



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600932
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Gao Xu (高旭)
Disputed Domain Names:	1. www.buypaulsmithbags.com; 2. www.buypaulsmithonline.com; 3. www.cheappaulsmithsale.com; 4. www.cheappaulsmithuk.com; 5. www.joypaulsmith.com; 6. www.paulsmithbags.com; 7. www.paulsmithstoreuk.com; and 8. www.top-paulsmith.com

1. The Parties and Contested Domain Name

The Complainant is Paul Smith Group Holdings Limited whose address is situate at The Poplars, Lenton Lane, Nottingham, NG7 2PW Great Britain; and the authorized representative of the Complainant in this proceeding is S & P Legal Limited whose address is situate at 29 Austen Road, Guildford, Surrey, GU1 3NP Great Britain.

The Respondent is Gao Xu (高旭) whose address is situate at Du Ji Qu Shuo li Kuang, Huai Bei 235000, China.

The domain names at issue are www.buypaulsmithbags.com; www.buypaulsmithonline.com; www.cheappaulsmithsale.com; www.cheappaulsmithuk.com; www.joypaulsmith.com; www.paulsmithbags.com; www.paulsmithstoreuk.com; and www.top-paulsmith.com (“the Disputed Domain Names”) registered by the Respondent with the registrar, Guangzhou Ehost Tech. Co. Ltd. (“the Registrar”) whose address is situate at Room 408, Siyou New Rold, No.124 Haojing Building, Yuexiu Dist Guangzhou 510600 China.

2. Procedural History

On 2 December 2016, the Complainant filed a Complaint with the Hong Kong Office (“HK Office”) of Asian Domain Name Dispute Resolution Centre (“ADNDRC”) pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the

Internet Corporation for Assigned Names and Numbers (“ICANN”) with an effective date of July 31, 2015 and the Complainant elects a single member panel for the dispute in this matter. The Complaint was later amended on 16 December 2016 by the Complainant in order to satisfy the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”) after the administrative check by the HK Office. All reference to the Complaint hereafter shall mean the Complaint as amended on 16 December 2016.

On 6 December 2016, the HK Office transmitted by email to the Registrar a request for confirmation of the WHOIS records of the Disputed Domain Names and other related information.

On 14 December 2016, the Registrar confirmed by email that it is the registrar of the Disputed Domain Names and that they were registered by the Respondent and the WHOIS information of the Disputed Domain Names; and that the registration agreement of these domain names was in the Chinese language; ; and that the Policy is applicable to the dispute relating to all these domain names together also with the other relevant information.

On 20 December 2016, in accordance with paragraphs 2(a) and 4(a) of the Rules, the HK Office issued in both the languages of Chinese and English the notice of commencement of proceeding and formally notified the Respondent of the Complaint. In accordance with paragraph 5(a) of the Rules, the due date for the Respondent to submit the Response was 9 January 2017. The Respondent did not submit any response to the Complainant. On 10 January 2017, the HK Office issued a Notice of the Respondent in Default in both the languages of Chinese and English.

The HK Office appointed Mr. Raymond HO as the Sole Panelist in this matter (“the Panel”) on 12 January 2017. Prior to the appointment Mr. Raymond HO submitted a Statement of Acceptance and Declaration of Impartiality and Independence to the HK Office in compliance with paragraph 7 of the Rules. On the same date, the Hong Kong Office transmitted the file in this matter to the Panel. The Panel finds that it was properly constituted.

Upon a review of the file, the Panel noted that the Complainant applied for English to be used as the language of the administrative proceeding on the ground that if the Chinese language were used the Complainant would be required to incur additional cost and expenses and there would be unavoidable delay in this proceeding. The Panel noted that the Respondent did not respond to the Complaint that was written in English that was transmitted by email to the Respondent under cover of a notice in both the languages of English and Chinese issued by the Hong Kong Office. If the Respondent objected to the use of English by the Complainant in this proceeding, the Respondent should have raised his/her objections. Furthermore, the Panel notes from the evidence tendered by the Complainant that the websites resolved by the Disputed Domain Names are all in English. Having regard to all the relevant circumstances in this case, despite that the registration agreements are in the Chinese language, in accordance with the Rules, the Panel decides to allow the Complainant’s application and it is herein ordered that English be used as the language of the administrative proceeding in this case.

