

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Muhammad Ibrar, Web Designer
Case No. D2023-4818

1. The Parties

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

The Respondent is Muhammad Ibrar, Web Designer, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <gallerydephat.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 21, 2023. On November 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 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 November 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Center then sent an email communication request clarification of mutual jurisdiction on November 22, 2023. The Complainant clarified its selection of mutual jurisdiction on November 22, 2023. The Complainant then filed an amended Complaint on November 27, 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 November 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 19, 2023.

The Center appointed David Stone as the sole panelist in this matter on January 2, 2024. 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 unisex clothing brand, specialising in design, production and branding, based in Los Angeles, California, and founded by artist and designer Josué Thomas.

The Complainant is the owner of trade mark registrations consisting of or including the sign GALLERY DEPT. in several jurisdictions worldwide, including:

- United States trade mark registration no. 6048485 GALLERY DEPT. (word) filed on August 27, 2018, registered on May 5, 2020, for goods in international class 25;
- Hong Kong, China (“Hong Kong”) trade mark registration no. 305253804 GALLERY DEPT. (word) filed on April 22, 2020, registered on September 30, 2020, for goods in international class 25;
- United Kingdom trade mark registration no. UK00801430638 GALLERY DEPT. (word), filed on September 6, 2018, registered on March 27, 2019, for goods in international class 25;

together, the “GALLERY DEPT. Marks”.

The Complainant is also the owner of trade mark registrations consisting of or including the sign ART THAT KILLS, in several jurisdictions worldwide, including:

- United States trade mark registration no. 6125383 ART THAT KILLS (word) filed on December 6, 2018, registered on August 11, 2020, for goods in international class 25;
- Hong Kong trade mark registration no. 305980898 ART THAT KILLS filed on June 10, 2022, registered on February 13, 2023, for goods in international class 25;
- United Kingdom trade mark registration no. UK00003702569 ART THAT KILLS (word) filed on September 28, 2021, registered on March 11, 2022, for goods in international class 25;

together, the “ART THAT KILLS Marks”.

The Complainant is the owner of the domain name “www.gallerydept.com” which was registered on October 19, 2014, and it is the address of the Complainant’s official website (the “Complainant’s Domain Name”).

The disputed domain name <gallerydephat.com> was registered on November 1, 2022. According to the evidence provided by the Complainant, the disputed domain name resolves to a website which purports to sell clothing, namely different types of hats, bearing the GALLERY DEPT. Marks and ART THAT KILLS Marks (Annexes 24 to 27).

The Complainant issued cease and desist letters to the Respondent in relation to the Complainant’s trade marks on (i) June 29, 2023, and (ii) July 24, 2023, to inform the Respondent of its rights in and to the GALLERY DEPT. Marks and the ART THAT KILLS Marks.

The Respondent failed to respond to the cease and desist letters.

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 each of the three elements specified in paragraph 4(a) of the Policy is established in the present case:

1) The Complainant asserts that the disputed domain name is confusingly similar to a trade mark which it claims to own rights in relation to, specifically the (i) GALLERY DEPT. Marks, and (ii) Complainant's Domain Name, under paragraph 4(a)(i) of the Policy.

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's Domain Name and the GALLERY DEPT. Marks, as the disputed domain name incorporates the entirety of the GALLERY DEPT. Marks.

The Complainant states that the only point of distinction between the disputed domain name and the Complainant's Domain Name is the inclusion of the word "hat" in the disputed domain name. The Complainant argues that the addition of this word does nothing to distinguish the disputed domain name from the Complainant's Domain Name. The Complainant further argues that the inclusion of the word "hat" in the disputed domain name only serves to enhance the confusing similarity of the disputed domain name to the Complainant's Domain Name, as it creates the impression that the Respondent's website is involved in the sale and merchandising of hats designed, produced and branded by the Complainant.

2) The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraph 4(a)(ii) of the Policy.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the domain name, because there is evidence to suggest that the disputed domain name is being used by the Respondent in an illegitimate manner to suggest some form of connection, sponsorship, or endorsement by the Complainant for the purpose of selling products and merchandise. The Complainant further submits that where a complainant has not authorised the respondent to use the mark, the burden shifts to the respondent to establish some right or legitimate interest in respect of the disputed domain name.

The Complainant states that the Respondent is not associated with the Complainant, nor has the Complainant ever permitted or authorised the Respondent to use the disputed domain name or the GALLERY DEPT. Marks.

