



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-18010114
<b>Complainant:</b>	Paul Smith Group Holdings Limited
<b>Respondent:</b>	Gueijuan Xu
<b>Disputed Domain Names:</b>	<paulsmithsalecheaps.com> and <shopspaulsmithclearance.com>

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

The Respondent is Gueijuan Xu, of 197 Hao Kanlecuen Wujianqu, Shaoguan, Guangdong 512026, People's Republic of China (PRC).

The domain name at issue are <paulsmithsalecheaps.com> and <shopspaulsmithclearance.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 May 18, 2018, the Complainant submitted the Complaint in English on domain names <paulsmithsalecheaps.com> and <shopspaulsmithclearance.com> to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules") approved by ICANN on October 24, 1999, and the Asian Domain Name Dispute Resolution Centre Supplemental Rules in effect as of July 31, 2015. The Complainant requested a single person panel.

After receiving the Complaint, the Centre, in accordance with the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on May 18, 2018, the Centre requested the Registrar to confirm: (1) that the disputed domain name was registered with the Registrar, (2) whether the Respondent is the registrant or holder of the name, and (3) whether the Policy applies

to the name; and to specify: (4) the language of the Registration Agreement of the disputed domain name, (5) WhoIs information for the disputed domain name, and (6) the current status of the domain name. Also, by email message dated May 18, 2018, the Center confirmed the receipt of the Complaint, together with Annexures. By email message dated June 13, 2018, the Center reiterated its request made to the registrar on May 18, 2018.

On June 13, 2018, the Registrar provided its response to the Centre through which it confirmed that: (1) the name was registered with GoDaddy.com LLC, (2) the Respondent is the registrant or holder of the name, and (3) the Policy applies to the name. The Registrar also stated that (4) the registration agreement is in the English language, (5) provided name and contact information pertinent to the name as reflected in its WhoIs database, and stated that (6) the domain name was locked and would remain locked during the pending administrative proceeding.

On June 27, 2018, the Centre sent the Complaint to the Respondent. The Respondent was then provided with a 20 calendar day period, expiring on July 17, 2018, to file its Response both with the Centre and the Complainant. As of July 18, 2018, the Respondent had not filed any Response with the Centre. Accordingly, on July 18, 2018, the Centre advised the parties by email that the Respondent had not filed any Response to the Complaint with the Centre and, as such, the Centre would then proceed to appoint a Panelist for this matter.

Pursuant to the Rules and Supplemental Rules, the Centre, by email dated August 24, 2018, contacted the undersigned, Prof. Dr. Julien Chaisse, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Prof. Chaisse responded and affirmed his ability to act completely independently and impartially in this matter. Subsequently, the Centre, through an email dated August 27, 2018, notified the Parties of the appointment of Prof. Chaisse as the Sole Panelist. The Panel finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules. Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before September 10, 2018.

### **3. Factual background**

#### **The Complainant: Paul Smith Group Holdings**

##### **A. The Complainant 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 Group Holdings is internationally known for design, fashion clothing and accessories. Paul Smith Group Holdings has, in particular, developed a 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 fine raw material and innovative techniques. Paul Smith Group Holdings 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.

##### **B. The Complainant's 'Paul Smith' Marks**

Paul Smith Group Holdings Limited have registered the "PAUL SMITH"

*Paul Smith* *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. 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;
- 24 handkerchiefs; towels;
- 25 articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties; and
- 27 rugs, wall coverings, namely, wallpaper.

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 Respondent**

As indicated in the WhoIs registration record provided in Annexure 1 to the Complaint, the Respondent registered the disputed domain name on January 16, 2017. Since June 13, 2018, the Disputed Domain Name has been locked by the Registrar and is currently inactive. The Centre confirmed that documents have been sent to the Respondent's address as registered with the registrar. However, the Centre did not receive a Response from the Respondent for the Domain Name Dispute within the required period of time. The Respondent is to be considered in default.

### **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. The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant submits that the Disputed Domain Names <paulsmithsalecheaps.com> and <shopspaulsmithclearance.com> are confusingly similar to the Complainant's trademark Paul Smith because the visual and conceptual similarities.

Firstly, the Complainant could provide evidences that he registered several trademarks long before the registration date of the Disputed Domain Names (16<sup>th</sup> January 2017).

Secondly, the Complainant submits that the Disputed Domain Names are confusingly similar to the Complainant's trademarks PAUL SMITH and *Paul Smith*.

Since the ".com" is not taken into account in the comparison, "cheappaulsmith2017", "paulsmithclearancesale" and "paulsmithonlinestoreus" are the main part of the Disputed Domain Names, of which "paulsmith" is identical to the Complainant's worldwide reputed PAUL SMITH and *Paul Smith* trademarks. Thus, the relevant public would easily separate the Disputed Domain Names into "paulsmith" + either "japan" or "store". It is obvious that "paulsmith" is the central and distinguishing element of the Disputed Domain Names.

Meanwhile, the Disputed Domain Names website are blatantly selling fake counterfeit PAUL SMITH goods in large quantities. This serves as good evidence proving that the Disputed Domain Names are 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 Names are owned or operated by the Complainant, or the Respondent has certain relation with the Complainant.

Therefore, the Disputed Domain Names are confusingly similar to the Complainant's trademarks PAUL SMITH and *Paul Smith*.

From these facts, it is argued that it is apparent that the Disputed Domain Names are confusingly similar to the Complainant's Paul Smith marks and that the respondent intended to, and is currently, riding on the reputation of Paul Smith's business.

- ii. The Respondent has no rights or legitimate interests in respect of the domain names:

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

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.

For the foregoing reasons, the Complainant submits that paragraph 4(a) (ii) of the Policy has been satisfied.

