

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Domain Privacy, Domain Name Privacy Inc.
Case No. D2024-1602

1. The Parties

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

The Respondent is Domain Privacy, Domain Name Privacy Inc., Cyprus.

2. The Domain Name and Registrar

The disputed domain name <fatface.xyz> is registered with Communigal Communications Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 17, 2024. On April 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 20, 2024, 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 (Domain Name Privacy Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 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 April 24, 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 May 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 24, 2024.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on June 5, 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, Fat Face Holdings Limited, is a British clothing, accessories and lifestyle brand, founded in 1988. The Complainant's FAT FACE trademark originates from the beginnings of the company and the term 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", and the Complainant owns registered trademarks rights in both "FAT FACE" and "FATFACE" marks. The Complainant opened 50 FAT FACE stores by 2002, continuing to grow over 200 stores in the United Kingdom and Ireland by 2012. The Complainant conducted business and earned revenues to the tune of GBP234.8 million in 2022 (an increase in revenue from 2021, which was GBP151.3 million). The goods sold under the FAT FACE trademark include women's, men's and children's clothes, household items, accessories and footwear. The Complainant uses its official website, "www.fatface.com" for the blog, and to offer e-commerce services. The Complainant's website was registered in April 1997.

The Complainant is the owner of several trademarks worldwide which are mentioned below:

Trademark	Country	Registration Number	Registration Date	Classes Covered
FAT FACE	European Union	001764760	October 16, 2001	9, 18, 25
FAT FACE	European Union	004152005	January 5, 2006	14, 35
FAT FACE	International Registration	848966	December 15, 2004	35
FAT FACE	United Kingdom	UK00912646659	October 14, 2014	3, 9, 14, 16, 18, 25, 35
FAT FACE	United Kingdom	UK00002448877	August 31, 2007	12, 22, 28

The Complainant has also established social media presence and uses their trademark FAT FACE to promote their services under the following:

Facebook: "<https://www.facebook.com/fatface/>"

Instagram: "<https://www.instagram.com/fatface/>"

X (formerly Twitter): "<https://twitter.com/fatface/>"

As part of their charitable work, the Complainant launched the Fat Face Foundation in 2009, through which it claims to have planted 57,000 trees, donated to the Red Cross for Ukraine, and supported for the Prince's Trust.

The disputed domain name was created on January 26, 2024. The disputed domain name lands on a page where the pay-per-click (PPC) in the Complainant's industry links are displayed.

The Respondent has not replied.

5. Parties' Contentions

Notably, the Complainant contends that the disputed domain name is identical to its registered trademarks FAT FACE and FATFACE; that the Respondent lacks rights and legitimate interests therein, and that the disputed domain name was registered and is being used in bad faith.

A. Complainant

The Complainant contends that the disputed domain name is identical to Complainant's trademark as it includes the Complainant's trademark FAT FACE in its entirety alongside the generic Top-Level Domain ("gTLD") ".xyz". The Complainant contends that by creating the disputed domain name, the Respondent is creating confusion, and the consumers may believe that the disputed domain name refers to the Complainant.

The Complainant further contends that the Respondent does not own any trademark corresponding to the disputed domain name. Furthermore, the Complainant has not licensed or authorized the Respondent to use its trademark or to register any domain name including the trademark FAT FACE. The Complainant alleges that the Respondent lacks rights or legitimate interests. The Complainant further contends that the Respondent has used the disputed domain name to host a series of Pay-Per-Click (PPC) links. The Complainant contends that many of these links relate to the Complainant's offering of goods, and some redirected online users to competing offerings instead of using the disputed domain name in connection with a bona fide offering of services. Further, according to the Complainant, the Respondent has deliberately used the goodwill attached to the FAT FACE brand for its own monetary gain. The Complainant also highlights that the Respondent is responsible for the content displayed on its domain name, even if PPC links appear "automatically". Further, there is no plausible reason for the registration or use of the disputed domain name, given the distinctive nature of the FAT FACE mark.

The Complainant argues that it enjoys a reputation in their trademark FAT FACE, due to their intensive, long standing, and worldwide use. The Complainant further contends that it is impossible that the Respondent did not have the Complainant's trademark in mind at the time of registering the disputed domain name as searching FAT FACE on popular internet search engines such as Google lists the Complainant's brand and services as the first result. Moreover, any average internet user has access to FAT FACE trademark registrations, as they can be found on public trademark databases. The Complainant's representatives sent a cease-and-desist letter to the Respondent via the domain registrar on January 31, 2024, to inform them of the Complainant's trademarks and seek an amicable resolution. The Respondent's failure to respond may indicate bad faith.

The Complainant indicates that the disputed domain name is listed for sale on Afternic for USD 688, which exceeds registration costs. Although not directly offered to the Complainant contends that this indicates the Respondent's intent to profit commercially.

B. Respondent

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

6. Discussion and Findings

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.

The Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Complainant has established that it has trademark rights by way of registrations and common law rights by way of extensive use of the trademark FAT FACE. The disputed domain name has been registered on

January 26, 2024, which is decades subsequent to when FAT FACE was registered by Complainant. [WIPO Overview 3.0](#), section 1.2.1.

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

[WIPO Overview 3.0](#), section 1.7. It is well established that the addition of a gTLD extension (such as “.xyz” in this case) is generally irrelevant when determining whether a domain name is confusingly similar to a Complainant’s trademark.

The generic Top-Level Domain (gTLD) “.xyz”, is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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. As noted above, the disputed domain name resolves to a website displaying of PPC links. While panels have recognized that using a domain name in connection with PPC links is not necessarily contrary to the Policy, here the PPC links seek to capitalize directly on the Complainant’s trademark, and the Panel therefore finds such use cannot confer any rights or legitimate interests on the Respondent. [WIPO Overview 3.0](#), section 2.9.

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’s registration and utilization of the disputed domain name demonstrates bad faith, a claim which the Respondent failed to contest. The usage of the Complainant’s registered trademark as a part of the Respondent’s domain name indicates that the Respondent was aware of the Complainant’s rights at the time of registering the disputed domain name. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s mark. [WIPO Overview 3.0](#), section 3.1.4.

In the present case, the Panel notes that the Respondent's registration of the disputed domain name that wholly incorporates the Complainant's trademark FAT FACE itself demonstrates bad faith. [WIPO Overview 3.0](#), section 3.1.4. The usage of the Complainant's registered trademark as a part of the disputed domain name indicates that the Respondent was aware of the Complainant's rights at the time of registering the disputed domain name.

The disputed domain name resolves to a website displaying PPC links. The Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark pursuant to paragraph 4(b)(iv) of the Policy.

As already discussed, the disputed domain name directs to a parking page containing PPC links. It is highly probable that the Respondent earns revenue through click-throughs on these links present on the website associated with the disputed domain name.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <fatface.xyz> be transferred to the Complainant.

/Meera Chature Sankhari/

Meera Chature Sankhari

Sole Panelist

Date: June 19, 2024