

ADMINISTRATIVE PANEL DECISION

Fat Face Holdings Limited v. Raffaella Damore
Case No. D2024-3244

1. The Parties

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

The Respondent is Raffaella Damore, France.

2. The Domain Name and Registrar

The disputed domain name <fatfacestore.com> is registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 7, 2024. On August 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10, 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 Admin, Whoisprotection.cc) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 13, 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 August 15, 2024.

The Center verified that the Complaint, together with the amendment to 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 August 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 17, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on September 23, 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 in the United Kingdom, manufactures clothing, accessories and household items. By 2012 the Complainant operated over 200 stores in the United Kingdom and Ireland, and in 2022 expanded and had international presence in the United States of America and Canada. The Complainant generated revenues of GBP 270.9 million in 2023.

The Complainant owns trademarks for both FAT FACE and FATFACE, such as the following:

- the European Union trademark registration number 001764760 for FAT FACE (word), filed on July 19, 2000, registered on October 16, 2001, covering goods in International classes 9, 18 and 25; and
- the European Union trademark registration number 004152005 for FAT FACE (word), filed on November 29, 2004, registered on January 5, 2006, covering goods and services in International classes 14 and 35.

In April 1997, the Complainant registered its official website available at <fatface.com> and uses it to promote its goods.

The Complainant has established a strong social media presence.

The disputed domain name was registered on April 9, 2024, and, at the time of filing of the Complaint, it was not actively used.

On April 26, 2024, the Complainant contacted the Respondent and the Registrar to request the transfer of the disputed domain name. The Registrar placed the disputed domain name in clienthold status. The Respondent did not respond.

According to Annex 20 to the amended Complaint, the Respondent was involved in another UDRP dispute, decided against it, see *Besson Chaussures SAS v. Raffaella Damore*, WIPO Case No. [D2023-5237](#).

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 FAT FACE is distinctive, has strong reputation and is widely known in its industry; the disputed domain name is confusingly similar to its trademark; the addition of the term "store" further strengthens such confusion; the Respondent has no rights or legitimate interests in the disputed domain name; the Respondent has registered and is using the disputed domain name in bad faith; the passive holding of a domain name does not, as such, prevent a finding of bad faith since the first registration of the Complainant's mark precedes the creation of the disputed domain name by over 25 years; the FAT FACE name has become renowned for designing modern and practical clothing, household items, accessories and footwear; the mark is distinctive and gained reputation; there has been a lack of response to the Complainant's letter before commencing the present proceeding; no evidence of any actual or contemplated good faith use has been presented; and the Respondent has been involved in a previous

UDRP proceeding decided against it which suggests that the Respondent likely targets third-party brands that operate in the Complainant's industry in its domain registrations.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities 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 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. 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 or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable 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 term, here "store", may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

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.

The Panel notes that the composition of the disputed domain name, which reproduces the Complainant's distinctive mark together with the descriptive term "store", suggests an affiliation with the trademark owner. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

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 disputed domain name was registered in bad faith, with knowledge of the Complainant, its trademark and business particularly because the disputed domain name incorporates the Complainant's trademark with a descriptive term "store" which suggests an affiliation with the Complainant's web-shop offerings; also, the Complainant's trademark acquired reputation in its field, and predates the registration of the disputed domain name by more than twenty five years.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and 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. [WIPO Overview 3.0](#), section 3.2.1.

At the time of filing the Complaint, the disputed domain name directed towards an inactive page.

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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes: the reputation and distinctive character of the Complainant's trademark; the composition of the disputed domain name, which is confusingly similar to the Complainant's trademark, domain name, and trade name; the Respondent's failure to provide a response to the Complainant's cease-and-desist letter and in this proceeding. Weighing the aforementioned evidence, the Panel 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.

Furthermore, according to Annex 20 to the Amended Complaint, the Respondent was involved in a previous UDRP dispute, involving two domain names incorporating the trademark of a third party. The Panel finds this can be considered a pattern of abusive conduct and registration of the disputed domain name in bad faith. [WIPO Overview 3.0](#), section 3.1.2.

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 <fatfacestore.com> be transferred to the Complainant.

/Marilena Comanescu /

Marilena Comanescu

Sole Panelist

Date: October 1, 2024