

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE
(Beijing Office)
ADMINISTRATIVE PANEL DECISION
Case No. CN-110506

Complainant: Paul Smith Group Holdings Limited
Respondent: liu zhixian
Domain Names: okpaulsmith.com
Registrar: Name.com LLC

1. Procedural History

On 13 October 2011, the Complainant submitted a complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (“the ADNDRC Beijing Office”) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the ADNDRC Supplemental Rules”).

On 19 October 2011, the ADNDRC Beijing Office sent to the Complainant by email an acknowledgement of the receipt of the complaint and asked ICANN and the Registrar for the confirmation of the registration information with regard to the disputed domain name.

On 24 October 2011, the Registrar transmitted by email to the ADNDRC Beijing Office its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 1 November 2011, the ADNDRC Beijing Office transmitted the complaint to the Respondent.

On 7 November 2011, the ADNDRC Beijing Office notified the Respondent about the commencement of the proceedings. On the same day, the ADNDRC Beijing Office notified the Complainant that the complaint had been confirmed and transmitted to the Respondent, and also notified ICANN and the Registrar of the commencement of the proceedings.

The Respondent had not filed a response within the stipulated time. On 29 November 2011, the ADNDRC Beijing Office sent out notice noting that no response had been received and the complaint were to be

proceeded to a decision by the Panel to be appointed.

On 7 December 2011, the ADNDRC Beijing Office gave notice to the potential candidate of the Panelist Mr. Gary Soo (苏国良‘Mr. Su Guoliang’), requesting him to confirm whether he would accept the appointment as a Panelist for this case, and if so, whether he could maintain impartiality and independence between the parties in this case.

Having received a Declaration of Independency and Impartiality and a Statement of Acceptance from Mr. Gary Soo (苏国良‘Mr. Su Guoliang’), the ADNDRC Beijing Office informed the disputing parties of the Confirmation of the Appointment of the sole panelist on 13 December 2011.

On 13 December 2011, the Panel received the file by email from the ADNDRC Beijing Office and was requested to render the Decision on or before 27 December 2011.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative proceedings shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceedings. The language of the current disputed domain name registration agreement is English, thus the Panel determines English as the language of the proceedings.

2. Factual Background

The Complainant

The Complainant in this case is Paul Smith Group Holdings Limited. The registration address is the Riverside Building, Riverside Way, Nottingham, NG2 1 UK. The Complainant appointed S&F Intellectual Property China as its authorized representative in this matter.

The Respondent

The Respondent, liu zhixian, is the current registrant of the disputed domain names <okpaulsmith.com> according to the Whois information. The address of the Respondent from the registration information is “putian meiyuan, putian, Fujian, 351100 CN”. The Respondent’s email address is nashliu@gmail.com. The Respondent registered the disputed domain name on 12 September 2009.

3. Parties’ Contentions

The Complainant

According to the Complainant, the Complainant is a renowned designer and manufacturer of fashion goods and the Complainant's products and services have acquired high fame throughout the world through long established marketing and sales, and well-known amongst relevant consumers.

The Complainant pointed out that the Complainant had registered the "PAUL SMITH" *Paul Smith*, *PS · Paul Smith*, trademarks throughout the world, including in UK, China, US, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro, etc., covering a large range of goods and services in classes 03, 09, 14, 16, 18, 20, 24, 25, and 27 etc. The specific goods/services designated include perfumery, colognes; cosmetics; soaps, shampoo, preparations for use for and after shaving, toilet preparations, skin care and hair care preparations, deodorants, anti-perspirants, dentifrices, bath and shower preparations; talcum powder; shoe cleaning preparations; spectacle frames, sunglasses frames, sunglasses, lenses, clips, cases and containers for spectacles and sunglasses, radios, calculators, parts and accessories for all the aforesaid goods; precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery, precious stones, horological and chronometric instruments, imitation jewellery, brooches, cuff links, ornamental pins, tie pins, watches, watch straps, clocks, money clips; key rings; paper; cardboard and cardboard articles; stationery, printed matter, printed publications, calendars, albums, writing materials and writing implements, notebooks, note pads, diaries, address books, posters, loose-leaf binders, files, folders; pen and pencil sets, cases and stands; letter racks, paper knives, cards, playing cards, paperweights, parts and fittings for all the aforesaid goods; leather and imitations of leather and goods made of these materials not included in other classes; animals skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage; rucksacks, bags, briefcases, pocket wallets, purses, pouches, credit card holders, chewing gum holders, notebook holders, coin holders, key cases; pillows and cushions; handkerchiefs; towels; articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties; and rugs, wall coverings, namely, wallpaper.

The Complainant noted also that the Complainant registered the trademark *Paul Smith* (International Registration No. 988039) through WIPO on June 5, 2008 and the trademark *Paul Smith* is granted for

protection in many countries including UK and Bahrain, covering the goods in Classes 03, 09, 14, 16, 18 and 25.

