



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK- 1801086
Complainant:	“Paul Smith” Group Holdings Limited
Respondent:	Xu Gueijuan
Disputed Domain Name(s):	paulsmithoutetsonline.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, Great Britain.

The Respondent is Xu Gueijuan, of Xu Gueijuan Address: 197 Hao, Kanlecuen Shaoguan, Guangdong, People’s Republic of China (PRC).

The domain name at issue is < paulsmithoutetsonline.com >, registered by Respondent with GoDaddy Operating Company LLC, 14455 North Hayden Rd, Suite 219, Scottsdale, AZ 85260, United States of America (USA).

2. Procedural History

On 16 March 2018, the Complainant filed the Complaint with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) in accordance with the Uniform Domain Name Dispute Resolution Policy (“Policy”) adopted by the Internet Cooperation for Assigned Names and Numbers (“ICANN”) on 24 October 1999. On the same date, the Centre transmitted by email to the Registrar a request for confirmation that the disputed domain name was registered by the Respondent and that the disputed domain name will be prohibited from being transferred to a third party.

On 17 March 2018, the Registrar confirmed by email that the Respondent was the registrant of the disputed domain name and the Disputed Domain Name had been locked during the pending administrative proceeding. In accordance with paragraphs 2(a) and 4(a) of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 20 March 2018.

In accordance with paragraph 5(a) of the Rules, the due date for the Response was 9 April 2018. The Respondent did not submit any response. Accordingly, the Centre notified the parties of the Respondent’s default on 10 April 2018.

On 13 April 2018, the Centre appointed Professor Julien Chaisse as Panelist in the administrative proceeding. 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 Complaint, the e-mails exchanged, the evidence presented, the Policy, the Rules, the Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from the Respondent. Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Centre on or before 27 April 2018.

3. Factual background

The Complainant: “Paul Smith” Limited

A. The Complainant “Paul Smith” Group and its activities

“Paul Smith” Limited are a subsidiary of “Paul Smith” Group Holdings who own the registered Trade Mark “Paul Smith” (hereinafter referred to as “Paul Smith”). “Paul Smith” is internationally known for design, fashion clothing and accessories. “Paul Smith” has, in particular, developed a reputation as a designer both in the United Kingdom (UK) and abroad. “Paul Smith” also trades at the top end of the retail market producing high quality products using fine raw material and innovative techniques. “Paul Smith” 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 its own retail outlets.

B. The Complainant “Paul Smith” Group and its Trade Marks

“Paul Smith” Group Holdings Limited have registered the “Paul Smith”

Paul Smith PS · Paul Smith, trademarks throughout the world, including in UK, China, USA, 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.

The specific goods/services designated include:

- (03) soaps, shampoo, preparations for use for and after shaving, toilet preparations, skin care and hair care preparations, deodorants, anti-perspirants, dentifrices, bath and shower preparations; talcum powder; shoe cleaning preparations; perfumery, colognes; cosmetics;
- 09 spectacle frames, sunglasses frames, sunglasses, lenses, clips, cases and containers for spectacles and sunglasses, radios, calculators, parts and accessories for all the aforesaid goods;
- (14) precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery, precious stones, horological and chronometric instruments, imitation jewellery, brooches, cuff links, ornamental pins, tie pins, watches, watch straps, clocks, money clips; key rings;
- (16) paper; cardboard and cardboard articles; stationery, printed matter, printed publications, calendars, albums, writing materials and writing implements, notebooks, note pads, diaries, address books, posters, loose-leaf binders, files, folders; pen and pencil

- sets, cases and stands; letter racks, paper knives, cards, playing cards, paperweights, parts and fittings for all the aforesaid goods;
- (18) leather and imitations of leather and goods made of these materials not included in other classes; animals skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage; rucksacks, bags, briefcases, pocket wallets, purses, pouches, credit card holders, chewing gum holders, notebook holders, coin holders, key cases;
- (20) pillows and cushions; handkerchiefs; towels; articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties; and
- (27) rugs, wall coverings, namely, wallpaper.

The Respondent

No information of significance is available about the Respondent except for the contact details provided for the purpose of registration of the disputed domain names. The Disputed Domain Name was registered on 30 January 2018. The Disputed Domain Name currently resolves to a website that allegedly enables users to search for and purchase counterfeit products fraudulently sold under the “Paul Smith” trade mark.

4. Parties’ Contentions

Since the Respondent defaults, the Panel understands that the Complainant bears the burden of pleading at least a prima facie case. See, e.g., *Cyro Industries v. Contemporary Design*, WIPO, No. D2000-0336, Jun. 19, 2000 (holding that in cases of default, panels must pay special attention to evaluating the accuracy of Complainant’s submissions); *Softquad Software Inc. v. Eleven-Eleven Ltd, DeC*, No. AF-0143 (Jun. 1, 2000) (stressing that in default cases, the burden of proving required elements remains with the Complainant).

