

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Kai Yip Cheung
Case No. D2022-4058

1. The Parties

The Complainant is Gallery Department, LLC, United States of America (“United States”).

The Respondent is Kai Yip Cheung, United States.

2. The Domain Name and Registrar

The disputed domain name <gallerydepts.art> is registered with Dynadot, LLC (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 31, 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 November 4, 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 7, 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 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2022.

The Center appointed Colin T. O’Brien as the sole panelist in this matter on January 4, 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 unisex clothing brand based in Los Angeles founded by artist and designer Josué Thomas. The Complainant claims that it owns and operates the “www.gallerydept.com” website since October 19, 2014 and operates retail stores in Los Angeles and Miami.

The Complainant owns the following trademark registrations:

- United States Registration No. 6048485 for GALLERY DEPT. for “clothing, namely, men’s, women’s, missy’s, juniors’, children’s and infants’ jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps being headwear, headwear, underwear, swimwear, gloves and ties” registered on May 5, 2020;
- Hong Kong, China Registration No. 305253804 for GALLERY DEPT. for “clothing, namely, men’s, women’s, missy’s, juniors’, children’s and infants’ jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps being headwear, headwear, underwear, swimwear, gloves and ties” registered on April 22, 2020;
- Japan Registration No. 1430638 for GALLERY DEPT. for “clothing, namely, men’s, women’s, missy’s, juniors’, children’s and infants’ jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps being headwear, underwear, swimwear, gloves and ties” registered on February 28, 2020;
- International Registration No. 1430638 GALLERY DEPT. for “clothing, namely, men’s, women’s, missy’s, juniors’, children’s and infants’ jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps, headwear, underwear, swimwear, gloves and ties” designating China, registered on September 6, 2018;
- United Kingdom Registration No. UK00801430638 for GALLERY DEPT. for “clothing, namely, men’s, women’s, missy’s, juniors’, children’s and infants’ jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps being headwear, headwear, underwear, swimwear, gloves and ties” registered on March 27, 2019.

The disputed domain name was registered on November 26, 2021. The Complainant submitted evidence showing that the disputed domain name resolves to an online store offering for sale goods bearing the Complainant’s trademark, as well as third-party goods.

5. Parties’ Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant’s GALLERY DEPT. trademark as it incorporates the entirety of the mark. The only difference between the disputed domain name and the Complainant’s GALLERY DEPT. mark and corresponding URL is the additional “s,” and the generic Top-Level Domain (“gTLD”) identifier, “.art.” The Complainant sells its artistic inspired clothing and other apparel based on its founder, artist Josué Thomas’ visions and ideas. The gTLD “.art” is recognized as “the top-level domain for the international arts and cultural community.” Because the “.art” gTLD is so closely associated with the artistic community, and given that Josué Thomas is a well-known artist and clothing designer, having the gTLD “.art” on the disputed domain name serves to make it confusingly similar to the Complainant’s domain name.

The Respondent is not commonly known by the disputed domain name. The opposite is true. The Complainant is the one who is commonly known as “Gallery Dept.”, and the Respondent is intentionally trying to benefit from the confusion for its own unauthorized commercial gain. The Respondent’s typosquatting with the additional letter “s” and use of the gTLD “.art” in the disputed domain name serve to better achieve that goal of creating confusion. 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. marks.

The Respondent is using the Complainant’s domain name and selling illegitimate counterfeit merchandise using the Complainant’s GALLERY DEPT. marks without authorization or permission. These actions are intended to try to pass his website off as the Complainant’s, and to create the impression that the Respondent’s website is associated with the Complainant, when it is not. This demonstrates that the Respondent has no legitimate business interest in the disputed domain name.

The Respondent is intentionally trying to attract consumers to its “www.gallerydepts.art” website for the Respondent’s own commercial gain by creating a likelihood of confusion with the Complainant’s GALLERY DEPT. marks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website. Additionally, the Respondent is selling counterfeit merchandise using the Complainant’s GALLERY DEPT. marks (and other companies’ marks) without any authorization.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the GALLERY DEPT. mark and has shown that no other entity has rights in or uses the Complainant’s mark. The addition of “s” does not prevent the Complainant’s trademark from being recognizable in the disputed domain name. The gTLD “.art” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the disputed domain name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name and has not been commonly known by the disputed domain name. The fact that the Respondent obtained the disputed domain name years after the Complainant had begun using its GALLERY DEPT. mark (which has gained renown in a short period of time) indicates that the Respondent sought to piggyback on the GALLERY DEPT. mark for illegitimate reasons.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. Moreover, the evidence provided by the Complainant shows that the disputed domain name resolves

to website seemingly impersonating the Complainant by featuring the Complainant's trademark and images of the Complainant's trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any information on the disputed domain name as to the website's lack of authorization or relation to the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Irrespective of the disputed domain name satisfying the so-called *Oki Data* test, the nature of the disputed domain name, comprising the Complainant's trademark and the addition of the letter "s" indicates an awareness of the Complainant and carries a risk of Internet user confusion (that seemingly being the Respondent's aim), especially when considering the impersonating nature of the content exhibited at the disputed domain name, and as such cannot constitute fair use.

While circumstantial, the lack of authorization and the severely discounted prices found at the disputed domain name suggest that, should any products be sold at the disputed domain name, they are likely to be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. The Panel finds that such use cannot be qualified as a *bona fide* offering of goods or services or legitimate noncommercial or fair use (see section 2.13 of the [WIPO Overview 3.0](#)). Rather, such illegal use can never confer rights or legitimate interests upon a respondent.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has satisfied its burden of proof in establishing the Respondent's bad faith in registration and use of the disputed domain name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the renown and uniqueness of the GALLERY DEPT. mark, it is inconceivable that the Respondent registered the disputed domain name with the addition of the letter "s" in the gTLD ".art" without knowledge of the Complainant. The disputed domain name is used for a website that is allegedly selling products identical to those offered by the Complainant and bearing its trademarks, but the Complainant has established that the Respondent's use is not authorized, nor is affiliated with the Complainant in any way. The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Such impersonation of the Complainant is sufficient to establish the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the disputed domain name was registered and used in bad faith.

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, <gallerydepts.art>, be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: January 17, 2023