

ADMINISTRATIVE PANEL DECISION

Gallery Department, LLC v. Hafiz Muhammad Awais Iqbal
Case No. D2023-4820

1. The Parties

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

The Respondent is Hafiz Muhammad Awais Iqbal, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <gallerydeptstore.net> 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 20, 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) 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 sent an email communication to the Complainant on November 22, 2023, requesting a clarification of mutual jurisdiction. The Complainant responded to the Center's request on November 22, 2023. The Complainant then filed an amendment to the Complaint on November 27, 2023.

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 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 20, 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. On January 11, 2024, the Panel issued a Panel Order, providing additional time for the Respondent to comment on the annexes submitted with the Complaint.

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 April 22, 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 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 June 10, 2022, 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;
- Japan Trade mark International Registration No. 6404613 ART THAT KILLS (word), filed on September 23, 2020, registered on June 18, 2021, for goods in international class 25,

together, the "ART THAT KILLS Marks".

The Complainant is the owner of the domain name <gallerydept.com> which was registered on October 19, 2014, and is the address of the Complainant's official website (the "Complainant's Domain Name").

The disputed domain name <gallerydeptstore.net> was registered on September 22, 2022. According to the evidence, the disputed domain name resolves to a website which sells clothing, including t-shirts, long-sleeve shirts, hoodies, shorts, sweatpants and hats bearing the GALLERY DEPT. Marks and the ART THAT KILLS Marks (Annexes 31 to 39).

The Complainant issued a cease and desist letter to the Respondent dated July 20, 2023, informing the Respondent of the Complainant's rights in the GALLERY DEPT. Marks and ART THAT KILLS Marks, amongst other trade marks (Annex 40).

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

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

The Complainant states that the only point of distinction between the Respondent's Domain Name and the GALLERY DEPT. Marks, and the Complainant's Domain Name is the (i) addition of the word "store" in the disputed domain name, and (ii) generic Top-Level Domain ("gTLD") identifier ".net". The Complainant argues that the gTLD is merely a technical requirement and, therefore, should be disregarded by the Panel when assessing confusing similarity. Instead, the Complainant argues that the assessment should involve a side-by-side comparison at the second level of the domain, citing *Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v. Banana banana*, WIPO Case No. [D2021-4320](#). On this basis, the Complainant argues that upon a side-by-side comparison of the disputed domain name and the Complainant's Domain Name, the disputed domain name is identical to the GALLERY DEPT. trade mark. The Complainant further argues that the addition of the word "store" in the disputed domain name only serves to enhance the confusing similarity of the disputed domain name as this word gives customers the false impression that the Respondent's Website is the "store" for the Complainant's merchandise bearing the GALLERY DEPT. Marks.

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 the disputed domain name because there is evidence that the Respondent is using the disputed domain name in an illegitimate manner to "suggest some form of connection, sponsorship, or endorsement by the complainant for the purpose of selling products". 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 argues that the Respondent is not commonly known by the disputed domain name. Additionally, the Complainant states that the Respondent is not associated with the Complainant, nor has the Complainant ever permitted or given authorization to the Respondent in respect of the disputed domain name or the GALLERY DEPT. Marks.

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 its domain name.

The Complainant notes that panels have previously found the sale of counterfeit goods via a respondent's website to be evidence of bad faith. The Complainant states that the Respondent is using the disputed domain name to intentionally 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.

The Complainant further argues that panels have previously decided that registering a domain name whilst under constructive notice of a complainant's domain name or other registered trade marks is evidence of bad faith. Further, the Complainant states that the Respondent had constructive notice of the Complainant's Domain Name when it acquired the disputed domain name on September 22, 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 bad faith by failing to respond to the cease and desist letter.

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

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

The threshold for confusing similarity is limited to a side-by-side comparison between the disputed domain name and the trademark. 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., *Red Bull GmbH v. Grey Design*, WIPO Case No. [D2001-1035](#); *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.

Furthermore, the Panel finds that the addition of the gTLD is viewed as a standard registration requirement and as such is disregarded. In accordance with section 1.11.1 of [WIPO Overview 3.0](#) and *Rexel Developments SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#), the Panel is permitted to disregard the addition of the gTLD “.net” included in the disputed domain name. The Panel therefore finds that, carrying out a side-by-side comparison of the domain names, 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 “Hafiz Muhammad Awais Iqbal”, 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, whilst the Respondent’s website might constitute evidence that the disputed domain name is to be used in connection with a *bona fide* offering of goods, on balance, the Panel concludes that this is not the case. The Panel agrees that the evidence 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 likely counterfeit goods bearing the GALLERY DEPT. Marks and ART THAT KILLS Marks owned by 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.

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 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.

Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

In the present case, the Complainant has provided documentation evidencing the manner in which the Respondent is illegitimately selling likely counterfeit clothing items bearing the GALLERY DEPT. Marks and ART THAT KILLS Marks. The Panel is satisfied that the Respondent's behaviour amounts to impersonation of the Complainant's website. The Panel concludes that the Respondent's conduct provides manifest evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Finally, the Panel draws an adverse inference from the fact that, as at the date of this decision, the Respondent's website is no longer available to access via the disputed domain name, returning a '403' error code.

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 <gallerydeptstore.net> be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: January 21, 2024