



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2101456
Complainant:	Paul Smith Group Holdings Limited
Respondent:	cocoshop coco
Disputed Domain Name(s):	<paulsmithstoresjp.com>

1. The Parties and Contested Domain Name

The Complainant is Paul Smith Group Holdings Limited, of The Poplars, Lenton Lane, Nottingham, NG7 2PW, GB.

The Respondent is cocoshop coco, of sdfasdfsdfasd, Beijing Economic and Technological Development Zone, Beijing, Beijing, SG 100000.

The domain name at issue is <paulsmithstoresjp.com> (the “Domain Name”), registered by Respondent with Dynadot, LLC of 210 S Ellsworth Ave., #345, San Mateo, CA, 94401, USA.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center”) on April 23, 2021. On April 26, 2021, the Center transmitted by email to the Registrar a request for registrar verification for the Domain Name. The Center contacted the Registrar again on April 28, 2021. The Center contacted the ICANN about lack of response from the Registrar on May 3, 2021. On May 4, 2021, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 4, 2021 providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. On May 5, 2021, the Complainant submitted the amended Complaint.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from July 31, 2015 (the “Supplemental Rules”).

Under Paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 7, 2021. Under Paragraph 5 of the Rules, the due date for filing a Response by the Respondent was May 27, 2021. The Respondent submitted no response by this deadline date.

The Center appointed Olga Zalomiy as the sole panelist in this matter on May 31, 2021. The Panel finds it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, Paragraph 7.

3. Factual background

The Complainant is a subsidiary of Paul Smith Group Holdings, a fashion company that sells fashion clothing predominantly under its PAUL SMITH mark. The Complainant owns numerous registrations for its PAUL SMITH trademark, such as:

- International Registration No. 755406 for the PAUL SMITH mark, registered on March 20, 2001;
- International Registration No. 988039 for the *Paul Smith* trademark, registered on June 5, 2008;
- International Registration No 708450 for the *PS • Paul Smith* trademark, registered on February 11, 1999;
- the U.S. trademark registration No. 1306038 for the PAUL SMITH trademark, registered on February 25, 1983;
- the U.S. trademark registration No. 1511432 for the PAUL SMITH mark, registered on February 2, 1988.

The Respondent registered the Domain Name on July 3, 2020. The Domain Name directs to an online store offering for sale of unauthorized or counterfeit copies of the Complainant's goods.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Complainant asserts that the Domain Name is confusingly similar to the Complainant's PAUL SMITH trademark because the Domain Name incorporates the Complainant's PAUL SMITH trademark in its entirety. The Complainant alleges that neither the addition of the geographical designation "jp", nor the addition of the term "store" detracts from confusing similarity. The Complainant contends that the addition of the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and, as such, is disregarded under the confusing similarity test.
- ii. The Complainant alleges that the Respondent has no rights or legitimate interests in the Domain Name because the Complainant did not authorize or permitted the Respondent to use the PAUL SMITH trademark under any circumstances, nor does the Respondent have any business relationship with the Complainant. The Complainant contends that the Respondent is not commonly known by the

Domain Name. The Complainant contends that the Respondent has no other rights in the PAUL SMITH mark.

- iii. The Complainant alleges that the Respondent registered the Domain Name in bad faith because it registered the Domain Name with the knowledge of the Complainant's trademark and the Complainant's business. The Complainant contends that the Respondent is using the Domain Name in bad faith because the Domain Name directs to a website that sells counterfeit versions of the Complainant's products.

B. Respondent

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

5. Findings

It is a consensus view among UDRP panelists that “[a] respondent's default does not automatically result in a decision in favor of the complainant... [T]he complainant must establish each of the three elements required by paragraph 4(a) of the UDRP.”¹ A panel may draw inferences from a respondent's default.²

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

To satisfy the first UDRP element, a domain name must be “identical or confusingly similar” to a trademark, in which a complainant has rights.

The Complainant has established its rights in the PAUL SMITH trademark by submitting copies of PAUL SMITH trademark registrations. Pursuant to section 1.2.1 of the WIPO Overview 3.0, “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”. Therefore, the Complainant satisfied the UDRP standing requirement.

The Domain Name consists of the Complainant's PAUL SMITH trademark, the term “store”, the geographical indication “jp”³ and the gTLD “.com”. “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”⁴ It is well-established,

¹ Paragraph 4.2., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)

² Paragraph 4.3., WIPO Overview 3.0.

³ JP stands for Japan.

