



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2401858
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Mei Juan Zhang
Disputed Domain Name(s):	<paulsmithclearan.com>

1. The Parties and Contested Domain Name

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

The Respondent is Mei Juan Zhang, of Chen You Dao 102, Yanling, Chen You, Anhui, 500000 China.

The domain name at issue is <paulsmithclearan.com>, registered by Respondent with GODADDY.COM, of Tempe, 2155 E. GODADDY WAY, USA.

2. Procedural History

The Complaint was filed with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC) (the “Centre”) on January 5, 2024. On the same day, the Centre requested for Registrar verification from the Registrar in relation to the Disputed Domain Name. The Registrar subsequently issued its verification response confirming the registrant of the Disputed Domain Name to be the Respondent. The Complainant filed an amended complaint on January 18, 2024, merely to update the identity of the Respondent, based on the information communicated by the Registrar to the Centre. 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”).

On January 22, 2024, the Centre notified the Respondent of the Complaint and advised that a response ought to be filed by the Respondent by February 11, 2024. The Respondent did not file any response, and this was notified by the Centre on February 14, 2024.

The Centre appointed David-Irving TAYER, Esq., as the Sole Panelist in this administrative proceeding on February 15, 2024. The Panel finds that it is properly constituted.

3. Factual background

The Complainant

The Complainant in this case is Paul Smith Group Holdings Limited, the registration address is The Poplars, Lenton Lane. The Complainant appointed Naazneen Schmittzehe for and on behalf of S & P Legal Limited, the address of which is 29 Austen Road, Guildford, Surrey, GU1 3NP, GB as its authorized representative in this matter.

The Complainant is Paul Smith Group Holdings who own the registered Trade Mark “Paul Smith”, holding company of Paul Smith Limited. The Complainant is internationally known for design, fashion clothing and accessories. It has, in particular, developed a significant reputation as a designer both in the UK and abroad and Paul Smith trade 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 predominantly under its own “Paul Smith” clothing mark which is sold through numerous retail outlets in the UK and throughout the world through their own retail outlets.

The Complainant demonstrated that it is the owner of trademark registrations “PAUL SMITH” and “PS PAUL SMITH” trademarks throughout the world, including in UK, China, US, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro, etc., covering a large range of goods and services in classes 03, 09, 14, 16, 18, 20, 24, 25, and 27 etc. It is worth mentioning some in more details:

- International Registration No. 755406 dating back to March 20, 2001, and duly renewed since claiming a protection in particular in UK, China, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro, etc., covering a large range of goods/services in classes 03, 09, 14, 16, 18 and 25.
- International Registration No. 988039 dating back to June 5, 2008, and duly renewed since claiming a protection in particular in UK and Bahrain, covering the goods in Classes 03, 09, 14, 16, 18 and 25.
- International Registration No. 708450, dating back to February 11, 1999 and duly renewed since claiming a protection in particular in UK, China, Benelux, Switzerland, Czech Republic, Germany, Denmark, Finland, France, Hungary, Iceland, South Korea, Monaco, Norway, Poland, Portugal, Romania, Sweden, Turkey and Serbia and Montenegro, covering the goods in Class 25, i.e. articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties.
- US Registration No. 1306038, dating back to February 25, 1983, duly renewed since, covering the goods in class 25.
- US Registration No. 1511432 dating back to February 2, 1988, duly renewed since, covering the goods in class 3.
- UK Registration No. 1190572 dating back to February 16, 1983, duly renewed since, covering the goods in class 25;
- UK Registration No. 2051161 dating back to May 16, 1997, duly renewed since, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34;
- EU Registration No. 45393, dating back to September 4, 2001, duly renewed since, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34;
- EU Registration No. 8673451 dating back to May 27, 2010, duly renewed since, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34;

The Respondent, Mei Juan Zhang, is the current registrant of the disputed domain name <paulsmithclearan.com> according to GODADDY.COM, the Registrar. The address of the respondent from the registration information is Chen you Dao 102, Yanling, Chen you, Anhui, 500000 China. The Respondent's email is stated to be mulon23@163.com.

The domain name at issue is <paulsmithclearan.com>, registered by Respondent with GODADDY.COM, of Tempe, 2155 E. GODADDY WAY, USA.

The Respondent did not file any response to the Complaint.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. Complainant has rights in the PAUL SMITH and PS PAUL SMITH mark through its registration of the mark with multiple trademark authorities around the world, including UK, China, US, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro, etc., covering a large range of goods and services in classes 03, 09, 14, 16, 18, 20, 24, 25, and 27 etc.
- ii. The disputed domain name <paulsmithclearan.com>, is identical to Complainant's PAUL SMITH and PS PAUL SMITH marks as Respondent incorporates the mark in its entirety, associated to the generic term "clearan" (undoubtedly referring to clearance) and adds the ".com" generic top-level domain ("GTLD").
- iii. Respondent lacks rights or legitimate interests in the <paulsmithclearan.com>, domain name as Respondent is not commonly known by the disputed domain name nor did Complainant authorize Respondent to use the PAUL SMITH and PS PAUL SMITH marks in any way.
- iv. Respondent registered and used the <paulsmithclearan.com> domain name in bad faith as Respondent's domain name resolves to webpages of website that are blatantly selling fake counterfeit PAUL SMITH goods in large quantities. This serves as good evidence proving that the Disputed Domain Name is actually viewed by the Respondent too as "the website for buying cheap PAUL SMITH goods".

