



Asian Domain Name Dispute Resolution Centre  
hong kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-1400597
<b>Complainant:</b>	Paul Smith Group Holdings Limited
<b>Respondent:</b>	Xiuxun Yang
<b>Disputed Domain Name(s):</b>	<cheappaulsmithbuy.com>

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### 1. The Parties and Contested Domain Name

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

The Respondent is Xiuxun Yang, of SHIMENZHENTAIXINGJIE99HAO, JIANGMENGSHI, CHONGQINGSHI, 632292, CHINA.

The domain name at issue is <cheappaulsmithbuy.com>, registered by Respondent with ENOM INC., of 5808 Lake Washington Blvd., Suite 300, Kirkland, WA 98033.

### 2. Procedural History

The Complainant filed a Complaint pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy") approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on 24<sup>th</sup> October 1999 to the Hong Kong office of the Asian Domain Name Dispute Resolution Center ("ADNDRC") on the 14<sup>th</sup> April 2014 concerning the disputed domain name to be determined in accordance with the Rules for Uniformed Domain Name Dispute Resolution Policy ("the Rules").

The formal date of commencement of the Administrative Proceeding in accordance with the Rules is 25<sup>th</sup> April 2014.

The Hong Kong office of the ADNDRC notified Respondent on the same day, 25<sup>th</sup> April 2014, that a Complaint had been submitted and that Respondent was required to submit a Response within twenty (20) days from the 25<sup>th</sup> April 2014, that is on or before the 15<sup>th</sup> May 2014 in accordance with Article 5 of the Rules.

No Response having been submitted in accordance with the Rules or at all, the Hong Kong office of ADNDRC appointed Jeffrey Elkinson to act as sole Panelist on the 26<sup>th</sup> May 2014 and notified Complainant and Respondent that the case file would be transferred to the Panelist for consideration and a Decision.

The Panel confirms that it received the appointment and the case file on the 26<sup>th</sup> May 2014.

### **3. Factual background**

The Complainant has made the complaint in respect of the trademark of its subsidiary, Paul Smith Limited, which trademark is registered as “Paul Smith” (which is also registered not only in typeface but in handwritten italic style) throughout the world, including the United Kingdom, China, United States, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro and covers a large range of goods and services in various classes, including but not limited to articles of clothing, footwear, leather and goods which include luggage, rucksacks, bags, briefcases, pocket wallets, etc. It also includes jewelry, which in turn includes such items as cufflinks, tie pins, money clips, key rings, etc. Complainant is internationally known for design, fashion, clothing and accessories and sell fashion clothing predominantly under its own “Paul Smith” clothing mark which is sold through numerous retail outlets in the UK and throughout the world through their own retail outlets. The Complainant registered the trademark through WIPO on 20<sup>th</sup> March 2001 although it has been registered in other forms since 1999.

As regards the Respondent, there is only basic information comprising an address, telephone number and email. It is unclear whether this is an operating telephone number or not.

### **4. Parties’ Contentions**

#### **A. Complainant**

The Complainant sets out in form C “Complaint in accordance with the Uniform Domain Name Dispute Resolution Policy” that the website can be easily understood as being confusingly similar to the Complainant’s trademarks based on the words “Paul Smith” as the disputed domain name resolves into their trademark plus the words “cheap” and “buy”. They contend that it is obvious that “Paul Smith” is the central and distinguishing element of the disputed domain name. Critically, whilst images and models used on the disputed domain name website are substantially similar to those used by Complainant, showing that Respondent is promoting this website as an official “Paul Smith” UK sale website, the goods for sale on that website are counterfeit.

#### **B. Respondent**

The Respondent did not provide any Response to the Complaint and the allegations made therein.

### **5. Findings**

Respondent has chosen not to participate having been required to submit a Response to the Complaint within twenty (20) days from the 25<sup>th</sup> April 2014 pursuant to Article 5 of the

Rules. Accordingly, the Panel proceeds to decide the dispute based upon the Complaint and the assertions made therein and available evidence.

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of the following three findings must be made in order for a Complainant to success in its Complaint:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which the 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**

The disputed domain name is indeed confusingly similar to that of Complainant not least as it contains the words, "Paul Smith" and simply has varied that by adding the words on either side of Paul Smith, "cheap" and "buy". It is clear it is not identical but it is so close to certainly be confusingly similar. It is well accepted that a small variation made by Respondent to its disputed domain name does not avoid confusing similarity – see **Telstra Corporation Limited v Nuclear Marshmallows – WIPO Case No. D2000-0003**. In all the circumstances, I have no difficulty in finding that the domain name is confusingly similar.

#### **B) Rights and Legitimate Interests**

I am satisfied by the factual and legal grounds on which the Complaint is made by Complainant that Respondent has no rights or legitimate interests in respect of the disputed domain name. It is clear as to the extent and duration of Complainant's rights as regards the trademark, "Paul Smith" in its various forms and Complainant has no relationship with Respondent which would give Respondent any rights to the use of the trademark. In reviewing the website with the disputed domain name, it is evident that the goods for sale are laid out in an enticing way with substantial discounts being offered on all items from what would appear to be a normal retail price, although that is not specified. It is a relatively sophisticated working website and given Complainant's position that the goods are counterfeit, it is surprising that no action was taken sooner to prevent the operation of it. On the basis of Complainant's assertion about the goods are counterfeit, I find that Respondent can have no right or legitimate interests in respect of the domain name.

#### **C) Bad Faith**

The Policy provides at paragraph 4(b) certain circumstances that can be evidence of the registration and use of a domain name in bad faith, although it is to be noted that the section particularly provides that the circumstances set out therein are not limited. At paragraph 4(b) (iv) it sets out that there is evidence of bad faith where a party intentionally attempts to attract for commercial gain users to a website by creating a likelihood of confusion with the Complainant's mark as to the source,

etc. and it would go without saying that where the products being sold are counterfeit items bearing the Complainant's trademark, that this would be evidence of bad faith.

I am satisfied that Complainant by its uncontradicted assertions in its Complaint that the products being sold on the disputed domain name website are counterfeit has established bad faith on the part of the Respondent.

## 6. Decision

For the reasons set out above, the Panel finds that the disputed domain name registered by Respondent is confusingly similar to Complainant's registered trademark, Paul Smith in its various forms, and that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the disputed domain name was registered and used in bad faith by the Respondent.

As a consequence of these findings, the Panel directs that the disputed domain name "**cheappaulsmithbuy.com**" be transferred to the Complainant, Paul Smith Group Holdings Limited.

Dated this 5<sup>th</sup> day of June 2014



JEFFREY P. ELKINSON  
PANELIST