Additionally, the Complainant argues that the Respondent is not commonly known by the disputed domain name. It is the Complainant's case that the Respondent is seeking to benefit from the confusion caused by its use of the disputed domain name, to achieve unauthorised commercial gain. The Complainant states that, in using the disputed domain name, the Respondent is seeking intentionally to redirect consumers away from the Complainant's website to its own website which, according to the Complainant, is selling illegitimate counterfeit merchandise containing the GALLERY DEPT. Marks and the ART THAT KILLS Marks owned by the Complainant, at a similar price to that of goods and merchandise sold legitimately via the Complainant's website.

The Complainant submits that the Respondent's actions are contrary to that of a *bona fide* offering of goods and services.

3) The Complainant asserts that the disputed domain name was registered and is being used in bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant argues that the Respondent has registered the disputed domain name in bad faith, evidenced by the Respondent's attempt to imply a connection with the Complainant's website, and the Respondent's attempt to imply that it is authorised to use the GALLERY DEPT. Marks in the disputed domain name.

The Complainant states that the Respondent is using the disputed domain name intentionally to attract customers, to the detriment of the Complainant. The Complainant states that the counterfeit merchandise being offered on the Respondent's website looks identical to the merchandise being offered on the Complainant's website. In addition, the Complainant states that when the search terms "gallery dept hat" are used in Google, the Respondent's website is displayed as one of the results on the first page, adding to the confusion which consumers are likely to face as a result of the disputed domain name.

Further, the Complainant states that the Respondent had constructive notice of the Complainant's Domain Name when it acquired the disputed domain name on November 1, 2022, and had the Respondent carried out a quick search, it would have been notified of the Complainant's Domain Name which has been registered since October 19, 2014. Additionally, the Complainant states that a search for the trade marks which it owns would have further notified the Respondent that the Complainant had registered the GALLERY DEPT. Marks as early as February 2, 2017. The Complainant also asserts that the Respondent has provided additional evidence of its bad faith by failing to respond to the cease and desist letters.

In addition, the Complainant contends that the Respondent's use of a privacy shield to obscure its identity, in addition to the fact that the Respondent has at least one adverse decision against it in a previous UDRP decision, further supports the argument that the Respondent has acted in bad faith, with respect to registration, and use, of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

- (i) that the disputed domain name is identical or confusingly similar to a trade mark 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 disputed domain name has been registered and is being used in bad faith.

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

A. Identical or Confusingly Similar

It is well accepted that the first requirement 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 trade mark 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 trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the GALLERY DEPT. Marks is reproduced within the disputed domain name.

Accordingly, the disputed domain name is confusingly similar to the GALLERY DEPT. Marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “hat”, may bear on assessment of the second and third elements, the Panel finds the addition of this term does not prevent a finding of confusing similarity between the disputed domain name and the GALLERY DEPT. Marks for the purposes of the Policy [WIPO Overview 3.0](#), section 1.8.

The threshold for confusing similarity typically involves a side-by-side comparison of the textual string within the domain names in dispute and the relevant mark. The Panel accepts that minor alterations cannot prevent a finding of confusing similarity between the trade mark and the domain name in dispute (see, e.g., *Dow Jones & Company, Inc. and Dow Jones, L.P. v. Powerclick, Inc.*, WIPO Case No. [D2000-1259](#)). The Panel, therefore, accepts that it is permitted to disregard the removal of the “.” found in the GALLERY DEPT. Marks from the disputed domain name, as this does not affect a finding of confusing similarity between the disputed domain name and the Complainant’s trade marks. The Panel therefore finds that, carrying out a side-by-side comparison of the disputed domain name and the mark, the disputed domain name is confusingly similar to the Complainant’s GALLERY DEPT. Marks.

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 sets out the criteria that determine whether a domain name registrant has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, the respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed 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 disputed domain name, even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognised that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). 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 available 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* case 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 the Respondent has failed to rebut the *prima facie* case established by the Complainant:

(a) With respect to paragraph 4(c)(i) of the Policy, there is no evidence in the record that the Respondent, with the name “Muhammad Ibrar, Web Designer”, before any notice of the dispute, used or prepared to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services.

(b) With respect to paragraph 4(c)(ii) of the Policy, there is no evidence in the record that the Respondent has ever been commonly known by the disputed domain name or has acquired trade mark rights in a name corresponding to it.

