



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1801106
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Katie Smith
Disputed Domain Name(s):	<paulsmithjacketuk.com>

1. The Parties and Contested Domain Name

1.1 The Complainant is Paul Smith Group Holdings Limited, of The Poplars, Lenton Lane, Nottingham, NG7 2PW England (the "Complainant") and represented by S&P Legal Limited of 29 Austen Road, Guildford Surrey, GU1 3NP England.

1.2 The Respondent is Katie Smith, of 47 Whitehall Croft Rothwell, Leeds, West Yorkshire LS26 0JD England (the "Respondent") and unrepresented.

1.3 The domain name at issue is <paulsmithjacketuk.com> the ("Disputed Domain Name"), registered by the Respondent with GODADDY.COM LLC, of 14455 N. Hayden Road 226 Scottsdale, AZ 85260, USA (the "Registrar").

2. Procedural History

2.1 The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (ADNDRC) (the "Centre") on 02 May 2018 and the Complaint was acknowledged by the Centre on the same date.

2.2 Upon receipt of a request for verification of the details of the registrant of the Disputed Domain Name from the Centre, the Registrar Go Daddy.com LLC, confirmed that the Respondent is listed as the registrant and confirmed the registrant's contact details on 03 May 2018. The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for the Uniform Domain Name Dispute Resolution Policy (the "Rules") and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

2.3 The Centre formally notified the Respondent of the Complaint and advised the Respondent of the prescribed twenty days deadline within which to file a response on or by 31 May 2018. The Respondent failed to file a response to the Complaint within the specified timeline.

2.4 The Centre appointed Mr. Ike Ehiribe as Sole Panelist in this matter on 27 June, 2018 and at the instance of the Panelist, the Centre extended the time within which to render the decision to 23 July 2018.

3. Factual background

For the Complainant.

3.1 The Complainant owns the well-known registered trade mark “PAUL SMITH” registered in the UK, China, US, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro covering a large range of goods and services in classes 03,09,14,16,18,20,24,25,and 27 etc. majorly, for the production of soaps, spectacle frames, precious metals, stationery, goods made of leather and imitation leather, pillows and cushions, articles of clothing and rugs etc. The Complainant also secured an international registration of the “PAUL SMITH” trade mark through the World Intellectual Property Organisation (WIPO) on March 2001 and an European Union registration through the Organisation for the Harmonisation in the Internal Market (OHIM) in September 2001 for the same designated classes of goods and services. The Complainant is said to be also known internationally for design, fashion clothing and accessories and has developed a significant reputation as a designer both in the UK and abroad. The Complainant also sells fashion clothing predominantly under its own “PAUL SMITH” trademark through numerous retail outlets in the UK and abroad etc.

For the Respondent.

3.2 The Respondent is an individual with an address stated to be at No. 47 Whitehall Croft Rothwell Leeds West Yorkshire LS26 0JD. According to the WhoIs record attached to this proceeding the Respondent created the Disputed Domain Name <paulsmithjacketuk.co> on 12 December, 2017 scheduled to expire on 12 December, 2018.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant asserts that the Disputed Domain Name <paulsmithjacketuk.com> is identical or confusingly similar to the Complainant's “PAUL SMITH” trademark; as the main body of the Disputed Domain Name <paulsmithjacket.com>, “paulsmith” is confusingly similar to the registered “PAUL SMITH” trademark of the Complainant. It is also contended on behalf of the Complainant that the identification part of the main body of the Disputed Domain Name i.e. “paulsmith” wholly incorporates the trademark of the Complainant and will certainly cause confusion in the minds of the public and Internet visitors and disrupt the Complainant's business. It is also argued on behalf of the Complainant that the addition of the generic top level domain

“.com” does absolutely nothing to preclude a finding of confusingly similarity. The Complainant asserts further that Internet visitors would easily separate the words “jacket” and or “uk” from the Disputed Domain Name and work out that the central and distinguishing element of the Disputed Domain Name is “paulsmith”.

- ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

The Complainant’s case is that the Respondent has never been authorized, licensed or otherwise permitted by the Complainant to use the Complainant’s trade mark or trade name in any form whatsoever. Secondly, it is contended by the Complainant that the Respondent has no business relationship with the Complainant and therefore the Respondent has no rights with regards to the “PAUL SMITH” trademark. Thirdly, the Respondent’s name, address and any other information cannot be linked with the Complainant’s trade mark. Fourthly, it is said that further searches by the Complainant do not prove that the Respondent has any other rights in respect of the “PAUL SMITH” trade mark.

- iii. The Disputed Domain Name has been registered and is being used in bad faith.

The Complainant contends that the Respondent has definitely registered the Disputed Domain Name in bad faith and continued to engage in bad faith use. In the first instance the Complainant alludes to the fact that the Respondent is using the website to which the the Disputed Domain Names resolves to blatantly sell fake counterfeit products bearing the Complainant’s registered trademark. The Complainant points out that the Respondent’s conduct in this regard should be considered as evidence of bad faith registration and use as prescribed in the policy. Secondly, the Complainant also asserts that since the Respondent decided to create the Disputed Domain Name on 15 December, 2018 well after the Complainant had taken considerable steps to register its “PAUL SMITH” trademark in the UK, the US and in China etc., it cannot possibly be argued by the Respondent that there was no knowledge of the prior existence of the Complainant’s existing registered rights before deciding to create the Disputed Domain Name. Thirdly, the Complainant argues that since the Respondent is in the business of selling in large quantities, fake counterfeit products bearing the Complainant’s prior registered “PAUL SMITH” trade marks, such conduct additionally, proves the Respondent’s awareness of the “PAUL SMITH” trade mark before creating the Disputed Domain Name <paulsmithjacket.com>.

