



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2001330
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Zhang Qiao Ling (张巧玲)
Disputed Domain Name(s):	<paulsmitheternal.com>

1. The Parties and Disputed Domain Name

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

The Respondent is Zhang Qiao Ling (张巧玲) of An Hui Sheng Su Zhou Shi Dang Shan Xian Xuan Miao Zhen Chen Zhuang Xing Zheng Cun Chen Zhuang Yi Dui 234000, China.

The disputed domain name is <paulsmitheternal.com>, registered by Respondent with Xin Net Technology Corporation of Level 3, Block A2, Sino-I Campus, No.1 Disheng West Street, Beijing 100176, China.

2. Procedural History

The Complainant filed the Complaint in English with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre on 20 March 2020 in accordance with the Uniform Policy for Domain Name Dispute Resolution approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 (the Policy), the Rules for Uniform Domain Name Dispute Resolution Policy approved by the ICANN Board of Directors on 28 September 2013 (the Rules) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 31 July 2015 (the Supplemental Rules). The Hong Kong Office acknowledged receipt of the Complaint on 20 March 2020 and sent emails to Xin Net Technology Corporation (the Registrar) requesting verification of information regarding the disputed domain name on 24 March 2020.

On 30 March 2020, the Registrar disclosed the disputed domain name registrant's name and contact information which differed from those identified in the Complaint, and further disclosed that the language of the Registration Agreement was Chinese. On 8 April 2020, the Hong Kong Office issued a notice of deficiencies in the Complaint and requested the

Complainant to amend the complaint form as regards the name and contact details of the Respondent. On 14 April 2020, the Complainant submitted an Amended Complaint.

On 15 and 27 April 2020, the Hong Kong Office sent emails to the Complainant concerning the language of the proceeding. On 27 April 2020 the Complainant requested that the language of the proceeding be English. On 29 April 2020 the Hong Kong Office sent an email to the Respondent in Chinese and English inviting him to comment on the language of the proceeding on or before 4 May 2020. The Respondent did not comment on the language of the proceeding by that deadline.

The Hong Kong Office confirmed that the Amended Complaint was in administrative compliance with the Policy and the Rules. On 16 April 2020, the Hong Kong Office sent the Respondent a written notice in Chinese and English of the Amended Complaint, informing him that he was required to submit a Response within 20 days from 16 April 2020 (that is, on or before 6 May 2020). The Hong Kong Office did not receive a Response from the Respondent regarding the Amended Complaint by that deadline. Accordingly, on 7 May 2020, the Hong Kong Office notified the Respondent's default.

On 11 May 2020, the Hong Kong Office appointed Prof. Matthew Kennedy as the sole Panelist in this dispute, who confirmed that he was available to act independently and impartially between the parties in this matter. On the same day, the Hong Kong Office transferred the case file to the Panel.

3. Factual background

The Complainant's subsidiary Paul Smith Limited produces fashion clothing and accessories that it sells predominantly under the PAUL SMITH mark. The Complainant owns various trademark registrations, including United Kingdom trademark registration number 2051161 for PAUL SMITH and "Paul Smith" in a particular script (the "Paul Smith signature mark"), registered on 16 May 1997, specifying articles of clothing and other goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34; and International trademark registration number 755406 for PAUL SMITH, registered on 20 March 2001, designating multiple jurisdictions, including China, and specifying articles of clothing and other goods in classes 3, 9, 14, 16, 18 and 25. These trademark registrations remain current.

The Respondent is an individual resident in China.

The disputed domain name was registered on 2 November 2018. It resolves to a website in English for an online store that displays the Complainant's Paul Smith signature mark as its title. The website also prominently displays the words "Paul Smith Shop" and offers for sale what are purportedly the Complainant's men's jackets and coats at discount prices.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name is confusingly similar to the Complainant's PAUL SMITH trademark.

- ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has never been authorized by the Complainant to use its PAUL SMITH trademarks. The Respondent has no business relationship with the Complainant. The Respondent's name cannot be linked with Paul Smith.
- iii. The disputed domain name was registered and is being used in bad faith. The associated website sells counterfeit products bearing the Complainant's PAUL SMITH mark. Thus, it can be reasonably inferred that the Respondent was aware of the Complainant's mark before registering the disputed domain name.

