

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Reece Kemp, Jake Foster, Spencer Collier, Niamh Willis, Lucy Nash
Case No. D2023-4362

1. The Parties

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

The Respondents are Reece Kemp, Italy, Jake Foster, Italy, Spencer Collier, France, Niamh Willis, France, and Lucy Nash, France.

2. The Domain Names and Registrar

The disputed domain names, <thefrankieshopargentina.com>, <thefrankieshopaustralia.com>, <thefrankieshopaustria.com>, <thefrankieshopbelgie.com>, <thefrankieshopbelgique.com>, <thefrankieshopbrasil.com>, <thefrankieshopbulgaria.com>, <thefrankieshopcanada.com>, <thefrankieshopchile.com>, <thefrankieshopcolombia.com>, <thefrankieshopcz.com>, <thefrankieshopdanmark.com>, <thefrankieshopdeutschland.com>, <thefrankieshopeesti.com>, <thefrankieshopfrance.com>, <thefrankieshopgreece.com>, <thefrankieshophrvatska.com>, <thefrankieshophungary.com>, <thefrankieshopireland.com>, <thefrankieshopisrael.com>, <thefrankieshopitalia.com>, <thefrankieshopjapan.com>, <thefrankieshopkuwait.com>, <thefrankieshoplatvija.com>, <thefrankieshoplietuva.com>, <thefrankieshopmexico.com>, <thefrankieshopnederland.com>, <thefrankieshopnorge.com>, <thefrankieshopnz.com>, <thefrankieshopperu.com>, <thefrankieshoppolska.com>, <thefrankieshopportugal.com>, <thefrankieshopromania.com>, <thefrankieshopschweiz.com>, <thefrankieshopslovenija.com>, <thefrankieshopslovensko.com>, <thefrankieshopsouthafrica.com>, <thefrankieshospain.com>, <thefrankieshopsrbija.com>, <thefrankieshopsuisse.com>, <thefrankieshopsuomi.com>, <thefrankieshopsverige.com>, <thefrankieshopturkey.com>, <thefrankieshopuae.com>, <thefrankieshopuk.com>, and <thefrankieshopuruguay.com>, are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 20, 2023. On October 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 23, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names

which differed from the named Respondents (“Venezia, IT” and “Paris, FR”) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 3, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed two amendments to the Complaint on November 7, 2023.

The Center verified that the Complaint together with the amendments 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 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on December 13, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on January 8, 2024. 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 specializes in the sale of clothing and accessories under the THE FRANKIE SHOP trademark, being its official website available at the domain name <thefrankieshop.com>.

The Complainant is the owner of the following, amongst other, trademark registrations:

- International Trademark Registration No. 1648994 for the word mark THE FRANKIE SHOP, registered on October 12, 2021, covering products and services in classes 3, 4, 9, 14, 18, 25 and 35;
- United States Trademark Registration No. 7028712 for the mark THE FRANKIE SHOP, filed on September 28, 2021, and registered on April 18, 2023, covering services in class 35.
- French Trademark Registration No. 4762800 for the word mark THE FRANKIE SHOP, filed on May 4, 2021, covering products and services in classes 3, 4, 9, 14, 18, 25, and 35; and

The disputed domain names were registered on and are presently used as follows:

Disputed Domain Name	Registration Date	Present Use
<thefrankieshopargentina.com>	September 21, 2023	No active webpage
<thefrankieshopaustralia.com>	September 19, 2023	No active webpage
<thefrankieshopaustria.com>	September 21, 2023	No active webpage
<thefrankieshopbelgie.com>	September 19, 2023	No active webpage
<thefrankieshopbelgique.com>	September 19, 2023	No active webpage
<thefrankieshopbrasil.com>	September 21, 2023	No active webpage
<thefrankieshopbulgaria.com>	September 21, 2023	No active webpage
<thefrankieshopcanada.com>	September 19, 2023	No active webpage
<thefrankieshopchile.com>	September 21, 2023	No active webpage
<thefrankieshopcolombia.com>	September 21, 2023	No active webpage
<thefrankieshopcz.com>	September 21, 2023	No active webpage

