



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400598
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Jee Morr
Disputed Domain Name:	<paulsmither.com>

1. The Parties and Contested Domain Name

The Complainant is Paul Smith Group Holdings Limited of The Poplars, Lenton Lane, Nottingham, NG7 2PW Great Britain.

The authorized representative of the Complainant is S & P Legal Limited, 29 Austen Road, Guildford, Surrey, GU1 3NP GB.

The Respondent is Jee Morr, Address Apt18, Singin St Py NYC, New York 12065 USA.

The domain name at issue is <paulsmither.com>.The domain name is registered with Fastdomain.com. of 560 Timpanogos Pkwy Orem, UT 84097 USA.

2. Procedural History

On April 14, 2014 the Complaint was filed with the Asian Domain Name Dispute Resolution Centre ("the Centre"). The Centre received the appropriate case filing fee on April 15, 2014.

On April 14 and 23, 2014, the Centre transmitted by email to FastDomain Inc., a request for registrar verification in connection with the registrant of the disputed domain name.

On April 23, 2014, FastDomain.Inc., transmitted by email to the Centre its verification response that the registrant of the disputed domain was Jee Morr, Apt18, Singin St Py NYC, New York 12065 US and that the registrant's email address was fenmanmail@yahoo.com.

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

After amendments were made to the Complaint by virtue of certain deficiencies, the Centre received the Amended Complaint and its annexures on April 29, 2014 and on that date the Complaint and its annexures were served on the Respondent at "fenmanmail@yahoo.com"; "postmaster@paulsmith.com" and "whois@bluehost.com" together with Notice dated April 29, 2014 notifying the Respondent that the proceeding commenced on 29 April 2014 and that the due date for the submission of the Response was 19 May 2014.

A Response was not received by the Centre within the required period of time or at all.

On May 27, 2014, the Centre appointed The Honourable Neil Anthony Brown QC as Panelist in the administrative proceeding. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rule 7.

The Panel finds that the Asian Domain Name Dispute Resolution Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Asian Domain Name Dispute Resolution Centre Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

3. Factual background

The Complainant is a company incorporated pursuant to the laws of the United Kingdom and is engaged in the design and sale of clothing and related goods and services. The Complainant holds trademark registrations for PAUL SMITH internationally, including International Registration No. 755406 through WIPO, registered on March 20, 2001 and the trademark PAUL SMITH in US (Registration No. 1306038) on February 25, 1983, together with other trademarks for PAUL SMITH, collectively referred to as "the PAUL SMITH trademarks."

Since the registration of the disputed domain name, the Respondent has been using it to sell counterfeit PAUL SMITH goods and to pass its website off as the Complainant's official website.

Parties' Contentions

A. Complainant

The Complainant's contentions are as follows:

1. The Complainant claims registered trademark rights in the PAUL SMITH trademarks.
2. The disputed domain name is confusingly similar to the PAUL SMITH trademarks.
3. That is so because the internet user would assume that the domain name was related to the Complainant and used in its business.
4. The disputed domain name was registered by the Respondent on July 19, 2010.
5. The Respondent has no rights or legitimate interests in the disputed domain name as the Respondent has been using it to sell counterfeit goods and the Respondent is using the website to pass it off as the Complainant's website.

6. The disputed domain name was registered and is being used in bad faith as the Respondent has been using the website to sell counterfeit PAUL SMITH goods and was aware of the Complainant's ownership of the PAUL SMITH trademarks before the domain name was registered.

B. Respondent

The Respondent failed to file a Response in this proceeding.

5. Findings and Discussion of the Issues

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 the 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 first question that arises is whether the Complainant has a trademark on which it can rely. The Complainant has adduced evidence that the Panel accepts to the effect that the Complainant has trademark rights on which it can rely with respect to the disputed domain name.

The Complainant claims registered trademark rights in the following registered trademarks: International Registration No. 755406 through WIPO, registered on March 20, 2001, the trademark PAUL SMITH in US (Registration No. 1306038) on February 25, 1983 and many other international trademarks, of which evidence has been adduced that the Panel accepts, collectively referred to as "the PAUL SMITH trademarks."

Accordingly, the Complainant has proved that it has a trademark on which it may rely.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the PAUL SMITH trademarks. The Panel finds that the disputed domain name is confusingly similar to the PAUL SMITH trademarks as, in making this comparison, the gTLD suffix ".com" is to be ignored and the objective internet user would naturally assume that a domain name so close to a trademark and adding only the letters "er" to the trademark is similar and confusingly so to the trademarks. The Complainant has therefore established the first of the three elements that it must establish.

B) Rights and Legitimate Interests

It is now well established that the Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the Policy and then the onus of proof shifts to the Respondent to show it does have rights or legitimate interests. There are many decisions to that effect, one of the most notable of which is *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the

respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name).

Having regard to the evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:

(a) the Respondent has chosen to take the Complainant's prominent PAUL SMITH trademark and to use it in its domain name making only the slight spelling difference of adding the letters "er" to the trademark;

(b) the unchallenged evidence is that the Respondent had no authority to register the domain name and to use it as it has done, namely to sell counterfeit goods and to try to pass its website off as the website of the Complainant;

(c) the Respondent has engaged in these activities without the consent or approval of the Complainant.

These matters go to make out the *prima facie* case against the Respondent and it is then up to the Respondent to rebut that case.

As the Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against him, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has thus made out the second of the three elements that it must establish.

C) Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

"... (i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, 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 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."

However, those criteria are not exclusive and Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

The Respondent registered the disputed domain name in bad faith because he must have known at all times that he had no right to register it because of the existence of the famous PAUL SMITH trademarks.

The Respondent used the domain name in bad faith by using it to sell counterfeit PAUL SMITH goods and to pass its website off as the website of the Complainant. The Respondent did this at a time when he must have known that he had no rights to the domain name at all. It is no exaggeration to say that the Respondent has acted dishonestly and had no rights to retain and use the domain name in the way it has done or in any other way and has not attempted in a Response to explain his actions.

These facts bring the case squarely within the provisions of paragraphs 4(b) (iii) and 4(b) (iv) of the Policy.

Having regard to the totality of the evidence, the Panel finds that, in view of Respondent's acquisition of the disputed domain name and using it in the manner described, the Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

6. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name, <**paulsmither.com**> be TRANSFERRED to the Complainant.

The Honourable Neil Anthony Brown QC

Dated: June 6, 2014