

ADMINISTRATIVE PANEL DECISION

Gabriel Bros, Inc. dba Gabriel & Company v. Oz Avci
Case No. D2023-0680

1. The Parties

The Complainant is Gabriel Bros, Inc. dba Gabriel & Company, United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, P.C., United States.

The Respondent is Oz Avci, United States.

2. The Domain Name and Registrar

The disputed domain name <gabrielandcompanynewyork.com> (the “Disputed Domain Name”) is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 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, 1&1 Internet Inc) and contact information in the Complaint. The Center sent an email communication to the Complainant February 17, 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 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 March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on April 3, 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 operates in the jewelry business. It is the owner of numerous trademark registrations for the GABRIEL & CO. family of trademarks for jewelry and related goods and services including:

United States Reg. No. 3,334,581 for GABRIEL & CO., registered on November 13, 2007, in Class 14 for "diamonds, precious and semi-precious stones, jewelry";

United States Reg. No. 3,249,102 for GABRIEL, registered on June 5, 2007, in Class 14 for "diamonds, precious and semi-precious stones, jewelry";

The Complainant also owns registrations for GABRIEL & CO. in Canada, United Kingdom, European Union, China, India and Australia.

The Disputed Domain Name was registered on January 11, 2023. The Disputed Domain Name is currently being used by the Respondent to resolve to an online store that features the GABRIEL trademark in the banners at the top of the pages, including the homepage. However, the website does not offer any of the Complainants' products for sale, but instead, offers jewelry from other designers and clothing, handbags, and shoes.

5. Parties' Contentions

A. Complainant

The Complainant has built an enormously successful jewelry business in the heart of New York City and in the more than 30 years since its founding, it has become one of the premiere jewelry companies in the United States. In addition to its trademark registrations, it also has extensive and strong common law rights in the GABRIEL & CO. trademarks.

The Complainant has invested substantial amounts of time, effort, and money in advertising and promoting its marks nationwide via publications and on the Internet via its website and social media. The Complainant has almost 5 million "likes" and followers on its GABRIEL & CO. brand on Facebook, Twitter, Pinterest, Instagram, YouTube, and TikTok. As a result of its advertising and promotional efforts, commercial success, and extent of sales under the marks, its marks have achieved widespread recognition.

The Disputed Domain Name was registered by the Respondent on January 11, 2023, decades after the Complainant first began using its GABRIEL & CO. marks, and long after the Complainant obtained its first trademark registrations for the GABRIEL & CO. trademarks in the United States.

The Disputed Domain Name is currently being used by the Respondent in connection with a website that closely resembles the Complainant's own website and features the GABRIEL trademark in the banner at the top of the homepage and all other pages of the website. The Respondent's website at the Disputed Domain Name does not offer any GABRIEL & CO. products for sale, instead, it offers jewelry from other designers such as Christian Dior, Cartier, and Louis Vuitton. The website contains no disclaimer concerning the Respondent's lack of affiliation with or authorization from the Complainant.

The Disputed Domain Name is also being used in connection with a scam where the Respondent is impersonating the Complainant with an unauthorized advertising campaign that the Respondent claims will

appear in *New York Fashion Magazine*. The Respondent sent messages to influencers via Instagram and Facebook, offering an opportunity to be in the campaign. The Complainant denies that anyone from its, or any related, companies sent or authorized such messages.

There has never been any relationship between the Complainant and the Respondent that would give the Respondent a license, permission, or authorization to use or register the Disputed Domain Name or use its mark for any other purpose.

The Disputed Domain Name incorporates, in its entirety, the Complainant's registered GABRIEL and GABRIEL & CO. trademarks. Beyond incorporation of the Complainant's GABRIEL and GABRIEL & CO. trademarks, the Disputed Domain Name consists only of the ampersand being spelled out as "and", the abbreviation "CO." being spelled out as "company," the geographic term "New York," and the ".com" generic Top-Level Domain (the "gTLD"). The substitution of the word "and" for the ampersand in the GABRIEL & CO. trademark does not negate the confusing similarity of the Disputed Domain Name to the Complainant's mark, because the ampersand symbol means "and". The Respondent's use of "company" in the Disputed Domain Name, rather than the abbreviated "co." is irrelevant, as the two terms are essentially equivalent. The Disputed Domain Name also incorporates the geographic term "New York," removing the space between the two words, a term closely related to the location of the Complainant's business.

There is no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the Disputed Domain Name or operate a website that mimics the Complainant's own website. The Complainant has never authorized the Respondent to use the GABRIEL & CO. marks, or any marks confusingly similar thereto, for any purpose, including as a domain name. Consequently, the Respondent's use of the Complainant's GABRIEL & CO. mark in the Disputed Domain Name cannot be *bona fide*.

If the goods being sold at the Respondent's website are genuine GABRIEL & CO. merchandise (and there is no evidence that this is the case), the Respondent's use of the Disputed Domain Name would still not be *bona fide*. Under the majority view, for a reseller to make a *bona fide* use of a trademarked term in a domain name, the Respondent must *inter alia*: (1) sell only the trademarked goods or services; and (2) accurately disclose the Respondent's relationship with the trademark owner.

There is no reason for the Respondent to have chosen the Disputed Domain Name unless the Respondent was seeking to create an association with the Complainant. Since the Respondent has no connection with the Complainant and has never been authorized by the Complainant to use or register the Disputed Domain Name, the very fact that the Respondent has registered the Disputed Domain Name establishes opportunistic bad faith use and registration.

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 well-known GABRIEL & CO. mark and has shown that no other entity has rights in or uses the Complainant's mark. The substitute of "and" instead of "&" does not prevent the Complainant's trademark from being recognizable in the Disputed Domain Name. The word "company" is commonly abbreviated "co" and the inclusion of the geographic term New York does not prevent a finding of confusing similarity of the Disputed Domain Name with the Complainant's registered mark. The TLD ".com" 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 decades after the Complainant had begun using its GABRIEL & CO. mark indicates that the Respondent sought to piggyback on the GABRIEL & CO. mark for illegitimate reasons. Moreover, the Disputed Domain Name incorporating the Complainant's trademark together with the geographical term "New York" which refers to New York City where the Complainant is based, itself carries a risk of implied affiliation.

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 resolved to a website seemingly impersonating the Complainant by featuring the Complainant's GABRIEL trademark. While impersonating the Complainant it does not appear that the Respondent actually offered any goods offered by the Complainant, rather it claims to offer jewelry offered by the Complainant's competitors as well as other luxury items.

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, noting the circumstances of this case, 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 of the GABRIEL & CO. mark and the Complainant's association with New York, it is inconceivable that the Respondent registered the Disputed Domain Name without knowledge of the Complainant.

The use of the Disputed Domain Name by the Respondent is clearly in bad faith. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's 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 the respondent's website or location or of a product or service on the respondent's website or location. The Complainant has submitted evidence that the Respondent has used the Disputed Domain Name in order to direct users to a website which uses the Complainant's trademark while offering jewelry from the Complainant's competitors as well as other luxury goods. Further, the

Respondent has used the Disputed Domain Name to convince influencers to sign up to a non-existent ad campaign.

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, <gabrielandcompanynewyork.com>, be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: April 17, 2023