

ADMINISTRATIVE PANEL DECISION

FRANKIE Shop v. Tu Feng

Case No. D2022-4103

1. The Parties

The Complainant is FRANKIE Shop, United States of America (“United States”), represented by Coblence Avocats, France.

The Respondent is Tu Feng, China.

2. The Domain Name and Registrar

The disputed domain name <thefrankiesale.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 1, 2022. On November 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 2, 2022, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 7, 2022, 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 amendment to the Complaint on November 8, 2022.

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 November 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 6, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on December 12, 2022. 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 retailer of fashion clothing, accessories, footwear, and associated products. It was established as a boutique in 2014 and commenced online trading in or about 2016.

The Complainant's brand is generally presented as THE FRANKIE SHOP and the Complainant is the owner of two pending trade mark applications, in the United States and France, for THE FRANKIE SHOP. The Complainant's brand is sometimes presented as FRANKIE SHOP and the Complainant owns trade marks for this term including, by way of example only, United States Service Mark, registration No. 5147070, registered on February 21, 2017, in class 35. The Complainant also owns and operates many domain names which comprise or include the term FRANKIE SHOP or THE FRANKIE SHOP, including <thefrankieshop.com> and <frankieshop.us>.

The disputed domain name was registered on November 9, 2021. For a period following registration, it resolved to a website selling clothing, footwear, bags, and related products. The Complainant has provided a screen shot of the home page of the Respondent's website which establishes that it was prominently branded as "The Frankie Shop", using a similar or identical font to that used by the Complainant, and that it used a similar style and layout to the Complainant's website. The disputed domain name does not presently resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which it has rights. In this respect, the Complainant refers to its pending trade mark applications for THE FRANKIE SHOP and to its registered marks for FRANKIE SHOP, an example of which is given above. Additionally, the Complainant says that it is known by the mark THE FRANKIE SHOP worldwide. In support of this contention, the Complainant has provided copies of various articles about it which have been published in a number of well-known periodicals. These include an article in Vogue, dated August 2021, entitled "How The Frankie Shop Became The Brand Editors Can't Live Without" and an article in Forbes magazine, dated November 2019, entitled "How This Lower East Side Boutique Became a Fashion Sensation: Welcome To The Frankie Shop".

The Complainant says that the disputed domain name blatantly imitates both its FRANKIE SHOP and THE FRANKIE SHOP marks, in that the only differences are that the word "sale" has been swapped for the word "shop" and, in relation to the first of these marks, the word "the" has been added. These changes do not serve to prevent confusion with the Complainant's marks.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with the Complainant and has not been licensed or otherwise authorized by it to use its trade marks nor to proceed with the registration of the disputed domain name. Moreover, use of the disputed domain name in order to redirect to a website offering sales of similar products to those of the Complainant cannot comprise *bona fide* use of it. Furthermore, the Respondent has not made a legitimate, noncommercial or fair use of the disputed domain name.

Lastly, the Complainant says that the disputed domain name was registered and is being used in bad faith. The Complainant has a worldwide reputation in its THE FRANKIE SHOP and FRANKIE SHOP marks. Bad faith registration can be established if a respondent knew or should have known of a complainant's rights. The content of the Respondent's website, combined with confusing similarity between the disputed domain

name and the Complainant's marks, indicates that the Respondent had the Complainant in mind as at the date of registration of the disputed domain name. Use of the disputed domain name in order to direct to a website creating a likelihood of confusion with the Complainant's trade marks is in bad faith.

B. Respondent

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

6. Discussion and Findings

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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

For the purpose of considering the first element of the Policy, the generic Top-Level Domain ("gTLD") component of the disputed domain name, namely ".com", is disregarded as this is a technical requirement of registration.

The Complainant has established its trade mark rights in FRANKIE SHOP by providing details of its registered marks for this term, including the mark cited above. Whilst the Complainant has additionally sought to rely on its service and trade mark applications for THE FRANKIE SHOP, pending trade mark applications, are not considered as comprising rights for the purposes of the first element. However, the Complainant has provided evidence of its repute in the term THE FRANKIE SHOP in the form of articles about it in leading fashion and other magazines, the earliest of which is dated April 2017. Collectively, these establish that, by the date of registration of the disputed domain name in November 2021, this term had become a distinctive identifier which the public and fashion industry associated with the Complainant's goods and/or services. In this respect, see section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel therefore finds that the Complainant has established unregistered or common law trade mark rights in THE FRANKIE SHOP for the purposes of the first element of the Policy.

