

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Stephen Duke

Case No. D2023-1506

1. The Parties

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

The Respondent is Stephen Duke, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <thegallerydept.net> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 6, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 April 12, 2023, providing the registrant and contact information behind the privacy service as disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 17, 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 April 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2023. The Respondent sent an informal email to the Center on April 21, 2023.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on May 23, 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 to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a clothing brand based in Los Angeles founded by artist and designer Josué Thomas. The Complainant runs a webpage at “www.gallerydept.com” since 2014.

The Complainant owns several trademarks around the world with the term GALLERY DEPT, such as U.S. Trademark Registration no. 6048485 registered on April 2, 2017. The Complainant also advertises the Gallery Dept. trademark and merchandise on Instagram where it has 248.000 followers to date.

According to the Complainant, the Respondent registered the Domain Name on September 30, 2022. The Domain Name previously resolved to webpage that sold illegitimate counterfeit merchandise using the Complainant’s trademark. At the time of drafting the Decision, the Domain Name resolved to a holding page with reference to WordPress.

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 Domain Name. The Complainant provides evidence of trademark registrations and argues that the Domain Name is confusingly similar to the Complainant’s trademark as it incorporates the Complainant’s trademark and merely adds the definitive article “the”.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent reproduces the Complainant’s trademark in the Domain Name without any authorization from the Complainant. The Respondent is not making any commercial or fair use of the Domain Name. The Respondent uses the Domain Name to sell illegitimate counterfeit merchandise using the Complainant’s trademark. The Complainant impersonates the Complainant to divert consumers to the Respondent’s website for its own financial gain.

The Complainant believes that the Respondent was aware of the Complainant and its trademark when the Respondent registered the Domain Name. The Respondent’s website has been used to impersonate the Complainant and sell counterfeit merchandise. The Complainant also argues that a simple search for similar domain names would have alerted the Respondent to the Complainant’s domain name. The Complainant’s domain name is registered nearly eight years before the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant’s contentions, but sent on April 21, 2023 an informal email to the Center which read: “Why you sending me this email?”.

6. Discussion and Findings

A. Identical or Confusingly Similar

The first element functions primarily as a standing requirement. The 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.

The Complainant has established that it has rights in the trademark GALLERY DEPT. The Domain Name incorporates the Complainant's trademark, adding "the". The addition does not prevent a finding of confusing similarity between the Domain Name and the trademark. For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain ("gTLD"); see [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

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, 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.

Based on the evidence, the Respondent is not affiliated or related to the Complainant in any way. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired trademark rights. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, the use, as it intends to confuse Internet users seeking the Complainant, is evidence of bad faith, see below.

The Panel finds that the Complainant has made out an un rebutted *prima facie* case. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

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.

It is clear from the composition and the use of the Domain Name that the Respondent knew of the Complainant and its prior rights when the Respondent registered the Domain Name. The Respondent's use of the Domain Name is not *bona fide* but clear evidence of bad faith.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

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 Domain Name <thegallerydept.net> be transferred to the Complainant.

/Mathias Lilleengen/

Mathias Lilleengen

Sole Panelist

Date: June 6, 2023