

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Linda Barnes

Case No. D2023-3816

1. The Parties

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

Respondent is Linda Barnes, United States.

2. The Domain Name and Registrar

The disputed domain name <thefrankieshop.shop> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2023. On September 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 14, 2023, 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 Complainant on September 14, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed two amendments to the Complaint on September 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 Respondent of the Complaint, and the proceedings commenced on September 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 11, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 13, 2023.

The Center appointed John C. McElwaine as the sole panelist in this matter on October 20, 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

- Complainant is a United States-based online retail store featuring women's clothing and accessories. Relevant to this matter, Complainant owns United States trademark registration no. 7028712, registered on April 18, 2023; and
- International trademark registration no. 1648994, registered on October 21, 2021.

Complainant's trademark rights are referred to herein as "THE FRANKIE SHOP Mark."

On June 30, 2023, Respondent registered the Domain Name with the Registrar. The Domain Name resolves to a functioning website that displays Complainant's THE FRANKIE SHOP trademark, as well as, uses images owned by Complainant to sell women's clothing and accessories.

5. Parties' Contentions

A. Complainant

As background, Complainant asserts that it is well-known company that specialized in the sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes, and cosmetics under the brand name "THE FRANKIE SHOP" through its websites located at the domain names <eu.thefrankieshop.com> and <thefrankieshop.com>.

With respect to the first element of the Policy, Complainant asserts that it is the owner of several trademark registrations in various jurisdictions globally. For example, an International trademark registration for THE FRANKIE SHOP, registration number 1648994, designating Australia, European Union, Brazil, United States, Mexico, China, Singapore, Republic of Korea, Japan, Malaysia, New Zealand, Russian Federation, Türkiye, Ukraine, Switzerland and United Kingdom, registered on October 12, 2021 in classes 03, 04, 09, 14, 18, 25 and 35; a French trademark application for "THE FRANKIE SHOP", application number 4762800, filed on May 4th, 2021 in classes 03, 04, 09, 14, 18, 25 and 35; and a United States trademark registration for "THE FRANKIE SHOP" Application Serial No. 97050056, filed on September 28th, 2021 in class 35. In addition, Complainant alleges that it owns multiple domain names containing THE FRANKIE SHOP trademark and provided evidence that Complainant and its THE FRANKIE SHOP trademark were featured in multiple online magazine articles. Complainant further points out that the Domain Name consists of Complainant's identical THE FRANKIE SHOP Mark and is thus confusingly similar.

With respect to the second element of the Policy, Complainant alleges that Respondent is not affiliated with Complainant and has not been authorized by Complainant to use THE FRANKIE SHOP Mark or to proceed with the registration of the Domain Name. Complainant further alleges that Respondent is neither a licensee nor a third party authorized to use THE FRANKIE SHOP Mark. Instead, Complainant asserts that the Domain Name resolves to a website that reproduces Complainant's THE FRANKIE SHOP Mark, as well as the name of its products and photographs of its products and models. Complainant also alleges that Respondent's website offers counterfeited products at very substantially discounted prices. Based upon these allegations, Complainant asserts that Respondent cannot have any legitimate interests in the Domain Name.

With respect to the third element of the Policy, Complainant asserts that bad faith registration of a domain name can be established if Respondent "knew or should have known" of Complainant's trademark rights and nevertheless registered a domain name for which it had no right or legitimate interest. Complainant alleges that in the present case, Respondent's use of the Domain Name for the infringing website demonstrates that it was aware of Complainant's prior rights when it registered the Domain Name. Complainant also re-alleges that Domain Name resolves to a website that reproduces Complainant's prior trademarks as well as the photographs and products' names and that Respondent's use of the Domain Name for such activity, clearly with a view to commercial gain, amounts to bad faith use.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4 of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

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

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); and *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules and applicable principles of law, the Panel's findings on each of the above cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. In this matter, the Panel finds that Complainant has sufficiently established that it has registered trademark rights in its THE FRANKIE SHOP Mark.