Also, the Complainant submitted that the Complainant registered the trademark *PS · Paul Smith* (International Registration No. 988039) through WIPO on February 11, 1999 and the trademark *PS · Paul Smith* is granted for protection in many countries/areas including UK, China, Benelux, Switzerland, Czech Republic, Germany, Denmark, Finland, France, Hungary, Iceland, South Korea, Monaco, Norway, Poland, Portugal, Romania, Sweden, Turkey and Serbia and Montenegro, covering the goods in Class 25, i.e. articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties.

The Complainant averred that the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 1306038) on February 25, 1983, covering the goods in class 25; the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 1511432) on February 2, 1988, covering the goods in class 3; the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 1703997) on April 19, 1990, covering the goods in class 14; the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 1661631) on June 4, 1990, covering the goods in classes 14 and 18; the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 1899650) on March 16, 1993, covering the goods in class 9; the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 3327649) on April 13, 2006, covering the goods in classes 24, 25 and 27; the Complainant registered the trademark “PAUL SMITH” in US (Registration No. 4024727) on July 12, 2010, covering the goods in classes 3, 20, 25 and 27; the Complainant registered the trademark *PS · Paul Smith* in US (Registration No. 2439173) on January 21, 1999, covering the goods in class 25.

The Complainant stated that the Complainant registered long before the registration date (September 12, 2009) of the disputed domain name the trademark “PAUL SMITH”, covering the goods in 9, 14 and 18; the Complainant registered long before the registration date (September 12, 2009) of the disputed domain name the trademark *Paul Smith*, covering the goods in 3, 9, 14, 16, 18 and 25; the Complainant registered long before the registration date (September 12, 2009) of the disputed domain name the trademark *PS · Paul Smith*, covering the goods in 3, 9, 14, 16, 18 and 25.

The Complainant submitted that since the “.com” is not taken into account in the comparison, “okpaulsmith” is the main part of the disputed domain name. Even if “okpaulsmith” can be separated in various ways, the most common way is to separate it into “ok” and “paulsmith” based on

humans' identifying habits. The rationale for this was as follows:-

- (1) Firstly, "paulsmith" is identical to the Complainant's trademarks "PAUL SMITH" and *Paul Smith*, since domain names are not case sensitive, no spaces are used.
- (2) Secondly, the wording "ok" is a most commonly used adjective to describe a thing. Therefore, "ok" + "paulsmith" can be easily understood as "great 'PAUL SMITH' goods", or "the PAUL SMITH goods is ok".

The Complainant also noted that the webpage linked by the disputed domain name itself is saying "the Paul Smith Shoes of our website are enjoying more and more popularity by people" when doing website introductions.

Thus, the Complainant is of the view that the disputed domain name can easily mislead consumers to mistakenly believe the disputed domain name is owned or operated by the Complainant, or the Respondent has certain relation with the Complainant. Therefore, the disputed domain name is confusingly similar to the Complainant's trademarks "PAUL SMITH" and *Paul Smith*.

Regarding the Respondent's right or legitimate interest in respect of the disputed domain name, the Complainant pointed out that:

- (1) Firstly, the Respondent has never been authorized by the Complainant to use the trademarks "PAUL SMITH" and *Paul Smith* under any circumstances. Furthermore, the Respondent has no business relationship with the Complainant. Thus, the Respondent does not have any rights with regards to the trademarks.
- (2) Secondly, the Respondent's name, address and any other information cannot be linked with "PAUL SMITH".
- (3) Thirdly, further searches by the Complainant do not prove that the Respondent has any other rights for "PAUL SMITH".

For the foregoing reasons, the Complainant believes that paragraph 4(a)(ii) of the Policy has been satisfied.

The Complainant also believes that paragraph 4(a)(iii) of the Policy has been satisfied, for the reasons below.

- (1) The Respondent is using the disputed domain name to offer links to webpages selling fake products bearing the Complainant's prior registered trademarks "PAUL SMITH" and *Paul Smith*. The website linked by the disputed domain name is blatantly selling fake products bearing the Complainant's registered trademarks "PAUL SMITH" and *Paul Smith*. It can be easily found that the goods sold on the

website linked by the disputed domain name are also named “PAUL SMITH” products by the owner of the website. The Respondent's conduct should be regarded as evidence of bad faith as prescribed in 4(b)(iv) of the Policy.

