

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Er Wu
Case No. D2024-1140

1. The Parties

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

The Respondent is Er Wu, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain names <fatfaace.com> and <fatface.com> (the “Disputed Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 15, 2024, against the Disputed Domain Names. On March 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On March 15, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 18, 2024, 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 March 18, 2024.

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 March 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 23, 2024.

The Center appointed Mariia Koval as the sole panelist in this matter on April 26, 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, founded in 1988, is a British company manufacturing clothing, footwear and accessories. The Complainant is also a multichannel retailer, with an international digital business, and over 180 stores in the United Kingdom and 20 stores in the United States. In particular, the Complainant opened 50 stores by 2002, continuing to grow to over 200 stores in the United Kingdom and Ireland by 2012; the Complainant has an international presence, with many stores in the United States and Canada, when the company expanded in 2022. The Complainant is a highly successful business, with a revenue of GBP 270.9 million in 2023 (an increase in revenue from 2022).

The Complainant is the owner of numerous FAT FACE and FATFACE trademarks registrations (collectively, the "FAT FACE Trademarks"), among which are:

- New Zealand FAT FACE Trademark Registration No. 294292, registered on December 21, 1998, in respect of goods in class 25;
- European Union FAT FACE Trademark Registration No. 001764760, registered on October 16, 2001, in respect of goods in classes 9, 18 and 25;
- United States FATFACE Trademark Registration No. 4934466, registered on April 12, 2016, in respect of goods and services in classes 3, 9, 14, 16, 18, 25 and 35.

The Complainant operates its official website "www.fatface.com" for offering e-commerce services and maintaining a blog to further inform customers on the Complainant's products, fashion tips and other stories. The Complainant's website was registered in April 1997 and has been used consistently therefrom, having received 42.8 million visits in 2023. Online sales accounted for 39.5 per cent of revenue in 2023, demonstrating that the FAT FACE Trademarks have a strong online presence. The Complainant has also established a social media presence and uses the FAT FACE Trademarks to promote its goods and services on social media platforms such as Facebook, Instagram, X formerly known as Twitter and YouTube.

The registration date of the Disputed Domain Name <fatfaace.com> is August 4, 2023, and of the Disputed Domain Name <fatfrace.com> is August 1, 2023. As of the date of this Decision, the Disputed Domain Names resolve to inactive websites. However, in accordance with the unrebutted evidence presented by the Complainant (Annex 15 to the Complaint) the Disputed Domain Name <fatfaace.com> previously redirected to the Disputed Domain Name <fatfrace.com> which was active and allegedly offered the competing products of the Complainant for sale.

On August 25, 2023, the Complainant sent a cease-and-desist letter (Annex 16 to the Complaint) to the Respondent, but no response was received.

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 Names.

Notably, the Complainant contends that the Disputed Domain Names are confusingly similar to the Complainant's FAT FACE Trademarks. Specifically, the Disputed Domain Names contain the FAT FACE Trademarks, but misspelled, with the addition of an extra "a" to the Disputed Domain Name <fatfaace.com> and the addition of letter "r" to the Disputed Domain Name <fatfrace.com>.

The Complainant further asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names in view of the following:

- to the best of the Complainant's knowledge, the Respondent does not have any registered or unregistered trademark rights to the term FAT FACE or any other term used in the Disputed Domain Names;
- the Respondent has not received any license from the Complainant to use the Disputed Domain Names featuring the FAT FACE Trademarks;
- there is no evidence showing that the Respondent has been using, or preparing to use, the Disputed Domain Names in connection with a bona fide offering of goods and services since its registration. Currently, the Disputed Domain Names do not resolve to active websites and are therefore not offering any goods or services;
- the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names;
- the Respondent is not commonly known by any terms used in the Disputed Domain Names;
- there is no plausible reason for the registration or use of the Disputed Domain Names, given the distinctive nature of the FAT FACE Trademarks.

The Complainant further contends that the Respondent registered and is using the Disputed Domain Names in bad faith based on the following: The Complainant's earliest FAT FACE Trademark registration predates the creation date of the Disputed Domain Names by 25 years. Searching "fat face" on popular Internet search engines such as Google list the Complainant's FAT FACE Trademarks and services as the first result. It is evident, therefore, that the simplest degree of due diligence would have otherwise made the Respondent aware of the Complainant's rights in the FAT FACE Trademarks. Bad faith is also supported by the fact that the Disputed Domain Names consist of intentional misspellings of the Complainant's FAT FACE Trademarks.

