

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. ahmad Akram

Case No. D2022-4078

1. The Parties

The Complainant is Gallery Department, LLC, United States of America (“U.S.”), represented by Adelman Matz P.C., U.S.

The Respondent is ahmad Akram, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <gallerydeptofficial.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 28, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 29, 2022, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 2022, 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 amended Complaint on November 4, 2022.

The Center verified that the Complaint together with the amended 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 November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 30, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on December 13, 2022. 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, Gallery Department, LLC, is a clothing company based in the U.S.

The Complainant is the owner of various trademarks consisting of or including the sign GALLERY DEPT., such as the following:

- GALLERY DEPT., U.S. word mark registered with the United States Patent and Trademark Office (“USPTO”) on May 5, 2020, under number 6048485 in class 25 (clothing), mentioning February 4, 2017 as the date of first use in commerce;
- GALLERY DEPT., international word mark registered with WIPO on September 6, 2018, under number 1430638 in class 25, designating *i.a.* the European Union and China;

The Complainant also holds trademarks for the sign “DÉPT. DE LA GALERIE”, such as the following:

- DÉPT. DE LA GALERIE, European Union word mark registered with the European Union Intellectual Property Office (“EUIPO”) on April 14, 2021, under number 018352984 in class 25.

The Complainant claims to be the holder of the domain name <gallerydept.com> since October 19, 2014, which it uses to resolve to its official website.

The Disputed Domain Name was registered on May 7, 2022. According to the evidence provided by the Complainant, the Disputed Domain Name resolved to a website which appears to offer products identical or at least similar to the products manufactured and sold by the Complainant. The Panel observes that the Disputed Domain Name currently redirects to the domain name <gallerydept.org>, which also resolves to a website appearing to offer products identical or at least similar to the Complainant’s products.

5. Parties’ Contentions

A. Complainant

The Complainant considers the Disputed Domain Name to be confusingly similar to a trademark in which it claims to have rights.

The Complainant furthers claim that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the Respondent is not commonly known by the Disputed Domain Name, is not associated in any way with the Complainant and has never been authorized to use the Complainant’s marks. The Complainant claims that the Respondent has never used the Disputed Domain Name in connection with a *bona fide* offering of goods and services but rather in an illegitimate manner to suggest some form of connection, sponsorship, or endorsement by the Complainant for purposes of selling products.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the Respondent registered the Disputed Domain Name under constructive notice of the Complainant’s trademarks. The Complainant contends that the Respondent has used the Disputed Domain Name in bad faith by intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s mark as to the

source, sponsorship, affiliation, or endorsement of the Respondent's website and / or of products on the Respondent's website. Moreover, the Complainant claims that the Respondent has acted in bad faith by showing a pattern cybersquatting behavior.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. The standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the 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.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that it has trademarks rights in the sign GALLERY DEPT. The Complainant's GALLERY DEPT. trademark has been registered and extensively used in connection with the Complainant's clothing business.

The Disputed Domain Name incorporates the Complainant's GALLERY DEPT. trademark in its entirety, merely removing the dot and adding the word "official".

As stated at section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the Disputed Domain Name, the addition of other terms would not prevent a finding of confusing similarity. In this case, the Panel finds that the confusing similarity is obvious as only one word has been added to the textual components of the Complainant's GALLERY DEPT. trademark.

Additionally, it is well established that the generic Top-Level Domain ("gTLD") ".com" may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's GALLERY DEPT. trademark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights (there being no Response or evidence of any such rights). According to the information provided by the Registrar, the Respondent is named “ahmad Akram”. There are no indications that a connection between the Complainant and the Respondent exists or existed.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant’s GALLERY DEPT. trademark in its entirety and adds the term “official”. The Panel finds that the composition of the Disputed Domain Name carries a risk of implied affiliation with the Complainant as it may mistakenly be seen as the official website of the Complainant.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Complainant provides evidence showing that the Disputed Domain Name resolved to a website purporting to sell products identical or at least similar to the Complainant’s products at discounted prices. The Panel observes that the Disputed Domain Name currently redirects to the domain name <gallerydept.org>, which resolves to a similar website. The Panel observes that the Complainant’s mark was, and is still, mentioned numerous times on these websites, including on the products depicted. The websites linked to the Disputed Domain Name even included and still include product pictures copying at least two different marks of the Complainant (GALLERY DEPT. and DÉPT. DE LA GALERIE) as used on the Complainant’s official products. Moreover, the websites do not accurately and prominently disclose the Respondent’s relationship with the Complainant. The Panel finds that the above elements are clear indications of illegal activity using the Disputed Domain Name. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove, on the balance of probabilities, both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and

Control Techniques Limited v. Lektronix Ltd, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainant and its rights in the GALLERY DEPT. mark when he registered the Disputed Domain Name, considering that:

- various GALLERY DEPT. marks of the Complainant predate the registration of the Disputed Domain Name;
- the Disputed Domain Name includes the Complainant's distinctive word mark in its entirety;
- the websites linked to the Disputed Domain Name mention at least two different marks of the Complainant, including on the products offered on these websites;
- the discounted products offered on the websites linked to the Disputed Domain Name are identical or at least highly similar to the Complainant's products.

As a result, the Respondent must have had knowledge of the Complainant's rights at the time of registering the Disputed Domain Name. The Panel finds that the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#)).

Given that the use of a domain name for *per se* illegitimate activity such as impersonation/passing off can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

The Respondent used and still uses the Disputed Domain Name to resolve to a website, which appear to offer products identical or at least similar to the Complainant's products at discounted prices. As mentioned above, this website mentions several trademarks of the Complainant, including on the products offered for sale. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to his website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

Moreover, the Complainant provides evidence of at least one other UDRP case in which the Respondent was found to be in bad faith. The Panel finds that this shows a pattern of cybersquatting behavior, which is an additional indication of willful bad faith.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is shown that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 <gallerydeptofficial.com> be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: December 27, 2022