

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Jie Wen
Case No. D2022-4197

1. The Parties

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

Respondent is Jie Wen, China.

2. The Domain Name and Registrar

The disputed domain name <frankieshopus.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 4, 2022. On November 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on November 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 1, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 2, 2022.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on December 13, 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

Complainant is a company organized under the laws of the United States that is active in the fashion industry.

Complainant has provided evidence that it is the registered owner of various trademarks relating to its company name and brand FRANKIE SHOP, *inter alia*, but not limited to the following:

- word mark THE FRANKIE SHOP, Institut National de la Propriété Industrielle (INPI) France, registration number: 4762800, registration date: May 4, 2021, status: active; and
- word mark THE FRANKIE SHOP, United States Patent and Trademark Office (USPTO), serial number: 97050056, filing date: September 28, 2021, status: filed/registration still pending.

Moreover, Complainant has demonstrated to enjoy further trademark rights through its registered agent, *e.g.*, the following:

- word mark FRANKIE SHOP, USPTO, registration number: 5147070, registration date: February 21, 2017, status: active.

Finally, Complainant has substantiated to own numerous domain names relating to its (THE) FRANKIE SHOP trademark, *inter alia*, the domain name <thefrankieshop.com> which redirects to Complainant's official website at "www.thefrankieshop.com" promoting Complainant's fashion products and related services worldwide.

Respondent, according to the Whois information for the disputed domain name, is a resident of China who registered the disputed domain name on September 13, 2022. By the time of rendering this decision, the disputed domain name does not resolve to any content on the Internet due to a deactivation by the Registrar after the sending of a formal abuse notice by Complainant dated October 23, 2022. Complainant, however, has evidenced that, at some point before the filing of the Complaint, the disputed domain name redirected to a website at "www.frankieshopus.com", reproducing Complainant's (THE) FRANKIE SHOP trademark and offering to sell fashion products similar to those of Complainant.

On October 23, 2022, Complainant sent an email to Respondent requesting, *inter alia*, to voluntarily transfer the disputed domain name upon Complainant, to which Respondent did not reply.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that its (THE) FRANKIE SHOP trademark has been featured in major magazines such as "Vogue" and "Forbes" and that it is known all over the world and enjoys a certain reputation worldwide.

Complainant submits that the disputed domain name is confusingly similar to its (THE) FRANKIE SHOP trademark, as it is composed of the two words "frankie" and "shop" and the adjunction of the letters "us". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent is in no way affiliated with Complainant and has not been authorized or licensed to use Complainant's (THE) FRANKIE SHOP trademark or to proceed with a registration of the disputed domain name including the latter, and (2) the reproduction of Complainant's well-known (THE) FRANKIE SHOP trademark in the disputed domain name and the resolution of the latter to a website which offers sales of similar fashion products than those of Complainant reveals a malicious intention on the part of Respondent to take advantage of the notoriety of said trademark. Finally,

Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) the fact that the disputed domain name reproduces Complainant's prior (THE) FRANKIE SHOP trademark (the only difference being the deletion of the word "the" and the addition of the word "us") as well as the architecture of Complainant's official website strongly suggests that Respondent had Complainant's trademark in mind at the time of the registration of the disputed domain name, (2) Complainant's (THE) FRANKIE SHOP trademark as it is reflected in the disputed domain name enjoys reputation and notoriety, and (3) the disputed domain name at some point redirected to a website which offers sales of products similar to Complainant's fashion products, demonstrating that Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name resolved, by creating a likelihood of confusion with Complainant's (THE) FRANKIE SHOP trademark.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

The Panel concludes that the disputed domain name <frankieshopus.com> is confusingly similar to the (THE) FRANKIE SHOP trademark in which Complainant has rights.

The disputed domain name incorporates the FRANKIE SHOP trademark in its entirety, and the (THE) FRANKIE SHOP trademark almost entirely, simply omitting the article "the". Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, 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 trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7). Moreover, it has been held in many UDRP decisions and has become a consensus view among UDRP panels (see [WIPO Overview 3.0](#), section 1.8), that the addition of other terms (whether e.g., geographic or otherwise) would not prevent the finding of confusing similarity under the first element of the UDRP. Accordingly, the addition of the term "us" (being e.g., the two-letter country code for the "United States", where Complainant is located) is not in contrast to find confusing similarity arising from the incorporation of Complainant's (almost) entire (THE) FRANKIE SHOP trademark in the disputed domain name.

Therefore, Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Panel is further convinced on the basis of Complainant's undisputed contentions that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor

has Respondent been commonly known by the disputed domain name, nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent has not been authorized to use Complainant's (THE) FRANKIE SHOP trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the term "(the) frankie shop" on its own. To the contrary, Respondent, at some point before the filing of the Complaint, obviously ran a website under the disputed domain name at "www.frankieshopus.com", reproducing Complainant's (THE) FRANKIE SHOP trademark and offering to sell fashion products similar to those of Complainant with no authorization whatsoever to do so (not even as an unauthorized reseller of Complainant's fashion goods, in which case Respondent, *inter alia*, would have needed to disclose the non-existing relationship with Complainant, which Respondent has not (the so-called "Oki Data test", see [WIPO Overview 3.0](#), section 2.8.1)). Such making use of the disputed domain name neither qualifies as *bona fide* nor as legitimate noncommercial or fair within the meaning of the Policy. Moreover, the nature of the disputed domain names is inherently misleading and carries a risk of an implied affiliation as it effectively suggests sponsorship or endorsement by Complainant which is not the case (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in respect of the disputed domain name. Now, the burden of production shifts to Respondent to come forward with appropriate allegations or evidence demonstrating to the contrary (see [WIPO Overview 3.0](#), section 2.1). Given that Respondent has defaulted, it has not met that burden.

C. Registered and Used in Bad Faith

The Panel finally holds that the disputed domain name was registered and is being used by Respondent in bad faith.

The circumstances to this case leave no serious doubts that Respondent was fully aware of Complainant's rights in the (THE) FRANKIE SHOP trademark when registering the disputed domain name and that the latter is clearly directed thereto. Moreover, using the disputed domain name, which is confusingly similar to Complainant's undisputedly well-known (THE) FRANKIE SHOP trademark, to run a website reproducing Complainant's (THE) FRANKIE SHOP trademark and offering to sell fashion products similar to those of Complainant, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant's (THE) FRANKIE SHOP trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

In this context, it also carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete contact information in the Whois register for the disputed domain name since, according to the Case File, the Written Notice on the Notification of Complaint dated November 11, 2022, could not be delivered to Respondent for formal reasons. This fact at least throws a light on Respondent's behavior which supports the Panel's bad faith finding.

Therefore, the Panel concludes that Complainant has also satisfied the third element under the Policy set forth by paragraph 4(a)(iii).

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 <frankieshopus.com> be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: December 27, 2022