(c) With respect to paragraph 4(c)(iii) of the Policy, the Panel agrees that the evidence provided does not suggest that the Respondent has made, and is making, a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain. On the contrary, the evidence provided by the Complainant demonstrates that the disputed domain name resolves to a website where clothing items, notably hats, bearing the GALLERY DEPT. Marks and ART THAT KILLS Marks are being sold, with the website itself being clearly labelled with the GALLERY DEPT. word mark. This leads the Panel to believe that it is the intention of the Respondent misleadingly to divert consumers to the disputed domain name, to enable the Respondent to sell possible counterfeit goods bearing the GALLERY DEPT. Marks and ART THAT KILLS Marks owned by the Complainant.

The Panel further notes that, upon examination of the Respondent’s website, it appears to the Panel that some of the images, particularly those of individuals wearing the hats which are being advertised, are not genuine, but are instead manipulated images intended to suggest the authenticity of the goods being sold, and imply a connection with the Complainant’s website.

Furthermore, the Panel draws an adverse inference from the section of the Respondent’s site containing contact information. Upon examination of the Respondent’s website, the Panel finds that the contact information includes the written street address of the flagship Gallery Department store in Los Angeles owned by Josué Thomas, alongside a map which fails to load correctly. The Panel is satisfied that this provides further evidence of the Respondent’s intention to divert and mislead consumers for its own commercial gain by attempting to fraudulently imply a connection between itself and the Complainant.

Finally, and crucially, if the Respondent was in the process of developing a legitimate business using the GALLERY DEPT. Marks as a name or brand, and was building a website to support and advertise that business, the Panel can see no reason as to why it would not have explained that in a response to the Complainant. The Panel concludes that the Respondent’s entire website is a mock-up designed to give an impression of legitimate commercial activity to the detriment of the Complainant. Moreover, the Panel concludes that the addition of the term “hat” in the disputed domain name increases the confusing similarity of the disputed domain name and carries a risk of implied affiliation, as the Complainant is known for selling clothes and merchandise, including hats, bearing the GALLERY DEPT. Marks.

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 is being 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.

Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

- (i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit;
- (ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct;
- (iii) disrupt the business of a competitor; or
- (iv) divert Internet traffic for commercial gain.

The Panel finds it to be inconceivable that the Respondent was unaware of the Complainant's rights in the GALLERY DEPT. Marks and the Complainant's Domain Name at the time of registering the disputed domain name.

In the present case, the Panel notes that the Respondent registered the disputed domain name on November 1, 2022, eight years after the Complainant's Domain Name had been registered on October 19, 2014, and several years after the Complainant had registered the GALLERY DEPT. Marks which were registered from as early as 2019. The Panel accepts that the Respondent knew of the trade marks owned by the Complainant, and that the Respondent deliberately chose the disputed domain name in reference to the Complainant's trade marks. The Panel further accepts that a rudimentary search for similar domain names or trade marks would have revealed the Complainant's Domain Name and the GALLERY DEPT. Marks, alerting the Respondent to the Complainant's rights. Furthermore, the Panel finds that the Complainant provided actual notice of its rights to the GALLERY DEPT. Marks and ART THAT KILLS Marks, to the Respondent, via the cease and desist letters to which the Respondent failed to respond.

In the present case, the Complainant has provided documentation evidencing the manner in which the Respondent is selling clothing items bearing the GALLERY DEPT. Marks and ART THAT KILLS Marks. Therefore, the Panel finds that the Respondent has registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks. Further, the Complainant asserts that products sold on the website at the disputed domain name are counterfeit which has not been rebutted by the Respondent. Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), sections 3.1.4 and 3.4. The Panel also notes that the Respondent uses the address of the Complainant's flagship store, and the Panel is satisfied that the Respondent's behaviour amounts to impersonation of the Complainant. The Panel concludes that the Respondent's conduct provides manifest evidence of bad faith.

Finally, the Panel finds that the Respondent's efforts to conceal its identity using a privacy shield identity, that the Respondent has at least one adverse decision against it in a previous UDRP decision (see *Gallery Department, LLC v. Privacy Service Provided by Withheld for Privacy ehf / Muhammad Ibrar, Web Designer*, WIPO Case No. [D2022-3193](#)), and the Respondent's lack of participation in these proceedings can be construed together as further evidence that the Respondent registered, and is using, the disputed domain name in bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element 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 disputed domain name, <gallerydephat.com>, be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: January 19, 2024