- (2) The Respondent was aware of “PAUL SMITH” and *Paul Smith* trademarks well before registering the disputed domain name. The Complainant’s “PAUL SMITH” and *Paul Smith* trademarks had been extensively registered throughout the world including UK, US and China, etc., long before the registration of the disputed domain name. The registered “PAUL SMITH” and *Paul Smith* trademarks, designating a large range of goods, such as clothes, leather products, shoes, scarves, have become worldwide reputed after continuous extensive uses and marketing throughout the world. Using WWW.GOOGLE.COM.HK to search for “PAUL SMITH” would obtain 163,000,000 results. All the information on the first page of the search result is associated to the Complainant. Also, the Respondent is using the disputed domain name to offer links to webpages selling fake products bearing the Complainant’s prior registered trademarks “PAUL SMITH” and *Paul Smith*, which additionally proves that the Respondent’s awareness of “PAUL SMITH” and *Paul Smith* before registering the disputed domain name.
- (3) Thus, it can be reasonably inferred that the Respondent was aware of the Complainant’s prior trademarks on “PAUL SMITH” and *Paul Smith* trademarks well before registering the disputed domain name.

In the premises, the Complainant asked for the transfer of the disputed domain name to the Complainant.

The Respondent

The Respondent had not submitted a response.

4. Findings

Paragraph 14 of the Rules provides that, in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by the Rules or the Panel, the Panel shall proceed to a decision on the complaint; and that, if a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Paragraph 15(a) of the Rules instructs the Panel as to the principles that the Panel is to use in determining the dispute, stating that the Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4 (a) of the Policy requires that the Complainant shall prove all of the following three elements in order to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identity or Confusing Similarity

The Complainant submits various documents to show that it is a renowned designer and manufacturer of fashion goods and notes that the Complainant's products and services have acquired high fame throughout the world through long established marketing and sales, and well-known amongst relevant consumers. These include documents regarding the registration of the trademarks of the Complainant, namely "PAUL SMITH", *Paul Smith* and *PS - Paul Smith* ("the Marks") throughout the world, including China. The Panel notices that such registrations were made prior to the registration of the disputed domain name. On the other hand, the Respondent did not respond or dispute the rights of the Complainant over the Marks.

In the circumstances, the Panel finds that the Complainant has succeeded in establishing the necessary rights over the Marks as required under Paragraph 4(a) of the Policy.

In the disputed domain name "okpaulsmith.com", the Panel accepts that the ".com" part is the generic top level domain name for company. Noting that "okpaulsmith" itself is not a word/phase within the daily use of vocabulary, the remaining part "okpaulsmith" is more commonly read as "ok" and "paulsmith" by internet users. The Panel also agrees that the word "ok" is a commonly used adjective to describe a thing as being okay. Therefore, the Panel is of the view that the main distinctive part in the disputed domain name is "paulsmith" and the "okpaulsmith" bears the meaning of "paulsmith" being okay. There being so, "paulsmith" is obviously confusingly similar to the Marks in which the Complainant has rights.

In the premises, the Panel finds that the Complainant has successfully established that the disputed domain name “okpaulsmith.com” is confusingly similar to the Marks in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(1) of the Policy as regards “okpaulsmith.com”.

Rights or Legitimate Interests of the Respondent

The Complainant submits that the Respondent has no such rights or legitimate interests necessary under the Policy as regards the disputed domain name. The Complainant made clear that the Respondent has never been authorized by the Complainant to use any of the Marks. To this, the Respondent does not deny or provide evidence to the contrary.

From the name of the Respondent, the Panel does not see any rights of the Respondent over the disputed domain name “okpaulsmith.com” or its prominent part, i.e. “paulsmith”. Also, taking into account that neither “paulsmith” or “okpaulsmith” is in the daily use of language, that the Respondent did not explain why it has rights to register this disputed domain name, and that the Complainant has trademark rights over the Marks, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(2) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose disrupting the business of a competitor; or
- (iv) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website or other on-line location, by creating a likelihood of confusion with the

Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

The Panel notices that, from the printouts of the websites, the Respondent is using the disputed domain name to offer links to webpages selling products bearing the Complainant's Marks and, in the website utilizing the disputed domain name, some of the Complainant's Marks were expressly mentioned or referred to. The Complainant highlights that the website linked by the disputed domain name is blatantly selling fake products bearing the Complainant's Marks. To this, no response has been submitted by the Respondent. The Panel notes also that the address of the Respondent as indicated in the domain name registration information is apparently in China and that the Complainant's Marks have been put into use throughout the world including China.

From all these, it seems clear to the Panel that the Respondent was well aware of the Complainant's rights in this regard when registering and using this disputed domain name. By doing this, the Panel finds that the registration and use of the disputed domain name were and are with bad faith and believes that the purpose is for using the domain name to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

Therefore, the Panel also finds that the Complainant has succeeded in proving the elements in Paragraph 4(a)(3) of the Policy as regards "okpaulsmith.com".

5. Decision

Having established all three elements required under the Policy in respect of the disputed domain name "okpaulsmith.com", the Panel concludes that relief should be granted in favour of the Complainant. Accordingly, the Panel decides and orders that the disputed domain name "okpaulsmith.com" shall be transferred to the Complainant Paul Smith Group Holdings Limited.

Sole Panelist:



Dated: 27 December 2011