

## **ADMINISTRATIVE PANEL DECISION**

Frankie Shop LLC v. Karin Dieter, Karin Dieter  
Case No. D2025-0183

### **1. The Parties**

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

The Respondent is Karin Dieter, Karin Dieter, Germany.

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

The disputed domain name <frankieshopaustralia.com> 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 January 17, 2025. On January 17, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 18, 2025, 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 (Domain Admin) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 20, 2025, 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 January 22, 2025.

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 January 22, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 11, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 12, 2025.

The Center appointed Taras Kyslyy as the sole panelist in this matter on February 14, 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 company specialized in the sale of clothing, accessories (leather goods, jewelry, etc.), women's shoes, cosmetics under the brand name "THE FRANKIE SHOP" and under third party brands across the world including notably New Zealand, the United Kingdom, the European Union ("EU"), Canada, Switzerland, Australia, South Africa, United Arab Emirates, Israel, Türkiye, Brazil, Argentina, Kuwait, Chile, Japan, Peru, Mexico, Colombia, Uruguay, through its websites <eu.thefrankieshop.com> and <thefrankieshop.com>.

The Complainant owns trademark rights for its THE FRANKIE SHOP mark worldwide including for instance International trademark registration No. 1648994, registered on October 12, 2021, designating also the EU.

The Complainant also owns dozens of domain names featuring its mark.

The disputed domain name was registered on November 27, 2024, and at the time of filing the Complaint did not resolve to any active website.

#### **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.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name is composed of an exact reproduction of the two words "frankie" and "shop" included in the Complainant's trademark. The suffix ".com" cannot be taken into account in the comparison between the Complainant's trademark and the disputed domain name. The addition of a geographical term is not such as to avoid the confusing similarity between the signs at issue. The addition of the geographical term "australia" is not such as to avoid the confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no rights in the name "The Frankie Shop" or "Frankie Shop" and has never acquired any prior rights on this wording. Furthermore, the Respondent is in no way affiliated with the Complainant and has not been authorized by the Complainant to use its prior trademarks or to proceed with the registration of the disputed domain name. The Respondent is neither a licensee nor a third party authorized to use the trademarks, including in the disputed domain name. The Complainant does not know the Respondent and has never had any relationship with it. The fact that the disputed domain name redirected to an inactive website is not evidence of a bona fide service or offering of goods. On the contrary, it appears that the Respondent clearly intended to take advantage of the use of the disputed domain name whose resemblance to the Complainant's trademark is confusing. Such use has never been authorized by the Complainant and therefore cannot be the basis for bona fide use of the disputed domain name.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith.

The Respondent could not have been unaware of the Complainant's trademark rights when it registered the disputed domain name. The disputed domain name reproduces the Complainant's trademarks with minor differences which are not sufficient to distinguish the disputed domain name. This therefore suggests that the Respondent had the Complainant's prior rights in mind at the time of the registration of the disputed domain name. The Complainant has a significant reputation in the world. The registration of the disputed domain name incorporating the Complainant's trademark knowingly can be considered as carried out in bad faith, the notoriety of the reproduced trademark is a clear indication of bad faith.

The Respondent deliberately registered the confusingly similar disputed domain name with the intent to divert Internet users from the Complainant's website to the Respondent's page.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 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.

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 Panel finds the dominant part of the mark is recognizable 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, "australia", may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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 applicable generic Top-Level Domain ("gTLD") 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. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated bona fide or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The composition of the disputed domain name carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

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 the Respondent registered the disputed domain name confusingly similar to the Complainant's distinctive trademark and the disputed domain name is inactive.

In the present case, considering the (i) degree of the Complainant's trademarks' reputation, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use and (iii) the implausibility of any good faith use to which the domain name may be put, the non-use of the disputed domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

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 <frankieshopaustralia.com> be transferred to the Complainant.

/Taras Kyslyy/

**Taras Kyslyy**

Sole Panelist

Date: February 20, 2025