

## **ADMINISTRATIVE PANEL DECISION**

Frankie Shop LLC v. Christopher Eby  
Case No. D2023-4956

### **1. The Parties**

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

Respondent is Christopher Eby, United States.

### **2. The Domain Name and Registrar**

The Disputed Domain Name <ehfrankieshop.shop> is 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 28, 2023. On November 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 29, 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 (No information available) and contact information in the Complaint. The Center sent an email communication to Complainant on November 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on December 4, 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 Respondent of the Complaint, and the proceedings commenced on December 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2023. On December 5 and 26, 2023, the Center received automatic replies from an email apparently related to Respondent’s website.

On December 21, 2023, the Center received an email communication from a third party.

The Center appointed Richard W. Page as the sole panelist in this matter on December 27, 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.

The Panel finds that the email from a third party did not contain information material to this proceeding.

#### **4. Factual Background**

Complainant is a very well-known company specializing in the sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes, and cosmetics under the brand name THE FRANKIE SHOP and under third party brands through the websites "www.eu.thefrankieshop.com" and "www.thefrankieshop.com".

Complainant is the owner of the following registrations for the trademark referred to herein as "THEFRANKIESHOP Mark":

International Registration No. 1648994 designating Australia, European Union, Brazil, USA, Mexico, China, Singapore, Republic of Korea, Japan, Malaysia, New Zealand, Russia, Turkey, Ukraine, Switzerland and United Kingdom for THE FRANKIE SHOP registered October 12, 2021, in classes 03, 04, 09, 14, 18, 25 and 35;

French Registration No. 4762800 for THE FRANKIE SHOP registered May 4, 2021, in classes 03, 04, 09, 14, 18, 25 and 35;

United States Registration No. 97050056 (Serial Number) filed on September 28, 2021, registered April 18, 2023, in class 35.

Mrs. Gaëlle Drevet, the Director of Complainant, is the owner of additional trademarks and Complainant is the owner of several domain names composed of the words "frankie" or "frankie shop".

The Disputed Domain Name was registered November 13, 2023, and redirects to a website that appears to reproduce THEFRANKIESHOP Mark, and purportedly sells Complainant's goods or counterfeited goods with a view to commercial gain.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Complainant further contends that THEFRANKIESHOP Mark is known all over the world and enjoys a high reputation throughout the world. For instance: it has been featured in major magazine such as Vogue and Forbes and is followed by over a million followers on the social network Instagram.

Complainant further contends that the entirety of the two principal elements of THEFRANKIESHOP Mark ("Frankie" and "Shop") are contained within the Disputed Domain Name. The additional phrase "ehe" is a substitution of "e" for "t" in THEFRANKIESHOP Mark, which is merely typosquatting and not distinctive. The generic Top-Level Domain ("gTLD") ".shop" does nothing to defeat the confusing similarity.

Complainant further contends that the Disputed Domain Name currently redirects to a website that reproduces THEFRANKIESHOP Mark, sells what falsely purport to be Complainant's goods and is clearly

with a view to commercial gain. The counterfeit goods are sold at deep discounts – which is deceptive and cannot be a *bona fide* or legitimate use.

Complainant asserts that Respondent is not commonly known by the Disputed Domain Name; Respondent is in no way affiliated with Complainant and has not been authorized by Complainant to use THEFRANKIESHIP Mark or to proceed with registration to the Disputed Domain Name; and that Respondent is neither a licensee nor a third party authorized to use THEFRANKIESHIP Mark or any related domain name.

Complainant alleges that Respondent is using the Disputed Domain Name in order to deceive and divert Complainant's customers and to sell counterfeit goods.

Complainant alleges that Respondent "knew or should have known" of Complainant's rights in THEFRANKIESHIP Mark and nevertheless registered the Disputed Domain Name.

Complainant alleges that Respondent intentionally attracted Internet users for commercial gain to its website by creating a likelihood of confusion with THEFRANKIESHIP Mark as to the source, sponsorship, affiliation or endorsement of the website.