<thefrankieshopdanmark.com>	September 19, 2023	No active webpage
<thefrankieshopdeutschland.com>	September 21, 2023	No active webpage
<thefrankieshopeesti.com>	September 21, 2023	No active webpage
<thefrankieshopfrance.com>	September 19, 2023	No active webpage
<thefrankieshopgreece.com>	September 21, 2023	No active webpage
<thefrankieshophrvatska.com>	September 21, 2023	No active webpage
<thefrankieshophungary.com>	September 21, 2023	No active webpage
<thefrankieshopireland.com>	September 19, 2023	No active webpage
<thefrankieshopisrael.com>	September 21, 2023	No active webpage
<thefrankieshopitalia.com>	September 21, 2023	No active webpage
<thefrankieshopjapan.com>	September 21, 2023	No active webpage
<thefrankieshopkuwait.com>	September 21, 2023	No active webpage
<thefrankieshoplatvija.com>	September 21, 2023	No active webpage
<thefrankieshoplietuva.com>	September 21, 2023	No active webpage
<thefrankieshopmexico.com>	September 21, 2023	No active webpage
<thefrankieshopnederland.com>	September 19, 2023	No active webpage
<thefrankieshopnorge.com>	September 19, 2023	No active webpage
<thefrankieshopnz.com>	September 19, 2023	No active webpage
<thefrankieshopperu.com>	September 21, 2023	No active webpage
<thefrankieshoppolska.com>	September 21, 2023	No active webpage
<thefrankieshopportugal.com>	September 21, 2023	No active webpage
<thefrankieshopromania.com>	September 21, 2023	No active webpage
<thefrankieshopschweiz.com>	September 19, 2023	No active webpage
<thefrankieshopslovenija.com>	September 21, 2023	No active webpage
<thefrankieshopslovensko.com>	September 21, 2023	No active webpage
<thefrankieshopsouthafrica.com>	September 19, 2023	No active webpage
<thefrankieshospain.com>	September 21, 2023	No active webpage
<thefrankieshopsrbija.com>	September 21, 2023	No active webpage
<thefrankieshopsuisse.com>	September 19, 2023	No active webpage
<thefrankieshopsuomi.com>	September 19, 2023	No active webpage
<thefrankieshopsverige.com>	September 19, 2023	No active webpage
<thefrankieshopturkey.com>	September 21, 2023	No active webpage
<thefrankieshopuae.com>	September 21, 2023	No active webpage
<thefrankieshopuk.com>	September 19, 2023	No active webpage
<thefrankieshopuruguay.com>	September 21, 2023	No active webpage

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant asserts to be a very well-known company specialized in the sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes, cosmetics under the brand THE FRANKIE SHOP, doing business across the world including notably New Zealand, the United Kingdom, the European Union, Canada, Switzerland, Australia, South Africa, United Arab Emirates, Israel, Turkÿe, Brazil, Argentina, Kuwait, Chile, Japan, Peru, Mexico, Colombia, and Uruguay.

The Complainant contends that the disputed domain names are subject to common control and the consolidation of multiple Respondents would be fair and equitable to all Parties given that all of the disputed domain names: (i) share the same naming pattern (reproducing the Complainant's well-known trademark in its entirety with the addition of a geographical term); (ii) were registered within two days; (iii) through the same Registrar; (iv) do not resolve to active websites; (v) share similar email addresses composed by the same structure, i.e. the first name followed by the last name and followed by a number and by the same provider (i.e. "cxtmail.com"); and (vi) the contact data for all of the named Respondents appears to be false or incomplete.

According to the Complainant, all of the disputed domain names incorporate the Complainants' well-known trademark in its entirety; the addition of geographical terms does not prevent a finding of confusing similarity thereof. Past UDRP panels have already found the Complainant's trademark well-known (*Frankie Shop LLC v. Bgeew Aferg*, WIPO Case No. [D2022-3619](#) "as Complainant enjoys an international reputation with the use of the referred trademark").

As to the absence of rights or legitimate interests, the Complainant argues that the Respondents are in no way affiliated with the Complainant and have not been authorized by the Complainant to use its prior trademark or to proceed with the registration of the disputed domain names; neither being the Respondents licensees nor third parties authorized to use the trademarks, including as domain names; further never having the Parties had any relationship whatsoever.

In what it relates to the bad faith registration and use of the disputed domain names, the Complainant asserts that the Respondents must have had knowledge of the Complainant's well-known trademark which is a matter of public record. In addition to that, the Complainant asserts that the present inactive use of the disputed domain names characterizes passive holding, as found in similar cases such as in *Frankie Shop LLC v. 蔡文辉 (wenhui cai / cai wenhui)*, WIPO Case No. [D2023-1815](#).

B. Respondents

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

6. Discussion and Findings

6.1 Procedural matter – Consolidation of Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes, as seen above, that all of the disputed domain names: (i) share the same naming pattern (reproducing the Complainant's trademark THE FRANKIE SHOP in its entirety with the addition of geographic terms); (ii) were registered two days apart (on September 19 and 21,

2023); (iii) through the same Registrar; (iv) do not resolve to active websites; (v) share similar email addresses at the same provider (i.e. "cxtmail.com"); and (vi) appear to have false or incomplete contact information associated with them.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants in a single proceeding.

