

## ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. 代振生 (Zhen Sheng Dai)  
Case No. D2024-1214

### 1. The Parties

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

The Respondent is 代振生 (Zhen Sheng Dai), China.

### 2. The Domain Name and Registrar

The disputed domain name <ukfatfaceonline.shop> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on March 20, 2024. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 22, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 27, 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 in English on March 28, 2024.

On March 27, 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 the following day, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in Chinese and English, and the proceedings commenced on April 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 25, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on May 1, 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 founded in 1988. The Complainant holds trademark registrations in multiple registrations, including:

- European Union trademark registration number 001764760 for FATFACE, registered on October 16, 2001, specifying goods in classes 9, 18, and 25; and
- International trademark registration number 848966 for FATFACE, registered on December 15, 2004, specifying services in class 35.

The above trademark registrations are current. The Complainant also registered the domain name <fatface.com> in April 1997 that it uses in connection with a website where it offers its products for sale, including Six Nations rugby jerseys and other clothing. The site prominently displays a FATFACE logo shown as one word in all capitals in a fancy script (referred to below as the "FATFACE logo"). The site received over 42 million visits in 2023. On October 13, 2023, the Complainant announced that it was to be acquired by Next PLC.

The Respondent is an individual apparently based in China. According to information provided by the Complainant, at least two panels in previous proceedings under the Policy have found that the Respondent had registered and was using a domain name in bad faith in circumstances similar to the present case. See, for example, *Chewy, Inc. v. 代振生 (Zhen Sheng Dai)*, WIPO Case No. [D2023-2230](#).

The disputed domain name was registered on December 12, 2023. It formerly resolved to a website that prominently displayed the Complainant's FATFACE logo and offered products for sale, including Six Nations rugby jerseys and other clothing, as well as accessories. Prices were discounted and displayed in GBP. At the time of filing the Complaint, the disputed domain name no longer resolved to any active website but was passively held.

#### **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 the Complainant's FATFACE mark. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent used the disputed domain name in connection with a site that impersonated the Complainant's offerings, using the Complainant's FATFACE logo and trademark. The Respondent used visual indicia from the Complainant's main website, purporting to sell goods under the Complainant's name at discounted prices. The disputed domain name was registered and has been used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 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.

The Complaint and amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the composition of the disputed domain name, which contains English words and a geographical reference to the United Kingdom ("uk"), the Respondent's involvement in previous UDRP disputes conducted in English, and translation of the Complaint would result in additional expenses and unnecessary delay.

The Respondent did not make any submission with respect to the language of the proceeding nor indicate any interest in otherwise participating in the proceeding, despite the Center having sent an email regarding the language of the proceeding, and the notification of the Complaint, in both Chinese and English.

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. The Panel would have accepted a Response in Chinese, but none was filed.

### **6.2. Substantive Issues**

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (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

#### **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. See [WIPO Overview 3.0](#), section 1.7.

In the present case, the Complainant has shown rights in respect of the FAT FACE trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name wholly incorporates the FAT FACE trademark, omitting only the space between the words for technical reasons. Although the disputed domain name adds the geographical reference “uk” (an abbreviation for the United Kingdom) and the word “online”, the mark is recognizable within the disputed domain name. The generic Top-Level Domain (“gTLD”) extension (“.shop”) is viewed as a standard requirement of domain name registration and may be disregarded in the assessment of confusing similarity for the purposes of the Policy. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7 and 1.11.

Therefore, 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. See [WIPO Overview 3.0](#), section 2.1.

In the present case, the Respondent formerly used the disputed domain name in connection with a website that prominently displayed the Complainant’s FATFACE logo and offered for sale the same type of products as the Complainant, including Six Nations rugby jerseys and other clothing. There was no indication of the operator of the website besides the FATFACE logo. Although the Panel has been unable to verify that the product photographs were reproduced from the Complainant’s own website, the website gave the impression that it was the online store for the United Kingdom market of the Complainant or its affiliate. However, the Complainant submits that the online store was not its own site nor that of an affiliate. Currently, the disputed domain name is passively held. Neither is a use in connection with a bona fide offering of goods or services. Nor is either use a legitimate noncommercial or fair use for the purposes of the Policy. Further, the Registrar has verified that the Respondent’s name is 代振生 (Zhen Sheng Dai), not the disputed domain name. Nothing on the record indicates that the Respondent has been commonly known by the disputed domain name.

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.

Based on the 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 being 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. See [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the disputed domain name was registered in 2023, years after the earliest registration of the Complainant’s FAT FACE mark. The disputed domain name wholly incorporates that mark. The

disputed domain name formerly resolved to a website that prominently displayed the Complainant's FATFACE logo and offered for sale the same type of products as the Complainant. In these circumstances, the Panel finds that the Respondent had the Complainant and its mark in mind when he registered the disputed domain name.

As regards use, the disputed domain name no longer resolved to any active website at the time when the Complaint was filed. However, previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See [WIPO Overview 3.0](#), section 3.3. In the present case, the Respondent formerly used the disputed domain name, which wholly incorporates the FAT FACE mark, in connection with an online store that gave the false impression that it was operated by the Complainant or an affiliate of the Complainant and offered for sale the same type of products as the Complainant. These circumstances indicate that, by using the disputed domain name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's FAT FACE mark as to the source or affiliation of his website or of the products on his website. Given these clear indicia of bad faith, the Panel finds that in the circumstances of this case the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Therefore, 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 <ukfatfaceonline.shop> be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: May 6, 2024