

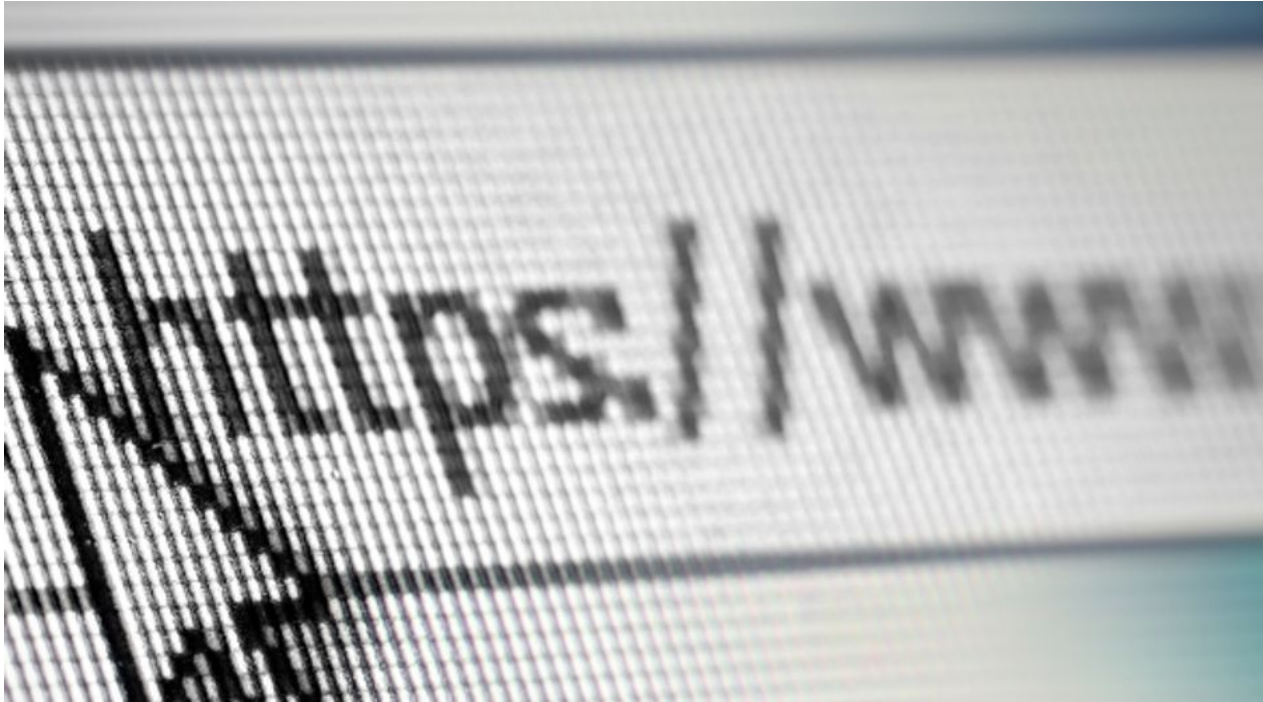


Inserting 'porn' within a trademark fails to eliminate confusing similarity

Jane Seager and Maria Rozylo

Hogan Lovells

18 October 2022



INTERNATIONAL

Legal updates: case law analysis and intelligence

- The complainant was the operator of the media platform at 'www.onlyfans.com'; the disputed domain name was 'onlypornfans.me'
- The panel found that the domain name was confusingly similar to the complainant's ONLYFANS and ONLYFANS.COM marks
- The respondent's bad faith was underlined by the insertion in the domain name of the term 'porn', which clearly referred to the complainant's services

In a recent decision under the [Uniform Domain Name Resolution Policy](#) (UDRP) before WIPO, a panel has cancelled the domain name 'onlypornfans.me', finding that the complainant had satisfied all the requirements under the UDRP.

Background

The complainant was Fenix International Limited, a US company operating a media platform at 'www.onlyfans.com' enabling users to post and subscribe to audio-visual content. The respondent was an individual.

The disputed domain name, 'onlypornfans.me', was registered in March 2021. When the complaint was filed, it resolved to a website providing adult entertainment services.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

(a) the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;

(b) the respondent has no rights or legitimate interests in respect of the domain name; and

(c) the domain name has been registered and is being used in bad faith.

Decision

With regard to the first limb, the complainant argued that it had trademark rights in ONLYFANS since 2019 in the European Union and the United States, as well as in ONLYFANS.COM in the United States. The complainant also contended that inserting the term 'porn' in the disputed domain name did not avoid confusing similarity with its trademark.

The respondent defended his position under all three limbs of the UDRP in an informal email in which he stated:

“

Hello, Domain. Trademark - onlyfans.com only_RANDOM_WORD_fans is not a trademark Thank you

”

The panel found for the complainant, noting that the disputed domain name was confusingly similar to the complainant's trademarks ONLYFANS and ONLYFANS.COM, as ONLYFANS was included in its entirety in the disputed domain name. The panel also considered that the inclusion of the additional term 'porn' between 'only' and 'fans' did not prevent a finding of confusing similarity. The panel therefore found that the complainant had satisfied the first limb.

Under the second element of the UDRP, the complainant stated that the respondent had no connection nor affiliation with the complainant. Moreover, the complainant underlined that it had not authorised the respondent to use the trademark in question and the respondent had been using the disputed domain name to offer similar goods and services, thus creating a risk of implied affiliation.

The panel found that the use of the disputed domain name to host a commercial website providing similar services in competition with the complainant's business did not give the respondent rights or legitimate interests. The panel also stated that such services did not represent a *bona fide* offering. Therefore, the panel made a finding that the complainant had successfully satisfied the second element of the UDRP.

With regard to the third limb, the complainant contended that the respondent had registered and used the disputed domain name in bad faith, given that it was registered long after the complainant had obtained its ONLYFANS trademark. Further, the complainant argued that the domain name was being used to offer competing goods and services.

The panel also found for the complainant under this limb. The panel stated that the respondent must have been aware of the complainant's rights given the popularity of the complainant's services and products among the relevant public. The panel added that the respondent's bad faith was further underlined by the insertion in the disputed domain name of the term 'porn', which clearly referred to the complainant's services. The panel also noted that the respondent's use of the domain name to point to a commercial website, combined with the respondent's failure to respond to the complainant's cease-and-desist letter and to submit a formal response, affirmed its finding of bad faith. In light of above, the panel made a finding that the domain name had been registered and used in bad faith, and the complainant had therefore proved the requirements of the third limb of the UDRP.

Comment

The decision serves as a reminder that the addition of a descriptive word to a trademarked term may not be sufficient to distinguish the complainant's rights from the disputed domain name. This holds true regardless of the placement of such term - whether as a prefix, a suffix, or indeed inserted anywhere between the various words of a trademark.

In addition, this decision underlines that a respondent's failure to provide a comprehensive explanation as to the registration and use of a disputed domain name may constitute one of the reasons for a finding of bad faith. Having said that, it should be stressed that the absence of a response to a cease-and-desist letter, or the failure to submit a formal response during the UDRP proceedings, will not always be treated by the panel as an indication of bad faith.

Jane Seager

Author | Partner

jane.seager@hoganlovells.com

Hogan Lovells

Maria Rozylo

Author | Associate

maria.rozylo@hoganlovells.com

Hogan Lovells

Copyright © Law Business Research Company Number: 03281866 VAT: GB 160 7529 10