

## **ADMINISTRATIVE PANEL DECISION**

Gallery Department, LLC v. ahmad Akram  
Case No. D2023-3455

### **1. The Parties**

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

The Respondent is ahmad Akram, Pakistan.

### **2. The Domain Name and Registrar**

The disputed domain name <gallerydept.info> 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 14, 2023. On August 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 15, 2023, 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 (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 August 16, 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 August 21, 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 August 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 18, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on September 26, 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.

The expiration date of the disputed domain name was on September 19, 2023. On September 20, 2023, the Registrar confirmed that the disputed domain name was renewed until September 19, 2024.

#### **4. Factual Background**

The Complainant owns a unisex clothing brand founded in Los Angeles by the artist and designer Josué Thomas.

The Complainant is the owner of several trademark registrations for GALLERY DEPT., including the following, as per trademark certificates submitted as annexes 6 through 10 to the Complaint:

- United States trademark registration No. 6048485 for GALLERY DEPT. (word mark), filed on August 27, 2018, and registered on May 5, 2020, in international class 25;
- Hong Kong, China trademark registration No. 305253804 for GALLERY DEPT. (word mark), registered on April 22, 2020, in class 25.
- Japan trademark registration No. 1430638 for GALLERY DEPT. (word mark), registered on September 6, 2018, in class 25;
- China trademark registration No. 1430638 for GALLERY DEPT. (word mark), registered on September 6, 2018, in class 25.
- United Kingdom trademark registration No. UK00801430638 for GALLERY DEPT. (word mark), filed on September 6, 2018, and registered on March 27, 2019 in class 25;

The Complainant is also the owner of the domain name <gallerydept.com>, registered on October 18, 2014, and used by the Complainant to promote and offer for sale its clothing products under the trademark GALLERY DEPT.

The disputed domain name <gallerydept.info> was registered on September 19, 2022, and is currently not pointed to an active website. However, according to the screenshots submitted by the Complainant - which have not been contested by the Respondent -, the disputed domain name was redirected prior to the present proceeding to a website featuring the Complainant's trademark GALLERY DEPT. and offering purported GALLERY DEPT. products at discounted prices.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the trademark GALLERY DEPT. and to the Complainant's <gallerydept.com> domain name.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is not commonly known by the disputed domain name and is intentionally

attempting to benefit from the confusion caused with the Complainant's trademark for its own commercial gain.

The Complainant highlights that the Respondent has never been given any permission to use Complainant's trademarks in any way nor has it ever been authorized or licensed by the Complainant to use its trademark or sell its merchandise.

The Complainant states that the Respondent pointed the disputed domain name to a website reproducing the Complainant's trademark and images of clothing taken from the Complainant's official website and offering for sale counterfeit GALLERY DEPT. products and submits that the Respondent has not made a *bona fide* offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name.

The Complainant also informs the Panel that the Respondent registered additional domain names encompassing the Complainant's trademark, which were used like the disputed domain name to offer counterfeit GALLERY DEPT. products on the websites to which they redirected, namely <gallerydeptofficial.com>, <gallerydept.org> and <gallerydept.llc>, and that two of them were subject of UDRP cases decided in favor of the Complainant, *i.e. Gallery Department, LLC v. ahmad Akram*, WIPO Case No. [D2022-4078](#) (<gallerydeptofficial.com>) and *Gallery Department, LLC v. Ahmad Akram*, WIPO Case No. [D2023-1593](#) (<gallerydept.org>).

With reference to the circumstances evidencing bad faith, the Complainant states that, considering a simple online search would have disclosed the Complainant's prior rights in the trademark GALLERY DEPT., the Respondent deliberately chose to register the disputed domain name as well as the additional domain names mentioned above, which only further proves that the Respondent was deliberately acting in a deceptive way and in bad faith.

The Complainant submits that the Respondent is using the disputed domain name for its own commercial gain and to the detriment of the Complainant, to intentionally attract consumers to its website where it is selling counterfeit merchandise using the Complainant's trademark without authorization.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 15(a) of the Rules: "A Panel shall decide a 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name, with the mere removal of the dot and the addition of the generic Top Level Domain (gTLD) “.info”, which can be disregarded being a standard registration requirement. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.11.1.

Therefore, based on the available record, the Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademark. Moreover, there is no element from which the Panel could infer the Respondent’s rights and legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Panel finds that the Respondent’s use of the disputed domain name, prior to the present proceeding, to redirect users to a website offering for sale apparently counterfeit versions of the Complainant’s products, using the Complainant’s trademarks and images taken from the Complainant’s website, does not amount to *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademarks.

Indeed, Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, since the disputed domain name entirely reproduces the Complainant’s trademark with the mere omission of a dot, it carries a high risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

As to bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the Complainant's trademark GALLERY DEPT. in connection with the Complainant's fashion products, promoted and offered for sale also on the Complainant's website "www.gallerydept.com", the Respondent was or should have been aware of the Complainant and its trademark at the time of registration.

The Panel also finds that the Respondent's pointing of the disputed domain name to a website displaying the Complainant's trademark and images of GALLERY DEPT. products demonstrates that the Respondent was indeed well aware of the Complainant's trademark.

The Panel further notes that, by pointing the disputed domain name to a website promoting and offering for sale *prima facie* counterfeit GALLERY DEPT. products whilst failing to accurately and prominently disclose the relationship with the trademark owner, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark GALLERY DEPT. as to the source, sponsorship, affiliation or endorsement of its website and the products promoted therein according to paragraph 4(b)(iv) of the Policy.

Moreover, Panels have held that the use of a domain name for illegal activity, including the sale of counterfeit goods and impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

As to the current redirection of the disputed domain name to an inactive website, prior Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness of the Complainant's trademark and the composition of the disputed domain name and finds that in the circumstances of this case the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel also finds paragraph 4(b)(ii) applicable in this case since the Respondent has registered the disputed domain name in order to prevent the Complainant from using the trademark and has engaged in a pattern of such conduct since, as mentioned above, it also registered at least two additional domain names incorporating the Complainant's registered trademark that have been subject of separate proceedings under the Policy. [WIPO Overview 3.0](#), section 3.1.2.

Therefore, based on the available record, the Panel finds the third element of the Policy has been established.

## 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.info>, be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: October 10, 2023