

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Privacy service provided by Withheld for Privacy ehf / Dung Hoang
Case No. D2022-3317

1. The Parties

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Dung Hoang, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <gallerydeptcollection.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 September 6, 2022. On September 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 7, 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 September 9, 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 13, 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 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 4, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on October 19, 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 language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is a clothing brand based in Los Angeles founded by artist and designer Josué Thomas. The Complainant owns and operates the website at “www.gallerydept.com”, as well as retail store fronts in Los Angeles and Miami. The garments created and sold often involve socio-political tropes.

The Complainant proved ownership of several GALLERY DEPT. trademarks, including the United Kingdom (“UK”) trademark no. 00801430638 registered on March 27, 2019 in class 25, the USA trademark no. 6048485 registered on May 5, 2020 in class 25.

The disputed domain name was registered on June 24, 2022 and was used to resolve to a website purporting to sell GALLERY DEPT. goods. At the date of this decision, the disputed domain name does not resolve to an active website due to a host error.

5. Parties’ Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its GALLERY DEPT. trademarks, as it incorporates those trademarks in addition to the descriptive word “collection”, which enhances the confusing similarity because the Complainant sells its artistic inspired clothing and other apparel in various collections.

In what concerns the second element, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name as the Respondent is not associated in any way with the Complainant, and the Complainant has never given the Respondent any authority or permission to use the Complainant’s GALLERY DEPT. trademarks. Also, the Respondent is not commonly known by the disputed domain name. Moreover, the Respondent has never used the disputed domain name in connection with a *bona fide* offering of goods and services. Rather, the Respondent is using the disputed domain name to sell counterfeit merchandise using the Complainant’s GALLERY DEPT. trademarks without authorization or permission.

With respect to the third element, the Complainant argues that the Respondent is intentionally trying to attract consumers to the website at the disputed domain name for its own commercial gain by creating a likelihood of confusion with the Complainant’s GALLERY DEPT. trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s Website. Moreover, the Respondent is selling counterfeit merchandise using the Complainant’s GALLERY DEPT. trademarks without any authorization.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Matters

No communication has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default.

6.2. Substantive Matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of its rights in the GALLERY DEPT. trademarks. The trademark GALLERY DEPT. is reproduced in its entirety in the disputed domain name. The addition of “collection” does not prevent a finding of confusing similarity with the Complainant’s trademark GALLERY DEPT., which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

It is well accepted by UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

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* case demonstrating 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark GALLERY DEPT. and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, according to the un rebutted evidence of

the Complainant, the website at the disputed domain name is used to offer for sale GALLERY DEPT. goods at significantly lower prices – not even 10 percent of their original price. By comparing the prices of the same product on the Complainant's website and the website at the disputed domain name, it is reasonable to conclude that those offered on the website at the disputed domain name appear to be counterfeit products. As a result, the Panel finds on balance of probability that the website to which the disputed domain name resolved offered alleged counterfeits of the Complainant's products. (Even if the products were genuine, the lack of any disclaimer on the website at the disputed domain name as to the registrant's relationship with the trademark owner or the lack thereof, would falsely suggest to Internet users that the website to which the disputed domain name resolves is owned by the Complainant or at least affiliated to the Complainant (as per the *Ok! Data* principles outlined in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).)

Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

Furthermore, the nature of the disputed domain name, that includes the Complainant's well-established trademark, carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because the Respondent did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Complainant's registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain name. The disputed domain name resolved to a website reproducing the Complainant's trademark and purportedly offering for sale the Complainant's products but at a much lower price. Given the distinctiveness and renown of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, and to target those trademarks.

The use of the term "collection" reinforces the impression that the disputed domain name is the Complainant's website for a certain collection of its clothing brands. The disputed domain name resolves to a website, which appears to offer counterfeits of the Complainant's products. As such, the disputed domain name suggests affiliation with the Complainant in order to attract consumers and offer alleged counterfeit products.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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 <gallerydeptcollection.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: November 1, 2022