

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. sad as
Case No. D2024-3681

1. The Parties

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

Respondent is sad as, United States.

2. The Domain Name and Registrar

The disputed domain name <thefrankietop.shop> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 11, 2024. On September 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 11, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to Complainant on September 12, 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 September 13, 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 September 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 8, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 9, 2024.

The Center received an email communication from a third party on September 23, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on October 14, 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 following facts appear from the Complaint (as amended) and its attached Annexes, which have not been contested by Respondent, and provides evidence sufficient to support:

Incorporated in 2015, Complainant is a well-known company selling clothing and fashion accessories, including leather goods, jewelry, women's shoes and cosmetics under the trademark THE FRANKIE SHOP ("THE FRANKIE SHOP Mark"), as well as providing such goods under third party brands around the world.

Complainant owns a number of registrations in the U.S. and around the world for THE FRANKIE SHOP Mark for its clothing products, including the following:

- United States Registration No. 7,028,712, THE FRANKIE SHOP, registered on April 18, 2023, for a range of online, mail order and retail store services for clothing and related goods in International Class 35, claiming a first use date at least as early as November 14, 2014; and

- International Registration No. 1648994, THE FRANKIE SHOP, registered on October 12, 2021, for a range of goods in International Classes 03, 04, 09, 14, 18, 25 and 35, with designations in Australia, European Union, Brazil, United States, Mexico, China, Singapore, Republic of Korea, Japan, Malaysia, New Zealand, Russia, Türkiye, Ukraine, Switzerland, United Arab Emirates, Norway, Canada, Israel, India, Thailand, Morocco and the United Kingdom.

Complainant's founder director, Mme. Gaëlle Drevet, holds United States Registration No. 5147070 for FRANKIE SHOP, registered to Complainant on February 21, 2017, for services in class 35, with a disclaimer of the exclusive right to use "shop" apart from the mark and assigned to Mme. Drevet on February 27, 2021.

Complainant also shows it incorporates THE FRANKIE SHOP Mark into its official domain name <thefrankieshop.com>, registered on September 17, 2014, that it uses to access its official website at "www.thefrankieshop.com" (the "Official THE FRANKIE SHOP Mark Website") where it offers its products for sale. Complainant also owns its official domain names <frankieonline.com> registered September 15, 2014, and <frankie.shop>, registered January 19, 2022.

Respondent registered the disputed domain name on May 28, 2024. The Panel's independent investigation of the disputed domain name found that as of the date visited, October 28, 2024, Respondent's disputed domain name resolved to what is generally referred to as a "copycat" website which displayed pages strikingly similar to the content on the Official THE FRANKIE SHOP Mark Website, including Complainant's trademark as well as infringing copies of Complainant's copyright protected digital images of its products and fashion models and offers the possibility to order purportedly counterfeited products at substantially discounted prices.¹ Numerous cases support a panel's power to undertake such limited factual research and the Panel has, in its discretion, examined Respondent's website as well as the United States Patent and Trademark Office database for the current status of Complainant's US trademark registration data.

¹ "Noting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name or accessing trademark registration databases." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8. See e.g., *Humble Bundle, Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0914](#); *Creative NetVentures, Inc. v. Webheads*, WIPO Case No. [D2000-1655](#).

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to cancel a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

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 disputed domain name. [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. Trademark registration evidence has been submitted in the form of electronic copies of valid and subsisting national and international trademark registration documents in the name of Complainant referenced in Section 4 above. Ownership of a nationally registered trademark constitutes prima facie evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1; see *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#); see also *Janus International Holding Co. v. Rademacher*, WIPO Case No. [D2002-0201](#).

A consensus among UDRP panels has recognized that the global nature of the Internet and Domain Name System renders the jurisdiction(s) where a trademark is registered irrelevant to panel assessment under the first element test, as are the goods and/or services for which the mark is registered or used in commerce, the filing/priority date, date of registration, and date of claimed first use. See [WIPO Overview 3.0](#), section 1.1.2.

The Panel finds Complainant's foregoing national and international registrations are sufficient to demonstrate statutory trademark rights in Complainant's THE FRANKIE SHOP Mark to meet Complainant's burden under the first element of the Policy.

A side-by-side comparison between the disputed domain name and Complainant's mark shows the disputed domain name is confusingly similar to Complainant's THE FRANKIE SHOP Mark.

Complainant's THE FRANKIE SHOP Mark is incorporated in its entirety in the disputed domain name except for Respondent inserting the term "top" between "thefrankie" and the Top-Level Domain ("TLD") ".shop" and Complainant's THE FRANKIE SHOP Mark remains recognizable within the disputed domain name.

Prior UDRP panels have held "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." See, *L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); see also, *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#). Prior UDRP panels have also found the TLD, being viewed as a standard registration requirement, may typically be disregarded under the paragraph 4(a)(i) analysis unless the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark. In such cases panels may consider the domain name in its entirety for purposes of assessing confusing similarity (e.g., for a hypothetical TLD ".mark" and a mark "TRADEMARK", the domain name <trade.mark> would be confusingly similar for UDRP standing purposes). See [WIPO Overview 3.0](#), section 1.11.3; see also *Compagnie Générale des Etablissements Michelin v. Pacharapatr W.*, WIPO Case No. [D2016-2465](#), (<tyre.plus>).

