

ADMINISTRATIVE PANEL DECISION

FRANKIE SHOP LLC v. Domain Admin, Privacy Protect LLC PrivacyProtect org
Case No. D2024-4160

1. The Parties

The Complainant is FRANKIE SHOP LLC, United States of America (“U.S.”), represented by Coblence Avocats, France.

The Respondent is Domain Admin, Privacy Protect LLC PrivacyProtect org, U.S.

2. The Domain Name and Registrar

The disputed domain name <thefrankieshop-turkiye.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 9, 2024. On October 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 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 (Domain Admin) and contact information in the Complaint.

The Center verified that 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 October 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 13, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on November 19, 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 and under third party brands. Its sales are in numerous countries throughout the world, and through its websites at the domain names <eu.thefrankieshop.com> and <thefrankieshop.com>.

The Complainant is the registrant of numerous trademarks worldwide, including the following:

- THE FRANKIE SHOP, International Registration No. 1648994, registered October 12, 2021, in classes 3, 4, 9, 14, 18, 25, and 35;
- THE FRANKIE SHOP, U.S. service mark registration No. 7028712, registered April 18, 2023, in class 35.

The signs THE FRANKIE SHOP and FRANKIE SHOP have been used as a company name since 2015 and 2017 respectively.

The Complainant registered the domain name <thefrankieshop.com> on September 17, 2014. Additionally, the Complainant is the registrant of numerous domain names composed of the words "frankie" or "frankie shop", and in numerous generic Top-Level Domains (gTLDs) and country-code Top-Level Domains.

The disputed domain name was registered on September 24, 2024, and the Registrar disclosed the name of the registrant as, "Domain Admin, Privacy Protect LLC PrivacyProtect.org". The disputed domain name resolves to an inactive website.

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 is confusingly similar to its THE FRANKIE SHOP trademarks and domain names. The disputed domain name is composed of an exact reproduction of the words "the", "frankie", and "shop" in the same order as the Complainant's mark, along with the addition of a geographical term "turkiye" (Türkiye) after the word "shop". The addition of the gTLD ".com" is irrelevant and cannot be taken into consideration in determining whether there is confusing similarity. The Complainant also contends that the word "frankie" has no meaning in either English or French.

The Complainant cited numerous prior UDRP decisions wherein there was found confusing similarity with domain names containing "the frankie shop" along with additional words or geographic indicators. The Respondent cannot credibly claim that it had just accidentally or by coincidence registered a domain name that is highly similar to the prior rights held by the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no rights in the name and has never been known by the name. Furthermore, the Respondent is not affiliated with the Complainant and has not been authorized by the Complainant to use its prior trademarks nor register domain names that include the Complainant's prior trademarks. The Complainant does not know the Respondent and has never had any relationship with it.

The Respondent is using the disputed domain name in order to deceive and divert the Complainant's consumers, with a malicious intention to take advantage of the notoriety of the Complainant's trademarks. The fact that the disputed domain name directs to an inactive website does not represent a bona fide offering

of goods or services, or a legitimate noncommercial or fair use, given the reputation and distinctiveness of the Complainant's trademarks.

The Complainant asserts that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent could not have been unaware of the Complainant's prior rights, and the addition of the geographical term to the Complainant's mark strongly suggests that the Respondent had the Complainant's prior rights in mind at the time of registration.

The disputed domain name resolving to an inactive website is passive holding, and constitutes bad faith given that the disputed domain name is clearly misleading and where it is apparent that the Respondent had knowledge of the Complainant's prior rights given their distinctiveness or reputation. The Respondent deliberately registered an identical domain name with the intent to divert Internet users from the Complainant's website to the Respondent's page. Further evidence of bad faith is the Registrant's concealing of its identity, as the Respondent utilized a proxy service without revealing its identity through the registrar. *Calvin Klein Trademark Trust & Calvin Klein, Inc. v. Registration Private, Domains by Proxy, LLC / [?? ?]*, WIPO Case No. [D2021-2798](#); *LEGO Juris A/S v. Registration Private, Domains by Proxy LLC / Leonel Andaya*, WIPO Case No. [D2021-0563](#). Based on the totality of the circumstances, the Respondent has registered and used the disputed domain name in bad faith, to the detriment of the Complainant's prior rights.

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 Panel finds 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.

Although the addition of a hyphen or other terms here, the geographical term "turkiye" (Türkiye), 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 disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Additionally, the ".com" 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 [WIPO Overview 3.0](#), section 1.11.1.

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.

The Complainant has averred that it has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the trademark THE FRANKIE SHOP. The Respondent has not come forward with any proof that it is known by, has any rights or legitimate interests in the disputed domain name, nor any rights or use of THE FRANKIE SHOP prior to the Complainant’s acquired rights in THE FRANKIE SHOP trademark.

Furthermore, the Respondent does not appear to be making any legitimate or noncommercial fair use of the disputed domain name. This Panel considers that the composition of the disputed domain name, with the Complainant’s mark and the added geographical term, carries a risk of implied affiliation with or endorsement by 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

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 name a number of years after the Complainant first registered its THE FRANKIE SHOP trademark. The disputed domain name contains the Complainant’s trademark in its entirety, and merely adds a geographical term referring to a location where the Complainant uses its trademark. This would be an indication that the Respondent registered the disputed domain name with knowledge of the Complainant’s trademark, with an intention to attract Internet users by creating a likelihood of confusion with the Complainant’s mark.

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 disputed domain name resolves to a website indicating that the Internet user is unable to access said website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. In making a determination, panelists will look at the “totality of the circumstances”, including (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details, and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Complainant has submitted evidence of the well-known status of its THE FRANKIE SHOP trademark, and prior panels have held the well-known status of the mark. The Panel notes (i) the distinctiveness or reputation of the Complainant's trademark, (ii) the composition of the disputed domain name, (iii) the use of a privacy service and failure to reveal Respondent's identity after filing of the complaint, as well as (iv) failure to respond to the complaint or provide any good faith use to which the domain name may be put, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy. *Frankie Shop LLC v. Reece Kemp, Jake Foster, Spencer Collier, Niamh Willis, Lucy Nash*, WIPO Case No. [D2023-4362](#); *FRANKIE SHOP LLC v. Peter Pfeiffer, Monika Austerlitz, Stefan Koertig*, WIPO Case No. [D2024-2679](#), *Calvin Klein Trademark Trust & Calvin Klein, Inc. v. Domain Admin, Privacy Protect LLC/ PrivacyProtect org*, WIPO Case No. [D2024-1024](#).

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 <thefrankieshop-turkiye.com> be transferred to the Complainant.

/Gary Saposnik/

Gary Saposnik

Sole Panelist

Date: December 3, 2024