⁴ Section 1.8., WIPO Overview 3.0.

that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement.⁵

Because the Complainant's PAUL SMITH trademark is recognizable within the Domain Name, neither the inclusion of the geographic term "jp", nor the addition of the word "store" or the gTLD ".com" detracts from confusing similarity. Therefore, the Domain Name is confusingly similar to the Complainant's PAUL SMITH trademark.

Thus, the first element of the UDRP has been satisfied.

B) Rights and Legitimate Interests

Under the second UDRP element, a complainant must make a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent⁶. Once the complainant has made out the *prima facie* case, the respondent carries the burden of producing evidence demonstrating it has rights or legitimate interests in the domain name⁷. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.⁸

Pursuant to paragraph 4(c) of the UDRP, the following may demonstrate rights or legitimate interests in the Domain Name:

(i) before any notice 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 Complainant has made out *prima facie* case in respect of the lack of rights or legitimate interests of the Respondent. First, the Complainant has not authorized or licensed the Respondent to use the Complainant's PAUL SMITH trademarks in any manner.

Second, the Respondent is not commonly known by the Domain Name, which supports finding of a lack of rights or legitimate interests.

Third, the Respondent's unauthorized use of the Complainant's PAUL SMITH trademark, its use of the images and models substantially similar to those of the Complainant and its offering of unauthorized or counterfeit PAUL SMITH products on its website constitute passing off, in that the Respondent is trying to pass off its website as the Complainant's

⁵ Section 1.11.1, WIPO Overview 3.0.

⁶ Section 2.1, WIPO Overview 3.0.

⁷ *Id.*

⁸ *Id.*

website or affiliated with the Complainant. Passing off activities have been consistently held to demonstrate a lack of rights or legitimate interests under the UDRP⁹.

Fourth, the Respondent's use of the Domain Name is not fair, because "it falsely suggests affiliation with the trademark owner".¹⁰ The nature of the Domain Name itself suggests affiliation between the Complainant and the Respondent because the Domain Name, which contains the Complainant's well-known PAUL SMITH trademark and the descriptive terms "jp" and "store", directs to the website that offers unauthorized and/or counterfeit articles of Complainant's clothes. The Respondent's website contains no disclaimer of its relationship or lack thereof with the Complainant.

Since the Respondent has failed to rebut the Complainant's case, the Panel holds that the second element of the UDRP has been satisfied.

C) Bad Faith

Under the third UDRP element, the Complainant is required to prove that the Domain Name was registered and is being used in bad faith.

First, the Respondent's registration and use of the Domain Name constitute bad faith under paragraph 4(b)(iv) of the Policy, because the Respondent has used the Domain Name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's well-known PAUL SMITH mark as to the source, sponsorship, affiliation, and/or endorsement of the Domain Name, the Respondent's website, and the unauthorized, counterfeit products advertised/offered therein. It is well-established, that "the mere registration of a domain name that is identical or confusingly similar (particularly domain names ...incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."¹¹ Taken into account the Respondent's use of the Domain Name for per se illegitimate activity, such as the sale of counterfeit goods, "such behavior is manifestly considered evidence of bad faith"¹².

Second, the Respondent's registration and use of the Domain Name constitute bad faith under paragraph 4(b)(iii) of the Policy, because the Respondent disrupts the Complainant's business and unfairly competes with the Complainant by using the Domain Name to advertise/offer unauthorized, counterfeit, products that compete with the Complainant's genuine products. See e.g., *BMW v. Codesoft Technologies*, WIPO Case No. D2018-1160 ("... the Respondent's registration and use of the disputed domain name [`<bmwcodesoft.com>`] constitutes bad faith under paragraph 4(b)(iii) of the Policy because in using the disputed domain name to resolve to a website on which it is selling unauthorized or fake BMW marked products, the Respondent is disrupting the Complainant's business and unfairly competing with the Complainant."

Therefore, the Panel finds that the Domain Name was registered and is being used in bad faith. The third element of the UDRP has been satisfied.

6. Decision

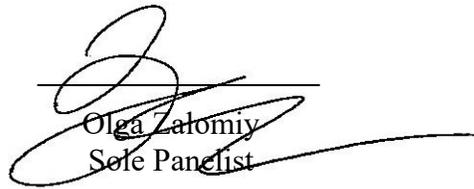
⁹ Section 2.13, WIPO Overview 3.0.

¹⁰ Section 2.5.1, WIPO Overview 3.0.

¹¹ Section 3.1.4, WIPO Overview 3.0.

¹² *Id.*

Under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <paulsmithstoresjp.com> be transferred to the Complainant.



Olga Zalomiy
Sole Panelist

Dated: June 8, 2021