



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK1300513
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Green
Disputed Domain Name(s):	<paulsmithsuk.com>

1. The Parties and Contested Domain Name

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

The Respondent is “Green”, of Bratislava, United States.

The domain name at issue is paulsmithsuk.com, registered by Respondent with Go Daddy LLC, of Scottsdale, Arizona, United States of America.

2. Procedural History

A complaint was filed with ADNDRC (Hong Kong office) by the Complainant on 27 June 2013. After obtaining registrar verification for the disputed domain name, ADNDRC (Hong Kong office) found that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (“the Policy” or “UDRP”), the Rules for UDRP (“the Rules”) and the ADNDRC Supplemental Rules. ADNDRC (Hong Kong office) formally notified the Respondent of the Complaint. The due date for a Response was 28 July 2013. On 29 July 2013 ADNDRC (Hong Kong office) advised the Respondent of its default in not filing a Response. ADNDRC (Hong Kong office) appointed Sir Ian Barker as the sole panelist in the matter on 30 July 2013. The Panel finds that it was properly constituted. The Panel undertook to ADNDRC (Hong Kong office) that it was impartial and independent.

3. Factual background

The Complainant owns many registered trademarks in many different countries for the words “Paul Smith”. Under this mark and through its subsidiary, Paul Smith Limited, it designs and markets fashion clothing at the top end of the market.

A trademark for the words “Paul Smith” both in capital letters and in cursive writing is registered in a wide range of countries including the United Kingdom, the United States, China, the European Union and European countries which are not members of the

European Union. There is also another registered trademark for “PS – Paul Smith” in cursive writing.

The trademark registrations took place at various dates in various jurisdictions from 1983 onwards.

The Complainant has a world-wide reputation and has developed a world-wide market for a large range of merchandise including clothing, leather products, shoes and scarves

On the website associated with the disputed domain name, counterfeited Paul Smith goods are being offered in large quantities. The images and marks used there are similar to the Complainant’s “Paul Smith” trademarks. The Respondent has no previous relationship with the Complainant which has not authorised the Respondent to use its trademark in any way whatsoever.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The disputed domain name is confusingly similar to the Complainant’s registered trademarks. The Respondent’s website could easily be thought by the public to be the United Kingdom website of the Complainant. The disputed domain name is easily separated into “paul smiths’ plus “UK”.
- ii. The Respondent has no right or legitimate interest in respect of the disputed domain name. The Respondent has not been authorised by the Complainant to use its trademark. The Respondent is not known by the disputed domain name and has no connection with the Complainant.
- iii. The Respondent registered and is using the disputed domain name in bad faith. This is amply demonstrated by the Respondent’s blatant selling of counterfeit products bearing the Complainant’s trademarked name. Paragraph 4(b)(iv) of the Policy applies.
- iv. The Complainant’s trademarks have been extensively registered throughout the world and the Respondent must have known of the Complainant’s interest in them and its world-wide reputation. Bad faith reputation is easily inferred because the Respondent is selling counterfeit goods bearing the Complainant’s trademarks.

B. Respondent

The Respondent filed no Response nor made any submissions.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The disputed domain name is clearly confusingly similar to the Complainant's trademarks. The disputed domain name would make the average internet user think that its website is the official website in the United Kingdom of the Complainant.

Paragraph 4(a)(i) of the Policy has been satisfied.

B) Rights and Legitimate Interests

The Complainant gave the Respondent no rights or interests such as to justify the use of the Complainant's trademark in a domain name. In the absence of any response from the Respondent, that fact alone is sufficient to satisfy Paragraph 4(a)(ii) of the Policy.

The Respondent could have sought to establish that it came within one of the circumstances envisaged by Paragraph 4(c) of the Policy which, if proven, could have provided it with a defence. But it did not do so. Accordingly, Paragraph 4(a)(ii) of the Policy is established.

C) Bad Faith

This is a blatant case of a Respondent's unlawful use of the Complainant's trademarks by offering on the internet counterfeit merchandise purporting to be goods bearing Complainant's brand.

In those circumstances, the inference of bad faith registration and ongoing bad faith use is irresistible. Accordingly, Paragraph 4(a)(iii) of the Policy is satisfied.

6. Additional Comment

The Panel considers that greater care have been taken over the registration of the disputed domain name. It is not good enough for a registrant to be known simply as "Green". There should be a full name provided of either an individual or a corporation.

Secondly, the address shown is "Bratislava, FM 2401 US, United States". Bratislava is the capital of Slovakia. No state of the United States is mentioned as part of the address, as is usual.

There may be a town called Bratislava in the United States but the reference may be to the Slovakian city. The exact location of the Respondent should have been included in the registration information.

7. Decision

For all the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <paulsmithsuk.com> be transferred to the Complainant.

Hon. Sir Ian Barker
Panelist

Dated: 9 August, 2013