



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK- 1701012
<b>Complainant:</b>	Paul Smith Group Holdings Limited
<b>Respondent:</b>	Zhang Ming
<b>Disputed Domain Name(s):</b>	<cheappaulsmith2017.com>, <paulsmithclearancesale.com> and <paulsmithonlinestoreus.com>

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**The Parties and Contested Domain Name**

1. The Complainant is Paul Smith Group Holdings Limited of The Poplars, Lenton Lane, Nottingham NG7 2PW, United Kingdom.
2. The Respondent is Zhang Ming of Hepingjiujie9hao, Shaoguanshi, China 512026, Hong Kong.
3. The domain names at issue are <cheappaulsmith2017.com>, <paulsmithclearancesale.com> and <paulsmithonlinestoreus.com> (the “Domain Names”), registered by the Respondent with GoDaddy.com LLC, 14455 North Hayden Road, Suite 219, Scottsdale, AZ 85260, United States of America (the “Registrar”).

**Procedural History**

4. The Complainant filed the Complaint with the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 10 August 2017. On 11 August 2017, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On 12 August 2017, the Registrar transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details.
5. The ADNDRC verified that the Complaint satisfied the formal requirements of the Domain Name Dispute Resolution Policy (the “Policy” or UDRP) and the Rules for Domain Name Dispute Resolution Policy (the “Rules”). In accordance with the Rules, the ADNDRC formally notified the Respondent of the Complaint and the proceeding commenced on 17 August 2017.
6. The ADNDRC did not receive any response from the Respondent on the due date of the Response which was 6 September 2017, in accordance with paragraph 5 of the

Rules. Accordingly, on 7 September 2017, the ADNDRC informed the parties that no response has been received and it would shortly appoint a single panelist.

7. On 14 September 2017, the ADNDRC appointed Karen Fong as sole Panelist in this matter. The Panelist accepted the appointment and has submitted a statement to the ADNDRC that she is able to act independently and impartially between the parties.

### **Factual background**

8. The Complainant's group of companies is a well know fashion house that market and sell its products under the trade mark "Paul Smith". "Paul Smith" clothing and accessories are sold in numerous retail outlets in the UK and throughout the world. The Complainant owns numerous trade mark registrations for the "Paul Smith", "Paul Smith" logo and "PS Paul Smith" logo (individually and collectively referred to as "the Trade Mark").
9. The Respondent registered the Domain Names on the following dates:

<cheappaulsmith2017.com> - 15 January 2017

<paulsmithclearancesale.com> - 16 January 2017

<paulsmithonlinestoreus.com> - 16 January 2017

All three Domain Names are connected to websites that appear to look like the Complainant's official website or websites that are authorised by the Complainant with <cheappaulsmith2017.com> purporting to be an outlet store, <paulsmithclearancesale.com> purporting to be the Complainant's Australian branch and <paulsmithonlinestoreus.com> purporting to be the American branch (collectively referred to as the "Websites"). The Websites offer for sale "Paul Smith" clothes, handbags and other accessories at a discounted price and hence likely to be counterfeit products. The Websites prominently display the Trade Mark on the home page and also use images and photographs that belong to the Complainant.

### **The Parties Contentions**

#### ***Complainant***

10. The Complainant contends that the Domain Names are confusingly similar to the Trade Mark, the Respondent has no rights or legitimate interests with respect to the Domain Names and that the Domain Names were registered and are being used in bad faith. The Complainant requests transfer of the Domain Names.

#### ***Respondent***

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

### **Findings**

#### ***General***

12. The 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 is 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.

### ***Identical / Confusingly Similar***

13. The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.
14. The threshold test for confusing similarity involves the comparison between the trade mark and the domain name itself to determine whether the domain name is confusingly similar to the trade mark. The trade mark would generally be recognizable within the domain name. In this case all the Domain Names contain the Trade Mark in its entirety with the addition of the descriptive term "cheap" and the numerals "2017" for the first, the descriptive terms "clearance sale" for the second and the descriptive terms "online store" and the geographical name "US" for the third. The addition of these terms does nothing to minimise the risk of confusion. There is a long line of authorities on the UDRP which make it clear that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.
15. For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the Top Level Domain as it is viewed as a standard registration requirement.
16. The Panel finds that the Domain Names are confusingly similar to a trade mark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

### ***Rights and Legitimate Interests***

17. Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:
  - i. before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
  - ii. the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
  - iii. the respondent is making a legitimate non- commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trade mark or service mark at issue.

18. Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that the overall burden of proof rests with the Complainant. The Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, [WIPO Case No. D2003-0455](#), *Belupo d.d. v. WACHEM d.o.o.*, [WIPO Case No. D2004-0110](#), *Banco Itau S.A. v. Laercio Teixeira*, [WIPO Case No. D2007-0912](#), *Malayan Banking Berhad v. Beauty, Success & Truth International*, [WIPO Case No. D2008-1393](#), and *Accor v. Eren Atesmen*, [WIPO Case No. D2009-0701](#).
19. The Respondent is not affiliated to the Complainant in any way nor has he been authorised by the Complainant to register and use the Domain Names or in any other way. He does not appear to be commonly known by the Domain Names and does not have any independent right to the Domain Names. It is implausible that when the Respondent registered the Domain Names, he did not know of the existence of the Complainant's business under the Trade Mark since he is offering for sale goods bearing the Trade Mark.
20. Further the products sold on the Websites appear to be counterfeit products as they are substantially discounted. The Respondent is not an authorized seller of the Complainant's products. Yet the Websites suggest that the Respondent is an official or authorized agent. The prominent display of the "Paul Smith" logo on the Websites increases the likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Websites.
21. It would appear to the Panel that the products on sale on the Websites are counterfeit goods. There can be no legitimate interest in the sale of counterfeits (see *Wellquest International, Inc. v. Nicholas Clark - WIPO Case No. 2005-0552* and *Farouk Systems, Inc v. QYM- WIPO Case No. D2009-1572*).
22. The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Names.
23. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names.

### ***Bad Faith***

24. To succeed under the Policy, a Complainant must show that the Domain Name has been both registered and used in bad faith. It is a double requirement.
25. The Panel is satisfied that the Respondent must have been aware of the Trade Mark when he registered the Domain Names. The Complainant has provided sufficient

evidence that the registration of the Domain Names post date the Trade Mark registrations. The very incorporation of the Trade Mark in the Domain Names and the display of the Trade Mark and the offer for sale of non - genuine “Paul Smith” products on the Websites confirm the Respondent’s awareness of the Trade Mark. Thus, the Panel concludes that the Respondent deliberately registered the Domain Names in bad faith.

26. The products offered for sale on the Websites are likely to be counterfeit “Paul Smith” products for reasons set out in paragraph 20. The use by a respondent of a domain name which includes a well known trade mark to resolve to a website which offers and sells counterfeit products under that trade mark is evidence of bad faith registration and use. (See *Burberry Limited v Jonathan Schefren*, WIPO Case No. D2008-1546 and *Prada SA v Domains for Life*, WIPO Case No 2004-1019).
27. The Panel also finds that the actual use of the Domain Name is in bad faith. The Websites depict the Respondent as the authorized agent or distributor of the Complainant. The content of the Websites is also calculated to give the impression that they have been authorized by the Complainant when this is not the case. Further the address of the Respondent on the Whois search does not look correct. “Shaoguanshi” is not in Hong Kong. Also, the providing of personal and credit card details when purchasing products from the Websites could be a phishing exercise for the purpose of using such information for fraudulent purposes. The Websites were set up to deliberately mislead internet users that it is connected to, authorised by or affiliated to the Complainant. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Respondent’s website is and the products sold on it are those of or authorised or endorsed by the Complainant.
28. The Panel therefore concludes that the Domain Name were registered and is being used in bad faith under paragraph 4(b)(ii) and (iv) of the Policy.

## **Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <cheappaulsmith2017.com>, <paulsmithclearancesale.com> and <paulsmithonlinestoreus.com> be transferred to the Complainant.

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Karen Fong  
Panelist

Dated: 27 September 2017