



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1500735
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Xong Ping
Disputed Domain Name(s):	<paulsmith-france.com>

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.

The Respondent is **Xong Ping**, of Sichuan, Chengdu, SC 610501, China.

The domain name at issue is **paulsmith-france.com** (“*Disputed Domain Name*”), registered by Respondent with Beijing Innovative Linkage Technology Limited, of 20/F, Block A, SP Tower, Tsinghua Science Park Building 8, No. 1 Zonguancun East Road, Haidian District, Beijing 100084, China.

2. Procedural History

On 17 March 2015, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On the next day, 18 March 2015, the ADNDRC-HK notified Beijing Innovative Linkage Technology Limited (“Registrar”) of the Disputed Domain Name of the proceedings by email and requested registrar verification in connection with the domain name at issue. On the same day, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that Xong Ping is the holder of the Disputed Domain Name, and provided contact details. The Center verified that the Complaint satisfied 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 ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of the Respondent’s nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database) on 2 April 2015. The Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 22 April 2015).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADRDRC-HK on 27 April 2015. The papers pertaining to the case were delivered to the Panel by email on the same day. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

For the Complainant

The Complainant, Paul Smith Group Holdings Limited, who own the registered Trade Mark “Paul Smith” (hereinafter referred to as “Paul Smith”), is internationally known for design, fashion clothing and accessories. The Complainant registered the “Paul Smith”, *Paul Smith* and *PS · Paul Smith* trademarks through WIPO in 2001, 2008 and 1999 respectively. The trademark “Paul Smith” has been granted protection in many countries including in the UK, China, and the US for a range of goods and services including clothing, footwear, accessories, soaps, spectacle frames, jewelry and stationary.

For the Respondent

The Respondent has not responded to the ADNDRC-HK within the stipulated timeframe (i.e. on or before 22 April 2015). As such the Respondent has not contested the allegations of the Complaint and is in default.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The domain name in dispute is confusingly similar to the Complainant’s trademark “Paul Smith”.
- ii. Respondent has no rights or legitimate interests in the registration of the domain names in dispute.
- iii. Respondent has registered and used the domain name in bad faith.

B. Respondent

The Respondent did not file a Response to the ADNDRC-HK within the required timeframe stipulated by the ADNDRC-HK (ie. on or before 22 April 2015) and as such has not contested the allegations of the Complaint and is in default.

5. Preliminary Issues: Language of Proceedings

The Panel notes that Claimant requested that the language of proceedings be in English for reasons of equity. While the Panel observes that the language of the registration agreement is in Chinese, in accordance with the Rules of UDRP, the Panel has the authority to determine otherwise, having regard to the circumstances of the proceedings. Having reviewed the Complainants submission, and given that the Respondent issued no objection, the Panel thus determines that the language of the proceedings is English.

5. Findings

Having considered all the documentary evidence before me, and the Respondent's non-participation in these proceedings after being afforded every opportunity to do so in accordance with Paragraph 14 of the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") the Panel is of the view that it should proceed to decide on the Disputed Domain Name ("paulsmith-france.com") based upon the Complaint and evidence submitted by the Complainant.

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

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights.

The Disputed Domain Name incorporates the Complainant's "Paul Smith" trademark in its entirety. The only difference between the Disputed Domain Name and the Complainant's "Paul Smith" trade mark is the inclusion of the word "france" as a suffix. It is well-established that in cases where the distinctive and prominent element of a Disputed Domain Name is the Complainant's mark and the only addition is a generic term that adds no distinctive element, such an addition does not negate the confusing similarity between the Disputed Domain Name and the mark. See, for example *LEGO Juris A/S v. Huangderong*, WIPO Case No. D2009-1325; *National Football League v. Alan D. Bachand, Nathalie M. Bachand d/b/a superbowl-rooms.com*, WIPO Case No. D2009-0121; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064.

"[P]aulsmith" is the distinctive and prominent component of the Disputed Domain Name and the addition of the name "france" does not substantively distinguish it from the Paul Smith trademarks. In fact, as noted by the Claimant, the addition of "france" adds further confusion by providing the appearance that the website is the French website for Paul Smith, which it is not. The connection between "paulsmith" with the name "france" as a suffix to the Complainant's "Paul Smith" trade mark is such that the relevant Disputed Domain Name considered as a whole would be likely regarded by potential customers of the Complainant as a reference to the Complainant's business. See, for example *eBay Inc. v. SGR Enterprises and Joyce Ayers* (Case No. D2001-0259) where, the Panel held that the domain names in question, namely <ebaylive.com> and <ebaystore.com>, were confusingly similar to the Complainant's trademark.

It is the view of this Panel that the Complainant has discharged its burden of proof in establishing the element of an identical and confusingly similar mark under Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006).

The Complainant contends that the Respondent has never been authorized by the Complainant to use the trademarks PAUL SMITH, *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.

Second, the Respondent's name, address and other identifying information cannot be linked with PAUL SMITH.

Third, according to the Complainant's search, no rights for PAUL SMITH can be found in the Respondents name.

It is also noted that according to the WHOIS search result, the Disputed Domain Name was registered on 27 June 2014, over 13 years after the Complainant registered the trademarks PAUL SMITH, *Paul Smith* and *PS · Paul Smith* through WIPO in 2001, 2008 and 1999 respectively.

Given the general recognition of the Complainant and the PAUL SMITH trademarks, globally including in the PRC where the Respondent resides, the Respondent must have known of the existence of the PAUL SMITH trademarks when registering the Disputed Domain Name.

Given the above reasons alongside a lack of response by the Respondent on its right and/or interest in the Disputed Domain Name, this Panel concludes that the Respondent has no rights and/or legitimate interests in respect of the Disputed Domain Name.

C) Bad Faith

Paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine to determine whether the Respondent has registered or used the Disputed Domain Name in bad faith. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. 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 you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.”

The Respondent, domiciled in the PRC, must have been aware of the Complainant's prior rights and interest in the Disputed Domain Name given the Complainant's reputation in the mark “PAUL SMITH” internationally as of the date that the Respondent registered that Disputed Domain Name.

According to the Claimant, the fact that the website features the name PAUL SMITH and *Paul Smith* in relation to the sale of fake counterfeit products bearing the Complainant's registered trademarks, makes it clear that the Respondent knew of the Complainant's trademark and registered the Disputed Domain Name in an attempt to attract internet traffic to the website on the mistaken belief that it is associated with the Complainant's business, and to make profit from the sale of counterfeit goods.

No evidence has been provided showing that the Respondent sought the permission of the Claimant to use its mark, nor any evidence showing that the Claimant gave such permission to the respondent.

Given the above findings, the Panel is of the view that the Respondent registered and used the contested domain name in bad faith.

6. Decision

The Complainant has proved its case. It has a registered trademark in the name “PAUL SMITH” to which the contested domain name is confusingly similar.

The Respondent has provided no evidence showing rights or legitimate interest in the Disputed Domain Name.

The Complainant has shown that the Respondent registered and used the Disputed Domain Name in bad faith.

For the foregoing reasons and in accordance with Paragraph 4 of the Policy, the Panel concludes that the relief requested by the Complainant be granted and orders that the Disputed Domain Name “**paulsmith-france.com**” be transferred to the Complainant **Paul Smith Group Holdings Limited**.

Dr. Shahla F. Ali
Panelist

Dated: 11 May 2015