

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. 蔡文辉 (wenhui cai / cai wenhui)
Case No. D2023-1815

1. The Parties

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

The Respondent is 蔡文辉 (wenhui cai / cai wenhui), China.

2. The Domain Name and Registrar

The disputed domain name <artfrankieshop.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 24, 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. On April 26, 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 (“-”) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 27, 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 in English on April 27, 2023.

On April 27, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. On May 3, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding by the due date.

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 in English and Chinese of the Complaint, and the proceedings commenced on May 4, 2023. In accordance with the

Rules, paragraph 5, the original due date for Response was May 24, 2023. On May 8, 2023, the Respondent sent an email communication in which he objected to the use of English as the language of the proceeding. On May 24, 2023, the Respondent requested an extension to the due date for Response. On the same day, in accordance with paragraph 5(b) of the Rules, the Response due date was extended to May 28, 2023. The Respondent did not submit any formal response. Accordingly, the Center notified the commencement of panel appointment process on June 1, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on June 13, 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, incorporated in 2015, specializes in the sale of clothing, accessories, women's shoes and cosmetics under the brand name "The Frankie Shop" and under third party brands. On May 4, 2021, the Complainant filed French trademark application number 4762800 for THE FRANKIE SHOP; that application is still pending. The Complainant holds United States trademark registration number 7028712 for THE FRANKIE SHOP, registered on April 18, 2023, specifying services in class 35, with a claim of first use in commerce on November 14, 2014, and a disclaimer of the exclusive right to use "shop" apart from the mark. The United States trademark registration is current. The Complainant has also registered multiple domain names, including <thefrankieshop.com>, registered on September 17, 2014, that it uses in connection with websites where it offers its products for sale. It also has an Instagram account named "thefrankieshop".

The Complainant's founder director, Mme Gaëlle Drevet, holds United States trademark registration number 86416726 for FRANKIE SHOP registered on February 21, 2017, specifying services in class 35, with a disclaimer of the exclusive right to use "shop" apart from the mark. She also holds French trademark registration number 4338335 for a semi-figurative mark featuring the name "Frankie Shop", registered on June 9, 2017, specifying goods in classes 3, 4, 9, 14, 18, and 25. Both of these trademark registrations remain current.

The Respondent is an individual based in China.

The disputed domain name was registered on April 10, 2023. It does not resolve to any active website; rather, it is passively held.

According to evidence provided by the Complainant, Chinese trademark application number 64081703 for FRANKIESHOPEDITION was filed on April 19, 2022 and Chinese trademark applications numbers 64160235 and 66654672, both for ARTFRANKIESHOP, were filed on April 22, 2022 and August 17, 2022, respectively. The Panel notes that the applicant in each case was 陈丹凤 (Chen Danfeng). The Panel also notes that trademark application number 66654672 was registered on March 28, 2023, and that trademark application number 64160235 was registered on October 14, 2022 and is currently subject to an invalidation proceeding.¹

¹ The Panel notes its general powers articulated *inter alia* in paragraphs 10 and 12 of the Rules and has searched the publicly available website of the China National Intellectual Property Administration ("www.cnipa.gov.cn") in order to verify the information provided by the Complainant regarding these three trademark applications. The Panel considers this process of verification useful in assessing the merits of this case and reaching a decision. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8.

5. Parties' Contentions

A. Complainant

The disputed domain name is confusingly similar to the prior trademarks THE FRANKIE SHOP and FRANKIE SHOP.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is in no way affiliated with the Complainant and has not been authorized by the Complainant to use its prior trademarks or to proceed with the registration of the disputed domain name incorporating the Complainant's or its director's prior trademarks. Indeed, the Respondent is neither a licensee nor a third party authorized to use the trademarks, including as a domain name. The Complainant does not know the Respondent and has never had any relationship with it. The disputed domain name resolves to a blank page.

The disputed domain name was registered and is being used in bad faith. The disputed domain name reproduces the Complainant's and its director's prior trademarks, the only difference being the addition of the descriptive word "art". This strongly suggests that the Respondent had the Complainant's and its Director's prior rights in mind at the time of the registration of the disputed domain name. The Complainant has a significant reputation in the world. The Respondent deliberately registered a quasi-identical domain name with the intent to divert Internet users from the Complainant's website to the Respondent's page.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue - Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that it is a United States entity and conducts business in English, the disputed domain name has been registered in Latin letters rather than Chinese characters, and the Complainant is unable to communicate in Chinese.

