



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400599
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Li Zumei
Disputed Domain Name(s):	< ps-outlet.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 Li Zumei, of No.11, Lane, 1865 Changyang Road, Shanghai, 200090 China.

The domain name at issue is **ps-outlet.com**, registered by Respondent with Beijing Innovative Linkage Technology, of Haidian District, Beijing Tsinghua Science Park T Building Block A-20. China.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the "Centre") on April 14, 2014. On the same day, the Centre transmitted by email to Beijing Innovative Linkage Technology (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue. On April 25, 2014, the Centre requested the Complainant to revise deficiencies of the Complaint and provide the Chinese translation thereof. Meanwhile, the Centre also notified the Complainant that the Registrar pointed out that the disputed domain name was registered by "Li Zumei". On April 29, 2014, the Complainant requested to use English as the language of the proceedings and submitted the revised Complaint. The Centre confirmed receipt of the revised Complaint and the language request on the same day. The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999 to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC), the Rules of Procedure under the Policy (the "Rules") and the Centre's Supplemental Rules.

In accordance with the Rules, the Centre attempted to formally notify the Respondent of the Complaint however no response was received, and the proceedings commenced on

April 30, 2014. In accordance with Article 5 of the Rules and the provisions of the Supplemental Rules, the due date for Response was May 20, 2014. The Respondent did not submit any response.

The Centre appointed Matthew Murphy as the sole panelist in this matter on May 26, 2014. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence.

The Panel considered the request of the Complainant for the decision to be issued in the English language, and on the date of issue of this decision, the Panel agreed to issue this decision in English.

3. Factual background

The Complainant - Paul Smith Group Holdings Limited - claims that it is known for designing and selling fashion clothing and accessories internationally, with its headquarters located in the UK. It claims that it has developed a significant reputation as a designer in the UK and abroad. Paul Smith is claimed to be the house brand of the Complainant. The brand "PAUL SMITH" has been registered as a trademark under the name of the Complainant throughout the world and is used as domain name by the Complainant. The Complainant has provided details of its international registrations for its trademark "PAUL SMITH" – the Panel notes in particular that the terms "PAUL SMITH" is registered as or contained in, the trademark registered in China through WIPO under Registrations

No.708450 *PS - Paul Smith* and No. 755406 PAUL SMITH (the Serial Trademarks of "PAUL SMITH"). The Complainant has also provided evidence to show that a domain name containing the trademark "PAUL SMITH", is owned by the Complainant.

The Respondent is Li Zumei, an individual, whose address is No.11, Lane, 1865 Changyang Road, Shanghai, 200090 China. The Respondent did not provide any submissions or evidence in this matter.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. Disputed domain name is confusingly similar to the complainant's trademarks

The Complainant has claimed the exclusive rights of the Serial Trademarks of "PAUL SMITH" all around the world long before the registration date of the disputed domain name (November 25, 2011). The Serial Trademarks of "PAUL SMITH" have been used continuously and extensively and have gained a worldwide reputation. Considering the fact that the website operated under the disputed domain name appears to be selling (or offering to sell at least) counterfeit PAUL SMITH goods, as well as fact that the disputed domain name uses Roman characters that could be taken to refer to a PAUL SMITH outlet of some kind. It is highly likely, that the disputed domain name will confuse

consumers to mistakenly believe that the disputed domain name is owned by or related to the Complainant.

- ii. The Respondent has no right or legitimate interest in respect of the disputed domain name

The Complainant has submitted that the Respondent has no relationship with the Complainant's business or the right to use the Serial Trademarks of "PAUL SMITH". The Complainant has submitted that the Respondent has no rights or legitimate interests in respect of the domain name. The Respondent has not submitted any evidence or submissions to the contrary.

- iii. The Respondent has shown bad faith in registering and using the domain name

The Complainant contends that the website being operated under the disputed domain name is blatantly selling (or offering to sell) counterfeit products bearing the Complainant's prior registered "PAUL SMITH" trademarks. The Respondent has not submitted any evidence or submissions to deny these claims. Such behavior by the Respondent indicates that the Respondent was aware of the Complainant's "PAUL SMITH" trademarks before registering the disputed domain name and has shown bad faith in registering and using the disputed domain name.

