

## **ADMINISTRATIVE PANEL DECISION**

The Frankie Shop LLC v. xi bing  
Case No. D2023-3311

### **1. The Parties**

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

The Respondent is xi bing, China.

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

The disputed domain name <the-frankie.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2023. On August 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 3, 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 (Redacted For Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 3, 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 in English on August 3, 2023.

On August 3, 2023, the Center sent an email communication to all Parties in Chinese and English regarding the language of the proceeding. On August 3, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on August 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 11, 2023. The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on September 19, 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 incorporated in New York, United States of America ("United States"), in May 2015. It specializes in the marketing of clothes, bags, cosmetics, and jewelry. It operates a website at "www.thefrankieshop.com" commercializing its products under the mark THE FRANKIE SHOP.

The Complainant is the proprietor of International trademark number 1648994 THE FRANKIE SHOP registered on October 12, 2021 designating a number of jurisdictions including China, the United Kingdom and the United States. In addition, a director of the Complainant is the proprietor of a number of registered trademarks comprising "Frankie", including French trademark number 4338335 for figurative mark FRANKIE SHOP registered on February 15, 2017 and United States trademark number 86416726 for FRANKIE SHOP registered on February 21, 2017.

The disputed domain name was registered on registered on November 10, 2022. Based on the Complainant's evidence, it previously resolved to a website prominently displaying the mark THE FRANKIE SHOP on the home page and offering for sale what purport to be the Complainant's products at heavily discounted prices.

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

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

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademarks for THE FRANKIE SHOP, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its trademarks are intensively used and provides printouts of its official website and of its marketing and related materials. The Complainant also refers to several prior decisions under the Policy which have recognized the reputation of the Complainant and its trademarks (see for instance *Frankie Shop LLC v. Jie Wen*, WIPO Case No. [D2022-4197](#) and *Frankie Shop LLC v. Domain Protection Services Inc. / My Mo*, WIPO Case No. [D2022-0825](#)). Moreover, the Complainant provides evidence that the disputed domain name is linked to an active website, which the Respondent is operating as an e-commerce website, selling what the Complainant presumes to be counterfeit products, due to their heavily discounted price and the lack of disclaimer and false suggestions of affiliation. In this context, the Complainant also essentially argues that the Respondent is unlawfully misrepresenting its website as operated by the Complainant, by using the Complainant's trademarks and product images. The Complainant essentially contends that the registration and use of the disputed domain name in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 the fact that the website linked to the disputed domain name itself is in the English language and that the disputed domain name has been registered in Latin, rather than Chinese script, which indicates a familiarity on the part of the Respondent with European languages.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

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.

### **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 3.0](#), section 1.7.

Based on the available record, the Panel finds 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 that the dominant feature of the Complainant's trademark THE FRANKIE SHOP is clearly 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. The Panel also finds that the hyphen may be disregarded as it is considered merely a punctuation mark (see also *Accor and SoLuxury HMC v. YinSi BaoHu Yi KaiQi (Hidden by Whois Privacy Protection Service) / Lin Qing Feng*, WIPO Case No. [D2016-1262](#)).

Based on the available record, 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.

While 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 often impossible 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. 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 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.

Moreover, upon review of the facts and evidence, the Panel notes that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, upon review of the facts and the evidence submitted in this proceeding, the Panel notes that the disputed domain name directed to an active website which showed a clear intent on the part of the Respondent to misleadingly pass it off as the Complainant’s website for commercial gain. In fact, said website prominently displayed the Complainant’s trademarks and used some of the Complainant’s own product images likely protected by copyright, thereby misleading consumers into believing that the Respondent is at least licensed by, or affiliated with the Complainant and/or its trademarks. Moreover, the Panel also accepts that, given the unclear origin, the lack of any accurately and prominently disclaimer and false suggestions of affiliation on the website and given the heavily discounted product prices, it is very likely that the products offered by the Respondent on such website are counterfeit products. Moreover, even if the products were legitimate products, it is clear to the Panel from the foregoing elements that the Respondent is not a good faith provider of goods or services under the disputed domain name, see also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Given the abovementioned elements, the Panel concludes that the Respondent’s use does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name.

Based on the available record, 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.

Given the intensive use, fame and distinctiveness of the Complainant’s prior registered trademarks, the Panel finds that the subsequent registration of the disputed domain name clearly and consciously targeted the Complainant’s prior registered trademarks for THE FRANKIE SHOP (which have been held by prior panels applying the UDRP to be famous, see for instance *Frankie Shop LLC v. Jie Wen*, WIPO Case No. [D2022-4197](#)). The Panel therefore deducts from the Respondent’s efforts to consciously target the Complainant’s famous prior trademarks that the Respondent knew of the existence of the Complainant’s trademarks at the time of registering the disputed domain name. This finding is confirmed by the fact that the website linked to the disputed domain name was used to offer for sale presumably counterfeit THE FRANKIE SHOP products, since this proves that the Respondent was fully aware of the Complainant’s business and its prior trademarks. In the Panel’s view, the foregoing elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directed to an active website which showed a clear intent on the part of the Respondent to misleadingly pass it off as the Complainant's website, displaying the Complainant's trademarks, some of its official product images (thereby likely violating the Complainant's copyrights), and offering products for sale that are likely counterfeit products due to their heavily discounted prices and unclear origin. The Panel concludes from these facts that the Respondent is intentionally attracting Internet users for commercial gain to such website, by creating consumer confusion between the website associated with the disputed domain name and the Complainant's trademarks. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Based on the available record, the Panel finds the third element of the Policy has been established.

## **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, <the-frankie.com>, be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: September 27, 2023