

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Hahn Tim, Tim Hahn
Case No. D2024-4956

1. The Parties

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

The Respondent is Hahn Tim, Tim Hahn, Germany.

2. The Domain Names and Registrar

The disputed domain name <thefrankieshop-de.com> (the "Disputed Domain Name") is registered with Hongkong Kouming International Limited (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 2, 2024. On December 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 3, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on December 3, 2024, providing the registrant and contact information disclosed by the Registrar. The Complainant filed an amendment to the Complaint in English on December 4, 2024.

On December 3, 2024 the Center informed the parties in Chinese and English, that the language of the Registration Agreement for the Disputed Domain Name is Chinese. On December 4, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Chinese, and the proceedings commenced on December 6, 2024. In accordance

with the Rules, paragraph 5, the due date for Response was December 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 27, 2024.

The Center appointed Andrew Sim as the sole panelist in this matter on January 6, 2025. 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 New York State limited liability company, having its registered head office in the USA. The Complainant is a company specialized in the sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes and cosmetics under the brand name "THE FRANKIE SHOP" (the "Brand Name") and other third party brands across the world including notably New Zealand, the United Kingdom, the European Union, Canada, Switzerland, Australia, South Africa, United Arab Emirates, Israel, Türkiye, Brazil, Argentina, Kuwait, Chile, Japan, Peru, Mexico, Colombia and Uruguay, through the websites "eu.thefrankieshop.com" and "thefrankieshop.com", the latter being the global official website of the Complainant (the "Global Website").

The Complainant holds several registered trademarks for the Brand Name (the "THE FRANKIE SHOP Trademark") in various jurisdictions.

Jurisdiction	Mark	Registration Number	Registration Date	Class(es) Covered	Status
France	THE FRANKIE SHOP	4762800	May 4, 2021	3, 4, 9, 14, 18, 25, and 35	Registered
USA	THE FRANKIE SHOP	97050056	April 18, 2023	35	Registered
International (designating China and European Union, among others)	THE FRANKIE SHOP	1648994	October 12, 2021	3, 4, 9, 14, 18, 25, and 35	Registered

The evidence submitted by the Complainant, in form of printouts of online fashion magazines and/or articles featuring the Brand Name as well as an Instagram account with 1.2 million followers which uses "thefrankieshop" as its account name and the THE FRANKIE SHOP Trademark as its profile picture, demonstrates that the Complainant and the THE FRANKIE SHOP Trademark enjoy a high degree of fame throughout the world.

The Complainant claims that it owns a number of domain names associated with the Brand Name and the THE FRANKIE SHOP Trademark, which are primarily composed of the words "FRANKIE" or "FRANKIE SHOP".

Most notably, the Complainant owns and maintains the primary domain name <thefrankieshop.com>, being composed entirely of the THE FRANKIE SHOP Trademark and a generic Top-Level Domain ("gTLD") ".com", since September 2014. The <thefrankieshop.com> domain name redirects to the Global Website, which displays information about the Complainant's businesses, offerings, store locations, and promotional and other corporate material.

As for the other “FRANKIE”- or “FRANKIE SHOP”-formative domain names listed in the Complaint that are allegedly owned by the Complainant, upon the Panel’s own visits, all of which, with the exception of <artfrankieshop.fr> which redirects to the Global Website, appear to be idling and unclaimed. Annex E3 enclosed with the Complaint could not prove that these idling domain names are owned by the Complainant. Therefore, for the purpose of this decision, the Panel will disregard these idling domain names.

The Disputed Domain Name was registered on October 18, 2024.

Based on the Complainant’s evidence, upon visiting the Disputed Domain Name, it resolves to a website (the “Respondent’s Website”) in the German language that reproduces some of the Global Website’s product offerings and photographs of its products and models. The products on the Respondent’s Website are purportedly counterfeit and are offered at a substantially discounted price. The THE FRANKIE SHOP Trademark is also featured prominently at the top of the Respondent’s Website.

Little information is known about the Respondent. Available information provided by the Registrar covers only the registrant’s name, postal address, telephone number, fax number, and email 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.

First, the Complainant contends that the Disputed Domain Name is confusingly similar to the Complainant’s THE FRANKIE SHOP Trademark, as it is composed of an exact reproduction of the THE FRANKIE SHOP Trademark. The only differences between the Complainant’s THE FRANKIE SHOP Trademark and the Disputed Domain Name are the insertions of the geographic description “-de”, which refers to Deutschland (i.e., Germany), and the gTLD “.com”. It is contended that the word “frankie” has no meaning in either English or French. The Disputed Domain Name incorporates the distinctive terms of the Complainant’s prior THE FRANKIE SHOP Trademark.

Second, the Complainant contends that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has no right in the THE FRANKIE SHOP Trademark and has never acquired any prior rights in this wording. The Respondent is not affiliated with the Complainant and has not been authorized/licensed by the Complainant to use the THE FRANKIE SHOP Trademark and/or to register the Disputed Domain Name which incorporates the same. The Complainant does not know the Respondent and has no prior relationship with him. The Respondent’s Website, which displays the THE FRANKIE SHOP Trademark, identical images as on the Global Website and counterfeit products, demonstrates the Respondent’s malicious intention to take advantage of the fame of the THE FRANKIE SHOP Trademark and/or to deceive and divert the Complainant’s consumers.