B. Respondent

The Respondent has not asserted any claims, defenses or contentions, nor submitted any evidence denying the claims by the Complainant.

5. Findings

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 must be 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

The Panel finds that the Complainant has established that it has rights or interests in the brand "PAUL SMITH" as well as the registered trademarks in China. Although the disputed domain name does not contain "PAUL SMITH" exactly, the Panel notices that the "ps" part of the disputed domain name is the same as the "PS" part contained in the prior registered trademark "*PS · Paul Smith*" (No. 708450) which at least constitutes partial similarity between the disputed domain name and the Complainant's

name. Whether such partial similarity is sufficient to fulfill the requirement of paragraph 4(a)(i) of the Policy, the question lies in that “is it likely that, because of the similarity between the domain name on the one hand and the Complainant’s trademark on the other hand, people will believe that the domain name is associated in some way with the Complainant?” (*see America Online, Inc v. Jonathan Investments Inc, and AOLNEWS.COM, WIPO Case No. D2001-0918; SANOFI-AVENTIS v. Jason Trevenio, WIPO Case No. D2007-0648*). Considering that the website operated under the disputed domain name is aimed at selling counterfeit goods bearing the Complainant’s prior registered Serial Trademarks of “PAUL SMITH”, it is highly possible that customers and visitors to that website operated under the disputed domain name may interpret the “ps” of the main part of the disputed domain name “ps-outlet” as an abbreviation of “PAUL SMITH”. Such an interpretation is entirely reasonable when the nature of the disputed domain name and the nature of the website operated under the disputed domain name are taken into consideration. Such a view may lead consumers to consider that the disputed domain name website is owned by, or related to, the Complainant.

As to the “outlet” part, numerous cases have been shown that “generic descriptive words such as “outlet” do not eliminate the identity or at least the similarity between the Complainant’s registered trademark and the disputed domain names” (*See Swarovski Aktiengesellschaft v. Luo Li, WIPO Case No. D2012-1604; Swarovski Aktiengesellschaft v. www.swarovski-outlet.org, WIPO Case No.D2013-0335*). Accordingly, the Panel finds that the disputed domain name <ps-outlet.com> is confusingly similar to the Serial Trademarks “PAUL SMITH” owned by the Complainant.

B) Rights and Legitimate Interests

There is no evidence that the Respondent had any right or legitimate interest whatsoever in respect of the Serial Trademarks of “PAUL SMITH”, or that there was any association between the trademarks “PAUL SMITH” and its activities, before registering the domain name. Given that the Respondent has not provided any evidence to support a right or legitimate interest in the domain name, the Panel finds that the Respondent has no rights or legitimate interests in respect of the domain name.

C) Bad Faith

The Serial Trademarks of “PAUL SMITH” are well-known enough that it is presumable that the Respondent knew about their existence when registering the domain name (*see Banca Sella S.p.A. v. Mr. Paolo Parente, WIPO Case No. D2000-1157; Expedia, Inc. v. European Travel Network, WIPO Case No. D2000-0137*). The sales of counterfeit PAUL SMITH goods on the disputed domain name website also evidence the said point. No argument has been submitted by the defaulting Respondent in order to counter these findings. The Panel concludes that the domain name has been registered in bad faith.

As far as use of the domain name in bad faith is concerned, the Panel concludes that the Respondent’s holding of the domain name in this particular case satisfies the requirement that the domain name “is being used in bad faith” by the Respondent (*See Telstra Corporation Limited v Nuclear Marshmellows, WIPO Case No. D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400*) - the Complainant’s trademarks are distinctive and widely known, as evidenced by its substantial use and registration in various countries throughout the world. The Panel notes that the Respondent has failed to provide any evidence or submissions regarding the

sale of the goods through its website operated under the disputed domain name, as being genuine, obtained through authorized sales channels or authorized by the Complainant.

The Panel therefore finds that the disputed domain name has been registered and used in bad faith.

6. Decision

Pursuant to paragraphs 4(i) of the Policy and Article 15 of the Rules, the Panelist orders that the disputed domain name <ps-outlet.com> be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: 28 May 2014