

ADMINISTRATIVE PANEL DECISION

The Frankie Shop v. Rwviu Ygber
Case No. D2023-0579

1. The Parties

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

The Respondent is Rwviu Ygber, China.

2. The Domain Name and Registrar

The disputed domain name <thefrankiestore.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 February 8, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on February 9, 2023, 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 February 10, 2023 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 February 11, 2023.

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 February 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on March 14, 2023. 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, based in New York, sells clothing, accessories such as leather goods and jewellery, women's shoes and cosmetics under the brand name THE FRANKIE SHOP and also under third party brands through websites at its domain names <eu.thefrankieshop.com> and at <thefrankieshop.com> and through outlets in New York and in Paris. The Complainant owns United States trade mark registration number 5147070 filed on October 7, 2014 and registered on February 21, 2017, for FRANKIE SHOP. It also owns pending trade mark applications for THE FRANKIE STORE both in the United States and in France.

The disputed domain name was registered on March 23, 2022 and resolves to a website prominently branded as "The Frankie Shop", and offering clothing and products which the Complainant alleges are counterfeit and which are being offered at very substantially discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns, in particular, registered trade mark rights for FRANKIE SHOP as set out above and that the disputed domain name is confusingly similar to this mark. It also submits that it owns pending trade mark applications for THE FRANKIE SHOP in the United States and in France. It submits that the disputed domain name incorporates the key distinguishing element "Frankie" and otherwise differs from its FRANKIE SHOP trade mark registration by the replacement of the word "shop" with "store" and the addition of the definite article "the". The Complainant says that these differences are not such as preclude a likelihood of confusion and that the disputed domain name is therefore confusingly similar to its registered trade mark rights.

The Complainant submits that the Respondent has no rights in the "Frankie shop" name or trade mark and is in no way affiliated with the Complainant and has not been licensed or authorised by it to use its trade marks. The Complainant submits that it does not know the Respondent and has never had any relationship with it.

The Complainant submits that the reproduction of its well-known trade mark "THE FRANKIE SHOP" is not by coincidence and reveals a malicious intent to take advantage of the notoriety of the trade mark. By using the disputed domain name to redirect Internet users to a website that offers sales of identical products to the Complainant's products (in particular clothing) and on which the Complainant's word trade mark is reproduced, the Complainant says that the Respondent clearly intends to take advantage of the use of the disputed domain name. This says the Complainant cannot amount to *bona fide* use of the disputed domain name and there is no evidence that the Respondent has made a legitimate, noncommercial or fair use of the disputed domain name.

As far as registration in bad faith is concerned, the Complainant says that the Respondent must have been aware of its trade marks and business when it registered the disputed domain name. This, says the Complainant, is because its trade marks and business are very well reputed and predate the Respondent's use and the disputed domain name essentially reproduces its registered trade mark (or the key elements of it) and the website to which the disputed domain name resolves reproduces THE FRANKIE SHOP mark as well as the architecture of the Complainant's website and photographs and names of its products.

In terms of use of the disputed domain name in bad faith, the Complainant submits, as noted above, that the use of its trade mark, product names and photographs and site architecture in order to sell counterfeit products on the website to which the disputed domain name resolves, amounts to use in bad faith in terms of

paragraph 4(b)(iv) of the Policy. Further, submits the Complainant, the website to which the disputed domain name resolves offers products that are counterfeits of the Complainant's products at substantially discounted prices.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it has registered trademark rights for FRANKIE SHOP. The disputed domain name incorporates the key distinguishing element "Frankie" and otherwise differs from its FRANKIE SHOP trade mark registration by the replacement of the word "shop" with "store" and the addition of the definite article "the".

The Panel finds that the disputed domain name incorporates the key distinctive element of the Complainant's registered trade mark, namely the name "Frankie". The addition of the definite article and the replacement of the common English word "shop" with the synonym "store" in the disputed domain name does not prevent a finding of confusing similarity. The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's registered trade mark and that the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that the Respondent has no rights in the "Frankie shop" name or trade mark and is in no way affiliated with the Complainant and has not been licensed or authorised by it to use its trade marks. The Complainant has also submitted that it does not know the Respondent and has never had any relationship with it.

The Respondent is using the disputed domain name without the Complainant's authorisation to redirect to a website that offers sales of identical products to the Complainant's products (in particular clothing) and on which the Complainant's word trade mark is reproduced. The Complainant alleges that the products offered on the website to which the disputed domain name resolves are counterfeit and are being offered at substantially discounted prices to the Complainant's products, although the Complainant has not provided any evidence that the Respondent's products are in fact counterfeit. The Complainant has submitted that this cannot amount to *bona fide* use of the disputed domain name and that there is no evidence that the Respondent has made a legitimate, noncommercial or fair use of the disputed domain name.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent's use of the disputed domain name to resolve to a website at which it appears to be masquerading as if it is the Complainant, or is authorised by it or is affiliated to it, when this is not the case, is not *bona fide* or legitimate conduct. The Respondent has failed to explain itself or to respond to or to rebut the Complainant's case and therefore the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The Complainant's United States trade mark registration for FRANKIE SHOP predates the registration of the disputed domain name in 2022 by a number of years. The Complainant has demonstrated that its mark enjoys some degree of international good will and reputation in its mark and uses it through both a physical shop front and an online presence. The website to which the disputed domain name resolves is branded as the "The Frankie Shop" instead of the "The Frankie Store" following the disputed domain name). The

Complainant's unchallenged assertion is that the website at the disputed domain name reproduces the Complainant's product photographs and architecture and also certain of its product names. In short it appears that the Respondent has registered the disputed domain name with a view to using it to confuse customers into thinking that it is the Complainant, or that it has some endorsement or affiliation with it, when this is not the case and with a view to selling products to them that the Complainant alleges are counterfeit. The Respondent has offered no explanation for this conduct and the Panel finds therefore that it is more likely than not that the Respondent was well aware of the Complainant's brand and business when it registered the disputed domain name in 2022.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

The Respondent's use of the disputed domain name which is confusingly similar to the Complainant's registered trade mark and its use of the disputed domain name to divert Internet users to its website, which as described above, appears to use the Complainant's brand, photographs, product names and architecture in order to confuse Internet users into erroneously thinking that it is the Complainant's website, or is affiliated or endorsed by it and in order to sell counterfeit products, is obviously for the commercial benefit of the Respondent and fulfills the requirements of paragraph 4(b)(iv) of the Policy. This amounts to evidence of registration and use of the disputed domain name in bad faith and the Respondent's use of a privacy service in an attempt to mask its identity and its failure to respond to the Complainant's agents' pre-action letter or to otherwise explain its conduct only reinforces the Panel's view of the Respondent's bad faith.

The Panel therefore finds that the disputed domain name has both been registered and used in bad faith and the Complaint also succeeds under this 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 <thefrankiestore.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: March 28, 2023