The Domain Name is identical to THE FRANKIE SHOP Mark in which Complainant has established valid trademark rights. The Top-Level Domain ("TLD") of the disputed domain name, in this case ".shop", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1. Therefore, Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Complainant need only make a *prima facie* showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); and *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

In this matter, Complainant has alleged that Respondent was not authorized to use THE FRANKIE SHOP Mark or to register the Domain Name. Complainant further alleges that Respondent is not affiliated with Complainant or a licensee and that the website that resolves from the Domain Name is infringing upon its trademarks and other third-party trademarks and has used Complainant's images without authorization.

Respondent has been properly notified of the Complaint by the Center; however, Respondent failed to submit any response concerning these serious accusations. As such, Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name.

Although Complainant has satisfied its burden, Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you of the dispute, your use of, or demonstrable 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a 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 Panel finds that Respondent has failed to show rights or legitimate interests under any of the three conditions.

As an initial matter, there is no evidence that Respondent is commonly known by the Domain Name, as the Registrar disclosed Respondent as “Linda Barnes”. Respondent cannot rely upon paragraph 4(c)(ii) of the Policy.

The Panel also finds that Respondent’s use is not legitimate use of the Domain Name. Respondent is using the Domain Name to resolve to a website allegedly engaged in trademark infringement and selling infringing or counterfeit goods, or may have been harvesting personal and financial information from consumers. [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”) In addition, the use of the Domain Name to divert Internet traffic to an infringing or misleading webpage is not a *bona fide* offering of goods or services. See *Chicago Mercantile Exchange Inc., CME Group Inc. v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Nikolay Korobeynikov*, WIPO Case No. [D2016-0654](#) (finding no legitimate interest in a website resolving from the disputed domain name, which mirrored, and purported to be, the website of “CME Group” and which provided information relating to the trading of futures and options). Even if the products sold on the website are genuine, there is no disclosure of Respondent’s lack of relationship with Complainant on the website, and thus, the Oki Data test cannot be met. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Lastly, Respondent’s use of the Domain Name is not noncommercial or fair use under paragraph 4(c)(iii) of the Policy, given that Respondent is allegedly selling counterfeit or competing products from an infringing online retail website. Such activity is not considered noncommercial or fair use. See, e.g., *Sermo, Inc. v. CatalystMD, LLC*, WIPO Case No. [D2008-0647](#).

Accordingly, for the reasons detailed above, Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent had the opportunity to put forth evidence of its rights or legitimate interests yet provided no substantive response as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a response and combined with the factors as detailed above, the Panel finds that Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent “knew or should have known” of a complainant's trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). As detailed above, Respondent registered the Domain Name which is confusingly similar to THE FRANKIE SHOP Mark. There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of Complainant's trademark or otherwise create a false association with Complainant. With no response from Respondent, this claim is undisputed.

As discussed herein, Respondent registered the Domain Name and linked it to a website using Complainant's THE FRANKIE SHOP Mark, including copies of Complainant's images to mimic the look and feel of Complainant's website. Complainant further alleges that Respondent is selling counterfeit clothing at discounted prices. This amounts to bad faith use of the Domain Name by Respondent. See *Identigene, Inc. v. Genetests Labs*, WIPO Case No. [D2000-1100](#) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); and *MathForum.com, LLC v. Weiguang Huang*, WIPO Case No. [D2000-0743](#) (finding bad faith under paragraph 4(b)(iv) of the Policy where the respondent registered a domain name confusingly similar to the complainant's mark and the domain name was used to host a commercial website that offered similar services offered by the complainant under its mark).

As detailed above, the Panel finds on the record before it that Respondent's intention in registering the Domain Name was to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with THE FRANKIE SHOP Mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of providing sufficient evidence that Respondent registered and is using the Domain Name in bad faith under paragraph 4(b)(iv) of the Policy.

For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) 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 Domain Name, <thefrankieshop.shop>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: November 3, 2023