

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Muhammad Arslan
Case No. D2023-0571

1. The Parties

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

The Respondent is Muhammad Arslan, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <officialgallerydept.com> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 9, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 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 February 13, 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 February 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023. The Respondent did not submit any substantive response, however sent three informal communications on February 12, 2023 and March 11, 2023. Accordingly, the Center notified Parties of the Commencement of Panel Appointment Process on March 9, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on March 9, 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 Los Angeles founded by artist and designer Josué Thomas that strives to make quality products with artistic integrity. The Complainant owns and operates a website at <gallerydept.com>, and also retail store fronts in Los Angeles and Miami.

The Complainant is the owner of the following trademarks:

- U.S. Registration No. 6048485 for GALLERY DEPT., registered on May 5, 2020;
- Hong Kong Registration No. 305253804 for GALLERY DEPT., registered on May 15, 2020;
- United Kingdom Registration No. UK00801430638 for GALLERY DEPT., registered on March 27, 2019.

The Complainant is and has been the registrant for <gallerydept.com> since October 19, 2014.

The disputed domain name was registered on September 27, 2022, and it is currently not in use.

At the time of filing the complaint, the disputed domain name resolved to a website where, according to the Complainant "Respondent is [...] selling illegitimate counterfeit merchandise containing Complainant's duly owned GALLERY DEPT. marks on its unauthorized website with its unauthorized domain name, and at a fraction of the price of Complainant's authentic merchandise". The Complainant has provided evidence of such use.

5. Parties' Contentions

A. Complainant

The Complainant requests that the disputed domain name be transferred to the Complainant.

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the GALLERY DEPT. mark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

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

B. Respondent

The Respondent did not submit any substantive response, however sent two informal communications.

On February 12, 2023, the Respondent emailed to the Center the following message: "This is the case Number. My domain officialgallerydept.com got suspended without any reason. i am the domain owner and it's completely legal so kindly unsuspend my domain i shall be very thankful to you!".

On March 11, 2023, the Respondent emailed to the Center the following message: “Kindly unsuspend my domain. I’m authorized distributor!!!”.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (i) the 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 such domain name; and
- (iii) the 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 disputed domain name directly and fully incorporates the Complainant’s GALLERY DEPT. trademark, preceded by the term “official”. The Panel finds the entirety of the mark is recognizable within the disputed domain name. 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 1.8.

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

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy lists the ways that a respondent may demonstrate rights or legitimate interests in the domain name:

- (i) before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

In this case, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. In particular, the Respondent has not submitted any evidence to rebut the Complainant's contention that it has never authorized, licensed or permitted the Respondent to use the GALLERY DEPT. mark in any way.

The Respondent is also not using the disputed domain name in connection with any *bona fide* offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name. Moreover, the composition of the disputed domain name, adding the term "official" before the Complainant's trademark, carries a risk of implied affiliation, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

With respect to the Respondent's statement that he is an authorized distributor, the Panel finds no evidence in the record to support this allegation. On the contrary, upon the evidence present in the case file, the Respondent seems to be trying to illegitimately pass off as the Complainant. In addition, the Complainant states that the Respondent is not nor has ever been an authorized retailer of the Complainant's merchandise.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that:

Indeed, the Respondent is purportedly selling illegitimate merchandise containing the Complainant's duly owned GALLERY DEPT. marks on its unauthorized website with its unauthorized domain name, and at lower prices of the Complainant's authentic merchandise. The Respondent is not now nor has ever been an authorized retailer of Complainant's merchandise, nor has Respondent ever been granted any rights or licenses in Complainant's GALLERY DEPT. marks.

The addition of the generic term "official" to the disputed domain name does not help the Respondent, and further supports a finding of bad faith by trying to confuse Internet users.

Based on the available record, the Panel finds the third element of the Policy has also 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, <officialgallerydept.com>, be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: March 22, 2023