence that the Respondent has been commonly known by the disputed domain name,

the Respondent has not used, or prepared to use, the disputed domain name in connection with a bona fide offering of goods and/or services or for any legitimate noncommercial or fair purpose. In addition, the Complainant stresses that the disputed domain name is only used to direct to an inactive website. As per the use of the disputed domain name, for the Complainant, the passive holding of the disputed domain name by the Respondent constitutes bad faith. Finally, the Respondent did not reply to the cease-and-desist letter.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless 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 Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Respondent's use of the "shop" keyword and '.top' extension in connection with the Complainant's FAT FACE mark suggests the Respondent intended to target English-speakers online users, which infers knowledge of the English language; the fact that the Respondent targeted a United Kingdom-based company, where English is the first language spoken; The fact that the Respondent received a cease and desist letter from the Complainant's representatives and did not provide a response to let the Complainant know that it did not understand its content and the fact that the Complainant's representatives are based in the United Kingdom and requiring a translation would allegedly result in the incurrence of additional expense and unnecessary delay.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time, and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issue

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 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 Complainant's marks 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.

Although the addition of other terms here, "shop" may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

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.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often 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 (although the burden of proof always remains on the complainant). 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 available 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.

Furthermore, the Panel notes that the disputed domain name directs to an inactive, blank webpage and that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services, nor any credible preparations for that purpose. In this regard, the Panel finds that holding a domain name passively, without making any use of it, does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

Finally, the Panel notes that the disputed domain name is composed of the term "shop" followed by FATFACE. While "fat face" is a combination of two dictionary terms, the composition of the domain name consisting of "fat face" but preceded by the term "shop" is not a common combination of terms, and the Panel finds that together are likely meant to be perceived in connection with the Complainant's trademark, as shop FATFACE products. The Panel finds that the nature of the disputed domain name, being confusingly similar to the Complainant's trademarks and containing the additional term "shop", carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

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

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name which is confusingly similar to the Complainant's longstanding trademarks for FAT FACE AND FATFACE. The Panel deducts from the above that by registering the disputed domain name fully incorporating the Complainant's marks and combining it with the word "shop", the Respondent deliberately and consciously targeted the Complainant's prior trademarks for FAT FACE AND FATFACE. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4. Furthermore, the Panel also notes that the Complainant's trademarks were registered several decades before the registration date of the disputed domain name. The Panel deducts from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. In the Panel's view, these elements indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use in bad faith, panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds that the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the strong reputation of the Complainant's trademark, the composition of the disputed domain name, the failure of the Respondent to respond to the Complainant's cease-and-desist letter or to any notification in this proceeding and the unlikelihood of any good faith use of the disputed domain name by the Respondent, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <shopfatface.top> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: May 1, 2024