



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1701042
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Mo Zegloul
Disputed Domain Name(s):	<paulsmithonlinecheap.com>

1. The Parties and Contested Domain Name

1. The Complainant is Paul Smith Group Holdings Limited, of The Poplars, Lenton Lane, Nottingham, Great Britain.
2. The Respondent is Mo Zegloul, of 108 Longfellow Ct, Pittsburgh, Pennsylvania, United States of America.
3. The domain name at issue is <paulsmithonlinecheap.com>, registered by the Respondent with GoDaddy.com LLC, of 14455 North Hayden Rd, Suite 219, Scottsdale, AZ 85260, United States of America.

2. Procedural History

4. The Complainant filed this complaint with the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 15 November 2017.
5. The ADNDRC sent a copy of the Complaint to the Respondent on 24 November 2017.
6. The Respondent failed to respond within 20 calendar days as required under paragraph 5 of the UDRP Rules. On 15 December 2017, the Respondent was in default of filing its response.
7. On 22 December 2017, after confirming that he was able to act independently and impartially between the parties, the ADNDRC appointed David Allison as the sole Panelist in this matter.

3. Factual background

8. The Complainant, Paul Smith Group Holdings, is internationally well-known for design, fashion clothing and accessories. The Complainant has developed a significant reputation as a designer both in the UK and worldwide. The Complainant sells fashion

clothing predominantly under its own 'Paul Smith' clothing mark which is sold through numerous retail outlets in the UK and throughout the world.

9. The Complainant has an extensive portfolio of trade marks. It has registered trade marks for 'PAUL SMITH', '*Paul Smith*', and '*PS · Paul Smith*', covering a large number of goods and services in Classes including 03, 09, 14, 16, 18, 24, 25 and 27 and in many countries including the UK, the US, China, Hong Kong, Australia, Czech Republic, Hungary, Iceland, Monaco, etc.
10. Among the earliest trade marks registered by the Complainant are the plain font 'PAUL SMITH' mark registered in the US in Class 25 in 1983 (reg. no. 1306038) and the logo mark '*Paul Smith*' registered in Class 25 in the UK, also in 1983 (reg. no. 1190572).
11. The evidence submitted by the Complainant demonstrates that the Complainant has extensive and long standing trade mark rights and has become very well known to consumers throughout the world, particularly in relation to the fields of fashion and design.
12. As the Respondent did not file any response to the Complaint, little is known about the background of the Respondent. However, according to the WHOIS search report of the disputed domain name, the Respondent appears to be an individual based in the United States.

4. Parties' Contentions

Complainant

13. The Complainant's contentions may be summarized as follows:
 - i. The disputed domain name is identical or confusingly similar to the trade marks of the Complainant.
 - ii. The Respondent has not been authorized by the Complainant and has no rights to the trade mark 'Paul Smith'.
 - iii. The website linked to the disputed domain name blatantly sells counterfeit 'Paul Smith' products.
 - iv. The Respondent was well aware of the Complainant's trade marks prior to registering the Disputed domain name

Respondent

14. The Respondent has not filed a response to the Complainant's complaint.

5. Findings

15. The ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) 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.

16. Whilst the Respondent has not filed a response to this Complaint, this fact has not resulted in an automatic finding against the Respondent. Despite the Respondent's default, the Panel must still satisfy itself that the Complainant has established each of the three elements required by paragraph 4(a) of the UDRP. The Panel has therefore, considered whether each of the three requirements under paragraph 4(a) have been met and its findings are as follows:

A) Identical / Confusingly Similar

17. The disputed domain name consists of the elements "paulsmithonlinecheap" and ".com". It is a well-accepted principle that TLD suffixes such as ".com", ".net", etc are ignored for the purposes of comparison and thus the Panel has not considered this suffix when comparing the disputed domain name to the Complainant's prior rights.

18. Further, the Panel finds that consumers would regard the main part of the disputed domain name as having two distinct parts, namely (1) 'paulsmith' and (2) 'onlinecheap'. The 'paulsmith' element is clearly the distinctive element of the disputed domain name and the element which consumers would remember and pay most attention to. On the other hand, the second element is clearly descriptive and merely informs customers that the website related to the disputed domain name offers something "cheaply" and "online. When assessing domain names for similarity, wholly descriptive elements will usually be ignored. Accordingly, in this case the Panel has restricted its analysis and assessment to the 'paulsmith' element and has ignored the descriptive portions of the disputed domain name.

19. As discussed at paragraph 9 above, the Complainant has demonstrated that it has an extensive collection of trade marks registered worldwide over the marks 'PAUL SMITH', 'Paul Smith', and 'PS · Paul Smith'. On the basis of the evidence adduced, the Panel finds that the Complainant has rights to the trade marks 'PAUL SMITH', 'Paul Smith', and 'PS · Paul Smith'.

