

Case Number: JP2025-0004

PANEL DECISION

1. The Parties

Complainant:

Name: FRANKIE SHOP LLC

Domicile: [Contact details omitted] New York, NY 10002, United States of America (“United States”)

Registrant:

Name: TAY MENG YEONG

Domicile: [Contact details omitted] Singapore

2. The Disputed Domain Name

The disputed domain name is <thefrankieshop.jp>.

3. Procedural History

As indicated in the Annex attached.

4. Factual Background

The Complainant is a limited liability company registered with New York, United States since May 4, 2015, 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 Japan, New Zealand, the United Kingdom, the European Union,

Canada, Switzerland, Australia, South-Africa, United Arab Emirates, Israel, Turkey, Brazil, Argentina, Kuwait, Chile, Peru, Mexico, Colombia, and Uruguay.

The Complainant notably owns the word trademarks THE FRANKIE SHOP (“THE FRANKIE SHOP Trademarks”) worldwide including (1) International trademark No. 1648994, designating Japan, Australia, European Union, Brazil, United States, Mexico, China, Singapore, Republic of Korea, Malaysia, New Zealand, Russia, Turkey, Ukraine, Switzerland and United Kingdom, registered on October 12, 2021 in classes 03, 04, 09, 14, 18, 25 and 35, (2) French trademark No. 4762800, filed on May 4, 2021 and registered on August 9, 2024 in classes 03, 04, 09, 14, 18, 25 and 35, and (3) United States trademark No. 7028712, filed on September 28, 2021 and registered on April 18, 2023 in class 35.

The Complainant owns the registrations for numerous domain names that incorporate THE FRANKIE SHOP Trademarks including <thefrankieshop.com>, <thefrankieshop.ch>, <thefrankieshop.us>, <the-frankie-shop.us>, <the-frankie-shop.co.uk>, <thefrankieshop.fr>, <thefrankieshop.uk>, <thefrankieshop.paris>, <the-frankie-shop.com> and <thefrankieshop.nyc>.

The Registrant registered the disputed domain name <thefrankieshop.jp> on July 11, 2024. The disputed domain name resolves to a parking page that contains a number of sponsored links and that offered the sales of the disputing domain name for the high amount of 4,000 Euros.

5. Parties' Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

The disputed domain name is composed of an exact reproduction of the three words “THE”, “FRANKIE” and “SHOP” included in the Complainant’s THE FRANKIE SHOP Trademarks. The disputed domain name differs from the Complainant’s THE FRANKIE SHOP Trademarks only by the addition of the country code Top-Level Domain (“ccTLD”) “.jp”. It should be noted

that the sole addition of the ccTLD “.jp” is irrelevant and cannot be taken into consideration in determining whether there is a confusingly similarity.

To the Complainant’s knowledge, the Registrant has no rights in the name “THE FRANKIE SHOP” and has never acquired any prior rights on this wording. Furthermore, the Registrant is in no way affiliated with the Complainant and has not been authorized by the Complainant to use its THE FRANKIE SHOP Trademarks or to proceed with the registration of the domain name including the Complainant’s THE FRANKIE SHOP Trademarks. The Registrant is neither a licensee nor a third party authorized to use THE FRANKIE SHOP Trademarks, including as a domain name. The Complainant does not know the Registrant and has never had any relationship with it.

The Complainant’s worldwide reputation attached to THE FRANKIE SHOP Trademarks. The Registrant could not have been unaware of the Complainant’s THE FRANKIE SHOP Trademarks when it registered the disputed domain name. In addition, if the registration of a domain name incorporating a trademark knowingly should be considered as carried out in bad faith, the notoriety of the reproduced trademark is a clear indication of bad faith rightly. It is obvious that the Registrant deliberately registered the disputed domain name quasi-identical to the Complainant’s THE FRANKIE SHOP Trademarks with the intent to divert Internet users from the Complainant’s website to the Registrant’s parking page which contains sponsored links and for the purpose of selling as it is also stated on the page that the disputed domain name is for sale for the sum of 4,000 Euros, which further reinforces the bad faith use.