A. Complainant

The Complainant’s contentions may be summarized as follows:

i. Identical or confusingly similar

The Complainant has registered numerous trademarks comprising the “Paul Smith” trademark to protect its interests around the world.

The Complainant registered the trademark “Paul Smith” (International Registration No. 755406) through WIPO on March 20, 2001. The trademark “Paul Smith” has granted protection in many countries including 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.

The Complainant registered the trademark *Paul Smith* (International Registration No. 988039) through WIPO on June 5, 2008. The trademark *Paul Smith* has granted protection in many countries including UK and Bahrain, covering the goods in Classes 03, 09, 14, 16, 18 and 25.

The Complainant registered the trademark *PS - Paul Smith* (International Registration No. 708450) through WIPO on February 11, 1999. The trademark *PS - Paul Smith* has granted

protection in many countries/areas including 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. The Complainant registered the trademark “Paul Smith” in US (Registration No. 1306038) on February 25, 1983, covering the goods in class 25. The Complainant registered the trademark “Paul Smith” in US (Registration No. 1511432) on February 2, 1988, covering the goods in class 3. The Complainant registered the trademark “Paul Smith” in US (Registration No. 1703997) on April 19, 1990, covering the goods in class 14. The Complainant registered the trademark “Paul Smith” in US (Registration No. 1661631) on June 4, 1990, covering the goods in classes 14 and 18. The Complainant registered the trademark “Paul Smith” in US (Registration No. 1899650) on March 16, 1993, covering the goods in class 9. The Complainant registered the trademark “Paul Smith” in US (Registration No. 3327649) on April 13, 2006, covering the goods in classes 24, 25 and 27. The Complainant registered the trademark “Paul Smith” in US (Registration No. 4024727) on July 12, 2010, covering the goods in classes 3, 20, 25 and 27. The Complainant registered the trademark *PS - Paul Smith* in US (Registration No. 2439173) on January 21, 1999, covering the goods in class 25. The Complainant registered long before the registration date of the Disputed Domain Names (16th January 2017) 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, covering the goods in class 25; The Complainant registered the trademarks “Paul Smith” and *Paul Smith*, in the UK (Registration No. 2051161) on May 16, 1997, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34; The Complainant registered the trademark *PS - Paul Smith*, in the UK (Registration No. 2184370) on June 4, 1999, covering the goods in class 25. The Complainant also registered long before the registration date of the Disputed Domain Names (16th January 2017) 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, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34; The Complainant registered the trademark *Paul Smith*, with OHIM (EU Registration No. 8673451) on May 27, 2010, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34.

The Complainant accordingly submits that it has proved that the Disputed Domain Name is identical and/or confusingly similar to its registered trademarks in which the Complainant has rights or interests for the purposes of paragraph 4(a)(i) of the Policy.

ii. No rights or legitimate interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a) (ii) and particular 4(c) of the Policy.

Firstly, the Respondent has never been authorized by the Complainant to use the trademarks “Paul Smith” and *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 for “Paul Smith”.

The Complainant accordingly submits that it has proved that the Respondent has no right or legitimate interest in respect of any of the Disputed Domain Name for the purposes of Article 4(a)(ii) of the Policy.

iii. Registered and used in bad faith

The Complainant contends that the Respondent actual use of the Disputed Domain Name demonstrates that it is registered and used in bad faith, with a view to free-riding the substantial reputation and goodwill enjoyed by the Complainant in the trade names / marks “Paul Smith”.

The Complainant accordingly submits that it has proved that the Respondent has registered and used the Disputed Domain Name in bad faith for the purposes of Article 4(a)(iii) of the Policy.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made 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

The Complainant must prove that it has rights in a trademark to which each disputed domain name is confusingly similar.

The registered trademarks: PAUL SMITH, *Paul Smith* and *PS - Paul Smith*, designate a large range of goods, such as clothes, leather products, shoes, scarves, etc., have gained a worldwide reputation after continuous extensive use and marketing throughout the world.

The Disputed Domain Name < paulsmithoutetsonline.com > incorporates the Complainant’s “Paul Smith” mark in its entirety. From a simple comparison of the name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, identical to the Complainant’s mark “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 Names websites are substantially similar to those used by the Complainant’s trademarks “Paul Smith” and *Paul Smith*. This is also evidence that the Respondent is promoting this website as the official “Paul Smith” website for buying goods.