At the time of the Complainant's formal notification of its rights in the FAT FACE Trademarks through a cease-and-desist letter sent to the Respondent, the Disputed Domain Name <fatfaace.com> redirected to the Disputed Domain Name <fatface.com> which was active, allegedly offering third-party products, such as ASICS shoes and accessories. By redirecting Internet users accessing the Disputed Domain Names expecting to reach the Complainant's offerings, and instead landing on a site allegedly offering third-party products, the Respondent is exploiting the Complainant's FAT FACE Trademarks by creating confusion among Internet users, who would believe that, at first glance, that the Disputed Domain Names may be associated or endorsed by the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was 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 3.0](#), section 1.7.

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 entirety of the Complainant's FAT FACE Trademarks is reproduced within the Disputed Domain Name <fatfaace.com> with addition of the additional letter "a" and the generic Top-Level domain ("gTLD") ".com". Also, the entirety of the Complainant's FAT FACE Trademarks is reproduced within the Disputed Domain Name <fatfrace.com> with addition of the letter "r" and the gTLD ".com". The Disputed Domain Names appear to be typical examples of typosquatting, i.e. a misspelling of the Complainant's FAT FACE Trademarks. According to the [WIPO Overview 3.0](#), section 1.9, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. The Panel finds that addition of one more letter "a" to the Disputed Domain Name <fatfaace.com> and letter "r" to the Disputed Domain Name <fatfrace.com> in this case does not prevent the Disputed Domain Names from being confusingly similar to the Complainant's FAT FACE Trademarks.

Accordingly, the Disputed Domain Names are confusingly similar to the Complainant's FAT FACE Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 Names. 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 Names such as those enumerated in the Policy or otherwise.

There is no evidence that the Complainant has licensed or otherwise permitted the Respondent to use its FAT FACE Trademarks or to register the Disputed Domain Names which are confusingly similar to the FAT FACE Trademarks. The Panel also finds that the Respondent has not been commonly known by the Disputed Domain Names. [WIPO Overview 3.0](#), section 2.3.

The Panel considers that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names. As at the date of this Decision, the Disputed Domain Names resolve to inactive websites. However, in accordance with the evidence presented by the Complainant (Annex 15) the Disputed Domain Name <fatfaace.com> previously redirected to the Disputed Domain Name <fatfrace.com> which was active and where the competing products of the Complainant were purportedly offered for sale. Therefore, the Panel cannot consider such use of the Disputed Domain Names as bona fide offering of goods or services, or a legitimate noncommercial or fair use.

Also, given the typosquatting nature of the Disputed Domain Names, the construction of the Disputed Domain Names is likely to mislead or cause confusion, which was likely the main intent of the Respondent when registering the Disputed Domain Names, which cannot amount to fair use nor confer rights or legitimate interests upon the Respondent.

Finally, the Respondent neither responded to the Complainant's cease-and-desist letter nor the Complainant's contentions and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Names.

In view of the foregoing, 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 and is using the Disputed Domain Names in bad faith in view of the following:

The Disputed Domain Names were registered long after the Complainant registered its FAT FACE Trademarks. The Disputed Domain Names incorporate the Complainant's FAT FACE Trademarks in their entirety and resolve to the inactive websites as at the date of this Decision. The Disputed Domain Name <fatface.com> previously redirected to the Disputed Domain Name <fatfrace.com> where the competing products of the Complainant were purportedly offered for sale. The Panel is of an opinion that the Respondent obviously chose to register the Disputed Domain Names, which are confusingly similar to the Complainant's FAT FACE Trademarks, for the purpose of attracting, for commercial gain, the Internet users to its websites by creating a likelihood of confusion with the Complainant's FAT FACE Trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites pursuant to paragraph 4(b)(iv) of the Policy.

The current non-use of the Disputed Domain Names does not prevent a finding of bad faith under the doctrine of passive holding. 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 distinctiveness and reputation of the Complainant's FAT FACE Trademarks, and the composition of the Disputed Domain Names, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use and finds that in the circumstances of this case the passive holding of the Disputed Domain Names does not prevent a finding of bad faith under the Policy.

The Panel is also of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Names, which are confusingly similar to the Complainant's FAT FACE Trademarks, intended to disrupt the Complainant's business and confuse Internet users seeking for or expecting the Complainant.

Finally, the Respondent neither responded to the Complainant's cease-and-desist letter nor the Complainant's contentions and did not participate in this proceeding at all. Previous UDRP panels have considered that a respondent's failure to respond to a complaint supports an inference of bad faith, see e.g., *Champagne Louis Roederer (CLR) v. Global Web Development, LLC*, WIPO Case No. [D2004-1073](#).

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 Names <fatfaace.com> and <fatfrace.com> be transferred to the Complainant.

/Mariia Koval/

Mariia Koval

Sole Panelist

Date: May 10, 2024