

ADMINISTRATIVE PANEL DECISION

Gama-Decor SAU v. Denis Fominev, EKONSULT Ltd.
Case No. D2022-1967

1. The Parties

The Complainant is Gama-Decor SAU, Spain, represented by Ebrand Services, Poland.

The Respondent is Denis Fominev, EKONSULT Ltd., the Russian Federation, represented by Fides LLC, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <gamadecor.com> is registered with DomReg Ltd. d/b/a LIBRIS.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2022. On June 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 3, 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 June 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same date, the Center sent a document to the Parties in English and Russian in respect of the language of the proceeding, and invited them to respond to it. On June 10, 2022, the Complainant filed an amendment to the Complaint and requested that the language of the proceeding be English.

The Center verified that the Complaint together with the amendment to the 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 June 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2022. On July 5, 2022, the Respondent requested an extension of the due date for the Response. On July 6, 2022, the Center granted the automatic four calendar day extension for response under paragraph 5(b) of the Rules, and the due date of the Response became July 9,

2022. The Response was filed with the Center on July 9, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on July 21, 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.

On July 22, 2022, the Complainant filed a supplemental filing. The Panel notes that, as discussed in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. Panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some "exceptional" circumstance). This has not been provided by the Complainant, and the Panel sees no justification for the acceptance of its supplemental filing.

4. Factual Background

The Complainant is a Spanish producer of contemporary kitchens, founded in 1987, and is part of the ceramics manufacturer Porcelanosa Group. The Complainant has about 200 employees and exports its products to more than thirty countries. It has its own showrooms in Spain, France, the United Kingdom, the United States of America, Italy, Portugal, and Germany, as has over a hundred independent distributors.

The Complainant is the owner of the following trademark registrations for the signs GAMADDECOR and GAMA-DECOR (jointly, the "GAMADDECOR trademark"):

- the Spanish trademark GAMA-DECOR, S.A. with registration No. N0211918, registered on June 22, 1998 for goods in International Classes 6, 17, and 19;
- the European Union trademark GAMADDECOR with registration No. 002098465, registered on June 14, 2002 for goods in International Classes 11, 20, and 21;
- the Chinese trademark GAMADDECOR with registration No. 3384497, registered on August 14, 2004 for goods in International Class 20; and
- the Mexican trademark GAMADDECOR with registration No. 915712, registered on January 16, 2006 for goods in International Class 20.

The Complainant is also the owner of the domain name <gama-decor.com>, which resolves to the Complainant's main website. The Complainant (or its parent company) is also the owner of the domain names <gamaddecor.com.mx>, <gamaddecor.info>, <gamaddecor.com.es>, <gamaddecor.es>, <gamaddecor.com.ve>, <kitchensgamaddecor.co.uk>, <gamaddecor.co.uk>, and <kitchensgamaddecor.uk>

The disputed domain name was registered on March 17, 2009. It resolves to a webpage that contains an offer for sale of the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant maintains that the disputed domain name is confusingly similar to its GAMADDECOR trademark, to the Complainant's company name and trade name, and to the domain names owned by the Complainant.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by it and is not affiliated to the Complainant. The Complainant states that “Gamadecor” is not a common word or phrase and is exclusively used by the Complainant. The Complainant notes that the disputed domain name was registered in 2009 and there is no information that it has ever been actively used. The Complainant is not aware of any intellectual property rights of the Respondent and notes that the information on the website under the disputed domain name indicates that it has been registered solely for commercial use, *i.e.*, to be sold for a profit to the Complainant.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the Registrant knew that there was a company using the “Gamadecor” designation or could easily check it. The Complainant notes that the Respondent is not actively using the disputed domain name and offers to sell it. The website at the disputed domain name contains the following statements: “If you are interested in purchasing domain name, please submit this form” and “Offers under \$1,000 US are usually not considered”. The Complainant maintains that the purpose of the registering of the disputed domain name was to sell it for a profit to the Complainant and points out that the minimum offer to be considered by the Respondent was USD 1,000, which amount is excessive. The Complainant adds that it made several attempts to contact the Respondent prior to the proceeding, but the Respondent never replied.

B. Respondent

The Respondent maintains that there is no evidence of bad faith or illegal use and ownership of the disputed domain name. According to it, it is legitimate to use a domain name if it is a noncommercial project; such a model is acceptable and valid within the framework of the UDRP.

In the Respondent’s words, the registration of the disputed domain name was made specifically for a non-profit organization, which initially registered it for the Ukrainian organization Gama Décor Studio. Then, the contact details of the registrant of the disputed domain name were changed to a non-profit association because the Ukrainian company was dissolved. According to the Respondent, the existence of a developed and implemented website design describing the field of activity and goals of a non-profit organization is a proof of the demonstrable preparations of the owner of the disputed domain name to use it.

The Respondent explains that its hosting provider mixed up domain names of different owners and accidentally placed the disputed domain name for sale, and maintains that it has not negotiated or personally offered the disputed domain name for sale. According to it, after learning that the disputed domain name was offered for sale, it immediately removed the offer.

The Respondent states that in the 14 years after the registration of the disputed domain name, the Complainant never contacted the Respondent, and no other incidents of similar character took place. The Respondent maintains that it has done nothing illegal, has not received any notice of anyone else’s claims and has not been addressed directly.

