

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Nova Baumann
Case No. D2023-3819

1. The Parties

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

The Respondent is Nova Baumann, United States.

2. The Domain Name and Registrar

The disputed domain name <shopthefrankie.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 September 13, 2023. On September 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 14, 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 (Wilayah Persekutuan, MY) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 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 a first amended Complaint on September 15, 2023. In response to the Center's deficiency notice of September 18, 2023, the Complainant filed a second amended Complaint on September 20, 2023.

The Center verified that the Complaint together with the amended Complaints 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 September 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 11, 2023.

The Center appointed William F. Hamilton as the sole panelist in this matter on October 13, 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 organized under the laws of the United States that is active in the fashion industry.

The Complainant owns numerous country and international trademarks registrations for the trademarks FRANKIE SHOP and THE FRANKIE SHOP (collectively herein, the “Marks”), including United States Patent and Trademarks Office Registration No. 86416726 (FRANKIE SHOP), dated February 21, 2017, and No. 97050056 (THE FRANKIE SHOP), dated April 18, 2023.

The Complainant owns the domain name <thefrankieshop.com> which resolves to the Complainant’s official website, “www.thefrankieshop.com”, promoting the Complainant’s fashion products and related services.

The disputed domain name was registered on August 20, 2023. The Respondent resides in the United States according to information provided by the Registrar. The disputed domain name resolves to a website that reproduces photographs of the Complainant’s products and offers for sale counterfeited imitations of the Complainant’s products at discounted prices.

5. Parties’ Contentions

A. Complainant

The Complainant asserts the disputed domain name is confusingly similar to the Marks because the disputed domain name merely reorders the words composing the Marks. The Complainant asserts that the Complainant never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, never operated a business under the disputed domain name, has not advertised the disputed domain name, and never engaged in any *bona fide* commercial activity in connection with the disputed domain name. The Complainant asserts that the Respondent obviously knew of the Marks and used the disputed domain name in bad faith to sell counterfeit products.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s Marks.

The disputed domain name is confusingly similar to the Marks because the disputed domain name consists of the Marks in its entirety, merely re-sequencing the words of the Marks. The disputed domain name wholly incorporates all the elements of the Complainant's trademark THE FRANKIE SHOP. The disputed domain name wholly incorporates all the elements of the Complainant's trademark FRANKIE SHOP while merely adding the article "the." The Marks are clearly recognizable in the disputed domain name notwithstanding the altered sequences of the Marks' words. *The Frankie Shop LLC v. Domain Protection Services, Inc. / My Mo*, WIPO Case No. [D2022-0825](#); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8 ("where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element").

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. See [WIPO Overview 3.0](#), section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. [D2016-1759](#).

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel finds on the evidence presented that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Marks. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. The Complainant has established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.3.

The disputed domain name will likely confuse unsuspecting Internet users into believing the disputed domain name will resolve to websites associated, sponsored, or affiliated with the Complainant. Such association seems to have been the intent of the Respondent given the Respondent's purported sale of counterfeit products at its website. While the genuine nature of the goods offered is in question, the impersonating nature of the disputed domain name preempts the Panel from needing to reach any conclusion on said nature of the goods. For instance, the selection of the TLD ".shop" seems purposeful given its descriptive function of the retail industry in which the Complainant operates. Given the risk of implied affiliation found in the inherently deceptive disputed domain name construction, compounded by the impersonating website content that lacks any disclaimer, the Respondent cannot be said to be engaging in fair use nor have rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), sections 2.5.1 and 2.8.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following non-exhaustive scenarios:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's Marks as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds on the evidence presented that the disputed domain name was registered and used in bad faith. Given the construction and use of the disputed domain name, both of which feature the entirety of the Marks, it is clear that the Respondent knew of, and purposefully targeted, the Complainant when registering the disputed domain name. Further, the Respondent has clearly used the confusingly similar disputed domain name to attract Internet visitors to the Respondent's website. In short, it is beyond any reasonable doubt that the Respondent has attempted to attract Internet users to the Respondent's website by using the disputed domain name that is confusingly similar to the Complainant's Marks to create a likelihood that Internet users will believe that the disputed domain names will resolve to a website offering the Complainant's products. This illicit use of the disputed domain name is paradigmatic evidence of bad faith registration and use. *Dm-Drogerie Markst GmbH & Co. KG v. WhoisGuard Protected, WhoisGuard, Inc. / Charlotte Meilleur*, WIPO Case No. [D2018-1248](#); *The Frankie Shop LLC v. Domain Protection Services, Inc. / My Mo*, WIPO Case No. [D2022-0825](#).

The Complainant has met its burden 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 disputed domain name <shopthefrankie.shop> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: October 27, 2023