

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Finlay Foster, Eric Naumann, and Emma Fry
Case No. D2024-1993

1. The Parties

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

The Respondents are Finlay Foster, Germany, Eric Naumann, Germany, and Emma Fry, Germany (referred to below as “the Respondents”).

2. The Domain Names and Registrar

The disputed domain names <thefrankieshop-australia.com>, <thefrankieshopbelgium.com>, <thefrankieshop-danmark.com>, <thefrankieshopesperana.com>, <thefrankieshop-france.com>, <thefrankieshop-ireland.com>, <thefrankieshop-japan.com>, <thefrankieshop-nederland.com>, <thefrankieshop-norge.com>, <thefrankieshop-schweiz.com>, <thefrankieshopsingapore.com>, <thefrankieshopturkiye.com>, <thefrankieshop-uae.com>, <the-frankie-shopuk.com>, <thefrankieshop-uk.com> and <thefrankieshopusa.com> are registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 13, 2024. On May 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 20, 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 (Domain Admin) and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 21, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on May 22, 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 May 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 19, 2024.

The Center appointed Iris Quadrio as the sole panelist in this matter on July 1, 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 very well-known company specialized in the sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes, cosmetics under the brand name THE FRANKIE SHOP. The Complainant operates in many countries worldwide including, among others, New-Zealand, the United Kingdom ("UK"), the European Union ("EU"), Canada, Switzerland, Australia, South Africa, United Arab Emirates, Israel, Türkiye, Brazil, Argentina, Kuwait, Chile, Japan, Peru, Mexico, Colombia, and Uruguay.

The Complainant is the owner of the trademark THE FRANKIE SHOP in many jurisdictions, including, International registration no. 1648994 registered on October 12, 2021, designating inter alia Brazil, Mexico, China, Singapore, Republic of Korea, Japan, Malaysia, New Zealand, Türkiye, Ukraine, Switzerland and UK, for classes 3, 4, 9, 14, 18, 25 and 35; and United States Patent and Trademark Office ("USPTO") Reg. No. 97050056 for class 35 registered on April 18, 2023.

The Complainant also owns an important domain names portfolio, including, among others, its primary website <thefrankieshop.com> registered since September 17, 2014.

The disputed domain names were registered on and are presently used as follows:

Disputed domain name	Registration date	Use
<thefrankieshop-uk.com>	April 9, 2024.	Inactive website
<thefrankieshopusa.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshop-japan.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshop-norge.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshop-uae.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshopespana.com>	April 9, 2024.	Inactive website
<thefrankieshop-australia.com>	April 9, 2024.	Inactive website
<thefrankieshop-danmark.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshop-france.com>	April 9, 2024.	Inactive website

<thefrankieshop-ireland.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshop-nederland.com>	April 9, 2024.	Inactive website
<thefrankieshop-schweiz.com>	April 9, 2024.	Inactive website
<thefrankieshopbelgium.com>	April 9, 2024.	Inactive website
<thefrankieshopsingapore.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<thefrankieshopturkiye.com>	April 9, 2024.	Active website imitating the Complainant's official website ("www.thefrankieshop.com").
<the-frankie-shopuk.com>	April 25, 2024.	Inactive website

The Respondents are Finlay Foster, Eric Naumann, and Emma Fry, all from Germany.

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 states that the disputed domain names are confusingly similar to its trademark THE FRANKIE SHOP, and to its official domain names.

The Complainant further contends that the Respondents have no rights or legitimate interests in respect of the disputed domain names, nor are related in any way to the Complainant. Neither license nor authorization has been granted to the Respondents to make any use of the Complainant's trademark THE FRANKIE SHOP or apply for registration of the disputed domain names.

More specifically, the Complainant alleges that the Respondents have not used and/or have no demonstrable intention to use the disputed domain names except to create a likelihood of confusion with the Complainant's trademark. In fact, the Complainant claims that the Respondents have selected the disputed domain names only to intentionally lead Internet users to believe they are accessing the Complainant's website.

Finally, the Complainant has requested the Panel to issue a decision ordering the transfer of the disputed domain names to the Complainant.

