



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2401945
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Mostow Co., Theresa Chavez
Disputed Domain Name(s):	<paulstore.shop>

1. The Parties and Contested Domain Name

The Complainant is Paul Smith Group Holdings Limited, of England.

The Respondent is Mostow Co., Theresa Chavez, of California, United States.

The domain name at issue is <paulstore.shop>, registered by Respondent with NameSilo.com, of Arizona, United States.

2. Procedural History

The Complaint was submitted by Paul Smith Group Holdings Limited pursuant to the Uniform Domain Name Dispute Resolution Policy (the "**Policy**") adopted by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on 24 October 1999 and the Rules for Uniform Domain Name Dispute Resolution Policy (the "**Rules**") to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "**Centre**" or "**ADNDRC**") on 6 December 2024 concerning the domain name <paulstore.shop>, henceforth the disputed domain name, registered by Mostow Co., Theresa Chavez. The Centre confirmed the receipt of the Complaint on 6 December 2024.

On 6 December 2024, the Centre served an email to the Registrar to confirm the WHOIS information. On the same day, the Registrar confirmed by email to the Centre that the disputed domain name was registered with the Registrar, and confirmed English as the language under the Registration Agreement.

On 27 December 2024, the Centre notified the Complaint about deficiencies in the Complaint. On 2 January 2025, the Complainant submitted an Amended Complaint. The Center confirmed that the Complaint is in administrative compliance with the Policy and its Rules on 2 January 2025.

On 2 January 2025, the Centre served the Complaint and all Annexes, setting a deadline of 22 January 2025, by which Respondent could file a Response to the Complaint.

On 23 January 2025, the Centre confirmed no Response was received within the deadline.

On 17 January 2025, according to Complainant's request to have the dispute decided by a single-member Panel, the Centre served a Panelist appointment notice to the undersigned.

On 23 January 2025, having declared no conflict of interests between the parties, the undersigned was appointed as the Panelist. The Panelist shall render a decision on or before 6 February 2025.

3. Factual background

The Complainant own the registered Trade Mark "Paul Smith" (hereinafter referred to as "Paul Smith"). The Complainant is known for design, fashion clothing and accessories. The Complainant, 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.

Paul Smith Group Holdings Limited have registered the "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.

The Complainant registered the trademark "PAUL SMITH", International Registration No. 755406 through WIPO on March 20, 2001.

The Complainant registered the trademark "PAUL SMITH", International Registration No. 708450 through WIPO on February 11, 1999.

The Complainant registered the trademark "PAUL SMITH" in US, Registration No. 1306038 on November 20, 1984.

The Complainant registered the trademark "PAUL SMITH" in US, Registration No. 1511432 on November 8, 1988.

The Complainant registered the trademark "PAUL SMITH" in US, Registration No. 1703997 on July 28, 1992.

The Complainant registered the trademark "PAUL SMITH" in US, Registration No. 1661631 on October 22, 1991.

The Complainant registered the trademark "PAUL SMITH" in US, Registration No. 1899650 on June 13, 1995.

The Complainant registered the trademark “PAUL SMITH” in US, Registration No. 3327649 on October 30, 2007.

The Complainant registered the trademark “PAUL SMITH” in US, Registration No. 4024727 on September 13, 2011.

The Complainant registered the trademark in US, Registration No. 2439173 on March 27, 2001.

The Complainant registered long before the registration date of the disputed domain name, 19 October 2024, the following trademarks with the UK Intellectual Property office:

The Complainant registered the trademark “PAUL SMITH”, in the UK, Registration No. 1190572 on February 16, 1983.

The Complainant registered the trademark “PAUL SMITH”, in the UK, Registration No. 2051161 on May 16, 1997.

The Complainant registered the trademark “PAUL SMITH”, in the UK, Registration No. 2184370 on June 4, 1999.

The Complainant also registered long before the registration date of the disputed domain name the following trademarks with the OHIM (Office for Harmonization in the Internal Market EU):

The Complainant registered the trademark “PAUL SMITH” with OHIM, EU Registration No. 45393 on September 4, 2001.

The Complainant registered the trademark “PAUL SMITH”, with OHIM, EU Registration No. 8673451 on May 27, 2010.

Using ‘WWW.GOOGLE.COM’ the Complainant searched for “PAUL SMITH” and obtained 692,000 results. Using ‘WWW.GOOGLE.COM.HK’ the Complainant searched for “PAUL SMITH” and obtained 1,690,000 results. The information on the first page of the search result is associated to the Complainant.

The disputed domain name was registered on 19 October 2024.

For the Respondent

The Respondent in Hong Kong, did not file a Response.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

A.

Since the “.SHOP” is not taken into account in the comparison, “PAULSTORE” is the main part of the disputed domain name, of which “paul” in conjunction with “store” is identical to the Complainant’s worldwide reputed “PAUL SMITH” and trademarks.

Thus the relevant public would easily separate and associate “paul” + “store”, when identifying the disputed domain name. Further, as “store” is a general English word and in this context associated with the home and manufacturing location of the designer. Accordingly, <paulstore.shop>, as a domain name, can be easily understood as “the sale website of PAUL SMITH goods”. It is obvious that “PAUL” which is commonly understood and associated with Paul Smith is the central and distinguishing element of the disputed domain name and the web pages clearly show reference to “Paul Smith”.

Meanwhile, the disputed domain name website is 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”.

Furthermore, the images and models used on the disputed domain name website are substantially similar to those used by the Complainant’s trademarks “PAUL SMITH” and this is also evidence that the Respondent is promoting this website as the official Paul Smith website for buying goods.

