

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Zhang Qiang
Case No. D2024-0776

1. The Parties

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

The Respondent is Zhang Qiang, China.

2. The Domain Names and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 19, 2024. On February 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 5, 2024, 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 (Whois Agent) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 5, 2024, 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 amended Complaint on March 5, 2024.

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 March 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 28, 2024.

The Center appointed Andrew F. Christie as the sole panelist in this matter on April 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 is a company specializing in the sale of clothing, accessories (leather goods, jewellery, etc.), women's shoes, and cosmetics. It sells these items under the brand name THE FRANKIE SHOP and under third party brands across the world, including in New Zealand, the United Kingdom, the European Union, Canada, Switzerland, Australia, South Africa, United Arab Emirates, Israel, Türkiye, Brazil, Argentina, Kuwait, Chile, Japan, Peru, Mexico, Colombia, and Uruguay. It also sells through its websites at "www.eu.thefrankieshop.com" and "www.thefrankieshop.com".

The Complainant owns numerous trademark registration across the world, including United States Trademark Serial No. 97050056 (filed September 28, 2021 and registered on April 18, 2023), and International Registration No. 1648994 (registered on October 12, 2021, designating numerous countries, including China), both for the word trademark THE FRANKIE SHOP. The Complainant also owns several generic Top-Level Domain ("gTLD") and country-code Top-Level Domain ("ccTLD") domain names incorporating its trademark, including <thefrankieshop.com> (registered September 17, 2014) and <thefrankieshop.ch> (registered January 19, 2022).

The Respondent registered each of the disputed domain names on January 17, 2024. The Complainant provided screenshots, dated February 14, 2024, of the websites to which the disputed domain names then resolved. Each of those websites prominently displayed the Complainant's trademark THE FRANKIE SHOP, and contained photographs of models wearing clothes, which appeared to have been taken from one of the Complainant's official websites. As of the date of this decision, none of the disputed domain names resolve to an active location.

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.

The Complainant contends that the disputed domain names are confusingly similar to a trademark in which it has rights on the following grounds, among others. The disputed domain names are composed of an exact reproduction of the words included in its registered word trademark THE FRANKIE SHOP, and differ only by the addition of a geographical term after the word "shop" and the gTLD suffix ".net". The disputed domain

names incorporate the distinctive terms of the trademark. The addition of a geographical term does not avoid the likelihood of confusion between the disputed domain names and the trademark.

The Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain names on the following grounds, among others. The Respondent has no rights in the name THE FRANKIE SHOP and has never acquired any prior rights in this wording. The Respondent is not affiliated with the Complainant and has not been authorized by the Complainant to use its trademark or to proceed with registration of the disputed domain names. The disputed domain names redirect to websites that reproduce the Complainant's trademark, as well as the names of its products and photographs of its products and models. These websites offer counterfeited products at very substantially discounted prices.

The Complainant contends that the Respondent registered and is using the disputed domain names in bad faith on the following grounds, among others. When the Respondent registered the disputed domain names, it could not have been unaware of the Complainant's prior rights in its trademark. The Complainant has a significant reputation in the world, its trademark registrations significantly predate registration of the disputed domain names, and a simple trademark search or Internet search would have informed the Respondent of the existence of the Complainant's prior trademark. This amounts to bad faith registration with intent to harm the Complainant's reputation. The disputed domain names redirect to websites that reproduce the Complainant's trademark as well as its photographs of products and models. This is use of the disputed domain names with a view to commercial gain, and amounts to bad faith use.

B. Respondent

The Respondent did not reply to the 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 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 entirety of the Complainant's word trademark THE FRANKIE SHOP is reproduced within, and is clearly recognizable in, the disputed domain names. Although the addition of other terms (here, a geographical location) may bear on assessment of the second and third elements, the Panel finds the addition of these terms does not prevent a finding of confusing similarity between the disputed domain names and the trademark 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.

The Panel considers that the composition of the disputed domain names carry a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Also, the evidence establishes that the Respondent has used the disputed domain names in an attempt to impersonate the Complainant, presumably in pursuit of the sale of counterfeit products. Panels have held that the use of a domain name for illegal activity (here, impersonation) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 Respondent registered the disputed domain names some years after the Complainant first registered its THE FRANKIE SHOP trademark, and that the disputed domain names incorporate the Complainant's trademark in its entirety, and merely add a geographical term which alludes to locations in respect of which the Complainant uses its trademark. It is clear the Respondent registered the disputed domain names with knowledge of the Complainant's trademark.

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.

Panels have held that the use of a domain name for illegal activity (here, 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 name constitutes bad faith under the Policy.

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

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.net>, <thefrankieshopaustralia.net>, <thefrankieshopaustria.net>, <thefrankieshopbelgie.net>, <thefrankieshopbelgique.net>, <thefrankieshopbrasil.net>, <thefrankieshopbulgaria.net>, <thefrankieshopcanada.net>, <thefrankieshopchile.net>, <thefrankieshopcolombia.net>, <thefrankieshopcz.net>, <thefrankieshopdanmark.net>, <thefrankieshopdeutschland.net>, <thefrankieshopeesti.net>, <thefrankieshopfrance.net>, <thefrankieshopgreece.net>, <thefrankieshophrvatska.net>, <thefrankieshophungary.net>, <thefrankieshopireland.net>, <thefrankieshopisrael.net>, <thefrankieshopitalia.net>, <thefrankieshopjapan.net>, <thefrankieshopkuwait.net>,

<thefrankieshoplatvija.net>, <thefrankieshoplietuva.net>, <thefrankieshopmexico.net>, <thefrankieshopnederland.net>, <thefrankieshopnorge.net>, <thefrankieshopnz.net>, <thefrankieshopperu.net>, <thefrankieshoppolska.net>, <thefrankieshopportugal.net>, <thefrankieshopromania.net>, <thefrankieshopschweiz.net>, <thefrankieshopslovenija.net>, <thefrankieshopslovensko.net>, <thefrankieshopsouthafrica.net>, <thefrankieshopspain.net>, <thefrankieshopsrbija.net>, <thefrankieshopsuisse.net>, <thefrankieshopsuomi.net>, <thefrankieshopsverige.net>, <thefrankieshopturkey.net>, <thefrankieshopuae.net>, <thefrankieshopuk.net> and <thefrankieshopuruguay.net> be transferred to the Complainant.

/Andrew F. Christie/
Andrew F. Christie
Sole Panelist
Date: April 23, 2024