B. Registrant

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Article 11 (a) of the Rules for JP Domain Name Dispute Resolution Policy (the “Rules”) provides, “The language of the Proceedings shall be Japanese, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the proceeding”.

However, the Complainant requests to change the language of the proceeding from Japanese to English with several reasons including that the Complainant is an entity in the United States and English is the main language of communication for the Complainant; the Registrant is located in Singapore, where English is one of the official languages; English language is the language the most widely used in international relations; the disputed domain name has been registered in Latin, rather than Japanese script, which indicates a familiarity on the part of the Registrant with European languages; the disputed domain name contains the English terms “the” and “shop”; and requiring the Complainant to submit documents in Japanese would lead to delay and cause the Complainant to incur translation expenses.

Considering the circumstances of the proceeding, including that the Registrant is located in Singapore, where English is commonly spoken, and the Registrant did not object to the Complainant’s request to change the language of the proceeding from Japanese to English, the necessity for conducting the proceeding in Japanese will not be so critical to justify the delay and translation costs. Thus, the Panel determines to proceed and render its decision in English.

6.2 Substantive Elements of the Policy

In accordance with Article 4(a) of the JP Domain Name Dispute Resolution Policy (the “Policy”), the Complainant must assert and prove the following three elements are present.

(i) The domain name of the Registrant is identical or confusingly similar to any mark such as trademark or service mark in which the Complainant has rights or legitimate interests; and

(ii) The Registrant has no relevant rights or legitimate interests in respect of the domain name;
and

(iii) The domain name of the Registrant has been registered or is being used in bad faith (unfair purpose).

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.

The Panel confirms that the Complainant registered several THE FRANKIE SHOP Trademarks. The disputed domain name consists of the Complainant's THE FRANKIE SHOP Trademarks in its entirety without spaces between the words plus a ccTLD ".jp".

Numerous JP-DRP and UDRP panels have recognized that the Top-Level Domain may be disregarded under the first requirement of confusing similarity test as a standard registration requirement of the domain name (see *Frankie Shop LLC v. Linda Barnes*, WIPO Case No. D2023-3816 <thefrankieshop.shop>).

Accordingly, the Panel finds that the first element in Article 4(a) of the Policy has been established.

B. Rights or Legitimate Interests

Article 4(c) of the Policy provides a list of circumstances in which the Registrant may demonstrate rights or legitimate interests in a disputed domain name.

As the Complainant asserts, the Registrant is not affiliated or related to the Complainant, or licensed or otherwise authorized to use THE FRANKIE SHOP Trademarks including as a domain

name. The Registrant is not commonly known by the disputed domain name (see Article 4(c)(ii) of the Policy) and has not acquired any trademark or service mark rights in the disputed domain name.

The Registrant is using the disputed domain name to operate a parking page that contains a number of sponsored links but the Registrant is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain (see Article 4(c)(iii) of the Policy).

Although the overall burden of proof in the proceedings is on the complainant, where the complainant makes out a *prima facie* case that the registrant lacks rights or legitimate interests, the burden of production on the second element in Article 4(a) of the Policy shifts to the registrant to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the registrant fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element in Article 4(a) of the Policy.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Registrant lacks rights or legitimate interests in the disputed domain name. The Registrant 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.

Consequently, the Panel finds that the second element in Article 4(a) of the Policy has been established.

C. Registered or Used in Bad Faith

Considering the evidence submitted by the Complainant that THE FRANKIE SHOP Trademarks has been featured in major magazines such as Vogue and Forbes and is followed by over a million

followers on the social network Instagram, the Panel finds that THE FRANKIE SHOP Trademarks are well known around the world as a fashion clothing brand for women.

Therefore, it is implausible that Registrant was unaware of the Complainant when registering the disputed domain name, and the composition of the disputed domain name imitating the Complainant's THE FRANKIE SHOP Trademarks strongly suggest that Registrant had THE FRANKIE SHOP Trademarks in mind when registering the disputed domain name (see *The Frankie Shop LLC v. Austin Hart*, WIPO Case No. D2021-3553 <shop-frankie.com>).

