

## **ADMINISTRATIVE PANEL DECISION**

Frankie Shop LLC v. Jordan Cole  
Case No. D2024-2160

### **1. The Parties**

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

The Respondent is Jordan Cole, Germany.

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

The disputed domain name <thefrankieshopuk.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 May 27, 2024. On May 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 28, 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 (Wilayah Persekutuan, MY) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 28, 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 amendment to the Complaint on the same date.

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 the Respondent of the Complaint, and the proceedings commenced on May 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 19, 2024.

The Center appointed Philippe Gilliéron as the sole panelist in this matter on June 24, 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 specialized in the sale of clothing, accessories, women's shoes and cosmetics under the brand name "THE FRANKIE SHOP", which operates in numerous countries.

The Complainant notably owns the following word trademarks for THE FRANKIE SHOP:

- The International trademark No. 1648994, that was registered on October 12, 2021, in classes 3, 4, 9, 14, 18, 25, and 35.
- United States trademark No. 5147070, registered on February 21, 2017, in class 35.

The Complainant further owns numerous domain names consisting in whole or in part of the expressions "FRANKIE" or "FRANKIE SHOP", such as, among others: <thefrankieshop.com>, <frankielabel.com>, <frankie-nyc.com>, <frankieonline.com>, <thefrankieshop.ch>, <frankie.shop>, <frankieshop.us>, <frankieshop.co.uk> or <thefrankieshop.uk>.

The Complainant has been subject to numerous cybersquatting cases which.

On May 7, 2024, the Respondent registered the disputed domain name.

The disputed domain name resolves to a website that reproduces the Complainant's trademark as well as the name of its products along with photographs of its products and related models. All these products are sold at a substantially discounted price.

#### **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 entirely incorporates its trademark THE FRANKIE SHOP and that the mere addition of the term "UK" before the generic Top-Level Domain ("gTLD") ".shop" is unlikely to exclude the resulting likelihood of confusion.

The Complainant then affirms that the Respondent has no rights or legitimate interests in the disputed domain name. It is not affiliated to the Complainant and has not been authorized to use the Complainant's trademark or to proceed with the registration of the disputed domain name. The website associated to the disputed domain name is a counterfeit website which, as such, cannot be considered a bona fide use.

The Complainant finally is of the view that the disputed domain name was registered and is being used in bad faith. Taking into account the reputation of the Complainant's trademark, the Respondent was obviously aware of its existence when it decided to register the disputed domain name. The disputed domain name resolving to a website selling counterfeit products is an obvious use in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “[...] 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”.

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

- (i) the disputed domain name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) 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.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

Furthermore, the Panel notes the composition of the disputed domain name, which carries a risk of implied affiliation with the Complainant, [WIPO Overview 3.0](#), section 2.5.1, and that that the disputed domain name used to resolve to a website purportedly offering the Complainant’s products at significantly discounted

prices, thus, potentially counterfeit. Panels have held that the use of a domain name for illegal activity, such as the sale of counterfeit goods, 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.

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.

The Panel further notes that the disputed domain name resolves to a website purportedly offering the Complainant's products at significantly discounted prices and that the Respondent has failed to come forward with any explanation for the registration and use of the disputed domain name. In light of these circumstances, the Panel finds that the Respondent targeted the Complainant.

Panels have held that the use of a domain name for illegal activity such as, in the present case, 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.

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 <thefrankieshopuk.shop> be transferred to the Complainant.

*/Philippe Gilliéron/*

**Philippe Gilliéron**

Sole Panelist

Date: July 8, 2024