

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Cheree Delaney
Case No. D2023-5108

1. The Parties

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

The Respondent is Cheree Delaney, Tuvalu.

2. The Domain Name and Registrar

The disputed domain name <frankieshop.top> is registered with Nicenic International Group Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 7, 2023. On December 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 7, 2024, 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 (Cheree Delaney/ Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 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 on December 13, 2023.

The Center verified that the Complaint together with the amended 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 December 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 9, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on January 30, 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, incorporated in 2015, specializes in the sale of clothing, accessories, women's shoes and cosmetics under the brand name THE FRANKIE SHOP.

The Complainant is the owner of the following trademark registrations:

- International trademark registration No. 1648994 for THE FRANKIE SHOP (word mark), registered on October 12, 2021, in classes 3, 4, 9, 14, 18, 25 and 35;
- United States trademark registration No. 7028712 for THE FRANKIE SHOP (word mark), filed on September 28, 2021, and registered on April 18, 2023, in international class 35.

The Complainant's founder director, Mme. Gaëlle Drevet, is the owner of the following trademarks:

- France trademark registration No. 4338335 for FRANKIE SHOP (semi-figurative mark), filed on February 15, 2017, and registered on June 9, 2017, in classes 03, 04, 09, 14, 16, 18 and 25;
- United States trademark registration No. 5147070 for FRANKIE SHOP (word mark), filed on October 7, 2014, and registered on February 21, 2017, in international class 35.

The Complainant is also the owner of numerous domain names, including <thefrankieshop.com>, which was registered on September 17, 2014, and is used by the Complainant to offer its products under the trademark THE FRANKIE SHOP.

The disputed domain name was registered on November 25, 2023, and was resolving at the time the complaint was filed to a website in Russian offering illegal drugs for sale.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the trademark THE FRANKIE SHOP in which the Complainant has rights as it reproduces the trademark with the mere omission of the article "the" and the addition of the generic Top Level Domain ("gTLD") ".top".

The Complainant submits that the Respondent has no rights in the disputed domain name and that the Respondent is in no way affiliated, licensed or authorized by the Complainant to use its prior trademarks in any way. The Complainant clarifies that it does not know the Respondent and has never had any relationship with it.

The Complainant also states that the reproduction of the Complainant's trademarks in the disputed domain name reveals a malicious intention to take advantage of the notoriety of the said trademarks. The Complainant further points out that the Respondent's pointing of the disputed domain name to a website that reproduces the Complainant's prior trademarks and offers illicit drugs for sale does not amount to a bona fide use, and notes that the Respondent has masked its identity in the Whois records probably to avoid being contactable in view of its illegal activities.

As to bad faith registration, the Complainant indicates that the Respondent could not have been unaware of the Complainant's prior trademarks when registering the disputed domain name considering i) the composition of the disputed domain name, reproducing the Complainant's prior registered trademarks, and ii) the reputation of the Complainant and the well-known character of its trademarks, which has been recognized also in prior UDRP panel decisions.

The Complainant further contends that, by using the disputed domain name to a website displaying the Complainant's trademarks and offering illegal drugs, clearly to derive commercial gain, the Respondent has used the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

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

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the 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 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. Indeed, the Complainant has provided evidence of ownership of valid trademark registrations for THE FRANKIE SHOP (Annexes E0 and E2 to the Complaint).

The Panel finds that the core of the Complainant's mark, consisting of the two words "frankie" and "shop", is recognizable within the disputed domain name, and that the omission of the article "the" does not prevent a finding of confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Moreover, the gTLD ".top" can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

Therefore, 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 name. 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 name such as those enumerated in the Policy or otherwise.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks and there is no element from which the Panel could infer the Respondent’s rights and legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website offering illegal drugs for sale. The Panel finds that such use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

Moreover, prior UDRP panels have held that the use of a domain name for illegal activities, here the sale of illegal substances, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Therefore, 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, in light of the prior registration of the Complainant’s trademark THE FRANKIE SHOP, and considering the well-known character of the trademark THE FRANKIE SHOP, recognized also in prior UDRP panel decisions, the Respondent knew or should have known the Complainant’s trademark at the time of registration of the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

The Panel notes that the Respondent has not replied to the Complainant’s contentions and finds that, in view of the composition of the disputed domain name, incorporating the core of the Complainant’s trademark “frankie shop”, and the reference to “FRANKIE SHOP” made on the website to which the disputed domain name resolves, the Respondent was more likely than not aware of the Complainant and its trademark.

In view of the use of the disputed domain name resolving to a website offering illegal drugs for sale and reproducing the core of the Complainant’s prior trademark, the Panel also finds that, on balance of probabilities, the Respondent has intentionally attempted to attract internet users to its website for commercial gain, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its website, according to paragraph 4(b)(iv) of the Policy. The disputed domain name reproduces the core of the Complainant’s trademark and is likely to unduly profit from the value of the Complainant’s trademark.

The Panel further finds that the Respondent's use of the disputed domain name for the illegal activity referenced above is apt to disrupt the Complainant's business and further demonstrates the Respondent's bad faith.

Therefore, 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 name <frankieshop.top> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: February 13, 2024