B. Respondents

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

6. Discussion and Findings

6.1. Consolidation: 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, as seen above: (i) All of the disputed domain names share the same naming pattern (reproducing the Complainant's trademark THE FRANKIE SHOP in its entirety with the addition of geographic terms); (ii) 14 disputed domain names were registered on April 9, 2024 while another one was registered only a few days later on April 25, 2024; (iii) all disputed domain names were registered through the same Registrar; (iv) eight of the disputed domain names resolve to similar active websites imitating the Complainant's official site, and the other eight of them resolve to inactive websites; and (v) all disputed domain names appear to have false or incomplete contact information associated with them.

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 in a single proceeding the disputes regarding the nominally different disputed domain name registrants.

6.2. Substantive matter

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain names, the Complainant must prove each of the following, namely that:

- (i) the disputed domain names are identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interest in respect of the disputed domain names; and
- (iii) the disputed domain names were registered and are 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 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 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.

While the addition of geographical terms ("uk", "usa", "japan", "norge", "uae", "espana", "australia", "danmark", "france", "ireland", "nederland", "schweiz", "belgium", "singapore", and "turkiye") 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.

Moreover, the “.com” generic Top-Level Domain (“gTLD”) is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

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 of the Respondents lack of rights or legitimate interests in the disputed domain names. The Respondents have 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 Complainant has claimed not to have authorized, licensed, or permitted the Respondents to register or use the disputed domain names or to use the trademark THE FRANKIE SHOP nor is there any other evidence in the file suggesting that the Respondents have or could have rights or legitimate interests in the disputed domain names. Also, the Complainant has prior rights in the THE FRANKIE SHOP trademark which clearly precede the Respondents’ registration of the disputed domain names.

Likewise, it does not seem that the Respondents are making any legitimate noncommercial or fair use of the disputed domain names. On the contrary, some of the disputed domain names direct to websites that prominently reproduce the Complainant’s prior trademarks as well as the name of its products and photographs of its products and models. This use of the disputed domain names appears to be merely intended to benefit from the Complainant’s reputation by confusing Internet users and leading them to believe that the websites to which the disputed domain names relate are the official websites of the Complainant. Hence, as established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” The other part of the disputed domain names resolve to inactive websites.

Furthermore, the Panel considers that the composition of the disputed domain names carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy contains a non-exhaustive list of factors evidencing registration and use in bad faith. Among others, the paragraph 4(b)(iv) states that it is sufficient to support a finding of bad faith the fact that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In such connection, the Complainant has submitted evidence to support that the trademark THE FRANKIE SHOP is widely known and was registered and used many years before the Respondents registered the disputed domain names. The Respondents when registering the disputed domain names have targeted the Complainant's trademark THE FRANKIE SHOP to generate confusion among the Internet users and benefit from the Complainant's reputation.

Therefore, the Panel is satisfied that the Respondents must have been aware of the Complainant and the Complainant's trademark THE FRANKIE SHOP when they registered the disputed domain names. Consequently, and in accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's THE FRANKIE SHOP trademark in the disputed domain names creates a presumption that the disputed domain names were registered in bad faith.

Furthermore, as previously indicated, some of the disputed domain names resolve to active websites that prominently reproduce the Complainant's prior trademarks as well as the name of its products and photographs of its products and models. The Panel finds therefore that the Respondents' use of the disputed domain names incorporating the Complainant's distinctive and well-known mark THE FRANKIE SHOP is intended to attract and mislead Internet users when searching for the Complainant's website and purportedly offer the Complainant's products at discounted prices.

The remaining part of the disputed domain names resolve to inactive websites. However, as per section 3.3 of [WIPO Overview 3.0](#), the fact that the disputed domain names do not resolve to an active website does not prevent a finding of bad faith under the doctrine of passive holding in the circumstances of this case. (See also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

In view of the above given reasons, the Panel finds that the Respondents have registered and used the disputed domain names in bad faith.

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 <thefrankieshop-australia.com>, <thefrankieshopbelgium.com>, <thefrankieshop-danmark.com>, <thefrankieshopespana.com>, <thefrankieshop-france.com>, <thefrankieshop-ireland.com>, <thefrankieshop-japan.com>, <thefrankieshop-nederland.com>, <thefrankieshop-norge.com>, <thefrankieshop-schweiz.com>, <thefrankieshopsingapore.com>, <thefrankieshopturkiye.com>, <thefrankieshop-uae.com>, <the-frankie-shopuk.com>, <thefrankieshop-uk.com> and <thefrankieshopusa.com> be transferred to the Complainant.

/Iris Quadrio/

Iris Quadrio

Sole Panelist

Date: July 16, 2024