Thus, the disputed domain name can easily mislead consumers into mistakenly believing the disputed domain name is owned or operated by the Complainant, or that the Respondent has certain relations with the Complainant.

Therefore, the disputed domain name is confusingly similar to the Complainant’s trademarks “PAUL SMITH”.

B.

Firstly, the Respondent has never been authorized by the Complainant to use the trademarks “PAUL SMITH” under any circumstances.

Furthermore, the Respondent has no business relationship with the Complainant. Thus, the Respondent does not have any rights with regard to the trademark “PAUL SMITH”.

Secondly, the Respondent’s name, address and any other information cannot be linked with “PAUL SMITH”.

Thirdly, further searches by the Complainant do not prove that the Respondent has any other rights to “PAUL SMITH”.

C.

The disputed domain name websites are blatantly selling fake counterfeit products bearing the Complainant’s registered trademarks “PAUL SMITH”. It can be easily found that the goods sold on the websites by the disputed domain name is also named “PAUL SMITH” products. The Respondent’s

conduct should be regarded as evidence of bad faith as prescribed in 4(b) (iv) of the Policy.

The Complainant's "PAUL SMITH" trademarks had been extensively registered throughout the world including UK, US and China, etc., long before the registration of the disputed domain name. The registered "PAUL SMITH" trademarks, designating a large range of goods, such as clothes, leather products, shoes, scarves, have become worldwide reputed after continuous extensive uses and marketing throughout the world.

Meanwhile, the Respondent is using the disputed domain name to sell fake counterfeit products bearing the Complainant's prior registered trademarks "PAUL SMITH", which additionally proves that the Respondent's awareness of "PAUL SMITH" before registering the disputed domain name.

Thus, it can be reasonably inferred that the Respondent was aware of the Complainant's prior trademarks on "PAUL SMITH" well before registering the disputed domain name.

B. Respondent

The Respondent did not file a 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

First, the Panel is satisfied that the Complainant has shown it owns rights in the "PAUL SMITH" trademark, with many trademark registrations, the earliest one dating to 1983, and the Complainant provided evidence of these.

Turning to analyze whether the disputed domain name and the trademark are confusingly similar, the Panel notes, based on the record at hand, that the disputed domain name reproduces the first part of the trademark, namely "PAUL", followed by the generic term "STORE". Based on this, the typical side-by-side comparison of the disputed domain name and the textual components of the

relevant trademark to assess whether the mark is recognizable within the disputed domain name is not enough to find confusing similarity.

The Panel must look at the matter holistically, which as per paragraph 1.7 of WIPO Overview 3.0, “In specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel would benefit from affirmation as to confusing similarity with the complainant’s mark, the broader case context such as website content trading off the complainant’s reputation... may support a finding of confusing similarity.”

In this instance, the Panel must look at the content of the website, which explicitly, as per the evidence provided by the Complainant, attempts to trade off the Complainant’s reputation by recreating elements associated with the Complainant and its trademarks and selling what appears to be counterfeit bearing the Complainant’s registered trademarks “PAUL SMITH”. This, in conjunction with the reproduction of the first part of the Complainant’s trademark, "PAUL", alongside the generic term "STORE", which appears to refer to an outlet for the products of the Complainant, leaves the Panel no option than to conclude that all these circumstances, without an explanation to the contrary and on the balance of probability, heighten the appearance of confusing similarity with the trademark “PAUL SMITH”.

A more complete analysis of this will be conducted in the elements below, but suffice to say that in what relates to the first element, the differences with the trademarks are insufficient to dispel the confusing similarity between the trademark and the disputed domain name. The circumstances adduced to earlier will be the subject of further analysis below.

Consequently, the Panel determines that the Complaint has satisfied the Policy’s first element set under paragraph 4(a)(i).

B) Rights and Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts.

The uncontested facts indicate that a) the Respondent is not commonly known by the disputed domain name; b) the Respondent is not related to the Complainant; c) the Respondent is not authorized to carry out any business activity for the Complainant; d) the Respondent has no license or authorization to use the trademarks; and e) the Respondent through the disputed domain sells counterfeit products bearing the Complainant’s registered trademarks “PAUL SMITH”.

Based on the above, the record at hand, and on the balance of probability, and considering that the Respondent has failed to respond to the Complainant’s contentions, the Respondent has consequently not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

The above fact pattern indicates, if nothing else, a likely intention to confuse Internet users and either offer counterfeit products bearing the Complainant's registered trademarks "PAUL SMITH" or a likely implied association with the Complainant by appearing to be a formal channel of the Complainant.

Based on the evidence on record, neither of these leads the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

C) Bad Faith

As per the record and evidence, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This is further reinforced by not only the fact that the "PAUL SMITH" trademark predates the registration of the disputed domain name but also the explicit reference the Respondent makes throughout the content of the website associated with the disputed domain name, in addition to offering to sell what appear to be counterfeit products bearing the Complainant's registered trademarks "PAUL SMITH".

This conduct could also appear to be an active effort by the Respondent to appear as a formal channel of the Complainant, without any visible explanation in the disputed domain name regarding its association with the Complainant. Without further explanation from the Respondent, at the very least, appears to misrepresent a link between the disputed domain name and the Complainant, if not an outright outlet for counterfeit products bearing the Complainant's registered trademarks "PAUL SMITH", which appears more likely under the circumstances and on the balance of probability. In any case, as the record supports, the Respondent appears to have targeted the Complainant.

All the preceding analysis leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

6. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.



Rodolfo C. Rivas
Panelist

Dated: 27 January, 2025