

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot
Case No. D2023-2529

1. The Parties

Complainant is Frankie Shop LLC, United States of America (“United States”), represented by Coblenç & Associés, France.

Respondent is Domain Sales - (Expired domain caught by auction winner) c/o Dynadot, United States.

2. The Domain Name and Registrar

The disputed domain name <frankieshopblanc.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 12, 2023. On June 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 12, 2023, 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 June 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 12, 2023.

The Center appointed Phillip V. Marano as the sole panelist in this matter on July 19, 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

Complainant is a fashion company that has offered luxury women's clothing, accessories, shoes, and cosmetics since 2014. Complainant offers its goods through its official <thefrankieshop.com> domain name and related websites. Complainant owns valid and subsisting registrations and applications for FRANKIE SHOP formative trademarks in numerous countries, including the trademark for FRANKIE SHOP (Reg. No. 5,147,070) in the United States, registered on February 21, 2017, with the earliest priority dating back to November 14, 2014.

Respondent registered the disputed domain name on April 14, 2023. At the time this Complaint was filed, the disputed domain name resolved to a domain name auction website advertising that the disputed domain name "is for sale! Buy this domain USD \$4,995".

5. Parties' Contentions

A. Complainant

Complainant asserts ownership (through Complainant's Director) of the well-known FRANKIE SHOP trademark and has adduced evidence of trademark registrations in numerous regions and countries around the world including in the United States with earliest priority dating back to November 14, 2014. The disputed domain name is confusingly similar to Complainant's FRANKIE SHOP trademark, according to Complainant, because it is composed of an exact reproduction of Complainant's distinctive FRANKIE SHOP trademark, with the sole differences being addition of the words "the" and "blanc" (which means "white" in English), which are generic and only reinforce a likelihood of confusion.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any relationship, affiliation, license, or authorization between Respondent and Complainant or Complainant's earlier registered FRANKIE SHOP trademark; and Respondent's offer to sell the disputed domain name in order to take advantage of its resemblance to Complainant's FRANKIE SHOP trademark.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the worldwide reputation of Complainant's FRANKIE SHOP trademarks and Respondent's resultant actual or constructive knowledge of Complainant's exclusive rights; Respondent's offer to sell the disputed domain name coupled with Respondent's intent to divert Internet users from Complainant's website to Respondent's page; and Respondent's ostensible connection to recently filed applications for a putative FRANKIESHOPBLANC in China, intended to infringe the prior worldwide rights of Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. 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.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the FRANKIE SHOP trademark has been registered in numerous countries with priority dating back to November 14, 2014. Thus, the Panel finds that Complainant's rights in the FRANKIE SHOP trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's FRANKIE SHOP trademark.

In this Complaint, the disputed domain name is confusingly similar to Complainant's FRANKIE SHOP trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the entirety of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n 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..."). In regards to gTLDs, such as ".com" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the article "the" and the term "blanc" (which means "white" in English) does not prevent a finding of confusing similarity between Complainant's FRANKIE SHOP trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element"); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]"); and *Pfizer Inc. v. Blue Viagra*, WIPO Case No. [D2004-0732](#) (Transferring the <blue-viagra.com> domain name and noting that "[t]he addition of a common term such as 'blue' preceding Complainant's famous and distinctive VIAGRA mark does not create a new or different mark in which the Respondent has rights, and therefore is not sufficient to avoid consumer confusion.")

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this proceeding, Respondent

fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1. Indeed, it is evident that Respondent, identified by Whois data for the disputed domain name merely as “Domain Sales - (Expired domain caught by auction winner) c/o Dynadot”, is not commonly known by the disputed domain name or Complainant’s FRANKIE SHOP trademark.

Based on the undisputed facts and circumstances in the record before it, the Panel finds that Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services. This is especially the case where a disputed domain name is so obviously connected with a complainant and its products, the very use, let alone attempts to sell, by a registrant with no connection to a complainant suggests opportunistic bad faith. The Panel concludes from the record that Respondent had Complainant’s FRANKIE SHOP trademark in mind when registering the disputed domain name, and that Respondent most likely registered the domain name in order to exploit and profit from Complainant’s trademark rights. Indeed, a respondent who knowingly adopted a third party’s well-known mark as a domain name cannot claim the benefit of paragraph 4(c)(i) of the Policy to establish rights to the domain name based on its mere use of the domain name to offer goods or services prior to the notice of a dispute. *Scania CV AB v. Leif Westlye*, WIPO Case No. [D2000-0169](#); see also *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#) (rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the complainant).

Moreover, registration of the disputed domain name with intent to profit by exploiting Complainant’s FRANKIE SHOP trademark and selling that domain name cannot establish rights or legitimate interests under the Policy. See e.g. *Halliburton Energy Services, Inc. v. Jon Hall*, WIPO Case No. [D2017-0413](#) (“Respondent’s acquisition and offering for sale the disputed domain name that is confusingly similar to a well-known Mark does not establish rights or legitimate interests under the Policy”); and *Elecnor, S.A. v. Privacy Protection / Premium Domain Seller, YUHUYUAN, BEIJINGDONGLU, HUAIYINQU*, WIPO Case No. [D2022-1534](#) (“The Respondent has used the [disputed] domain name to redirect to a webpage that offers [it] for sale. This is not *bona fide*, but rather, under the circumstances of this case, evidence of bad faith[...].”). As discussed below with respect to paragraph 4(b) of the Policy, Respondent has targeted Complainant’s well-known FRANKIE SHOP trademark and configured the disputed domain name to resolve to a website offering it for sale for USD 4,995.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (particularly where no conceivable good faith use could be made). [WIPO Overview 3.0](#), Section 3.1.4. Complainant has adduced evidence of recognition of the FRANKIE SHOP trademark and cited at least one UDRP panel determination in agreement that Complainant's FRANKIE SHOP trademark is considered to be well-known. See *e.g. Frankie Shop LLC v. Bgeew Aferg*, WIPO Case No. [D2022-3619](#) ("Complainant is well-known around the world for the trademark FRANKIE SHOP" and "the well-known trademark FRANKIE SHOP is recognizable in the disputed domain name"). As such, the Panel finds it is unconceivable that Respondent could have registered the disputed domain name without knowledge of Complainant's FRANKIE SHOP trademark, or without any intention to benefit from confusion with Complainant's FRANKIE SHOP trademark.

In addition, registration of the disputed domain name with intent to profit by exploiting Complainant's trademark and selling that domain name constitutes axiomatic bad faith registration and use under paragraph 4(b)(i) of the Policy. As in this case, bad faith is evident where Respondent clearly has actual or constructive knowledge of Complainant's trademarks, the trademarks at issue are distinctive, well-known, and well predate registration of the disputed domain name, and Respondent offers to sell the disputed domain name to the highest bidder or otherwise to the general public. [WIPO Overview 3.0](#), section 3.1.1. Specifically, Respondent configured the disputed domain name to resolve to an auction website with an open offer to the public to sell the disputed domain name for USD 4,995. This is far in excess of any conceivable or apparent registration costs and it falls well within paragraph 4(b)(i) of the Policy. Respondent's offer at this price is clear evidence of Respondent's opportunistic bad faith intention to acquire and sell the disputed domain name, which contains Complainant's identical FRANKIE SHOP trademark.

In view of the foregoing, the Panel concludes that Complainant has established the third 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, <frankieshopblanc.com>, be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: July 28, 2023