6.2 Substantive matter

Paragraph 4(a) of the Policy sets forth the following three requirements which the Complainant must meet in order for the Panel to order the transfer of the disputed domain names:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms ("argentina", "australia", "austria", "belgie", "belgique", "brasil", "bulgaria", "canada", "chile", "colombia", "cz", "danmark", "deutschland", "eesti", "france", "greece", "hrvatska", "hungary", "ireland", "israel", "italia", "japan", "kuwait", "latvija", "lietuva", "mexico", "nederland", "norge", "nz", "peru", "polska", "portugal", "romania", "schweiz", "slovenija", "slovensko", "southafrica", "spain", "srbija", "suisse", "suomi", "sverige", "turkey", "uae", "uk", and "uruguay") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which a respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with

relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain names. These circumstances are:

- (i) before any notice of the dispute, the Respondents' use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondents (as individuals, businesses, or other organizations) have been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondents are making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondents, in not formally responding to the Complaint, have failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain names. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a *prima facie* case against the Respondents.

In that sense, the Panel notes that the Complainant has made out a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names, indeed stating that the Respondents are in no way affiliated with the Complainant and have not been authorized by the Complainant to use its prior trademark or to proceed with the registration of the disputed domain names; neither being the Respondents licensees nor third parties authorized to use the trademarks, including as domain names; further never having the Parties had any relationship whatsoever.

Also, the lack of evidence as to whether the Respondents are commonly known by the disputed domain names or the absence of any trademarks registered by the Respondents corresponding to the disputed domain names, corroborates the indication of an absence of rights or legitimate interests in the disputed domain names.

The present inactive use made of the disputed domain names further cannot be characterized as a *bona fide* offering of goods or services.

Therefore, the Panel finds that the Respondents lack rights or legitimate interests in the disputed domain names. The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The registration and use of the disputed domain names in bad faith can be found in the present case in view of the following circumstances:

- (i) the Respondents have provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain names, not having submitted a response;
- (ii) the well-known status of the Complainant's trademark;

- (iii) the nature of the disputed domain names (reproducing the entirety of the Complainant's trademark), and the Respondent's likely intention to unduly profit from the value of the Complainant's trademark, suggest rather a clear indication of the Respondent's registration and holding of the disputed domain names in bad faith, with the implausibility of any good faith use to which the disputed domain names may be put;
- (iv) the lack of reply to the cease-and-desist letter sent prior to this procedure (Annex C2 to the Complaint); and
- (v) the indication of what appears to be false contact details, not having the Center been capable of delivering the written notice to the Respondents.

Considering the totality of the circumstances in case, the Panel finds the current inactive use of the disputed domain names does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in 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, and (iii) the respondent's use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

The Panel finds that the 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 names, <thefrankieshopargentina.com>, <thefrankieshopaustralia.com>, <thefrankieshopaustria.com>, <thefrankieshopbelgie.com>, <thefrankieshopbelgique.com>, <thefrankieshopbrasil.com>, <thefrankieshopbulgaria.com>, <thefrankieshopcanada.com>, <thefrankieshopchile.com>, <thefrankieshopcolombia.com>, <thefrankieshopcz.com>, <thefrankieshopdanmark.com>, <thefrankieshopdeutschland.com>, <thefrankieshopeesti.com>, <thefrankieshopfrance.com>, <thefrankieshopgreece.com>, <thefrankieshophrvatska.com>, <thefrankieshophungary.com>, <thefrankieshopireland.com>, <thefrankieshopisrael.com>, <thefrankieshopitalia.com>, <thefrankieshopjapan.com>, <thefrankieshopkuwait.com>, <thefrankieshoplatvija.com>, <thefrankieshoplietuva.com>, <thefrankieshopmexico.com>, <thefrankieshopnederland.com>, <thefrankieshopnorge.com>, <thefrankieshopnz.com>, <thefrankieshopperu.com>, <thefrankieshoppolska.com>, <thefrankieshopportugal.com>, <thefrankieshopromania.com>, <thefrankieshopschweiz.com>, <thefrankieshopslovenija.com>, <thefrankieshopslovensko.com>, <thefrankieshopsouthafrica.com>, <thefrankieshopspain.com>, <thefrankieshopsrbija.com>, <thefrankieshopsuisse.com>, <thefrankieshopsuomi.com>, <thefrankieshopsverige.com>, <thefrankieshopturkey.com>, <thefrankieshopuae.com>, <thefrankieshopuk.com>, and <thefrankieshopuruguay.com>, be transferred to the Complainant.

Wilson Pinheiro Jabur

Wilson Pinheiro Jabur

Sole Panelist

Date: January 11, 2024