3. Factual background

Paul Smith Limited, is a subsidiary of the Complainant, Paul Smith Group Holdings Limited, who owns the registered trademark "PAUL SMITH" (hereinafter referred to as "Paul Smith"). The Complainant is internationally known for design, fashion clothing and accessories with a significant reputation as a designer both in the UK and abroad that sells fashion clothing predominantly under the "Paul Smith" clothing mark which is sold through retail outlets in the UK and throughout the world. The Complainant has have registered the trademark "PAUL SMITH" and the trademarks of the hand-written words "Paul Smith" and "PS. Paul Smith" throughout 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.

The Respondent is an individual with an address in Huai Bei, China as disclosed in the WHOIS records of the Disputed Domain Names. The Respondent has registered the Dispute Domain Names for one year from 16 March 2016 to 16 March 2017 and the Disputed Domain Names resolve to websites that show photographs and images of handbags and other collections of fashion products bearing the mark "Paul Smith" for sale.

4. Parties' Contentions

A. Complainant's Contentions

I. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant asserts that the Complainant is the true owner to the exclusive rights of the serial trademarks of "PAUL SMITH", including also the trademarks of the hand-written words "Paul Smith" and of the hand written words "PS. Paul Smith".

The Complainant registered the trademark "PAUL SMITH" (International Registration No. 755406) through WIPO on March 20, 2001 with the protection of this trademark granted protection in countries including UK, China, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro, covering a large range of goods/services in classes 03, 09, 14, 16, 18 and 25.

The Complainant registered the trademark of the hand-written words "Paul Smith" (International Registration No. 988039) through WIPO on June 5, 2008 with the protection of this trademark granted in countries including UK and Bahrain, covering the goods in Classes 03, 09, 14, 16, 18 and 25.

The Complainant registered the trademark of the hand-written words "PS. Paul Smith"(International Registration No. 708450) through WIPO on February 11, 1999 with the protection of this trademark granted 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 trademark PAUL SMITH in US (Registration No. 1511432) on February 2, 1988, covering the goods in class 3; the trademark PAUL SMITH in US (Registration No. 1703997) on April 19, 1990, covering the goods in class 14; the trademark PAUL SMITH in US (Registration No. 1661631) on June 4, 1990, covering the goods in classes 14 and 18; the trademark PAUL SMITH in US (Registration No. 1899650) on March 16, 1993, covering the goods in class 9; the trademark PAUL SMITH in US (Registration No. 3327649) on April 13, 2006, covering the goods in classes 24, 25 and 27; the trademark PAUL SMITH in US (Registration No. 4024727) on July 12, 2010, covering the goods in classes 3, 20, 25 and 27; the trademark of the hand-written words “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 March 2016) the following trademarks with the UK Intellectual Property office:

- (a) The Complainant registered the trademark of the hand-written words “Paul Smith”, in the UK (Registration No. 1190572) on February 16, 1983, covering the goods in class 25;
- (b) The Complainant registered the trademarks PAUL SMITH and of the hand-written words “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; and
- (c) The Complainant registered the trademark of the hand-written words “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 March 2016) the following trademarks with the OHIM (Office for Harmonization in the Internal Market EU):

- (a) 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; and
- (b) The Complainant registered the trademark of the hand-written words “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 submits that the registered trademarks “PAUL SMITH”, and of the written words “Paul Smith” and “PS. Paul Smith” designate a large range of goods, such as clothes, leather products, shoes, scarves, etc., that have gained a worldwide reputation after continuous extensive use and marketing throughout the world.