Thus, the Disputed Domain Names can easily mislead consumers to mistakenly believe the Disputed Domain Name is owned or operated by the Complainant, or the Respondent has certain relation with the Complainant.

Therefore, the Panel finds that the disputed domain name < paulsmithoutetsonline.com > is, for all practical purposes, identical to the mark “Paul Smith”, which forms one of the Complainant’s “Paul Smith” Marks, so as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The “Paul Smith” Trade Marks are inherently distinctive and given also their extensive use by the Complainant in commerce, “Paul Smith” Trade Marks are immediately recognisable to consumers as being associated with the Complainant, its business and its products. The fame of the “Paul Smith” Trade Marks, coupled with the fact that the Complainant has not licensed, consented to or otherwise authorised the Respondent's use of the “Paul Smith” Trade Marks, has the practical effect of shifting to the Respondent the burden of proof in establishing that it has rights and/or legitimate interests in the Disputed Domain Name (see *PepsiCo, Inc v. Amilcar Perez Lista d/b/a Cybersor*, WIPO Case No. D2003-0174).

The Respondent has not responded to the Complaint to assert any rights or legitimate interests. The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and thereby the burden of production shifts to the Respondents to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see for example *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455).

Paragraph 4(c) of the Policy sets out ways in which a Respondent may establish they have rights and legitimate interests. These are: “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are 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 trademark or service mark at issue.”

In substance, the Disputed Domain Name currently resolves to a website that allegedly enables users to search for and purchase counterfeit products. However, the Respondent is not an authorised representative or partner of the Complainant, and the Complainant has

never authorised the Respondent to use its “Paul Smith” Trade Marks or to operate the Respondent Website.

Furthermore, there is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name. The Respondent's name (Xu Gueijuan) does not reflect or correspond with the Disputed Domain Name, and there is no justification or apparent need for her to use “Paul Smith” in the Disputed Domain Name.

In the absence of a timely any Response, the Panel infers that the Respondent is not using the name on either a non-commercial or fair use basis without intent to misleadingly divert consumers or tarnish any of the Complainant’s marks, or, prior to receiving notice of this dispute, in connection with any *bona fide* offering of goods or services or demonstrable preparations for making such an offering, thus failing to qualify under either of paragraphs 4(c)(i) and 4(c)(iii) of the Policy. Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a) (ii) and 4(c) of the Policy.

C) Bad Faith

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.

After a careful examination of the four, non-exclusive examples enumerated in paragraph 4 (b) of the UDRP, the panel ultimately found, that, based on the available facts and circumstances, the registration and use of the domain name could be said to have been made in bad faith.

Firstly, the Respondent is using the Disputed Domain Name to sell fake counterfeit products bearing the Complainant’s prior registered trademarks “Paul Smith” and *Paul Smith*. The Disputed Domain Names websites are blatantly selling fake counterfeit products bearing the Complainant’s registered trademarks “Paul Smith” and *Paul Smith*.

Secondly, the Respondent was aware of “Paul Smith” and *Paul Smith* trademarks well before registering the Disputed Domain Name. The Complainant’s “Paul Smith” and *Paul Smith* trademarks had been extensively registered throughout the world including UK, US and China, etc., long before the registration of the Disputed Domain Names. The registered “Paul Smith” and *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 Names to sell fake counterfeit products bearing the Complainant’s prior registered trademarks “Paul Smith” and, which additionally proves that the Respondent’s awareness of “Paul Smith” and before registering the Disputed Domain Names. As stated in the case of *Alibaba Group Holding Limited v. Alexey Gurov* (ADNDRC Case No. HKS-1400012), *"the fact that the disputed domain names are identical to the Complainant's trademarks will mislead users into believing that they are associated with the Complainant. Good faith registration and use by the Respondent is inconceivable."* In this respect, it is inconceivable that registration and use of the Disputed Domain Name < paulsmithoutetsonline.com > could be for any reason other than bad faith, in order to mislead users into believing the Respondent is associated with the Complainant for the purposes of commercial gain; to sell the Disputed Domain Names for profit; and/or to prevent the Complainant from reflecting its “Paul Smith” Trade Marks in a corresponding domain name. Thus, it can be reasonably inferred that the Respondent was aware of the Complainant’s prior trademarks on “Paul Smith” and *Paul Smith* trademarks well before registering the Disputed Domain Names. This falls squarely within paragraph 4(b) of the Policy as evidence of bad faith.

The Panel finds that the Respondent’s actions, with respect to the disputed domain name, constitute bad faith registration and use. Consequently, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(i) thereof.

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 < paulsmithoutetsonline.com >, be TRANSFERRED to the Complainant.



Professor Julien Chaisse

Panelist

Dated: April 23, 2018