



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1700956
<b>Complainant:</b>	Paul Smith Group Holdings Limited
<b>Respondent:</b>	Geraldine McDonagh
<b>Disputed Domain Name(s):</b>	<paulsmithoutletcheap.com>, <paulsmithoutletsaleonline.com>, <cheappaulsmithoutletstore.com>, <cheappaulsmithsaleonline.com>, <cheappaulsmithoutlet.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, represented by S&P Legal Limited of 29 Austen Road, Guildford, Surrey, GU1 3NP, Great Britain.

The Respondent is Geraldine McDonagh of 1438 Wedgewood, Des Plaines, IL 60018, USA.

The domain names at issue are <paulsmithoutletcheap.com>, <paulsmithoutletsaleonline.com>, <cheappaulsmithoutletstore.com>, <cheappaulsmithsaleonline.com> and <cheappaulsmithoutlet.com> ("Disputed Domain Names") registered by the Respondent with GoDaddy.com, LLC ("Registrar"), of 14455 North Hayden Road, Suite 219, Scottsdale, AZ 85260, USA.

**2. Procedural History**

On 21 March 2017, the Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre ("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 22 March 2017, the Centre transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On 23 March 2017, the Registrar transmitted by email to the Centre its verification response confirming the Respondent as the registrant of the Disputed Domain Names and provided contact details for the Respondent.

In accordance with paragraphs 2(a) and 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 3 April 2017. The Respondent was informed that the due date for Response was 23 April 2017. No Response was filed by the Respondent. Accordingly, the Centre notified the parties of the Respondent's default on 24 April 2017.

The Centre appointed Gabriela Kennedy as the sole panelist in this matter on 27 April 2017. The Panel finds that it was properly constituted.

### **3. Factual background**

The Complainant owns registered rights in the "PAUL SMITH" trade mark and related device marks throughout the world, including in the UK, China, USA, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro ("Paul Smith Trade Marks"). The Complainant designs and distributes clothing and accessories worldwide.

The Respondent is an individual based in the USA. She registered the Disputed Domain Names on the following dates: <paulsmithoutletcheap.com> on 1 August 2016, <paulsmithoutletsaleonline.com> on 23 August 2016, <cheappaulsmithoutletstore.com> on 19 September 2016, <cheappaulsmithsaleonline.com> on 20 January 2017 and <cheappaulsmithoutlet.com> on 26 January 2017.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant's contentions may be summarized as follows:

- i. The Complainant holds registered rights in the Paul Smith Trade Marks, including International, UK, USA and EU trade mark registrations, the earliest of which dates back to 1983. An internet search on [www.google.com](http://www.google.com) for "Paul Smith" reveals 450,000,000 results, and the information revealed on the first page of the search results relates to the Complainant. The distinctive element of the Disputed Domain Names is "paulsmith", which is identical to the Complainant's Paul Smith Trade Marks. Therefore, the Disputed Domain Names are confusingly similar to the Complainant's Paul Smith Trade Marks.
- ii. The Disputed Domain Names are being used to resolve to websites that sell counterfeit goods bearing the Paul Smith Trade Marks. Such websites also incorporate the Paul Smith Trade Marks and images which are similar to those used by the Complainant. Therefore, the Disputed Domain Names will mislead consumers into believing that the resulting websites are owned and operated by the Complainant, or that the Respondent has a relationship with the Complainant. The Respondent has never been authorized by the Complainant to use the Paul Smith Trade Marks and has no business relationship with the Complainant. The Respondent's name and information do not correspond to "paul smith".

- iii. The Respondent is using the Disputed Domain Names in bad faith in order to resolve to websites selling counterfeit products of the Complainant under the Paul Smith Trade Marks. The Respondent therefore must have been aware of the Complainant's prior rights in the Paul Smith Trade Marks, especially in light of the Complainant's worldwide reputation, prior to the Respondent registering the Disputed Domain Names.

B. Respondent

The Respondents did not file a Response.

The fact that the Respondents have not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the Respondents' failure to file a Response may result in the Panel drawing certain inferences from the Complainant's evidence, and the Panel may accept all reasonable and supported allegations and inferences flowing from the Complainant's submissions as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437, and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000 0403).

## 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

The Panel accepts that the Complainant has rights in the Paul Smith Trade Marks, based on its International, USA, UK and EU registrations.

