

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Merilynn Rupp, Merilynn Rupp
Case No. D2024-0222

1. The Parties

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

Respondent is Merilynn Rupp, USA.

2. The Domain Name and Registrar

The disputed domain name <thefrankieus.shop> (the “Domain Name”) 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 January 18, 2024. On January 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 20, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Wilayah Persekutuan, MY) and contact information in the Complaint. The Center sent an email communication to Complainant on January 26, 2024, 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 January 29, 2024.

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 February 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 25, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 1, 2024.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on March 12, 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

Complainant Frankie Shop LLC sells clothing, accessories (leather goods, jewelry, etc.), women's shoes, and cosmetics under the mark THE FRANKIE SHOP through various websites having domain names that include THE FRANKIE SHOP Mark, including one website found at the domain: <thefrankieshop.com> (registered September 17, 2014). Complainant owns various trademark registrations for THE FRANKIE SHOP Mark or "the Mark" including: International Trademark Registration No. 1648994 (registered on October 12, 2021); and USA Trademark Registration No. 7,028,712 (registered April 18, 2023).

Complainant has been featured in well-known magazines such as Vogue and Forbes and Complainant is followed by over a million followers on Instagram.

The Domain Name was registered on August 16, 2023. It resolves to a website selling apparel, accessories, and shoes ("Respondent's website"), akin to the products Complainant sells on its website. Furthermore, from the undisputed evidence in the Complaint, Respondent's website is using some of the exact same photographs from Complainant's website of models modeling clothes to sell seemingly the same clothes at deep discounts on Respondent's website. Also, Respondent is using on its website the same descriptions as Complainant uses on its website to sell products (e.g., "Zayn Jeans – Brown Hash"; "Zia Pintuck Trousers – White The Frankie Shop"; "Wren Sleeveless Knit Dress – White The Frankie Shop"; "Proenza Schouler Forma Sandals"; "Proenza Schouler White Label Twin Nappa Tote").

Complainant's counsel wrote a cease and desist letter to Cloudflare, Inc., who hosts Respondent's website. It does not appear that Complainant received a response to that letter.

5. Parties' Contentions

A. Complainant

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

Notably, Complainant contends that confusing similarity exists because: the Domain Name reproduces the two words "frankie" and "the" included in the Mark; and by incorporating the generic Top-Level Domain (gTLD) ".shop", the Domain Name fully incorporates the three elements of Complainant's "THE FRANKIE SHOP" Mark. The only difference between the Domain Name and the Mark is that the word "US" is substituted for the word "SHOP" in the Mark and the addition of the gTLD ".shop."

Complainant asserts that Respondent does not have any rights in the Domain Name because: (1) to Complainant's knowledge, Respondent has no rights in the name "The Frankie Shop" and has never acquired any prior rights to it; and (2) Respondent is not affiliated with Complainant and has not been authorized by Complainant to use the Mark for any purpose. Complainant further asserts that Respondent has no legitimate interests in the Domain Name because Respondent is not using the Mark for a bona fide use but, rather, to redirect the public to a website that reproduces the Mark and Complainant's photographs to sell competing and possibly counterfeit goods.

Complainant asserts that Respondent has registered the Domain Name in bad faith because: Complainant has rights in the Mark and it has used it on a worldwide basis; Respondent has neither the rights nor a legitimate interest in the Domain Name; and Respondent could not have been unaware of Complainant's rights in the Mark when it registered the Domain Name. The Domain Name redirects to a website that reproduces Complainant's Mark as well as photographs and captions for product names that are the same

as those used by Complainant on its website to sell apparel and accessories. This use of the Domain Name is clearly with a view to commercial gain, which amounts to bad faith use.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

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

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 Mark is recognizable within the Domain Name. Accordingly, the Domain Name is confusingly similar to the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The difference between the Domain Name and the Mark is that the term "US" is substituted for the third term "Shop" in THE FRANKIE SHOP but the term "shop" appears as a gTLD. While it is usual practice to disregard the gTLD portion of the Domain Name as a functional aspect of the domain name protocol, here the combination of the gTLD (".shop") with the other words ("the frankie") gives the overall impression that the Domain Name (<thefrankieus.shop>) comprises the entirety of the Mark.

Although the addition of the term "US" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Domain Name 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 Respondent may demonstrate rights or legitimate interests in the 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the 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 Domain Name such as those enumerated in the Policy or otherwise. More specifically, it is unrebutted that: (1) to Complainant's knowledge, Respondent has no rights in the name "The Frankie Shop" and has never acquired any prior rights to it; (2) Respondent is not affiliated with

Complainant and has not been authorized by Complainant to use the Mark for any purpose; and (3) Respondent is not using the Mark for a bona fide use but, rather, to resolve Internet users to a website that reproduces the Mark and Complainant's photographs to sell competing and possibly counterfeit goods.

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 Complainant has been using the Mark internationally for many years before Respondent registered the Domain Name including in conjunction with Complainant's website. The record also indicates that Complainant has been advertised in well-known magazines such as Vogue and Forbes and on Instagram. This alone would lead one to conclude that Respondent would likely have known of Complainant before registering the Domain Name. This is further evident from the Domain Name which contains the geographic term "US", which is one location where Complainant does business, and the gTLD ".shop", which completes the inclusion of Complainant's Mark in the Domain Name. Respondent's knowledge of Complainant and its rights in the Mark is clear because Respondent reproduces on its website the Mark as well as photographs and product names that Complainant uses on its website to sell what looks like the same or similar apparel and accessories.

Respondent has used the Domain Name in bad faith to divert Internet users to Respondent's website selling apparel and accessories that compete with those that Complainant sells on its website (<thefrankieshop.com>). By using the Domain Name in this manner, Respondent has intentionally attempted to attract for commercial gain Internet users to the website associated with the Domain Name.

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 Domain Name <thefrankieus.shop> be transferred to Complainant.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: March 26, 2024