Moreover, the Registrant is using the disputed domain name to operate a parking page that contains a number of sponsored links. Further, the Registrant offered the sales of the disputing domain name for the high amount of 4,000 Euros at the parking page. These facts support a finding of use in bad faith since the disputed domain name is used for intentionally attempting to attract Internet users for commercial gain within the meaning of Article 4(b)(iv) of the Policy.

As a result, the Panel reached the conclusion that the Complainant has succeeded in the third element of Article 4(a) of the Policy and is entitled to the remedy requested, namely that the disputed domain name be transferred to the Complainant.

7. Decision

For all the foregoing reasons, in accordance with Article 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name <thefrankieshop.jp> be transferred to the Complainant.

Decided on May 26, 2025

Yuji Yamaguchi

Sole Panelist

Japan Intellectual Property Arbitration Center

Annex: Procedural History

(1) Submission of the Complaint

The Japan Intellectual Property Arbitration Center (the “Center”) received the complaint (including related documents attached herewith) from the Complainant by Electronic Transmission on March 12, 2025.

(2) Fee Payment

The Center received the entire fee from the Complainant on March 12, 2025.

(3) Confirmation of the Domain Name and the Registrant

The Center made an inquiry of the registration data to the JPRS on March 14, 2025 and received from the JPRS the verification response confirming the Registrant named in the Complaint is listed as the registrant of the disputed domain name and the e-mail addresses, postal addresses, etc. of the registrant registered by the JPRS on March 14, 2025.

(4) Verification of the Formal Requirements

The Center determined that an amendment (correction of the information in the complaint, etc.) was necessary on March 19, 2025 and notified the Complainant to that effect. The Center received the amended documents and the request to change the language of the proceeding from Japanese to English on March 21, 2025 and verified that the Complaint satisfied the formal requirements of the Policy and Rules on March 21, 2025.

(5) Commencement of the Proceeding

The Center notified the Complainant, JPRS and JPNIC of the commencement of the Proceeding by Electronic Transmission on March 28, 2025. The Center sent the Registrant the Commencement Notice by postal service and Electronic Transmission on March 28, 2025. The Commencement Notice informed the Registrant of the commencement date of the Proceeding (March 28, 2025), the deadline for the submission of the Answer (April 25, 2025) and the means for the receipt and submission of documents and asked the Registrant to submit the opinion regarding the language of the proceedings. However, some of the e-mails sent to the Registrant were not able to be sent. In addition, the Commencement Notice sent to the Registrant address were returned with the message “Address not found”.

(6) Submission of the Answer

Since the Center did not receive the Answer by the deadline for submission, the Center sent a

notice on non-submission of the Answer to the Complainant and the Registrant by Electronic Transmission on April 28, 2025, stating that “the Answer shall be deemed not to have been submitted.” The Center did not receive the opinion regarding the language of the proceedings from the Registrant.

(7) Notice on the Appointment of the Panel and Scheduled Date of Decision

The Complainant elected to have the dispute decided by a single-member panel, and the Center appointed Yuji Yamaguchi, Attorney at law, as the sole panelist and forwarded the case file to the Panel by Electronic Transmission on May 7, 2025. The Center notified the Complainant, the Registrant, JPNIC and JPRS of the appointed panelist and scheduled date of decision (May 27, 2025) by Electronic Transmission on May 7, 2025. The Panel submitted the declaration of impartiality and independence to the Center on May 7, 2025.

(8) Request for Further Statements

The Panel issued the Panel Order on Submission of Request to Change the Language of the Proceeding to the Complainant on May 12, 2025. The Complainant submitted detailed reasons why the language of the proceeding in this case should be English rather than Japanese on May 13, 2025.

(9) Decision by the Panel

The Panel determined that the language of the proceedings shall be English, having regard to the circumstances of the proceedings, and then completed the review and rendered the decision on May 26, 2025.