20. In comparing the Complainant's trade marks with the distinctive element of the disputed domain name, the Panel finds that trade marks are identical to the distinctive element of the disputed domain name. It is also relevant that the Complainant's trade marks have been wholly incorporated within the disputed domain name and placed at the beginning of the disputed domain name – ie where it is most prominent. All of these elements add to the likelihood of confusion.

21. Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade marks and thus element 1 of UDRP paragraph 4(a) has been satisfied.

B) Rights and Legitimate Interests

22. The Complainant contends that the Respondent has never been authorized by the Complainant to use its trade marks. This is despite the fact that the website of the disputed domain name clearly and prominently uses the Paul Smith trade marks and appears to present itself as somehow associated with or authorized by the Complainant.
23. On the other hand, the Respondent has failed to adduce any evidence to show why it has chosen a domain name where the dominant and distinctive element is identical to that of the Complainant's trade marks. It has not provided any evidence to demonstrate that it has a right or legitimate interest in the disputed domain name.
24. While the Panel notes that the overall burden of proving this element rests with the Complainant, it also recognizes the well-established principle that once the Complainant has established a *prima facie* case that the Respondent lacks sufficient legitimate rights and interests, the burden then shifts to the Respondent.
25. In this case, the Panel finds that the Complainant has adduced a sufficient *prima facie* case whereas the Respondent has failed to adduce any evidence whatsoever. Therefore, the Panel finds therefore, that the Complainant has established the second element of UDRP paragraph 4(a).

C) Bad Faith

26. To prove this element, the Complainant must establish that the Respondent both registered and has used the disputed domain name in bad faith. To establish bad faith, reference may be made to the circumstances outlined in paragraph 4(b) of the UDRP. These circumstances are not exhaustive however, and the Panel may take into account other circumstances which demonstrate bad faith.
27. The Complainant alleges that the Respondent is selling counterfeit goods through the website under the disputed domain name and this demonstrates the Respondent's bad faith. However, no evidence has been adduced to support this contention. Accordingly, the Panel is unable to uphold the Complainant's contention in this regard.
28. The Complainant also claims that it '*can be reasonably inferred*' that the Respondent was aware of the Complainant's trade marks prior to its registration of the disputed domain name. While the concept of knowledge or constructive knowledge will generally only apply where the Complainant's mark is "well-known", the Panel finds that this argument has some force in this case. Here, the Complainant has adduced significant evidence to show that the Complainant's trade marks are extensive both in terms of numbers registered and geographical reach and that they are reasonably well known to the public.
29. Further, the Complainant's trade marks have been registered for many years and well before the Respondent registered the disputed domain name.
30. Finally, the Respondent uses the stylized version of Paul Smith prominently on the home page of its website. It appears to the Panel almost impossible that the Respondent

could have chosen this stylized Paul Smith mark without being fully aware of the Complainant's prior trade mark rights.

31. As a result of the above, the Panel finds that the Respondent was well aware of the Complainant's trade marks and rights prior to registering the disputed domain name and this is a clear indicia pointing towards bad faith.
32. In addition, the Panel finds that the way in which the disputed domain name has been used strongly suggests bad faith. As noted above, the website of the disputed domain name prominently features the Paul Smith stylized trade mark. Further, all products featured on the site are described as 'Paul Smith' products only. The overall impression therefore, is that this website is an 'official' Paul Smith website or at the very least it is affiliated with Paul Smith and the Complainant in some way. As the Complainant makes clear in its complaint, this is not the case and this website has not been authorized by the Complainant.
33. As a result of the above, UDRP paragraph 4(b)(iv) is relevant, namely that: "*...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.*"
34. In light of the matters described above, the Panel finds that it is highly likely the Respondent intentionally used the disputed domain name as a means to confuse and attract consumers to its site. Such use satisfies the definition of bad faith as outlined in UDRP paragraph 4(b)(iv).
35. Considering all of the matters discussed above, the evidence submitted by the Complainant and the complete failure of the Respondent to make any submissions whatsoever, the Panel finds that the third element of UDRP paragraph 4(a) has been made out and that the Respondent has registered and used the disputed domain name in bad faith.

6. Decision

36. For the reasons outlined above, the Panel finds that the Complainant has satisfied all three elements of UDRP paragraph 4(a). Accordingly, the Panel orders that the disputed domain name, <**paulsmithonlinecheap.com**>, be transferred to the Complainant.



David Allison
Sole Panelist

Dated: 28 December 2017