

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Ahmad Akram

Case No. D2023-1593

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 Ahmad Akram, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <gallerydept.org> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 12, 2023. On April 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name(s) which differed from the named Respondent (Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 21, 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 amended Complaint on April 24, 2023.

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 April 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 8, 2023.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on June 13, 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 clothing company based in the United States.

The Complainant is the owner of trademark registrations consisting of or including the sign GALLERY DEPT. in several jurisdictions worldwide, such as:

- United States Trademark registration No. 6048485 GALLERY DEPT. (word) filed on August 27, 2018, registered on May 5, 2020, for goods in Class 25;
- Hong Kong, China Trademark registration No. 305253804 GALLERY DEPT. (word) filed on April 22, 2020, registered on April 22, 2020, for goods in Class 25;
- International Registration No. 1430638 GALLERY DEPT. (word), designating China, European Union and Japan, registered on September 6, 2018, for goods in Class 25;
- United Kingdom Trademark registration No. UK00801430638 GALLERY DEPT. (word), filed on September 6, 2018, registered on March 27, 2019, for goods in Class 25.

The Complainant has registered the domain name <gallerydept.com> on October 19, 2014 which it uses as its official website.

The disputed domain name <gallerydept.org> was registered on September 19, 2022. According to the evidence provided by the Complainant, the disputed domain name resolved to a website which appeared 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 "vloneofficial.com/gallery-dept" which also appears to offer products identical or at least similar to the Complainant's products.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4 (a) of the Policy is established in the present case:

The Complainant argues that the disputed domain name is confusingly similar to a trademark which it claims to own rights.

It states that the disputed domain name incorporates its GALLERY DEPT. trademark in its entirety. The top-level domain ".org" is required only for technical reasons and, as well established in UDRP proceedings, is to be disregarded when assessing confusing similarity. In addition, the Complainant argues that, on a side-by-side comparison, the letter string "gallerydept" and the disputed domain name, the GALLERY DEPT. trademark is not just recognizable in the disputed domain name, but it is identical to the second level domain, making the disputed domain name confusingly similar.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant states that the Respondent is not commonly known by the disputed domain name. Rather, the Complainant is the one who is commonly known as "Gallery Dept". Furthermore, the Respondent is not associated with the Complainant, nor have the trademarks ever have been licensed to the Respondent. Additionally, it is firmly established that a respondent has no rights or legitimate interests in the domain

name, where there is evidence that a respondent is using the domain name in an illegitimate manner to suggest some form of connection, sponsorship, or endorsement by the Complainant for purposes of selling products. This, according to the Complainant, is precisely the case here, as the Respondent is using the disputed domain name in order to sell illegitimate counterfeit merchandise displaying the GALLERY DEPT. trademark and using the Complainant's trademark without authorization. Moreover, the disputed domain name was used by the Respondent as the landing page of a 301 Redirect from the domain name <gallerydeptofficial.com> held by the Respondent as well and subject to previous UDRP proceedings between the parties. This, the Complainant argues, is the contrary of a *bona fide* offering.

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

According to the Complainant, the registration of the disputed domain name was made in bad faith in the first place. Registering a domain name while under constructive notice of the Complainant's trademark is evidence of bad faith. Here, the Complainant argues, the Respondent easily had the chance to be notified of the Complainant's official domain name <gallerydept.com>. Likewise, a quick search would have revealed its trademarks because these registrations have been applied for several years before the Respondent's registration of the disputed domain name. The Complainant claims that the Respondent is using the disputed Domain name to intentionally attract consumers to the website under the disputed domain name for the Respondent's own commercial gain, where it is selling counterfeit merchandise using the Complainant's GALLERY DEPT. trademarks without any authorization (Annexes 17-30). Moreover, the fact that the Respondent has permanently redirected the domain name <gallerydeptofficial.com> via a 301 Redirect to the disputed domain name, while being subject to another UDRP proceeding, is further evidence for use in bad faith. Additionally, the Respondent has redacted or allowed the redaction of its details from the public Whois database. The Complainant contends that the use of such privacy service by the Respondent is indicative of bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4 (a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (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.

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

A. Identical or Confusingly Similar

On the first element, a complainant has to establish that there is a trademark or service mark, in which it has rights. Here, the Complainant has amply demonstrated registered trademark rights in and extensive use of trademarks consisting of or comprising GALLERY DEPT.

Further, the test for identity or confusing similarity under the Policy, paragraph 4 (a)(i) is limited in scope to a direct comparison between the Complainant's trademarks and the textual string which comprises the disputed domain name. The Panel agrees that the disputed domain name consists of the term "GALLERY DEPT", merely removing the dot and adding the generic Top-Level Domain (gTLD) ".org". The removal of the dot and addition of the gTLD does not affect the confusing similarity in any way. For the purposes of

assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is therefore permissible for the Panel to ignore the gTLD (section 1.11 of [WIPO Overview 3.0](#), see also *Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *G4S Plc v. Noman Burki*, WIPO Case No. [D2016-1383](#); *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)). Thus, the Panel shall disregard the gTLD “.org” included in the disputed domain name. Therefore, the disputed domain name is confusingly similar to the Complainant’s GALLERY DEPT. trademarks.

In view of the above, the Panel finds that the Complainant has satisfied the requirement of paragraph 4 (a)(i) of the Policy.