The Disputed Domain Names incorporate the Complainant's "PAUL SMITH" trade mark in its entirety, the only difference being the use of the words "cheap", "outlet", "store", "online" and/or "sale" as suffixes or prefixes. The foregoing words are generic terms. It is well established that where the distinctive and prominent element of a disputed domain name is the complainant's mark, and the only difference is a generic term that adds no distinctive element, then such a generic term does not negate the confusing similarity between the disputed domain name and the mark (see *Oakley, Inc. v. Joel Wong/BlueHost.com- INC*, WIPO Case No. D2010-0100; *Diageo Ireland v. Guinnessclaim*, WIPO Case No. D2009-0679; and *The Coca-Cola Company v. Whois Privacy Service*, WIPO Case No. D2010-0088).

The Panel finds that "paulsmith" is the distinctive component of the Disputed Domain Names, and the addition of generic terms does nothing to distinguish them from the Complainant's trade marks.

It is also well established that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the generic top-level domain extensions, in this case ".com", may be disregarded (see *Rohde & Schwarz GmbH & Co. KG v. Pertshire Marketing, Ltd*, WIPO Case No. D2006-0762).

The Panel accordingly finds that paragraph 4(a)(i) of the Policy is satisfied.

## **B) Rights and Legitimate Interests**

Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") states that once a complainant establishes a prima facie case in respect of the lack of rights or legitimate interests of a respondent, the respondent then carries the burden of demonstrating that 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 Policy.

The Panel accepts that the Complainant registered and began using the Paul Smith Trade Marks many years before the Disputed Domain Names were registered by the Respondent, and the Complainant has never authorised the Respondent to use its trade marks. Accordingly, the Panel is of the view that a prima facie case has been established and it is for the Respondent to prove that it has rights or legitimate interests in the Disputed Domain Names. As the Respondent has not submitted a Response to the Complainant's contentions, the Panel will assess the case based on the reasonable inferences that can be drawn from the Complainant's evidence.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Names by demonstrating any of the following:

- (i) before any notice to them of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Names or a name corresponding to the Disputed Domain Names was in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the Disputed Domain Names, even if she has acquired no trade mark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Respondent has not provided any evidence to demonstrate that she has become commonly known by the Disputed Domain Names, or a name corresponding to it. The Disputed Domain Names resolve to websites that offer products for sale which bear the Complainant's Paul Smith Trade Marks (the "Respondent Websites"). The Respondent Websites also incorporate the Complainant's Paul Smith Trade Marks at the top of the webpage, and claim to be a "Paul Smith outlet store".

In light of the foregoing, the Respondent cannot be said to be using the Disputed Domain Names to make a *bona fide* offering of goods, or for any legitimate non-commercial or fair

use, as the Respondent is attempting to take advantage of the Complainant's trade marks in order to generate profit.

The Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C) Bad Faith**

The Panel accepts that the Respondent knew of the Complainant and the Complainant's Paul Smith Trade Marks at the time she registered the Disputed Domain Names, and registered and used the Disputed Domain Names in bad faith, based on the following:

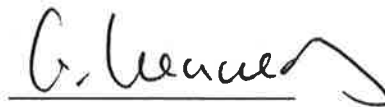
- (i) the Respondent registered the Disputed Domain Names in either 2016 or 2017, about 3 decades after the Complainant first obtained its registration in the USA for the "PAUL SMITH" trade mark;
- (b) the nature of the Disputed Domain Names themselves demonstrate that the Respondent must have been aware of the Complainant, as it cannot be mere coincidence that the Respondent registered 5 domain names that incorporate the Complainant's "PAUL SMITH" trade mark along with the words "outlet", "online", "cheap", "sale" and/or "store", which all imply that the resulting websites will sell products relating to the Complainant;
- (c) the Respondent Websites feature the Complainant's "PAUL SMITH" device mark, includes a statement saying that they are a "Paul Smith outlet store", and replicate the look and feel of the Complainant's official website; and
- (d) the Respondent Website purports to be selling clothes that bear the Complainant's Paul Smith Trade Marks.

Based on the above, the Panel believes that the Respondent registered and is using the Disputed Domain Names in bad faith to misleadingly divert consumers to the Respondent Websites for commercial gain, by creating a likelihood of confusion as to their sponsorship and association with the Complainant.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy is satisfied.

## **6. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Names be transferred to the Complainant.



Gabriela Kennedy  
Panelist

Dated: 11 May 2017