6. Discussion and Findings

6.1. Procedural issue – Language of the proceeding

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain name is Russian. Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests that the language of the proceedings be English. It submits that the Respondent understands English, because the content of the website at the disputed domain name is available in English. The Complainant also states that if it is required to submit the Complaint and the evidence

translated in Russian, it would incur substantial translation costs and the proceedings would be delayed.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted any objections to the Complainants' request that the proceedings be held in English, but has submitted the response noted above.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English.

6.2 Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

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

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]"

A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of various registrations of the GAMADECOR trademark and has thus established his rights in this trademark for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain ("TLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" TLD section of the disputed domain name.

The disputed domain name reproduces the GAMADECOR trademark in its entirety without any other elements. In view of the this, the Panel finds that the disputed domain name is identical to the GAMADECOR trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

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 often 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. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it is not commonly known by it, has no intellectual property rights in it and is not affiliated to the Complainant, and because “gamadecor” is not a common word or phrase but is exclusively used by the Complainant. The Complainant notes that since it was registered in 2009, the disputed domain name has not been actively used, but has only been offered for sale for a profit. Thus, the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent submits that the registration of the disputed domain name was made for a non-profit organization, which initially registered it for the Ukrainian organization Gama Décor Studio. Then, the contact details of the registrant of the disputed domain name were changed to a non-profit association because the Ukrainian company was dissolved. It however provides no details about the identities and activities of these entities and its relations with them, and does not specify the dates when the circumstances it describes took place, or indeed their current status or relation to an interest in the disputed domain name. The Respondent submits no supporting evidence about these allegations either.

The Respondent also explains that its hosting provider mixed up domain names of different owners and accidentally placed the disputed domain name for sale, and maintains that it has not negotiated or personally offered the disputed domain name for sale. According to it, after learning that the disputed domain name was offered for sale, it immediately removed the offer. The Panel is willing to put this aside but notes that there is however no evidence of any correspondence between the Respondent and its hosting provider about this, and in any case the registrant of a domain name is the entity that is in control of and is fully responsible for the content of the website to which its domain name resolves, including for the offer for sale that was placed at the webpage associated to the disputed domain name.

The Respondent states that in the fourteen years after the registration of the disputed domain name, the Complainant never contacted the Respondent. This statement is however disproven by the evidence submitted by the Complainant showing that in 2022 the latter has made several attempts to serve its claims to the Respondent, and the Registrar has confirmed forwarding the Complainant’s correspondence to the Respondent. This is sufficient for the Panel to conclude that the Respondent is most likely to have received the Complainant’s correspondence but has decided not to respond. The Panel would expect a party having rights or legitimate interests in a domain name to respond to the Complainant’s claims and to explain its position.

The evidence in the case file shows that as late as May 27, 2022, the disputed domain name resolved to a webpage that informed visitors that the disputed domain name is for sale and invited them to submit offers with the note that offers under USD 1,000 are usually not considered. The Panel conducted limited factual research by checking the archived versions of the website at the disputed domain name, available at the Wayback Machine. With regard to the Panel conducting limited factual research into matters of public record, such as consulting relevant publicly available websites including the Wayback Machine, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The research made by the Panel showed that the Respondent’s website has contained for years a notice in one or other form that the disputed domain name is for sale, without any other substantive website content.

According to the Respondent, the existence of a developed and implemented website design describing the field of activity and goals of a non-profit organization is a proof of the demonstrable preparations of the owner of the disputed domain name to use it. The new version of the website, as submitted by the Respondent, was however activated only after May 27, 2022 (for which date the evidence submitted by the Complainant shows that the website still contained the notice that the disputed domain name was for sale). It is unclear on which date the new version of the website was activated, as the only archived copy of this

version of the website is from July 9, 2022. The Respondent does not specify on which date it changed the content of the website, which it could easily have done, but it appears from the evidence in the case that this must have happened after the Respondent learned about the claims of the Complainant (the Complaint was filed with the Center in May, 2022 but the Complainant had written several times prior to complain to the Respondent). For this reason, the Panel does not consider that the version of the website submitted by the Respondent supports a conclusion that prior to the notice of the dispute, the Respondent has made demonstrable preparations to use the disputed domain name for a *bona fide* noncommercial purpose.

In view of all the above, the Panel is not convinced by the Respondent's allegations that the disputed domain name was registered for a *bona fide* purpose, and that prior to the dispute the Respondent has made demonstrable preparations for the use of the disputed domain name for a non-profit project. It is more likely that this version of the website was activated by the Respondent after it learned of the present proceeding in an attempt to set up a defense against it.

Therefore, the Panel finds that the Complainant's *prima facie* case has not been rebutted, and the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The disputed domain name is identical to the Complainant's GAMADDECOR trademark, which appears to the Panel as distinctive. For years, it has resolved to a webpage containing a statement that the disputed domain name is for sale and an invitation to interested parties to submit offers for it with a notice that offers for less than USD 1,000 are not likely to be considered. The Panel considers that the amount of USD 1,000 is a valuable consideration that is likely to be in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name.

As discussed in section 6.2.B above, the Respondent's allegations that it has registered the disputed domain name for a *bona fide* purpose and that prior to the dispute it had started demonstrable preparations for its use in relation to non-profit entities, are not supported by evidence. Rather, the evidence in the case supports a conclusion that is more likely that the Respondent activated a new version of the website at the disputed domain name only after it learned of the present proceeding and that it must have been set up as a defense against the Complaint.

Taking the above into account, the Panel finds as more likely that the Respondent has registered the disputed domain name primarily for the purpose of selling it to the Complainant who is the owner of the

GAMADECOR trademark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name.

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 <gamadecor.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: August 4, 2022