B. Rights or Legitimate Interests

On the second element, under paragraph 4 (a)(ii) of the Policy, the Complainant bears the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

It is consistent case-law of UDRP panels that 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 names in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that, with respect to paragraph 4 (c)(i) of the Policy, there is no evidence in the record that the Respondent with the apparent clear name “Ahmad Akram”, before any notice of the dispute, used or prepared 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.

The Panel further notes that, with respect to paragraph 4 (c)(ii) of the Policy, there is no evidence that indicates that the Respondent has ever been commonly known by the disputed domain name or has acquired trademark rights in a name corresponding to it.

Additionally, with respect to paragraph 4 (c)(iii) of the Policy, there is no evidence that the Respondent has made, and 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 at issue. On the contrary, according to the evidence provided by the Complainant, the disputed domain name resolves to a website where clothing items bearing the Complainant’s GALLERY DEPT. trademarks are for sale, the website itself being labelled prominently with the Complainant’s GALLERY DEPT. trademark.

In light of this, the Panel finds that it is obvious that the Respondent did not pursue any legitimate interests when registering and using the disputed domain name, but rather intended to mislead Internet users into believing that its purchasing platform is actually one of the Complainant. Such exploitation of a complainant’s reputation and name can never constitute a *bona fide* use of a domain name (see *SB Advances Systems Ltd. v. Internet Ad & Seo*, WIPO Case No. [DRO2021-0009](#)).

Moreover, the Complainant has not authorized, licensed or permitted in any other way the Respondent to register or use the disputed domain name or its trademarks.

These findings are supported by the fact that the Respondent failed to file a response within the proceedings before the Panel. In fact, it is for a complainant to prove its case and there may be good reasons why an honest respondent may decide not to prepare and file such a document. But where allegations are made which are as serious as those levied by the Complainant in the Complaint, one would expect any honest respondent to positively deny those allegations (see *The Commissioners for HM Revenue and Customs v. Tyrone Jackson*, WIPO Case No. [D2018-0298](#)).

Therefore, the Panel finds that the Complainant has provided sufficient evidence to hold that the disputed domain name was used for dishonest purposes incapable of conferring any right or legitimate interest in

holding the domain name to the Respondent. The Complainant has satisfied the requirement of paragraph 4 (a)(ii) of the Policy.

C. Registered and Used in Bad Faith

On the third element, under paragraph 4 (a)(iii) of the Policy, the Complainant has to establish that the Respondent registered and used the disputed domain name in bad faith.

As to registration in bad faith, the Panel notes that the disputed domain name was registered several years after the Complainant's GALLERY DEPT. trademarks and accepts that the disputed domain name was chosen by reference to these trademarks. The Panel agrees with the Complainant that a simple, rudimentary search for similar domain names or trademarks would have alerted the Respondent to the Complainant's domain name and GALLERY DEPT. trademark which had been applied for and registered several years before the Respondent registered the disputed domain name. Furthermore, the Complainant provides evidence of a previous UDRP case between the parties to the present proceedings regarding the earlier domain name <gallerydeptofficial.com> in which the very same Respondent had made use of the Complainant's GALLERY DEPT. trademark (Annex 31).

Taken all these elements together, the Panel finds that it is inconceivable that the Respondent was unaware of the Complainant upon registration of the disputed domain name.

As to use in bad faith, according to paragraph 4(b)(iv) of the Policy, the following circumstance shall be evidence of the registration and use of a domain name in bad faith: By using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site or location or of a product or service on his web site or location.

In the present case, the Complainant has provided ample documentation (Annexes 17 to 29) displaying the way the Respondent is illegitimately selling likely counterfeit clothing items branded with the GALLERY DEPT. trademarks and impersonating the Complainant. This is manifest evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

In addition, the Panel finds that the act of redirecting the <gallerydeptofficial.com> domain name to the disputed domain name via a 301 Redirect, as well as the present redirect from the disputed domain name to <vloneofficial.com/gallery-dept/> while the present UDRP proceedings are ongoing is a further indication of use of the disputed domain name in bad faith (see *Cintas Corporation v. Registration Private, Domains By Proxy, LLC / Scott Roberts*, WIPO-Case No. [D2020-2049](#); *Roberto Federico Wille Buschmann and Industrial Esco-will, S.A. de C.V. v. STX*, WIPO Case No. [D2017-2581](#)). The Respondent was and is using both domain names in order to compete with the Complainant's website and to benefit thereof to the Complainant's disadvantage. At the same time, this shows a pattern of cybersquatting behavior which is another indication of bad faith.

In addition, the Respondent did not respond to the Complainant's contentions and allowed the deadline for reply to expire. In accordance with paragraph 14(b) of the Rules, the Panel sees further evidence of the Respondent having acted in bad faith.

Finally, the Panel finds that the Respondent's efforts to conceal its identity through the use of a Whois proxy service with an address located in Iceland and the fact that the Respondent has not participated in these proceedings can be construed as further evidence that the disputed domain name was registered and is being used in bad faith (see also *Confederation Nationale du Credit Mutuel v. WhoisGuard Protected, WhoisGuard, Inc. / Jean Duca*, WIPO Case No. [D2021-0977](#); *TTT Moneycorp Limited. v. Diverse Communications*, WIPO Case No. [D2001-0725](#)).

For all of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has satisfied the requirement of paragraph 4(a)(iii) 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 <gallerydept.org> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: June 27, 2023