



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1500736
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Samantha Jones
Disputed Domain Name(s):	<ps-outlets.com>

1. The Parties and the Disputed Domain Name

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

The Respondent is Samantha Jones of Shanghai, China.

The domain name at issue is <ps-outlets.com>, registered by the Respondent with Beijing Innovative Linkage Technology Limited (the “Registrar”) of Beijing, China.

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the “Center”) on March 17, 2015. On March 18, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 18, 2015, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of the disputed domain name and providing the Respondent’s contact details.

On March 19, 2015, the Center transmitted by email to the Complainant a request for language translation, requesting the Complainant to file a Chinese language translation of the Complaint, or a request that the language of the proceeding be English, by March 24, 2015. On March 30, 2015, the Center issued a notice of termination, without prejudice to the Complainant’s right to re-file a different complaint, the Complainant having failed to respond to the Center’s language request. On March 30, 2015, the Complainant filed a further Complaint, which included a request that English be the language of the proceeding. On March 30, 2015, the Center transmitted by email a new case notification to the Registrar.

The Center has verified that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”) and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint and the proceeding commenced on April 2, 2015. In accordance with the Rules, the due date for the Response was April 22, 2015.

No Response was received by the Center.

The Center appointed Sebastian Hughes as the Panelist in this matter on April 29, 2015. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

A. Complainant

The Complainant is a company incorporated in England and the owner of numerous registrations worldwide for the trade marks PAUL SMITH (word and stylised) and PS PAUL SMITH (stylised) (the “Trade Marks”), the earliest dating from 1983.

B. Respondent

The Respondent is an individual apparently with an address in China.

C. The Disputed Domain Name

The disputed domain name was registered on May 8, 2014.

D. The Website at the Disputed Domain Name

The disputed domain name has been used in respect of a website offering for sale discounted goods under the Trade Marks (the “Website”).

4. Parties’ Contentions

A. Complainant

The Complainant made the following submissions in the Complaint.

The Complainant has used the Trade Marks continuously since 1983 in respect of a wide range of goods, such as clothes, leather products, shoes, scarves, etc., and the Trade Marks have gained a worldwide reputation after continuous extensive use and marketing throughout the world.

The disputed domain name is confusingly similar to the Trade Marks. “PS”, which is commonly understood and associated with the Complainant, is the central and distinguishing element of the disputed domain name. The relevant public would easily separate the disputed domain name into “ps” + “outlets”. Furthermore, as “outlets” is a general English word and in this context associated with the home and manufacturing

location of the designer, “ps-outlets.com”, as a domain name, can be easily understood as “the sale website of PAUL SMITH goods”.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent has never been authorised by the Complainant to use the Trade Marks and the Respondent has no business relationship with the Complainant.

The disputed domain name has been registered and used in bad faith. It has been used by the Respondent in respect of the Website, which offers for sale “fake counterfeit” goods under the Trade Marks, and reproduces the images and models used by the Complainant to promote its goods.

B. Respondent

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

5. Findings

5.1 Language of the Proceeding

The language of the registration agreement for the disputed domain name is Chinese.

Pursuant to the Rules, paragraph 11, in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement. No agreement has been entered into between the Complainant and the Respondent to the effect that the language of the proceeding should be English.

Paragraph 11(a) allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding. In other words, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Complainant has requested that English be the language of the proceeding for the following reasons:

- (1) There would be an additional cost to the Complainant to translate the Complaint and this would be inequitable given the damage that has been suffered to date by the operation of the Website;
- (2) It is unnecessary to incur such cost since the Complainant’s representatives have written to and called the Registrar on several occasions, and the Complainant’s representatives know that the Registrar can conduct the proceeding in English;

- (3) The Registrar has been given numerous opportunities to assist the Complainant in taking action against the Website but has, to date, not acknowledged the Complainant's representatives' emails or telephone calls.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs.

The Panel does not find the submissions of the Complainant regarding the approaches made to the Registrar at all convincing or indeed relevant to the question of the language of the proceeding.

The Panel is however mindful of the need to ensure the proceeding is conducted in a timely and cost effective manner. The Respondent has elected to take no part in this proceeding. The Respondent did not file any submissions with respect to the language of the proceeding and did not file a Response.

The most telling factor in support of English as the language of the proceeding is the fact the Website is a sophisticated English language website, which provides cogent evidence in support of the likely possibility that the Respondent is conversant and proficient in the English language.

In all the circumstances, the Panel therefore finds it is not foreseeable that the Respondent would be prejudiced, should English be adopted as the language of the proceeding.

Having considered all the matters above, the Panel determines under paragraph 11(a) that the language of the proceeding shall be English.

5.2 Substantive Elements of the Policy

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the Trade Marks acquired through registration and use which predate the date of registration of the disputed domain name by several decades.

UDRP panels have consistently held that domain names are identical or confusingly similar to a trade mark for purposes of the Policy "when the domain name includes the trade mark, or a confusingly similar approximation, regardless of the other terms in the domain name".

The disputed domain name comprises the letters "PS" which are (1) a common abbreviation for the Complainant, the Complainant's Trade Marks and its goods; and (2) a prominent part of the Complainant's PS PAUL SMITH trade mark registered in numerous jurisdictions worldwide since 1999, together with the non-distinctive word "outlets". The use of the word "outlets" does not serve to distinguish the disputed domain name from the Trade Marks in any significant way, particularly given the content of the Website.

The Panel therefore finds that the disputed domain name is confusingly similar to the Trade Marks and holds that the Complaint fulfills the first condition of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed 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 disputed domain name even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

There is no evidence that the Complainant has authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Marks. The Complainant has prior rights in the Trade Marks which precede the Respondent's registration of the disputed domain name by several decades. The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that she has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name has been used in connection with a *bona fide* offering of goods or services. To the contrary, the evidence shows that the disputed domain name is being used in respect of the Website, which promotes and offers for sale discounted goods under the Trade Marks, and reproduces the images and models used by the Complainant, in clear infringement of the Complainant's intellectual property rights¹.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain name.

There has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.

The Panel finds that the Respondent has failed to produce any evidence to establish rights or legitimate interests in the disputed domain name.

¹ The Complainant asserts that the goods offered for sale on the Website are "fake counterfeits", but has not provided any evidence to substantiate this claim.

The Panel therefore finds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, the following conduct amounts to registration and use in bad faith on the part of a respondent:

“By using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website 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 website or location or of a product or service on the respondent’s website or location.”

The undisputed evidence of the Complainant demonstrates that the Website is being used to attract Internet users for commercial gain, by reproducing without authorisation the Complainant’s images, models and Trade Marks, and offering for sale discounted goods under the Trade Marks. Even if the goods offered for sale on the Website are not “fake counterfeits”, the Panel has no hesitation in concluding that the unauthorised use of the domain name in this manner, effectively to pass off the Website as an official authorised online sales outlet of the Complainant and/or of the Complainant’s good, amounts to clear evidence of bad faith.

The Panel therefore finds, in all the circumstances, the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and is being used in bad faith. Accordingly, the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 name <ps-outlets.com> be transferred to the Complainant.

Sebastian Hughes
Sole Panelist

Dated: May 5, 2015