

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Privacy Service Provided by Withheld for Privacy ehf / Muhammad Ibrar, Web Designer
Case No. D2022-3193

1. The Parties

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Muhammad Ibrar, Web Designer, Pakistan.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 29, 2022. On August 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 30, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 31, 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 September 2, 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 September 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 28, 2022. Then, the Respondent’s informal communication was received on September 29, 2022.

The Center appointed John Swinson as the sole panelist in this matter on September 30, 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.

The Respondent sent a further email to the Center on September 30, 2022, as discussed below.

4. Factual Background

The Complainant is United States enterprise that markets and sells a unisex clothing brand based in Los Angeles. The Complainant was founded by artist and designer Josué Thomas. The Complainant owns trademark registrations in several countries, including United States Registration No. 6048485 for GALLERY DEPT. This registration was filed on August 27, 2018 and claims a date of first use of February 4, 2017. The trademark was registered on May 5, 2020.

The disputed domain name was registered on April 14, 2022.

The disputed domain name resolves to a website that advertises and allows consumers to purchase items of clothing, such as T-shirts, hats and jackets. The website is branded "Gallery Dept." Some of the items of clothing have words on the clothing including "Dept" and "Gallery Dept".

The Respondent did not file a formal Response, so little information is known about the Respondent.

5. Parties' Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant is a clothing designer and retailer, that has an online presence and physical stores in Los Angeles and Miami.

The Complainant owns registered trademarks for GALLERY DEPT.

The Respondent is not commonly known by the disputed domain name, and the Respondent is not associated with the Complainant. The Complainant has never given the Respondent permission to use the Complainant's trademarks. The Respondent is not now nor has ever been an authorized retailer of the Complainant's merchandise, nor has the Respondent ever been granted any rights or licenses in Complainant's trademarks.

The Respondent's use of GALLERY DEPT. is not *bona fide* because the Respondent sells pirated goods. The website at the disputed domain name attempts to improperly suggest some form of connection, sponsorship, or endorsement by the Complainant when none actually exists.

The Respondent is blatantly selling illegitimate counterfeit merchandise containing the Complainant's GALLERY DEPT. trademarks on its unauthorized website.

The Respondent's webpage with FAQs state that the Respondent's merchandise is in fact designed by Josué Thomas himself, which is false.

The Respondent is intentionally attempting to attract consumers to the Respondent's website for its own commercial gain by creating a likelihood of confusion with the Complainant's GALLERY DEPT. trademarks and creating confusion as to the source, sponsorship, affiliation, or endorsement of the Complainant's

website. This constitutes registration and use in bad faith under the third element of the Policy set forth by paragraph 4(a)(iii).

B. Respondent

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

On September 28, 2022, the Center received an email from the Respondent that stated: "Hi, can you please explain what you want by me and what is my fault" to which the Center replied and provided more information.

In response to the Notification of Panel Appointment that was sent by the Center to all parties, the Respondent sent an email on September 30, 2022 to the Center that stated: "Sorry for the late reply, i turn off my website very soon and i give back this domain to you, sorry for everything. I'll agree to give this domain back."

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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 *onus* of proving these elements is on the Complainant even though the Respondent failed to submit a Response.

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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has clearly proven ownership of registered trademarks for GALLERY DEPT.

The disputed domain name includes the Complainant's trademark GALLERY DEPT. in its entirety, other than the dot at the end of the trademark which is not included in the disputed domain name.

The disputed domain name includes the term "clothing". The word "clothing" does not prevent a finding of confusing similarity.

The Panel accordingly concludes that the disputed domain name is confusingly similar to the Complainant's GALLERY DEPT. trademark, disregarding the generic Top-Level Domain ".com".

The fact that the Respondent is targeting the Complainant's trademark (as discussed below) supports the Complainant's position, in that this assists in demonstrating that its trademark has achieved significance as a source identifier.

The Complainant succeeds on the first element of the Policy in relation to the disputed domain name.

B. Rights or Legitimate Interests

For the second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant alleges that the Respondent is not commonly known by the disputed domain name, and that the Respondent is not associated with the Complainant. Further, the Complainant asserts that the Complainant has never given the Respondent permission to use the Complainant's trademarks. The Complainant states that the Respondent is not now nor has ever been an authorized retailer of the Complainant's merchandise, nor has the Respondent ever been granted any rights or licenses in Complainant's trademarks. Further, the Complainant states that the Respondent's use of GALLERY DEPT. is not *bona fide* because the Respondent sells pirated goods, and that the website at the disputed domain name attempts to improperly suggest some form of connection, sponsorship, or endorsement by the Complainant when none actually exists.

The Complainant has rights in its trademark which precedes the Respondent's registration of the disputed domain names.

The Complainant has established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain names and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain names.

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain name. Based on the evidence before the Panel, none of the circumstances listed in paragraph 4(c) apply in the present circumstances. Moreover, in emails to the Center referred to above, the Respondent agrees to give back the disputed domain name to the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or any legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

The Panel is of the view that the Respondent was aware of the Complainant and the Complainant's trademark when the disputed domain name was registered. This is because the Complainant has registered and used the trademark GALLERY DEPT. well before the Respondent registered the disputed domain name and by the fact that the disputed domain name resolves to a website that refers to the Complainant and the Complainant's founder. Moreover, the website at the disputed domain name has a similar look and feel to the Complainant's own website. Therefore, the Respondent registered the disputed domain name in bad faith.

The Respondent's use of the disputed domain name to impersonate the Complainant or to imply sponsorship or endorsement of the Respondent by the Complainant, is evidence of bad faith use.

The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's GALLERY DEPT. trademark. The Complainant meets paragraph 4(b)(iv) of the Policy.

The Complainant succeeds on 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 <gallerydeptclothing.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: October 16, 2022