B. Respondent

The Respondent did not file any response.

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 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.

A) Identical / Confusingly Similar

Under the first UDRP element, the Complainant is required to prove that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case." Here, the Complainant has proved that it has standing for the purposes of this proceeding by submitting copies of registration certificates for the PAUL SMITH marks, such as the International Registration No. 755406 for the PAUL SMITH trademark registered on March 20, 2001, and the U.S. Registration No. 1306038 for the PAUL SMITH registered on February 25, 1983.

The Complainant has also demonstrated that the Domain Name is identical or confusingly similar to its PAUL SMITH trademark. "Where a domain name incorporates the entirety of a trademark, [...] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". "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." The addition of the gTLD ".com" is disregarded under the confusing similarity test.

Here, the Domain Name <paulsmithclearan.com> consists of the PAUL SMITH trademark, the generic and descriptive word "clearan" (undoubtedly referring to the idea of clearance, clearing) and the gTLD ".com".

Thus, the Panel finds that the Domain Name is identical or confusingly similar to the Complainant's trademark and the Complainant satisfied the first element of the UDRP.

B) Rights and Legitimate Interests

Under the second UDRP element, a complainant must make a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent. Once the complainant has made out the *prima facie* case, the respondent carries the burden of producing evidence demonstrating it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name because the Complainant has not authorized the Respondent to use and register the Complainant's PAUL SMITH trademark or to register any domain name incorporating the PAUL SMITH mark. Previous UDRP panels have found that in the absence of any license or permission from a complainant to use a complainant's trademarks, generally no bona fide or legitimate use of the domain name could reasonably be claimed. See, *LEGO Juris A/S v. DomainPark Ltd*, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master, WIPO Case No. D2010 -0138.

The Complainants also claims that the Respondent is using the Domain Name to direct to website offering for sale counterfeit PAUL SMITH goods. “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods ...) can never confer rights or legitimate interests on a respondent”. While “[p]anels are generally not prepared ... to accept merely conclusory or wholly unsupported allegations of illegal activity”, “circumstantial evidence can support a complainant’s otherwise credible claim of illegal respondent activity”. Here, the Complainant claims that the Respondent used the Domain Name to direct to website offering for sale cheap goods bearing the PAUL SMITH trademark. The Respondent does not dispute this contention. Moreover, the website indicates what could be a false information of “Paul Smith Official shop” from the indication of the Complainant the Respondent has not authorization whatsoever to use the Mark. The Panel finds that the totality of circumstantial evidence in this case indicates that the Complainant’s contentions are likely true. Therefore, the Respondent’s use of the Domain Name did not confer rights or legitimate interest on him.

The Panel therefore finds that the Complainant has made out a *prima facie* case in respect to the Respondent’s lack of rights or legitimate interests in the Domain Name.

C) Bad Faith

Under the third UDRP element, the Complainant is required to prove that the Domain Name was registered and are being used in bad faith.

Pursuant to paragraph 4(b) of the UDRP, any one of the following non-exclusive scenarios may constitute evidence of a respondent’s bad faith:

- i. circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
- ii. the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- iii. the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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.

Here, the Panel finds that the Respondent registered the Domain Name in bad faith because at the time of the Domain Name registration he was aware of the Complainant and its PAUL SMITH trademark and registered the Domain Name without consent from the Complainant, to confuse and mislead visitors to his website. The evidence shows that the Respondent used the Domain Name incorporating the Complainant’s PAUL SMITH trademark, to resolve to the websites displaying the Complainant’s word and design PAUL SMITH trademark and

offering for sale unauthorized goods bearing the Complainant's trademark. Therefore, it is likely that the Respondent knew about the Complainant and its trademarks when he registered the Domain Name, which amounts to bad faith registration.

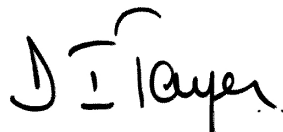
Further, the Panel finds that the Respondent is using the Domain Name in bad faith. Evidence on file shows that prior to filing of the Complainant in this case, the Domain Name directed to the website offering for sale purported products of the Complainant. The "Home" page of the Respondent's website prominently displayed the Complainant's word and design PAUL SMITH trademark. As a result, Internet users may have been misled on the source, sponsorship, affiliation, or endorsement of the Respondent's website, which constitutes bad faith use of the Domain Name.

Moreover, the Complainant claims that the products offered on the Respondent's website are counterfeit. Previous UDRP panels found that use of domain name in connection with website offering for sale unauthorized copies of complainants' goods, was in bad faith. See, *Philip Morris USA Inc. v. Samurai Kapok and*, WIPO Case No. D2016-2179 ("The Panel, therefore, concludes that the sale of purported, grey market goods or counterfeit cigarettes as well as promoting the brands that compete with Complainant under a domain name incorporating Complainant's mark indicate use in bad faith."). Similarly, this Panel finds that the Respondent's use of the Domain Name linked to website selling unauthorized copies of the Complainant's goods is in bad faith.

Therefore, the Panel finds that the Domain Name was registered and are being used in bad faith. The third element of the UDRP has been satisfied.

6. Decision

For all the foregoing reasons, in accordance with paragraph 4 of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <paulsmithclearan.com> be transferred to the Complainant.



David-Irving TAYER
Panelists

Dated: February 26, 2024