

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. GNavarro Julia
Case No. D2023-4726

1. The Parties

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

The Respondent is GNavarro Julia, United States.

2. The Domain Name and Registrar

The disputed domain name <thefrankieshops.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2023. On November 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 2023, 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 November 15, 2023.

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 November 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2023.

The Center appointed Ezgi Baklacı Gülkökar as the sole panelist in this matter on December 12, 2023. 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 limited liability company incorporated in New York, United States. The Complainant is a well-known company specialized in the sale of clothing, accessories, women's shoes, cosmetics under its brand name "The Frankie Shop" and under third party brands through its websites "eu.thefrankieshop.com" and "www.thefrankieshop.com".

The Complainant is the owner of the THE FRANKIE SHOP and formative trademark registrations. The relevant THE FRANKIE SHOP trademarks are International Registration No. 1648994, registered on October 12, 2021, in International Classes 03, 04, 09, 14, 18, 25, and 35; French trademark No. 4762800, filed on May 4, 2021, in International Classes 03, 04, 09, 14, 18, 25 and 35; and United States trademark No. 7028712, registered on April 18, 2023 in International Class 35 as evidenced with the Annexes E0, E1, and E2 of the Complaint.

The Director of the Complainant is also the owner of the FRANKIE SHOP and formative trademark. The relevant FRANKIE SHOP registrations are French trademark Registration No. 4338335, registered on June 9, 2017, in International Classes 03, 04, 09, 14, 16, 18, and 25; and United States trademark No. 86416726, registered on February 21, 2017, in International Class 35 as evidenced with the Annexes E3 and E4 of the Complaint.

The Complainant holds and uses several domain names consisting of THE FRANKIE SHOP trademark in combination with various generic and country code Top-Level Domain names, e.g., <thefrankieshop.com> and <frankielabel.com>.

The disputed domain name was registered on October 18, 2023, as evidenced with the Annex B of the Complaint. As of the date of the Complaint, the disputed domain name resolves to a website prominently displaying the Complainant's trademark, and copying website content from website belonging to the Complainant. On the "contact us" section, the company name was not mentioned, however, an address in United States was mentioned as a contact address.

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 each of the three elements specified in paragraph 4(a) of the Policy is satisfied in the present case, as follows:

Identical or confusingly similar

The Complainant argues that the disputed domain name is confusingly similar to THE FRANKIE SHOP trademarks in full as the disputed domain name is an exact reproduction of the mark THE FRANKIE SHOP, the sole difference being the addition of the letter "s".

The Complainant also contends that the Top-Level Domain ("gTLD") ".com" shall be disregarded.

Rights or legitimate interests

The Complainant argues that the Respondent has no rights and legitimate interests in the disputed domain name, has no affiliation with the Complainant, and the Complainant has not given the Respondent permission to register and/or use the Complainant's trademarks in any manner.

In addition, the Complainant argues that the Respondent is not known by the disputed domain name.

Furthermore, the Complainant argues that the disputed domain name directs to a website that reproduces the Complainant's prior trademarks as well as the name of its products and photographs of its products and models. However, such use has never been authorized by the Complainant and therefore cannot be the basis for *bona fide* use of the disputed domain name. The Complainant cites in support of its allegations various previous UDRP decisions.

The disputed domain name was registered and used in bad faith

The Complainant argues that THE FRANKIE SHOP is a well-known trademark throughout the world and that the Respondent should be presumed to have known or should have known the Complainant's trademarks. The Complainant further argues that the disputed domain name was registered in bad faith as the disputed domain name entirely incorporates the Complainant's trademarks. The Complainant cites in support of its allegations various previous UDRP decisions.

The Complainant also argues that the Respondent has knowingly registered the disputed domain name in order to create an impression of an association with the Complainant as the disputed domain name directs to a website that reproduces the Complainant's prior trademarks as well as the photographs and products' names and the website offers counterfeited products at very substantially discounted prices as evidenced with the Annex C2 of the Complaint. Further the Complainant claims that the use of the disputed domain name for such activity is a view to commercial gain and the Complainant contends that such use cannot be considered in good faith.

In summary, the Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

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

Based on the available record, the Panel finds 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 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 applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” [WIPO Overview 3.0](#), section 1.11. Here, the TLD “.com” may be disregarded.

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 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.

The Panel notes that there is no evidence showing that the Respondent holds any rights for the trademark or name “The Frankie Shop”. The Panel also notes that there is no evidence showing that the Respondent is authorized or licensed to use the Complainant’s trademark.

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.

As of the date of the Complaint, the disputed domain name resolves to a website prominently displaying the Complainant’s trademark, and copying website content from website belonging to the Complainant. The Panel notes that there are similarities between the website to which the disputed domain name resolves and the Complainant’s website at “www.thefrankieshop.com”. These include the exact duplication of the registered trademarks, exact copying of the images, and the models. Also, these similarities can be observed by the Panel as the website which the disputed domain resolves to can be accessed as of the date of this decision.

The Panel finds that use of the disputed domain cannot amount to a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Panels have held that the use of a domain name for illegal activity, such as impersonation/passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, in the absence of a reply from the Respondent and noting the products on the website are being sold at heavily discounted prices, the Panel accepts the Complainant’s undisputed allegations that the products offered on the website are counterfeit or not genuine products of the Complainant.

Based on the available record, 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 more likely than not was aware of the trademark THE FRANKIE SHOP, as the Complainant's trademark registrations predate the registration date of the disputed domain name. According to the evidence submitted by the Complainant, the Panel finds that the Respondent knew or should have known about the Complainant's rights (and such information could readily have been reached by a quick online search; see *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

In addition, previous UDRP panels have held that the mere registration of a domain name that is confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4). THE FRANKIE SHOP trademarks are widely known in the world and that suggests that the disputed domain name has been selected with an intent to create an impression of an association with the Complainant (see *General Motors LLC v. desgate.*, WIPO Case No. [D2012-0451](#)).

The Panel agrees that the Respondent not only knows the Complainant's marks but intends to benefit from their reputation as well. The website at the disputed domain name includes the Complainant's products and models to obtain gain from the Complainant's clients, by creating the misleading image that there is an affiliation with the Complainant. Such purposes include identity theft or hosting a copycat version of the complainant's website ([WIPO Overview 3.0](#), section 3.4).

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.

Moreover, panels have held that the use of a domain name for illegal activity such as impersonation/passing off or 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.

Based on the available record, 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 <thefrankieshops.com> be transferred to the Complainant.

/Ezgi Baklacı Gülkökar/

Ezgi Baklacı Gülkökar

Sole Panelist

Date: December 26, 2023