Third, the Complainant contends that the Disputed Domain Name was registered and is being used in bad faith. The Complainant reiterates its rights in, and the worldwide reputation attached to the THE FRANKIE SHOP Trademark. In comparison, the Respondent has neither the rights nor a legitimate interest in the Disputed Domain Name. At the time of registration, the Respondent knew or should have known the Complainant’s rights in the prior THE FRANKIE SHOP Trademark. Bad faith can also be inferred by the Respondent’s Website which offers counterfeit products at substantially discounted prices.

The Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including:

- (a) The Complainant is a USA entity, and English is the main language of communication for the Complainant;
- (b) English language is the language the most widely used in international relations and is one of the working languages of the Center;
- (c) The Disputed Domain Name has been registered in Latin, rather than Chinese, which indicates a familiarity on the part of the Respondent with European languages;
- (d) The Respondent's Website is in the German language, and English is widely used in Germany;
- (e) The currency used on the Respondent's Website is the Euro, not the Chinese Yuan;
- (f) The Respondent is domiciliated in Germany, a country in which English is spoken fluently by its inhabitants; and
- (g) The Complainant is unable to communicate in Chinese. Requiring the Complainant to submit documents in Chinese would lead to delay and cause the Complainant to incur translation expenses.

The Respondent did not make any submissions with respect to the language of the proceeding. This is despite the fact that the Center had sent the notification of the Complaint which includes instructions on the language of the proceeding to the Respondent in both Chinese and English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

Paragraph 4(a) of the Policy states that, in an administrative proceeding, the Complainant must prove each of the following three elements:

- (a) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered and is being using in bad faith.

For the below reasons, support for the Complaint can be found due to the satisfaction of the three conditions for the Disputed Domain Name.

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 trademarks and the Disputed Domain Name. [WIPO Overview 3.0](#), section 1.7.

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 entirety of the THE FRANKIE SHOP Trademark is reproduced within the Disputed Domain Name. Although the additions of the geographical term “-de” and the gTLD “.com” following the THE FRANKIE SHOP Trademark may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the Disputed Domain Name and the THE FRANKIE SHOP Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Accordingly, the Disputed Domain Name is confusingly similar to the Complainant's THE FRANKIE SHOP Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. 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.

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.

From the overall appearance of the Respondent's Website as described in section 4 above, the Panel finds that it is intended to mislead customers in believing that it is a legitimate website of the Complainant. From the Complainant's assertions, particularly the facts that the Respondent has misappropriated images from the Global Website and that the goods are offered disproportionately below market value, which have not been rebutted by the Respondent, there is also a credible case that the products sold on the Respondent's Website are counterfeit versions of those from the Complainant. [WIPO Overview 3.0](#), section 2.13.2.

According to previous UDRP decisions, the use of a domain name for illegitimate and/or illegal activity, such as impersonation and the sale of counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Particularly in regard to the three illustrative examples of legitimate interests in paragraph 4(c) of the Policy, the Panel finds that:

- (i) the Respondent has not used the Disputed Domain Name in connection with a bona fide offering of goods and services, as it displays a misleading website pretending to be a legitimate website of the Complainant, offering counterfeit versions of the Complainant's products bearing the THE FRANKIE SHOP Trademark instead of any original products offered by the Respondent;
- (ii) the Disputed Domain Name does not correspond with the Respondent's name (i.e., "Hahn Tim, Tim Hahn"), and there is no evidence of the Respondent operating any business or organization with similar name as the Disputed Domain Name; and
- (iii) the Respondent's use of the Disputed Domain Name does not fall within the scope of legitimate noncommercial or fair use, as the Respondent's Website clearly has the effect of misleadingly diverting customers from the Complainant.

The Panel also finds that the Respondent has no rights or legitimate interests to use the Complainant's THE FRANKIE SHOP Trademark.

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.

The Panel finds that the circumstances of registering and using the Disputed Domain Name clearly demonstrate the Respondent's bad faith and have constituted the situation as specified in paragraph 4(b)(iv) of the Policy:

- (a) The Complainant's THE FRANKIE SHOP Trademark has been internationally registered, designating, among others, the European Union and, by inclusion, Germany (at which the Disputed Domain Name is intended to target, based on the insertion of the geographical term "de" and the content of the Respondent's Website) before the Respondent's registration of the Disputed Domain Name which is confusingly similar to the Complainant's THE FRANKIE SHOP Trademark, and also similar to its primary domain name <thefrankieshop.com>;
- (b) Based on the content of the Respondent's Website and the Complainant's evidence as to its international reputation, the Panel finds that the Respondent must have had actual knowledge of the Complainant (and the THE FRANKIE SHOP Trademark) at the time of registering the Disputed Domain Name;
- (c) As earlier found in section 6.2 above that the products offered on the Respondent's Website are counterfeit and that the Respondent's Website is intended to impersonate a legitimate website of the Complainant, bad faith is manifestly apparent. [WIPO Overview 3.0](#), section 3.1.4; and
- (d) There is no reasonable connection or association between the Respondent and the Disputed Domain Name.

Inference of bad faith is also drawn in accordance with paragraph 14(b) of the Rules for the Respondent's failure to file a response as required in paragraph 5(a) of the Rules in the absence of exceptional circumstances.

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 <thefrankieshop-de.com> be transferred to the Complainant.

/Andrew Sim/

Andrew Sim

Sole Panelist

Date: January 27, 2025