Complainant also contends that the disputed domain name must be considered confusingly similar to Complainant's Mark because the inserted term "top" is a reference to Complainant's services in the retail apparel industry, but this issue is more properly considered under elements two and three of the Policy.

The Panel finds that the inserted term "top" does not prevent a finding of confusing similarity with Complainant's THE FRANKIE SHOP Mark and the mark is recognizable 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.

Based on the available record, 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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Complainant contends that none of the circumstances provided in paragraph 4(c) of the Policy for demonstrating a respondent's rights to and legitimate interests in a domain name are present in this case. 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 disputed domain name such as those enumerated in the Policy or otherwise.

First, Complainant contends that Respondent has no rights in the disputed domain name. Complainant asserts that it has no commercial relationship with Respondent, Respondent is not sponsored by or affiliated with Complainant in any way, and Complainant has not given Respondent authority or license to register or use Complainant's trademarks in any manner, including in domain names. Prior UDRP panels have held "in the absence of any license or permission from Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed". *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Second, there is no evidence to suggest that Respondent is commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests under Policy paragraph 4(c)(ii). Respondent, as registrant of the disputed domain name, identified as "sad as" is not commonly known by the disputed domain name because it clearly bears no resemblance to it. Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is commonly known by the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Most importantly, Complainant contends Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services because, as Complainant's attached screen shots of the web pages accessed through the disputed domain name show, the disputed domain name resolves to a carefully crafted "copycat" version of Complainant's Official THE FRANKIE SHOP Mark Website to create a false association with Complainant.

The Panel notes that evidence submitted persuasively supports Complainant's argument because it shows Respondent's website prominently features the unauthorized use of infringing copies of Complainant's copyright protected digital images of its products and fashion models and offers the possibility to order counterfeited products at substantially discounted prices. Respondent's activities therefore undermine any claim of rights and legitimate interests. Respondent, therefore, is using the disputed domain name to confuse Internet users and suggest an affiliation with or sponsorship by Complainant to redirect Internet users to its website for its commercial gain. Based on these facts the Panel finds Respondent's actions are clearly not legitimate and clearly are misleading. Respondent, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. See *Six Continents Hotels v. "m on"*, WIPO Case No. [D2012-2525](#); see also *Frankie Shop LLC v. Jie Wen*, WIPO Case No. [D2022-4197](#).

It is a well-established principle according to a consensus of UDRP Panels that the use of a domain name for illegitimate activity such as the impersonation or selling possibly counterfeit goods found here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. See also *Frankie Shop LLC v. Domain Protection Services Inc. / My Mo*, WIPO Case No. [D2022-0825](#).

Having reviewed the record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed 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 disputed domain name such as those enumerated in the Policy or otherwise.

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 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 also 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.

Complainant contends that Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business by registering a domain name that incorporates the THE FRANKIE SHOP Mark in its entirety with the insertion of the term "top" between the first two terms of Complainant's mark, "the frankie" and the final term "shop" configured as the TLD ".shop". Respondent has thereby created a domain name for registration that is confusingly similar to Complainant's trademark, as well as its official domain name. Prior UDRP panels have found a domain name was registered in bad faith where the respondent registered the domain name for the purpose of intentionally attempting to impersonate or mislead in order to commit fraud. See, e.g., *Houghton Mifflin Co. v. The Weatherman Inc.*, WIPO Case No. [D2001-0211](#); *Frankie Shop LLC v. Bgeew Aferg*, WIPO Case No. [D2022-3619](#); *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#).

Prior UDRP panels have also held where the disputed domain name is configured in a manner to wholly incorporate a complainant's mark, as Complainant's Mark is incorporated here, with an intervening term, "top", related to Complainant's retail clothing industry, the disputed domain name can only sensibly refer to Complainant; thus, there is no obvious possible justification for Respondent's selection of the disputed domain name other than registration in bad faith. See *Frankie Shop LLC v. Bgeew Aferg, supra*.

As discussed in greater detail in Section 6B above, Complainant shows in evidence in the Annexes to its Complaint that Respondent used the disputed domain name to configure a copycat website to impersonate Complainant attempted to attract Internet users seeking Complainant's products through counterfeit products at substantially discounted prices constitutes evidence of bad faith use under the well-established principles in the cases decided under the Policy. See [WIPO Overview 3.0](#), section 3.4 and *The Coca-Cola Company v. PrivacyProtect.org/ N/A, Stephan Chukwumaobim*, WIPO Case No. [D2012-1088](#); *Ropes & Gray LLP v. Domain Administrator, c/o DomainsByProxy.com / Account Receivable*, WIPO Case No. [D2020-0294](#).

Moreover, the Center received an email communication from a third party on September 23, 2024, claiming their address had been used without their knowledge or authorization. Respondent's use of an address when registering the disputed domain name from a third party further supports a finding of bad faith.

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith registration and use under the Policy. The Panel finds that the evidence presented here: 1) Respondent's copycat website using Complainant's trademark as well as content displaying infringing copies of Complainant's copyright protected digital images of its products and fashion models; and 2) offering users the possibility to order counterfeited products at substantially discounted prices, is sufficient for this Panel to find bad faith registration and use. Under these circumstances, there can be little doubt Respondent had actual knowledge of Complainant, targeted Complainant's mark and used its actual knowledge to configure a mimic website for its commercial advantage. Accordingly, 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 <thefrankietop.shop> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: November 5, 2024