- iii. The disputed domain names have been registered and are being used in bad faith:

The Complainant submits that the Respondent has shown bad faith in registering and using The disputed domain names, <paulsmithsalecheaps.com> and <shopspaulsmithclearance.com> because of two essential reasons: on the one hand, the Respondent was aware of Paul Smith trademark and activities, and, on the other hand, there is an intent to cause confusion.

Firstly, the Disputed Domain Names websites are blatantly selling fake counterfeit products bearing the Complainant's registered trademarks PAUL SMITH and *Paul Smith*. In this respect, the goods sold on the websites by the Disputed Domain Names are 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.

Secondly, 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. 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.

For the foregoing reasons, it can be reasonably inferred that the Respondent was aware of the Complainant's marks well before registering the Disputed Domain Names and that they are intentionally attempting to attract users for commercial gain by creating a likelihood of confusion.

#### B. Respondent

The Respondent is to be considered in default and the Panel will decide the dispute based on the information available to it and may draw such inferences as it deems appropriate from the Respondent's failure to submit a timely Response.

### 5. Findings

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

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

The Complainant has established its rights in the trademarks "Paul Smith" with various registrations for such a name (See Annexes to the Complaint).

The Complainant has submitted conclusive evidence that the domain names <paulsmithsalecheaps.com> and <shopspaulsmithclearance.com> are confusingly similar to its trademark "Paul Smith".

The main differences between the disputed domain name and the Complainant's mark is the addition of the words "cheap" or shops" and "clearance" before or after the Complainants' mark.

This does not render the said domain name totally distinctive from the Complainant's trademark. Previous UDRP panels have consistently held that a domain name is identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662).

In effect, UDRP panels have found domain names to be identical or at least confusingly

similar when based on “close variant” or “close misspelling” of the mark in question (e.g. *AltaVista Company v. Grandtotal Finances Limited et al.*, WIPO Case No. D2000-0848; *Yahoo!Inc. v. Eitan Zviely et al.*, WIPO Case No. D2000-0273; *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. Integrity Ltd.*, WIPO Case No. D2005-0404; *Guccio Gucci S.p.A. v. Huangwensheng, Shirley, wangliang, xiaomeng xiexun, jiangxiuchun*, WIPO Case No. D2012-0342).

There is no reason in the instant matter to depart from these decisions under the circumstances described above, not rebutted by the Respondent.

The Panel therefore holds that Complaint fulfils the first condition of paragraph 4(a) 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 Respondent has never been authorized by the Complainant to use the trademarks PAUL SMITH and *Paul Smith* under any circumstances. Moreover, the Respondent’s name, address and any other information cannot be linked with PAUL SMITH.

The Panel infers from the above 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**

In accordance with Paragraph 4(a)(iii) of the Policy the Complainant must prove that the Domain Name has been registered and is being used in bad faith. The Complainant has adduced evidence to prove that by using confusingly similar disputed domain names, Respondents have intentionally attempted to attract, for commercial gain, Internet users to Respondents’ websites offering Complainant’s Paul Smith products.

The Complainant has adduced evidence to prove that by using confusingly similar disputed domain names, Respondents have intentionally attempted to attract, for commercial gain, Internet users to Respondents’ websites offering Complainant’s Paul Smith products.

The Panel finds that it is not conceivable that Respondent would not have had actual notice of Complainant’s trademark rights at the time of the registration of the disputed domain name. The Panel also finds that the trademarks are not one that traders could legitimately adopt other than for the purpose of creating an impression of an association with Complainant. (*The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. D2009-0610). Moreover, Respondent has chosen not to respond to

Complainant's allegations in the Complaint. According to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, supra, "the failure of Respondents to respond to the Complaint further supports an inference of bad faith". (see also *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. D2002-0787).

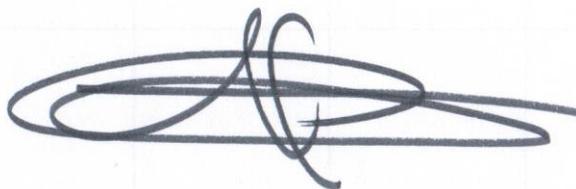
Given the widespread reputation of the trademarks, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to the fact. There is a strong likelihood of confusion as to source, sponsorship, affiliation or endorsement of the website to which the disputed domain name resolves (see Annexes to the Complaint). In other words, the Respondent has through the use of confusingly similar disputed domain name created a likelihood of confusion with Complainant's trademarks. Moreover, the Respondent has not responded to the Complaint. The Panel therefore concludes that the disputed domain name is being used by Respondent in bad faith. The passive holding of some of the disputed domain name also amounts to use in bad faith in the circumstances of this case.

In summary, Respondent, by choosing to register and use the disputed domain names which are confusingly similar to Complainant's well-known trademarks, intended to ride on the goodwill of Complainant's trademarks in an attempt to exploit, for commercial gain, Internet users destined for Complainant. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the disputed domain name and the conduct of Respondent as far as the website to which the disputed domain name resolve is indicative of registration and use of the disputed domain names in bad faith. The Panel therefore holds that the Complaint fulfils the third condition of paragraph 4(a) of the Policy.

## 6. Decision

Based on the above analysis, the Panelist decides that: (1) the disputed domain names <paulsmithsalecheaps.com> and <shopspaulsmithclearance.com> are confusingly similar to the Complainant's name or mark in which the complaint has rights; (2) the Respondent has no right or legitimate interest in respect of the disputed domain names; (3) the Respondent has registered and is using the domain name in bad faith.

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panelist grants the relief sought by the Complainant. The disputed domain names, <paulsmithsalecheaps.com> and <shopspaulsmithclearance.com>, are ordered transferred to the Complainant.



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Prof. Julien Chaisse  
Panelist

Dated: September 2, 2018