

## **ADMINISTRATIVE PANEL DECISION**

ABG-Frye, LLC v. dfh set  
Case No. D2022-1682

### **1. The Parties**

The Complainant is ABG-Frye, LLC, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is dfh set, China.

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

The disputed domain name <thefryecompany.store> (the “Domain Name”) is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2022. On May 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 17, 2022 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 May 17, 2022.

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 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 14, 2022.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on June 20, 2022. 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 are undisputed.

The Complainant is a limited liability company, headquartered in New York, New York, United States. The Complainant's history dates back to 1863 when John A. Frye opened his first store. The Complainant ever since designs, produces and sells footwear, apparel, bags and other accessories. The Complainant uses the domain name <thefryecompany.com> as its official website.

The Complainant is the owner of several trademark registrations comprising of the word element FRYE, including, but not limited to the European Union trademark, FRYE (word mark), with registration No. 004236923 and with a registration date of December 19, 2006, for goods and services in classes 18, 25 and 35, and the United States trademark, FRYE (word mark), with registration No. 76434885 and with a registration date of September 20, 2005, for goods in class 3 (together in singular also referred to as the "FRYE Trademark").

The Domain Name was registered on March 16, 2022. The Domain Name resolves to a website (the "Website"), displaying the FRYE Trademark and promoting and selling goods, such as shoes, bags and accessories, at heavily discounted prices.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends the following:

The Complainant's brand has become an American icon, outfitting many of the world's biggest names from Jackie O. to John Lennon. The brand is a longtime favorite brand of rock stars and celebrities alike. The Complainant spends millions of dollars marketing its goods and services globally, using the FRYE Trademark, and has undertaken extensive efforts to protect its name and enforce such trademarks. The Complainant exerts careful control over use of the FRYE Trademark and imposes strict quality control measures over goods and services offered in connection with the FRYE Trademark. The Complainant further protects the FRYE Trademark by diligently pursuing infringers.

The Domain Name is identical or at least confusingly similar to the FRYE Trademark. More specifically, the Domain Name consists of the FRYE Trademark in its entirety and only adds the article "the" and the descriptive term "company". Therefore, the FRYE Trademark is recognizable within the Domain Name.

The Respondent has no rights or legitimate interests in regard to the Domain Name. The Respondent is not commonly known by the Domain Name and is not affiliated with the Complainant in any way. Additionally, the Respondent has not secured a license to use the FRYE Trademark. Nor has the Respondent obtained any other authorization and never requested such permission to use the FRYE Trademark. Furthermore, the Respondent uses the Website to offer counterfeit products for sale. Such use cannot constitute a *bona fide* offering of goods and services.

Moreover, the Domain Name has been registered and used in bad faith. The Respondent registered the Domain Name with prior knowledge of the FRYE Trademark. This is because the Respondent's Website offers counterfeit products under the FRYE Trademark for sale. Therefore, there is no plausible explanation

other than that the Respondent must have been aware of the Complainant's rights and activities. By doing so, the Respondent intentionally attempts to attract Internet users to its Website for commercial gain. Moreover, the Respondent uses a privacy shield to register the Domain Name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith

### **A. Identical or Confusingly Similar**

The Complainant has sufficiently proven to have rights in the FRYE Trademark.

The Domain Name consists of the FRYE Trademark in its entirety, to which the Respondent added the article "the" and the descriptive term "company".

As set out in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, the addition of other terms would not prevent a finding that a domain name is confusingly similar to the relevant mark for purposes of the first element.

The FRYE Trademark is clearly recognizable in the Domain Name and the addition of the article "the" and the descriptive term "company" does not prevent a finding of confusing similarity between the Complainant's trademark and the Domain Name.

Accordingly, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant in its Complaint has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name.

The Panel could not find any evidence by referring to the types of evidence set forth in paragraph 4(c) of the Policy from which the Panel may conclude that the Respondent has rights or legitimate interests in the Domain Name, such as:

(i) use or preparation to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services prior to notice of the dispute; or

(ii) being commonly known by the Domain Name (as an individual, business or other organization) even if the Respondent has not acquired any trademark or service mark rights; or

(iii) making legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interest in the Domain Name. However, the Respondent has not presented evidence of any rights or legitimate interest it may have in the Domain Name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

The Complainant has asserted that the Respondent cannot be commonly known by the Domain Name and that the Respondent is not in any way affiliated with the Complainant. More specifically, the Respondent has not been licensed or otherwise permitted by the Complainant to use the FRYE Trademark.

The Respondent has also not put forward any evidence that would support the claim that the Respondent has used or made preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

To the contrary, the Respondent uses the Website to offer products for sale at heavily discounted prices under the FRYE Trademark. The Complainant asserts that those products sold on the Website appear to be counterfeit FRYE goods, to which has not been rebutted by the Respondent. In accordance with section 2.13.1 of the [WIPO Overview 3.0](#) the use of a domain name for illegitimate activity, such as the sale of counterfeit goods, can never confer rights or legitimate interest on a respondent.

Hence, the Respondent's use can not be considered a legitimate noncommercial or fair use of the Domain Name either.

The Panel, therefore, finds that the second element has been satisfied.

### **C. Registered and Used in Bad Faith**

The Panel finds that the Respondent has registered and used the Domain Name in bad faith and refers to its consideration under section 6.B. above.

In light of the evidence filed by the Complainant, the Panel finds that the FRYE Trademark and the Complainant's activities are well known. The Complainant is owner of numerous trademarks which are being used and were registered many years before the Domain Name was registered. Furthermore, the Complainant has heavily invested in its global marketing strategy and the protection of its intellectual property. In addition to this, the Panel considers the fact that for its official website the Complainant uses the domain name <thefryecompany.com> for the offering of FRYE products, and the Domain Name is almost identical to the Complainant's domain name. Accordingly, in the Panel's view, the Respondent must have been aware of the existence of the Complainant's activities and rights at the time the Respondent registered the Domain Name. Moreover, using the Domain Name for a Website that appears to offer counterfeit products must be considered bad faith, and no Response has been filed. It can therefore also not lead to any other plausible conclusion other than that the Respondent has registered and used the Domain Name in bad faith.

As a result, the Respondent has registered and is using the Domain Name to intentionally attract Internet users for commercial gain to its website by creating a likelihood of confusion with the Complainant's FRYE Trademark as to the source, sponsorship, affiliation or endorsement of the Website or the products that are being offered for sale on the Website. Furthermore, in accordance with section 3.1.4 of the [WIPO Overview 3.0](#), the use of a domain name for *per se* illegitimate activity, such as the sale of counterfeit goods, is manifestly considered evidence of bad faith.

Finally, although the lack of a formal or substantive response by the Respondent as such cannot by itself lead to the conclusion that there is registration and use in bad faith, the cumulative circumstances as outlined in the Decision are sufficient for the Panel to find that the registration and use of the Domain Name by the Respondent is in bad faith.

In light of the above circumstances, the Panel is satisfied that the third element of the Policy is met and that the Domain Name has been registered and used 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 Domain Name, <thefryecompany.store>, be transferred to the Complainant.

*/Willem J. H. Leppink/*

**Willem J. H. Leppink**

Sole Panelist

Date: July 4, 2022