



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1300525
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Chen Jingping
Disputed Domain Name(s):	<paulsmithsacpascher.com>

1. The Parties and the Disputed Domain Name

The Complainant is Paul Smith Group Holdings Limited, of Nottingham, the United Kingdom.

The Respondent is Chen Jingping, of Kunming, China.

The domain name at issue is <paulsmithsacpascher.com>, registered by the Respondent with CHINANET TECHNOLOGY (SUZHOU) CO, LTD., (the “Registrar”) of Suzhou, China.

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the “Center”) on July 10, 2013. On July 10, 2013 the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 15, 2013 the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of the disputed domain name and providing the Respondent’s contact details. The Center has verified that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”) and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint and the proceeding commenced on July 23, 2013. In accordance with the Rules, the due date for the Response was August 12, 2013.

No Response was received by the Center.

The Center appointed Sebastian Matthew White Hughes as the Panelist in this matter on August 21, 2013. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

On September 12, 2013 the Panel issued a Panel Order requiring the Complainant's representatives to file evidence of the Respondent's use of the disputed domain name (as alleged by the Complainant in the Complaint) by September 20, 2013. On September 17, 2013 the Complainant's representatives filed the requested evidence.

3. Factual background

A. Complainant

The Complainant is a company incorporated in the United Kingdom and the owner of numerous registrations worldwide for the trade mark PAUL SMITH (the "Trade Mark"), the earliest dating from 1983, including registrations in China, where the Respondent is based.

B. Respondent

The Respondent is an individual apparently with an address in China.

C. The Disputed Domain Name

The disputed domain name was registered on March 7, 2013.

4. Parties' Contentions

A. Complainant

The Complainant made the following submissions in the Complaint.

The Complainant is internationally known as a designer of fashion clothing and accessories, in particular at the top end of the retail market, producing high quality products using the finest raw material and innovative techniques. The Complainant sells fashion clothing under the Trade Mark through numerous retail outlets in the United Kingdom and worldwide.

The disputed domain name is confusingly similar to the Trade Mark. It incorporates the Trade Mark in its entirety, together with the non-distinctive French words "sac" (meaning "bag") and "pas cher" (meaning "not expensive").

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent is not commonly known by the disputed domain name and is not making a bona fide commercial use of the disputed domain names.

The disputed domain name has been registered and used in bad faith. It has been used by the Respondent in respect of a French language website which advertises and sells counterfeit PAUL SMITH goods (the "Website"). Thus the relevant public would easily understand the disputed domain name as representing "the French website for cheap PAUL SMITH goods".

The images and models used on the Website are substantially similar to those used by the Complainant. This shows that the Respondent is promoting the Website as the official French website for cheap PAUL SMITH goods

The disputed domain name can therefore easily mislead consumers into mistakenly believing that the disputed domain name is owned or operated by the Complainant, or that the Respondent has a certain relationship with the Complainant.

B. Respondent

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

5. Findings

5.1 Language of the Proceeding

The language of the registration agreement for the disputed domain name is Chinese.

Pursuant to the Rules, paragraph 11, in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement. No agreement has been entered into between the Complainant and the Respondent to the effect that the language of the proceeding should be English.

Paragraph 11(a) allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding. In other words, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding (*Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) Electrical Appliance Co. Ltd.*, WIPO Case No. D2008-0293; *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. D2006 0593).

The Complainant has requested that English be the language of the proceeding for the following reasons:

- (1) There would be an additional cost to the Complainant to translate this Complaint and this would be inequitable given the damage that has been suffered to date in this matter by the operation of the Website;
- (2) The Complainant's legal representatives have written to and telephoned the representatives of the Registrar on several occasions and believe that the Registrar can conduct the proceeding in English;
- (3) The Registrar has been given numerous opportunities to assist the Complainant in taking action against the Website but has, to date, not acknowledged the emails or telephone calls of the Complainant's legal representatives.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (*Groupe Auchan v. xmxzl*, WIPO Case No. DCC2006 0004; *Finter Bank Zurich v. Shumin Peng*, WIPO Case No. D2006 0432).

The Complainant has not adduced any evidence to suggest the likely possibility that the Respondent is conversant and proficient in the English language (*Finter Bank Zurich v. Shumin Peng*, supra).

In compliance with the Panel Order, the Complainant's legal representatives submitted a screenshot of the home page of the Website dated June 18, 2013 which shows that the Website is apparently entirely in the French language.

The submissions of the Complainant's legal representatives as to whether or not the Registrar is able to communicate in English are, with respect, not relevant.

The Panel is however mindful of the need to ensure the proceeding is conducted in a timely and cost effective manner. The Respondent has elected to take no part in this proceeding. The Respondent did not file any submissions with respect to the language of the proceeding and did not file a Response.

The Complainant is a company based in the United Kingdom, whereas the Respondent is apparently an individual based in China, and the Website is in the French language.

In all the circumstances, the Panel therefore finds it is not foreseeable that the Respondent would be prejudiced, should English be adopted as the language of the proceeding.

Having considered all the matters above, the Panel determines under paragraph 11(a) that the language of the proceeding shall be English.

5.2 Decision

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the Trade Mark acquired through registration and use which predate the date of registration of the disputed domain name by several decades.

UDRP panels have consistently held that domain names are identical or confusingly similar to a trade mark for purposes of the Policy "when the domain name includes the trade mark, or a confusingly similar approximation, regardless of the other terms in the domain name" (see *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000 0662).

The disputed domain name comprises the Trade Mark in its entirety together with the non-distinctive French words "sac" (meaning "bag") and "pascher" (meaning "not expensive").

This does not serve to distinguish the disputed domain name from the Trade Mark in any way, particularly given the content of the Website.

The Panel therefore finds that the disputed domain name is confusingly similar to the Trade Mark and holds that the Complaint fulfills the first condition of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed 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 to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

There is no evidence that the Complainant has authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Mark. The Complainant has prior rights in the Trade Mark which precede the Respondent's registration of the disputed domain name by several decades. The Panel finds on the record that there is therefore a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption (see *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. D2000 0624; and *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003 0455).

The Respondent has failed to show that it has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name has been used in connection with a bona fide offering of goods or services. To the contrary, the evidence suggests the Website is being used to offer for sale counterfeit goods under the Trade Mark.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain name.

There has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.

The Panel finds that the Respondent has failed to produce any evidence to establish rights or legitimate interests in the disputed domain name. The Panel therefore finds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, the following conduct amounts to registration and use in bad faith on the part of the Respondent:

“By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s 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 the Respondent’s website or location or of a product or service on the Respondent’s website or location.”

The Complainant has filed evidence to suggest the Respondent has registered and used the disputed domain name in respect of the Website which offers for sale counterfeit products under the Trade Mark. Irrespective of whether the goods on the Website are counterfeits, it is clear that the Respondent has not been authorised to sell the Complainant’s goods under the Trade Mark, nor has the Respondent been authorised to use the Complainant’s Trade Mark and product images featured on the Website.

Such use of the disputed domain name amounts to clear evidence of bad faith. The Panel therefore finds, in all the circumstances, the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

6. 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 <paulsmithsacpascher.com> be transferred to the Complainant.

Sebastian Hughes
Sole Panelist

Dated: September 24, 2013