B. Respondent

- iv. The Respondent failed to file a response to the Complaint within the time stipulated in the rules; accordingly the Panel shall draw such inferences as it considers appropriate from the Respondent’s default.

5. Finding

5.1 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) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii) The Respondent has no rights or legitimate interests in respect of the domain name; and
- iii) The Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

5.2 The Panel is undoubtedly satisfied that the Complainant has acquired prior exclusive intellectual property rights in the "PAUL SMITH" trademark in a considerable number of jurisdictions including in the UK where the Respondent is said to be domiciled. That much is duly evidenced by the number of trademark registration certificates referred to by the Complainant. Furthermore, the Panel finds that the Complainant has adduced sufficient evidence which indicates that the Complainant's trademark "PAUL SMITH" has acquired worldwide reputation and recognition in the manufacture of clothing apparels and fashion accessories etc. The Panel is therefore, satisfied that the Disputed Domain Name <paulsmithjacketuk.com> on a visual examination, is confusingly similar to the Complainant's trademark. Without any question, the Disputed Domain Name wholly incorporates the Complainant's "PAUL SMITH" trademark as the dominant and most distinctive part of the Disputed Domain Name. The Panel finds that the mere addition of the generic top level domain ". com" does absolutely nothing to prevent a finding of confusing similarity. In the same vein the Panel finds that the addition of the ordinary words "jacket" and the country abbreviation "uk" does not prevent a finding of confusing similarity. In arriving at this conclusion the Panel relies on the following previous cases which underline the insignificance of gTLD suffixes and generic terms when conducting a confusing similarity enquiry. Namely, *Promgirl LLC v. Weddingwhoo.com, Beijing Touchtel Tech. Co. Ltd*, HK-1500757; *Promgirl LLC v. Jack Zhang*, HK-1500814; *Alibaba Group Holding Limited v. (Liu Xiao Bo)*; *Lingping*, HK- 1400677; *Alibaba Group Holding Limited v. Pan Zhongyi*, HK-1500718; and *GWS Technology (Shenzen) Co. Ltd. v. Jin Fan*, HK-1600884.

B) Rights and Legitimate Interests

5.3 The Panel also finds that the Respondent has completely failed to adduce any evidence indicating that she has rights or legitimate interests in the Disputed Domain Name. The Respondent has not produced any evidence of authorization, permission or a license from the Complainant to use the Complainant's "PAUL SMITH" trademark under any circumstances. Secondly, the Panel finds that the Respondent has been intentionally

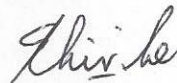
utilizing the Disputed Domain Name to attract Internet visitors to its website for commercial gain by exploiting the confusion in the minds of Internet visitors as the Disputed Domain Name resolves to the Respondent's website which displays for sale large quantities of counterfeit "PAUL SMITH" goods. The Respondent's activities in so far as it involves the infringement of the Complainant's protected rights and the diversion of potential customers from the Complainant's website cannot be described as a *bona fide* offering of goods and services nor a legitimate non-commercial or fair use of the Disputed Domain Name. See in particular a previous ADNDRC decision in *Promgirl LLC v. Changkang Wen*, HK-1500790 and in general an often-cited WIPO decision in *Oki Data Americas Inc. v. ASD Inc.*, WIPO Case No. D2001-0903.

C) Bad Faith

5.4 With regards to the question of bad faith registration and use, the Panel finds without any hesitation that the Respondent deliberately registered the Disputed Domain Name in bad faith and has continued to engage in bad faith use. In arriving at this conclusion, the Panel has considered a number of irrefutable factors arising from the unchallenged evidence adduced by the Complainant. First of all, the Panel has taken into account the chronology of events in this matter, considering that the Complainant has been in existence since long before 1997 when the Complainant first registered the "PAUL SMITH" trademark in the UK, where the Respondent is based, covering goods in classes 3,8,9,14,16,18,21, 24, 25, and 34. According to the WhoIs record, the Respondent elected to create the Disputed Domain Name in December 2015, the Panel therefore, finds it inconceivable that the Respondent would not have been aware of the Complainant's extensive rights in, and worldwide reputation of, the "PAUL SMITH" trademark before electing to create the Disputed Domain Name. The Panel finds that a mere trademark search or google search would have confirmed the prior existence of the Complainant's rights. Secondly, the fact that the Disputed Domain Name in itself resolves to the Respondent's website which displays for sale, large quantities of counterfeit "PAUL SMITH" goods confirms the deliberate and indeed bad faith or *mala fides* intentions of the Respondent; which is, clearly to benefit from the confusion in the minds of Internet visitors and to disrupt the Complainant's business for commercial gain. Thirdly, and in any event as indicated at paragraph B (iv) above, the Panel has drawn adverse inferences from the Respondent's failure to respond to this complaint and the adduced evidence attached thereto.

6. Decision

6.1 For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the Disputed Domain Name <paulsmithjacketuk.com> be transferred to the Complainant forthwith.



Ike Ehiribe
Panelist

Dated: July 21, 2018