

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Debbie Khan, Diana Graham, Jamie Kubitz,
Jessica Gallatin, Joel Narcisse
Case No. D2023-4758

1. The Parties

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

The First Respondent is Debbie Khan, United States.

The Second Respondent is Diana Graham, United States.

The Third Respondent is Jamie Kubitz, United States.

The Fourth Respondent is Jessica Gallatin, United States.

The Fifth Respondent is Joel Narcisse, United States.

2. The Domain Names and Registrar

The disputed domain names <shopthefrankies.shop>, <thefrankieshopoutlet.shop>, <thefrankieshopsus.shop>, <thefrankieshopus.shop>, <thefrankiesshop.shop> are registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 26, 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 Respondent (Wilayah Persekutuan, MY) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 2023 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file a separate Complaint 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 an amendment to the Complaint on November 23, 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 November 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent's default on December 28, 2023.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on January 9, 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 is a New York company operating an e-commerce website offering clothing, accessories, women's shoes, and cosmetics under its own and third-party brands.

The Complainant is the proprietor of the following registered trademarks:

- International Trademark No. 1648994 for THE FRANKIE SHOP (word mark), registered on October 12, 2021 for goods and services in classes 3, 4, 9, 14, 18, 25 and 35; and
- United States Trademark Registration No. 7028712 for THE FRANKIE SHOP (word mark), registered on April 18, 2023 for services in class 35, claiming a date of first use of November 14, 2014.

The Complainant states that its director Gaelle Drevet is the proprietor of United States Trademark Registration No. 5147070 for FRANKIE SHOP (word mark), registered on February 21, 2017 for services in class 35, claiming a date of first use of November 14, 2014.

The Complainant has registered numerous domain names reflecting all or part of these registered trademarks, including <thefrankieshop.com>, at which it hosts its primary e-commerce website.

The disputed domain names <shopthefrankies.shop> and <thefrankieshopus.shop> were registered on October 6, 2023. The disputed domain names <thefrankieshopoutlet.shop>, <thefrankieshopsus.shop>, <thefrankiesshop.shop> were registered on October 9, 2023. At the time of the Complaint and of this Decision, they all resolved to e-commerce websites purportedly offering women's clothing and accessories mentioning the Complainant's FRANKIES mark and using images of the Complainant's products.

5. Parties' Contentions

A. Request to Consolidate Proceedings

The Complainant requested consolidation of multiple Respondents for the following reasons: all the disputed domain names were registered with the same registrar, within three days of each other. All disputed domain names redirect to websites reflecting identical content, reproducing the trademarks and photographs of the Complainant. The images reflect products sold on the Complainant's website. The registrants' email

addresses, which are hosted on the same server, follow the same structure; they are composed of a name, followed by a number. The contact data for all of the registrants appears to be false or incomplete. In view of these elements, it is obvious that the registrant of the disputed domain names is the same person and/or that all the disputed domain names are under common control.

B. Complainant's Substantive Contentions

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 contends that its mark has a significant reputation and the disputed domain names are confusingly similar to it. The Respondent is not affiliated with the Complainant and has no rights in the disputed domain names, which resolve to identical websites reflecting the Complainant's mark and images from its website. The goods sold on these websites copy the Complainant's product names but are offered at a very significant price discount and appear to be counterfeit. The Complainant has been the frequent target of such schemes.

C. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue – 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 that the disputed domain names, which were registered in a three-day period, all reflect a near copy of the Complainant's mark; they resolve to identical websites, and the registrants all use email addresses hosted on the same server. The Panel finds that, on balance, the evidence indicates that the disputed domain names are under common control.

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 (referred to below as "the Respondent") in a single proceeding.

6.2. Substantive Issues

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has 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 Complainant’s THE FRANKIE SHOP mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “us” and “outlet” and the additional letter “s”) 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.

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 the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence

demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. The Panel notes that the Complainant has provided credible evidence to indicate that the Respondent is offering goods identical to the Complainant's at substantially discounted prices, indicating that they appear to be counterfeit. Further, the images on the Respondent's website are copies from the Complainant's website. There is no indication that the Respondent has been known by the disputed domain names, which are nearly identical to the Complainant's mark, carrying a high risk of implied affiliation.

The Panel finds the second element of the Policy has been established.

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.

In the present case, the Panel notes that the Complainant's rights in it's the FRANKIE SHOP mark predate the registration of the disputed domain names, which reflect a near copy of mark together with terms related to e-commerce, such as "shop" and the geographic term "us". UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. [WIPO Overview 3.0](#), section 3.1.4.

The Panel therefore finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark. Such conduct clearly demonstrates the Respondent's bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Panels have held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods and impersonation) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy. The websites, by mirroring the Complainant's product names and images, demonstrate the Respondent's attempt to impersonate the Complainant or create an association with the Complainant for commercial gain. In the absence of a response from the Respondent, the Panel notes that the Complainant provides un rebutted evidence that the products offered by the Respondent are most likely counterfeit, as they are sold at a significant discount and the Respondent is not an authorized reseller of these goods.

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 <shopthefrankies.shop>, <thefrankieshopoutlet.shop>, <thefrankieshopsus.shop>, <thefrankieshopus.shop>, and <thefrankiesshop.shop> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: January 23, 2024