The Respondent opposes the use of English as the language of the proceeding because he is a citizen of China and the official language that he uses is Chinese. He did not comment on the language request by the due date because he was celebrating the May Day holiday. He also requested information in Chinese regarding the Policy and the Rules.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); and *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

In the present case, the Panel observes that the Complaint and the amendment to the Complaint were filed in English. The disputed domain name is also composed of English words, which suggests that the

Respondent is familiar with that language. Although the Respondent requests that Chinese be the language of this proceeding, he does not deny that he understands English. Despite having received notice of the Complaint in English and Chinese and having been granted an extension of time, the Respondent filed no formal Response. Therefore, the Panel considers that requiring the Complainant to translate the Complaint would create an undue burden and delay.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Chinese, but none was filed.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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.

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the THE FRANKIE SHOP trademark, by virtue of its United States trademark registration. Although that registration is very recent, it was in effect at the time when the Complaint was filed, which is sufficient for the purposes of the first element of paragraph 4 of the Policy. The Panel will consider further the timing of that registration under the third element in section 6.2C below. See [WIPO Overview 3.0](#), section 1.1.3.

The disputed domain name incorporates most of the Complainant's trademark, omitting only the definite article "the", for which it substitutes the word "art". Despite this difference, the dominant elements of the mark remain clearly recognizable in the disputed domain name on a side-by-side comparison. See [WIPO Overview 3.0](#), section 1.7.

The only other element of the disputed domain name is the generic Top-Level Domain ("gTLD") ".com". As a standard requirement of domain name registration, this element may be disregarded in the comparison between a domain name and a trademark unless it has some impact beyond its technical function, which is not the case here. See [WIPO Overview 3.0](#), section 1.11.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or

(iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, the disputed domain name is passively held. The Complainant submits that the Respondent is in no way affiliated with it and has not been authorized by it to use its prior trademarks. In view of these circumstances, the Panel has no reason to find that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services, nor that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

As regards the second circumstance set out above, the Registrar verified that the Respondent's name is 蔡文辉 (wenhui cai / cai wenhui), which is not the disputed domain name. Nothing on the record indicates that the Respondent has been commonly known by the disputed domain name.

The Complainant refers to three Chinese trademark applications for FRANKIESHOPEDITION or ARTFRANKIESHOP that were filed shortly after the registration of the disputed domain name. Two trademark applications for ARTFRANKIESHOP, which are identical to the disputed domain name, have since proceeded to registration, as summarized in section 4 above. However, the name and address of the registered proprietor of those Chinese trademark registrations differ from those of the Respondent and nothing on the record demonstrates that they are related. Accordingly, these circumstances do not demonstrate that the Respondent holds rights in any trademark.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because he did not respond in substance to the Complainant's contentions.

Therefore, based on the record of this proceeding, the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, but these circumstances are not exhaustive.

As regards registration, the disputed domain name was registered on April 10, 2023, eight days before the registration of the Complainant's trademark in the United States. The Panel recalls that, where a respondent registers a domain name before the complainant's trademark rights accrue, UDRP panels will not normally find bad faith on the part of the respondent. See [WIPO Overview 3.0](#), section 3.8.1. However, as an exception to that general proposition, bad faith may be found where a respondent registered a domain name in anticipation of the complainant's trademark rights. See [WIPO Overview 3.0](#), section 3.8.2.

In the present case, the Complainant's United States trademark application for THE FRANKIE SHOP was pending since September 28, 2021, over 18 months prior to the registration of the disputed domain name. The Complainant was using that mark (including the definite article "the") on its website since at least 2020. The disputed domain name incorporates this mark with the only difference being the substitution of "art" for "the". The Complainant's founder director also holds trademark registrations consisting of or including FRANKIE SHOP (without "the") that were registered in 2017 and that the disputed domain name wholly incorporates. The Complainant provides evidence of extensive press and social media coverage in English and French of itself and both marks in 2021 and earlier, including in British Vogue, ForbesWomen, Hypebae and Look Online. The Complainant's branded products are widely available on retail websites such as Net-a-Porter. Given that "Frankie" is a personal name with only an arbitrary connection to "shop", it is difficult to believe that these two elements were combined in the disputed domain name without prior knowledge of the Complainant. The Respondent provides no explanation for its registration of the disputed domain name.

In view of all the evidence, the Panel considers that the Respondent's intent in registering the disputed domain name was to unfairly capitalize on the Complainant's nascent trademark rights in bad faith.

The Respondent makes only passive use of the disputed domain name but that circumstance does not preclude a finding of use in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In the present case, the disputed domain name incorporates the Complainant's THE FRANKIE SHOP mark, omitting only "the", for which it substitutes "art". The mark has acquired a strong reputation in the fashion industry due to its extensive use, particularly online. The disputed domain name gives the impression that it will resolve to a website affiliated with the Complainant that sells art, which is false. The Respondent provides no explanation of any proposed good faith use of the disputed domain name. In these circumstances, the Panel considers it more likely than not that the Respondent is using the disputed domain name in bad faith.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 <artfrankieshop.com> be transferred to the Complainant.

/Matthew Kennedy

Matthew Kennedy

Sole Panelist

Date: June 22, 2023