

## **ADMINISTRATIVE PANEL DECISION**

Frankie Shop v. Lin Xiaofei  
Case No. D2023-4172

### **1. The Parties**

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

The Respondent is Lin Xiaofei, China.

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

The disputed domain name <thefrankieshopw.shop> is registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 6, 2023. On October 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on October 10, 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 the same date.

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 October 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 1, 2023.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on November 3, 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 company based in the United States, specialized in the sale of clothing, accessories, women's shoes and cosmetics under the brand THE FRANKIE SHOP.

The Complainant is the owner of several trademarks for THE FRANKIE SHOP and FRANKIE SHOP (the "FRANKIE SHOP trademark"), including:

- International Trademark Registration for the THE FRANKIE SHOP word mark No. 1648994, registered on October 12, 2021, for several jurisdictions, including European Union, China, New Zealand and United Kingdom;
- French Trademark Registration for the FRANKIE SHOP design mark No. 4338335, registered on June 9, 2017; and
- United States Trademark Registration for the FRANKIE SHOP word mark No. 5147070, registered on February 21, 2017.

The Complainant is also owner of several domain names including the FRANKIE SHOP trademark, such as the domain name <thefrankieshop.com>, registered on September 17, 2014.

The disputed domain name was registered on September 16, 2023 and it resolves to a website displaying the FRANKIE SHOP trademark and products as well as photographs of products identical to those on the Complainant's website.

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

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

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the Complainant's FRANKIE SHOP trademark. The disputed domain name includes the entire FRANKIE SHOP trademark, with only the addition of the letter "w". The FRANKIE SHOP trademark remains recognizable in the disputed domain name and the addition of the letter "w" does not prevent a finding of confusing similarity.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. To the Complainant's knowledge, the Respondent has no rights in the disputed domain name and has never acquired any prior rights on the terms "the frankie shop". Furthermore, the Respondent is in no way affiliated with the Complainant and has not been authorized by the Complainant to use the FRANKIE SHOP trademarks or to proceed with the registration of the disputed domain name. The Complainant does not know the Respondent and has never had any relationship with it. Moreover, the reproduction of the FRANKIE SHOP trademarks reveals a malicious intention to take advantage of the notoriety of the said trademarks. In addition, it is clear that the Respondent offers counterfeited products under the website of the disputed domain at heavily discounted prices. Such use has never been authorized by the Complainant and therefore cannot be the basis for *bona fide* use of a domain name.

On the third element of the Policy, the Complainant asserts that the Respondent registered and uses the disputed domain name in bad faith. In the present case, the Respondent could not have been unaware of the Complainant's prior rights when it registered the disputed domain name. The disputed domain name reproduces the FRANKIE SHOP trademarks. The only difference being the addition of a letter "w", which is not sufficient to distinguish the signs at issue. This therefore strongly suggests that the Respondent had the Complainant's prior rights in mind at the time of the registration of the disputed domain name. Further, the disputed domain name redirects to a website that reproduces the Complainant's trademarks as well as the photographs and products' names of the Complainant's websites. In addition, the Respondent offers counterfeited products under the website of the disputed domain name at heavily discounted prices. The use of the disputed domain name for such activity, clearly with a view to commercial gain, amounts to bad faith use.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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

The Complainant, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

Section 1.8 of [WIPO Overview 3.0](#) states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements." Further, section 1.11.1 of [WIPO Overview 3.0](#) states: "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".

The Complainant is registered as the owner of trademark the FRANKIE SHOP. Suitable evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the FRANKIE SHOP trademark.

The disputed domain name contains the FRANKIE SHOP trademark entirely with the addition of the letter “w”, as well as the gTLD “.shop”. The gTLD “.shop” will be disregarded in the Panel’s consideration of confusing similarity. The Panel finds that the relevant FRANKIE SHOP trademark within the disputed domain name is recognizable, so that the letter “w” does not prevent a finding of confusing similarity.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark, and that the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

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

The second element the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the second element of the Policy, section 2.1 of [WIPO Overview 3.0](#) states, “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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”. In addition, section 2.13.1 of [WIPO Overview 3.0](#) reads: “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 this case, the Respondent did not reply to the Complainant’s contentions. According to the Complaint, the Complainant has not authorized the Respondent to use the FRANKIE SHOP trademark, the Respondent is not commonly known by the disputed domain name, and the Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain name was registered. The Complainant asserts that the Respondent sells counterfeit products but omits to provide evidence showing why the products sold by the Respondent are counterfeit. While some circumstantial evidence, such as the significant, unusual discount prices, covering (almost) all products offered on the website, tends to suggest the Respondent is offering counterfeit products, the Panel need not come to a final determination on this matter. In any event, the website at the disputed domain name fails to disclose the lack of relationship between the Parties and the Panel finds that the composition of the disputed domain name, adding the term “w” to the FRANKIE SHOP trademark, coupled with the use of the disputed domain name resolving to a website displaying the FRANKIE SHOP trademark and products as well as photographs of products identical to those on the Complainant’s website, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant, as to the origin or affiliation of the website at the disputed domain name.

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent. The Panel therefore finds that the Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

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

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrate that the Respondent registered and is using the disputed domain name in bad faith.

Section 3.1 of [WIPO Overview 3.0](#) states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. Section 3.2.2 of the [WIPO Overview 3.0](#) reads: “Noting the near instantaneous and global reach of the Internet and search engines and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

Considering the public presence of the Complainant, it is unlikely that the Respondent had no knowledge of the FRANKIE SHOP trademark. The incorporation of the FRANKIE SHOP trademark within the disputed domain name as well as the fact that the disputed domain name resolves to a website displaying the FRANKIE SHOP trademark and products as well as photographs of products identical to those on the Complainant’s website, demonstrates the Respondent’s actual awareness of and intent to target the Complainant. In light of the lack of any rights to or legitimate interests in the disputed domain name by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract Internet users to its website or affect the commercial activities of the Complainant by creating a likelihood of confusion with the Complainant’s trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 disputed domain name <thefrankieshopw.shop> be transferred to the Complainant.

*/Christian Gassauer-Fleissner/*  
**Christian Gassauer-Fleissner**  
Sole Panelist  
Date: November 16, 2023