## **B. Respondent**

Respondent did not directly respond to Complainant's contentions. Therefore, the Panel deems the email referenced above sent seemingly by a third party did not constitute a refutation of Complainant's contentions.

## **6. Discussion and Findings**

Even though Respondent has been deemed to have failed to file a Response or to contest Complainant's assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to THEFRANKIESHIP Mark which Complainant has rights; and
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- iii) that the Disputed Domain Name has been registered and is 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 Complainant's trademark and the Disputed Domain Name. [WIPO Overview 3.0](#), section 1.7.

Complainant contends that it has International, French and U.S. registrations of THEFRANKIESHIP Mark. [WIPO Overview 3.0](#), section 1.2.1 states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in THEFRANKIESHIP Mark. Respondent has not refuted these contentions.

Based on the available record, the Panel finds 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.

Complainant further contends that the entirety of the two principal elements of THEFRANKIESHOP Mark (“Frankie” and “Shop”) are contained within the Disputed Domain Name. The additional phrase “ehe” is a substitution of “e” for “t” in THEFRANKIESHOP Mark, which is merely typosquatting and not distinctive. The gTLD “.shop” does nothing to defeat the confusing similarity.

[WIPO Overview 3.0](#), section 1.7 says that inclusion of the entire trademark in a domain name will be considered confusingly similar. [WIPO Overview 3.0](#), section 1.8 instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.11.1 instructs that gTLDs such as (“.shop”) may be disregarded for purposes of assessing confusing similarity.

The Panel finds the entirety of the mark is reproduced within the Disputed Domain Name (with a slight misspelling). Accordingly, the Disputed Domain Name is confusingly similar to THEFRANKIESHOP Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the addition of the term “ehe” does not prevent a finding of confusing similarity between the Disputed Domain Name and THEFRANKIESHOP 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 Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name.

Although the overall burden of proof in UDRP proceedings is on Complainant, panels have recognized that proving Respondent lacks rights or legitimate interests in the Disputed Domain Name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of Respondent. As such, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Disputed Domain Name currently redirects to a website that reproduces THEFRANKIESHOP Mark, sells what falsely purport to be Complainant’s goods and is clearly with a view to commercial gain. The counterfeit goods are sold at deep discounts. Complainant further asserts that Respondent is using the Disputed Domain Name in order to deceive and divert Complainant’s customers. Complainant asserts that Respondent has not made any *bona fide* or legitimate use of the Disputed Domain Names.

Complainant asserts that Respondent is not commonly known by the Disputed Domain Name. Complainant further asserts that Respondent is in no way affiliated with Complainant and has not been authorized by Complainant to use THEFRANKIESHIP Mark or to proceed with registration to the Disputed Domain Name. Complainant further asserts that Respondent is neither a licensee nor a third party authorized to use THEFRANKIESHOP Mark or any related domain name.

Having reviewed the available record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name 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 Respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Complainant alleges that Respondent intentionally attracted Internet users for commercial gain to its website by creating a likelihood of confusion with THEFRANKIESHOP Mark as to the source, sponsorship, affiliation or endorsement of the website in violation of paragraph 4(b)(iv) of the Policy.

Complainant alleges as additional factor the Respondent sells counterfeit goods. Complainant further alleges that, given the well-known nature of THEFRANKIESHOP Mark, Respondent knew or should have known of Complainant's rights ([WIPO Overview 3.0](#), section 3.2.2). A further indication of bad faith is the use of an intentional misspelling or typo ([WIPO Overview 3.0](#), section 3.2.1).

Panels have held that the use of a domain name for illegal activity here the sale of counterfeit goods 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 Name constitutes bad faith under the Policy.

Based on the available record, the Panel finds 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 <ehfrankieshop.shop> be transferred to Complainant.

*/Richard W. Page/*

**Richard W. Page**

Sole Panelist

Date: January 10, 2024