Using www.google.com the Complainant searched for “PAUL SMITH” and obtained 492,000,000 results. Using www.google.com the Complainant searched for “PAUL SMITH” and obtained 79,400,000 results. The information on the first page of the search result is associated to the Complainant.

The Complainant submits that the Disputed Domain Names are confusingly similar to the Complainant’s trademarks “PAUL SMITH” and of the hand-written words “Paul Smith” and “PS. Paul Smith”.

The Complainant adds that since the “.com” is not taken into account in the comparison, “buypaulsmithbags”, “buypaulsmithonline”, “cheappaulsmithsale”, “cheappaulsmithuk”, “joypaulsmith”, “paulsmithbags”, “paulsmithstoreuk” and “top-paulsmith” are the main part of the Disputed Domain Names, of which “paulsmith” is identical to the Complainant’s worldwide reputed “PAUL SMITH” and the trademarks of the hand-written words “Paul Smith” and “PS. Paul Smith”. The Complainant submits that the relevant public would easily separate the Disputed Domain Names into “paulsmith”; and that it is obvious that “paulsmith” is the central and distinguishing element of the Disputed Domain Names.

The Complainant points out that the websites resolved by the Disputed Domain Names are blatantly selling fake counterfeit PAUL SMITH goods in large quantities. The Complainant submits that this serves as good evidence proving that the Disputed Domain Names are actually used by the Respondent as “the website for buying PAUL SMITH goods”. Furthermore, the Complainant adds that the images and models used on the Disputed Domain Names websites are substantially similar to those used by the Complainant’s trademark “PAUL SMITH” and the trademarks of the hand-written words “Paul Smith” and “PS. Paul Smith”. This is also evidence that the Respondent is promoting this website as the official Paul Smith website for buying goods.

Thus, the Complainant submits that 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.

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

II. The Respondent has no rights or legitimate interests in respect of the domain name(s):

Firstly, the Respondent has never been authorized by the Complainant to use the trademark “PAUL SMITH” and the trademarks of the hand-written words “Paul Smith” and “PS. 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 believes that paragraph 4(a) (ii) of the Policy has been satisfied.

III. The disputed domain name(s) has/have been registered and is/are being used in bad faith:

The Respondent is using the Disputed Domain Names to sell fake counterfeit products bearing the Complainant's prior registered trademark "PAUL SMITH" and the prior registered trademarks of the hand-written words "Paul Smith" and "PS. Paul Smith"

The Complainant submits that the Disputed Domain Names websites are blatantly selling fake counterfeit products bearing the Complainant's registered trademarks. It can be easily found that the goods sold on the websites by the Disputed Domain Names are also named PAUL SMITH products. A screenshot of all the disputed domain names attached to the Complaint of these webpages is evidence that shows the Respondent's conduct should be regarded as evidence of bad faith as prescribed in 4(b)(iv) of the Policy.

The Respondent was aware of the Complainant's trademarks well before registering the Disputed Domain Names.

The Complainant's trademarks had been extensively registered throughout the world including UK, US and China, etc., long before the registration of the Disputed Domain Names.

The Complainant submits that the registered "PAUL SMITH" and the hand-written words "Paul Smith" and "PS. 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 trademark "PAUL SMITH" and the trademarks of the hand-written words "Paul Smith" and "PS. Paul Smith", which additionally proves that the Respondent's awareness of PAUL SMITH and before registering the Disputed Domain Names. Thus, the Complainant submits that it can be reasonably inferred that the Respondent was aware of these prior trademarks of the Complainant well before registering the Disputed Domain Names.

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

Therefore, the Complainant asks for the transfer of the Disputed Domain Names to the Complainant.

B. Respondent's Contentions

The Respondent has not submitted any response to the Complaint.

5. Findings

The Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. The respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- ii. The respondent has no rights or legitimate interests in respect of the domain name; and
- iii. The respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

Based on the documentary evidence submitted by the Complainant, the Panel finds that the Complainant is the owner of the registered trademark “PAUL SMITH” and the registered trademarks of the hand-written words “Paul Smith” and of the hand-written words “PS. Paul Smith”.