B. Respondent

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

5. Findings

A. Language of the Proceeding

According to Paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In this proceeding, the Registration Agreement for the disputed domain name is in Chinese but the Complaint and Amended Complaint were filed in English. The Complainant requests that English be the language of the proceeding.

The Panel notes that the website associated with the disputed domain name is in English, from which it is reasonable to infer that the Respondent is able to communicate in that language. Further, despite having been sent notice of the Amended Complaint in Chinese and English, the Respondent has not indicated any interest in participating in this proceeding. Therefore, the Panel considers that translation of the Amended Complaint and annexes would create an unnecessary expense for the Complainant and unduly delay the proceeding, whereas conducting the proceeding in English would not be unfair to either party.

Having regard to these circumstances, the Panel determines that the language of this proceeding is English.

B. Substantive Issues

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

Based on the evidence submitted, the Panel finds that the Complainant has rights in the PAUL SMITH mark.

The disputed domain name wholly incorporates the PAUL SMITH mark, except for the space between those names for technical reasons.

The disputed domain name also includes the word “eternal”. However, as a mere dictionary word, that element does not prevent a finding of confusing similarity between a disputed domain name and a trademark for the purposes of the first element of the Policy. See *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty Ltd*, WIPO Case No. D2001-0110.

The only other element in the disputed domain name is a generic Top-Level Domain (gTLD) suffix (i.e. “.com”), which is a technical requirement of domain name registration. A gTLD suffix may be disregarded in the comparison between a domain name and a trademark for the purposes of the first element of the Policy unless it has some impact beyond its technical function, which is not the case here.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element of Paragraph 4(a) of the Policy.

B) Rights and Legitimate Interests

The disputed domain name resolves to an online store that displays the PAUL SMITH trademarks, offers for sale what is purportedly the Complainant’s clothing and gives the impression that it is operated or approved by, or affiliated with, the Complainant. The Complainant submits that the Respondent has never been authorized by the Complainant to use its PAUL SMITH trademarks and that the Respondent has no business relationship with the Complainant. Therefore, the Panel does not consider this use of the disputed domain name to be in connection with a *bona fide* offering of goods or services, nor does it constitute a legitimate non-commercial or fair use of the disputed domain name.

Nothing on the record indicates that the Respondent has been commonly known by the disputed domain name.

There is no other indication on the record that the Respondent has any right or legitimate interest in respect of the disputed domain name.

Accordingly, based on the evidence on the record, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has satisfied the second element of Paragraph 4(a) of the Policy.

C) Bad Faith

As regards registration, the disputed domain name wholly incorporates the Complainant's PAUL SMITH trademark, omitting only the space between those names for technical reasons. The Complainant's registration of the PAUL SMITH trademark predates the registration of the disputed domain name by many years, including in China, where the Respondent is resident. The disputed domain name resolves to a website that displays the Complainant's Paul Smith signature mark as its title and offers for sale what is purportedly the Complainant's PAUL SMITH clothing. This all gives the Panel reason to believe that the Respondent was aware of the Complainant's PAUL SMITH trademark at the time that it registered the disputed domain name and deliberately registered the disputed domain name in bad faith.

As regards use, the disputed domain name resolves to a website that is falsely presented as if it were operated or approved by, or affiliated with, the Complainant, whereas the Complainant submits that the Respondent has no business relationship with the Complainant. The website offers for sale what is purportedly the Complainant's PAUL SMITH clothing. In these circumstances, the Panel finds that the disputed domain name is being used intentionally in an attempt to attract, for commercial gain, Internet users to the Respondent's website 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 of the products on that website, within the terms of Paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the third element of Paragraph 4(a) of the Policy.

6. Decision

For the foregoing reasons, the Panel orders that the disputed domain name <paulsmitheternal.com> be transferred to the Complainant



Matthew Kennedy
Panelist

Dated: 14 May 2020