

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Chapman Sandy

Case No. D2024-1690

1. The Parties

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

The Respondent is Chapman Sandy, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fatfacesupply.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2024. On April 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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 (REDACTED FOR PRIVACY) 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 25, 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 April 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 28, 2024.

The Center appointed Daniel Peña as the sole panelist in this matter on June 3, 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 British clothing, accessories, and lifestyle brand founded in 1988 by Tim Slade and Jules Leaver who sold t-shirts at ski resorts under the FAT FACE and FATFACE trademarks.

The Complainant opened 50 FAT FACE stores by 2002, having reached over 200 stores in the United Kingdom and Ireland by 2012 and presently also counting with an international presence in the United States of America.

The Complainant is the owner of the following, amongst other, trademark registrations:

- New Zealand trademark registration No. 294292, for the word mark FAT FACE, filed on June 24, 1998, registered on December 21, 1998, subsequently renewed, in class 25;
- European Union trademark registration No. 001764760, for the word mark FAT FACE, registered on October 16, 2001, subsequently renewed, in classes 9, 18, and 25;
- International trademark registration No. 848966, for the word mark FAT FACE, registered on December 15, 2004, successively renewed, in class 35;
- United States of America trademark registration No. 4,934,466, for the word mark FATFACE, registered on April 12, 2016, in classes 3, 9, 14, 16, 18, 25 and 35;
- United Kingdom trademark application No. UK00003651752, for the word mark FAT FACE MADE FOR LIFE, registered on November 5, 2021, in class 25; and
- European Union trademark application No. 018487191, for the word mark FAT FACE MADE FOR LIFE, registered on October 13, 2021, in class 25.

The disputed domain name was registered on March 20, 2024. DDN use?

5. Parties' Contentions

A. Complainant

The Complainant asserts that its FAT FACE trademark was coined after the famous black mountain skiing run in Val d'Isère, named "La Face", having the Complainant's brand often been stylized to FATFACE or FAT FACE, applied to women's, men's, and children's clothes, in addition to accessories and footwear and that it has become a leading clothing and accessory retailer, with wide scale consumer recognition.

The disputed domain name redirects to an active website seemingly offering FATFACE trademarked products, at discounted prices. In the website's home page, there is a FATFACE logo which is identical to the mark that is used at the Complainant's official website.

The disputed domain name incorporates the Complainant's trademark FATFACE in its entirety with the additional generic term "supply".

The disputed domain name is confusingly similar to the FATFACE trademark in which the Complainant has rights.

The Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to seek registration of any domain name incorporating the FATFACE mark.

The Respondent did not demonstrate use of the disputed domain name in connection with a bona fide offering of goods or services.

The Complainant has never concluded any agreement, gave any license or otherwise authorized or allowed the Respondent to use its FATFACE trademark and logo in any way. To the best of the Complainant's knowledge, the Respondent has not been commonly known by the name "fat face".

The Respondent in any event is not authorized or licensed to use the FATFACE trademark, nor to seek registration of any domain name incorporating such trademark.

The Complainant has never authorized the Respondent to offer for sale and sell the Complainant's products. All products on the website had been offered for sale at a discounted price, and the Respondent had masked its identity.

The Respondent's registration of the disputed domain name was made primarily with intention to attract, for commercial gain, Internet users to website by creating a likelihood of confusion with the Complainant's trademark.

The Respondent registered and used the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true, see section 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that: (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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the FATFACE and FAT FACE trademarks on the basis of its multiple trademark registrations in several countries. A trademark registration prima facie satisfies that the rights in the trademark belong to the Complainant, see [WIPO Overview 3.0](#), section 1.2.1. It has also been established by prior UDRP panels that when a domain name incorporates a trademark in its entirety, it will

normally be considered that the domain name is confusingly similar to that trademark. Such finding is confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#).

The Respondent's incorporation of the Complainant's mark in full in the disputed domain name is sufficient to establish that the disputed domain name is confusingly similar to the Complainant's marks. Mere fact of the addition of the term "supply", to the Complainant's trademark FATFACE does not prevent a finding of confusing similarity with the Complainant's marks.

Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" does not prevent a finding of confusing similarity either. The Panel is satisfied that the disputed domain name is confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a prima facie case which, if not rebutted by relevant evidence from the Respondent will lead to this ground being set forth.

The Panel finds that the Complainant has made a prima facie case showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent is not commonly known under the disputed domain name, is not affiliated with the Complainant in any way and that the Complainant never authorized the Respondent to use its trademarks FATFACE and FAT FACE as part of the disputed domain name, given the alleged use of the disputed domain name to use its logos and sell online its products at discounted prices.

The Panel notes that the Respondent has not filed any Response and thus did not deny the Complainant's assertions, nor brought any information or evidence for demonstrating any rights or legitimate interests. Accordingly, the Panel finds that the Complainant satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or 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 the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (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 respondent has engaged in a pattern of such conduct; (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 its 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 respondent's website or location or of a product or service on its website or location.

With regard to the bad faith at the time of registration, the Panel notes that even though the Complainant's trademark consists of two common or descriptive words "fat face", this term has become a renowned trademark in and to which the Complainant has demonstrated rights. The disputed domain name reproduces, without any authorization or approval, the Complainant's registered trademarks. Moreover, the disputed domain name is inherently misleading as it reproduces the Complainant's FATFACE and FAT FACE trademarks together with the term "supply", which is a generic commercial term, it is at the least very

unlikely that the Respondent was not aware of the existence of the Complainant's trademarks when registering a domain name that entirely reproduces the Complainant's trademark.

The Panel takes note of the construction of the disputed domain name, which combines the FATFACE mark with the descriptive term "supply" as well as the fact that the disputed domain name directs to a website that contains the Complainant's logo and allegedly offers the Complainant's trademarked goods. The Panel is satisfied that by directing the disputed domain name to a commercial website allegedly offering the Complainant's goods at discounted prices, 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 as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Panels have held that the use of a domain name for illegal activity, here, sale of counterfeit goods or impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having considered the Complainant's submissions and in the absence of a Response, the Panel accepts the Complainant's submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register or use the inherently misleading disputed domain name.

Consequently, the Panel finds that the disputed domain name was registered and used by the Respondent in bad faith within paragraph 4(a)(iii) 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 <fatfacesupply.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: June 17, 2024