As for the generic Top-Level Domains (“gTLD”), it is well established that in making an inquiry under the Policy as to whether a domain name is identical or confusingly similar to a trade mark, the gTLD suffixes, such as “.com”, may be disregarded when establishing whether or not the domain name is identical or confusingly similar to a mark that the Complainant has rights.

The Panel also finds on a comparison of non-gTLD components of the Disputed Domain Names, namely, “buypaulsmithbags”, “buypaulsmithonline”, “cheappaulsmithsale”, “cheappaulsmithuk”, “joypaulsmith”, “paulsmithbags”, “paulsmithstoreuk” and “top-paulsmith” with the Complainant’s registered “Paul Smith” trademarks that each of the Disputed Domain Names has the distinctive “paulsmith” that is identical or confusingly similar to the Complainant’s “PAUL SMITH” registered trademark and the registered trademarks of the hand-written words “Paul Smith” and “PS. Paul Smith”. The Panel considers that other components of the Disputed Domain Names such as “buy”, “bags”, “online”, “cheap”, “sale”, “uk”, “joy”, “store” and “top” are merely generic descriptive words and finds that “paulsmith” is the central and distinguishing element of the Disputed Domain Names. The Panel therefore accepts the Complainant’s submission that the consuming public would easily be misled into believing that the Disputed Domain Names were those of the Complainant and otherwise connected with the Complainant’s “Paul Smith” trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

As stated in paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), 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 disputed 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 finds that the Complainant has made a *prima facie* case here. It is therefore for the Respondent to show that this is not the case.

Paragraph 4(c) of the Policy provides that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the respondent’s rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to the respondent of the dispute, the respondent's 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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial 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.

The Panel finds that the Respondent did use the Disputed Domain Names to resolve to various websites that contain images and photographs of lady's handbags and other collections of fashion, dresses and consumable products bearing the "Paul Smith" mark registered by the Complainant.

Based on an evaluation of all the relevant evidence, that Panel finds that none of the circumstances as referred to in paragraph 4(c) of the Policy exists in this case.

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

C) Bad Faith

Paragraph 4(b) of the Policy provides that for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or the respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 the respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's web site or location or of a product or service on the respondent's web site or location.

Based on the evidence, in particular, the screenshot of the webpages of the Disputed Domain Names, the Panel finds that the Respondent is using the Disputed Domain Names to sell fake counterfeit products bearing the Complainant's prior registered trademark "PAUL SMITH" and the prior registered trademarks of the hand-written words "Paul Smith" and "PS. Paul Smith". Such evidence is evidence of bad faith registration and use of the Disputed Domain Names as prescribed in 4(b)(iv) of the Policy.

The Panel accepts the Complainant's submission that it can reasonably be inferred from the circumstances of this case that the Respondent was aware of the Complainant's trademarks that had been extensively registered throughout the world including UK, US and China well before registering the Disputed Domain Names.

On totality of evidence, the Panel considers that the irresistible inference in the circumstance of the present case must be bad faith registration and use of the Disputed Domain Names by the Respondent.

The Panel finds that the Respondent registered and has been using the Disputed Domain Names in bad faith, and that paragraph 4(a)(iii) of the Policy has been satisfied.

6. Decision

For all the foregoing reasons, in accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the Panel orders that all the Disputed Domain Names, namely:

**1. www.buypaulsmithbags.com; 2. www.buypaulsmithonline.com;
3. www.cheappaulsmithsale.com; 4. www.cheappaulsmithuk.com;
5. www.joypaulsmith.com; 6. www.paulsmithbags.com;
7. www.paulsmithstoreuk.com; and 8. www.top-paulsmith.com
be transferred to the Complainant.**

Raymond HO
Sole Panelist
17 January 2017