

ADMINISTRATIVE PANEL DECISION

Frankie Shop LLC v. Johnny G Everett
Case No. D2025-0061

1. The Parties

Complainant is Frankie Shop LLC, United States of America, represented by Coblenche Avocats, France.

Respondent is Johnny G Everett, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <thefrankieshopus.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 8, 2025. On January 8, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2025, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to Complainant on January 10, 2025, providing the additional registrant and contact information disclosed by the Registrar.

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 January 13, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2025. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on February 9, 2025.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on February 12, 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

Complainant is a limited liability company (LLC) registered in the State of New York, United States. Complainant specializes in the marketing and sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes, and cosmetics using the trademark THE FRANKIE SHOP, as well as third party brands. Complainant markets and sells its products in brick-and-mortar retail shops in select locations, and online at its principal websites located at "https://eu.thefrankieshop.com/" and "https://thefrankieshop.com/." Complainant has provided evidence that its trademark and products are well known within the fashion sector.

Complainant is the owner of registration for the word trademark THE FRANKIE SHOP on the register of the French Institut National de la Propriete Industrielle (INPI), registration number 4762800, registration dated May 4, 2021, in international classes (ICs) 3, 4, 9, 14, 18, 25 and 35, covering, inter alia, clothing, footwear, jewelry, and retail services for a range of related products. Complainant is the owner of an international trademark registration for the word trademark THE FRANKIE SHOP under the Madrid System, registration number 1648994, registration dated October 12, 2021, in ICs 3, 4, 9, 14, 18, 25 and 35, designating a substantial number of countries (or regions), including (but not limited to) Australia, the European Union, Brazil, the United States, Mexico and China. Complainant is the owner of registration for the word trademark THE FRANKIE SHOP on the Principal Register of the United States Patent and Trademark Office (USPTO), registration number 97050056, registration dated April 18, 2023, in IC 35, covering computerized on-line retail store services in the field of clothing, as further specified.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to the Whois record, the disputed domain name was registered on November 15, 2024. There is no evidence on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since its initial creation date.

Respondent has used the disputed domain name to direct Internet users to a website headed with Complainant's THE FRANKIE SHOP trademark, and prominently offering a range of clothing and accessory products labeled with Complainant's trademark (among other brands). Text on the website includes statements such as "UPGRADE YOUR WARDROBE WITH FRANKIE SHOP'S SALE" AND "THE FRANKIE SHOP WEEKLY DISCOUNT PRODUCTS". Complainant indicates that Respondent's website includes products and photographs of Complainant's products and fashion models. The prices for the products listed on Respondent's website are very substantially lower than comparable prices shown on Complainant's website. Complainant advises that the products offered by Respondent are counterfeit.

There is no affiliation, commercial or otherwise, between Complainant and Respondent.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that it owns rights in the trademark THE FRANKIE SHOP and that the disputed domain name is confusingly similar to the trademark.

Complainant argues that Respondent lacks register legitimate interest in the disputed domain name because: (1) Respondent has not been authorized to use Complainant's trademark in the disputed domain name or otherwise; (2) Respondent has no rights in the name "THE FRANKIE SHOP" and has never acquired any prior rights on this wording, and; (3) Respondent's use of the disputed domain name to host a website offering counterfeit versions of Complainant's products does not constitute bona fide use of the disputed domain name.

Complainant alleges that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent must have been aware of Complainant's distinctive trademark when it registered the disputed domain name given its adoption of an identical term differing only by the addition of a geographic abbreviation; (2) a simple Internet search or trademark registry search would have immediately notified Respondent Complainant and its trademark; (3) Respondent's use of the disputed domain name for a website offering counterfeit versions of Complainant's products constitutes use of Complainant's trademark to confuse Internet users for commercial gain regarding an association between Respondent and Complainant.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration. Courier delivery to the physical address provided by Respondent in its record of registration was successful. There is no indication of difficulties in email transmission to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

(i) the disputed 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 disputed domain name; and

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

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 Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

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 mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "us", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 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 Respondent. As such, where Complainant, as here, makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on Complainant). If Respondent, as here, fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds that Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

Respondent’s registration and use of the disputed domain name to direct Internet users to a website headed with Complainant’s trademark and offering unauthorized and presumptively (unrebutted) counterfeit goods does not constitute bona fide preparations for use, or use, of Complainant’s trademark, and Respondent is not engaged in legitimate noncommercial or fair use of Complainant’s trademark.

Panels have held that the use of a domain name for illegitimate and illegal activity, as claimed here the sale of presumptively (unrebutted) counterfeit goods and impersonation/passing off, can never confer rights or legitimate interests on Respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, the Panel notes that Respondent manifestly targeted Complainant and its distinctive trademark, including by creating a website designed to appear as operated by or with the consent of Complainant and offering goods that replicate Complainant’s branded products without authorization. Respondent could not have been unaware of Complainant and its trademark when it registered and used the disputed domain name.

Respondent for commercial gain is using the disputed domain name that is confusingly similar to Complainant’s trademark to create a likelihood of confusion for Internet users regarding Complainant acting as the source, sponsor, affiliate or endorser Respondent’s website. Such conduct and the associated offering and sale of presumptively (unrebutted) counterfeit products demonstrates bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Respondent has made no effort to justify its conduct.

Panels have held that the use of a domain name for illegitimate and illegal activity, as claimed here, the sale of presumptively (unrebutted) counterfeit goods and impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that 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 <thefrankieshopus.com> be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: February 26, 2025