For the purpose of determining whether the disputed domain name is identical or confusingly similar to the Complainant's marks, the generic Top-Level Domain ("gTLD") ".com" is disregarded as this is a technical requirement of registration. In comparing the disputed domain name with the Complainant's THE FRANKIE SHOP and FRANKIE SHOP marks, the only difference is the substitution of the word "sale" for the word "shop" and the addition of the word "the" to the second of these marks. Section 1.7 of the [WIPO Overview 3.0](#) explains that; "While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". The most distinctive feature of each of the Complainant's marks is the FRANKIE component and this term is clearly recognizable in the disputed domain name.

For the above reasons, the Panel finds that the disputed domain name is confusingly similar to the Complainant's FRANKIE SHOP and THE FRANKIE SHOP trade marks.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, without limitation, examples of circumstances whereby a respondent might demonstrate that it has rights or legitimate interests in a domain name. In summary, these are if a respondent has used or prepared to use the domain name in connection with a *bona fide* offering of goods and services, if a respondent has been commonly known by the domain name, or if a respondent has made a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark in issue.

The previous use of the disputed domain name, as described above, establishes that the Respondent's intent was to mislead Internet users, who are likely to have been searching for the Complainant's website, into believing that its website was that of the Complainant. Use of the disputed domain name for these purposes does not amount to use in connection with a *bona fide* offering of goods and services. In this respect, see the decision of the panel in *Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilipplein*, WIPO Case No. [D2015-1050](#); "The Respondent's use of a domain name that is confusingly similar to the Complainant's trade marks in order to attract Internet users looking for genuine products of the Complainant's company and to offer them unauthorized copies instead is a 'bait and switch' strategy that lacks *bona fides* and does not give rise to rights or a legitimate interests under the Policy". See also section 2.13.1 of the [WIPO Overview 3.0](#) which explains that UDRP "[p]anels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent".

There is no evidence to indicate that the Respondent has been commonly known by the disputed domain name and the second circumstance set out at paragraph 4(c) of the Policy is therefore inapplicable. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name. Lastly, the current inactive status of the disputed domain name comprises neither a *bona fide* offering of goods and services nor a legitimate noncommercial or fair use of it; see, by way of example, *G4S Plc v. Muyou Chen, wer*, WIPO Case No. [D2020-0715](#).

The Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent; see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). In the absence of any response from the Respondent to the Complaint, it has failed to satisfy that burden. The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

In the light of the fact that, following registration, the Respondent has used the disputed domain name to resolve to a website which purported to be that of the Complainant, it is reasonable to infer that the Respondent was aware of the Complainant as at the date of registration and that the disputed domain name was registered in order to take advantage of the Complainant's marks in some manner. It is well established under the Policy that registration of a domain name by an unconnected party with knowledge of a complainant's trade mark registration and in circumstances where the domain name is put to a misleading use, amounts to bad faith. As the UDRP panel found in *Herbalife International, Inc. v. Surinder S. Farmaha*, WIPO Case No. [D2005-0765](#), "the registration of a domain name with the knowledge of the Complainant's trade mark registration amounts to bad faith". Similarly, as explained at section 3.1.4 of the [WIPO Overview 3.0](#): "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of

bad faith". The Panel accordingly finds that disputed domain name was registered in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a 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. The previous use to which the Respondent has put the disputed domain name falls within these circumstances in that the form and content of its website will have led Internet users to believe that it was operated by, or with the authorization of, the Complainant. Such a belief will have been reinforced because of the confusing similarity between the disputed domain name and the Complainant's trade marks. The Respondent's previous use of the disputed domain name in order to create the false impression of a connection with the Complainant's business was accordingly in bad faith; in this respect see, by way of example, *Richemont International SA v. brandon gill*, WIPO Case No. [D2013-0037](#).

The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. Section 3.3 of the [WIPO Overview 3.0](#) explains that; "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding". The factors that are typically considered when applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealment of its identity or its use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put. See also *VOLKSWAGEN AG v. Danny de graaf*, WIPO Case No. [D2020-1940](#).

Applying these factors to the current circumstances: (i) in the context of the Policy, the Complainant's FRANKIE SHOP and THE FRANKIE SHOP marks are distinctive and the Complainant has provided evidence of their repute; (ii) the Respondent has not provided a response to the Complaint and the previous use made of the disputed domain name was in bad faith; (iii) the Respondent has used a privacy service to conceal its identity; (iv) there is no plausible good faith use to which the disputed domain name could be put by the Respondent. Accordingly, the circumstances of the Respondent's holding of the disputed domain name support a finding of bad faith use under the doctrine of passive holding.

The Panel accordingly finds that the Respondent has registered and is using the disputed domain name in bad faith.

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 <thefrankiesale.com> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: December 26, 2022