



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2001327
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Nancy Anderson
Disputed Domain Name(s):	<www.paulsmithstore.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, represented by S&P Legal Limited of 29 Austen Road, Guildford, Surrey, GU1 3NP, Great Britain.

The Respondent is Nancy Anderson of 3402 Timberbrook Lane, Fort Collins, CO 80525, USA.

The domain name at issue is <www.paulsmithstore.com> (“Disputed Domain Name”) registered by the Respondent with NameSilo, LLC (“Registrar”), of 1300 E. Missouri Avenue, Suite A-110, Phoenix, AZ 85014, USA.

2. Procedural History

On 17 March 2020, the Complaint was filed with the Hong Kong office of the Asia Domain Name Dispute Resolution Centre (“Centre”) in accordance with the Uniform Domain Name Dispute Resolution Policy (“Policy”) adopted by the Internet Cooperation for Assigned Names and Numbers (“ICANN”) on 24 October 1999. On 20 March 2020, the Centre transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On 20 March 2020, the Registrar transmitted by email to the Centre its verification response confirming the Respondent as the registrant of the Disputed Domain Name and provided contact details for the Respondent.

In accordance with paragraphs 2(a) and 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”), the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 7 April 2020. The Respondent was informed that the due date for Response was 27 April 2020. No Response was filed by the Respondent. Accordingly, the Centre notified the parties of the Respondent's default on 28 April 2020.

The Centre appointed Gabriela Kennedy as the sole panelist in this matter on 8 May 2020. The Panel finds that it was properly constituted.

3. Factual background

The Complainant owns registered rights in the “PAUL SMITH” trade mark and related device marks throughout the world, including in the UK, China, USA, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro (“Paul Smith Trade Marks”). The Complainant designs and distributes clothing and accessories worldwide.

The Respondent is an individual based in the USA. She registered the Disputed Domain Name on 16 July 2019.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Complainant holds registered rights in the Paul Smith Trade Marks, and the earliest trade mark registration dates back to 1983. The Disputed Domain Name is identical or confusingly similar to the Complainant’s Paul Smith Trade Marks, which has been wholly incorporated into the Disputed Domain Name;
- ii. The Respondent is not commonly known by the Disputed Domain Name and the Complainant has never authorized or given permission to the Respondent, who has no business relationship with the Complainant, to use the Paul Smith Trade Marks. Consequently, the Respondent has no rights or legitimate interests in the Disputed Domain Name; and
- iii. The facts that the Paul Smith Trade Marks enjoy a reputation worldwide and the Disputed Domain Name resolves to a website selling counterfeit products under the Paul Smith Trade Marks indicate that the Respondent must have been aware of the Complainant’s prior rights in the Paul Smith Trade Marks and the Disputed Domain Name was registered and has been used in bad faith.

B. Respondent

The Respondent did not file a Response.

The fact that the Respondent has not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the Respondent’s failure to file a Response may result in the Panel drawing certain inferences from the Complainant’s evidence, and the Panel may accept all reasonable and supported allegations and inferences flowing from the Complainant’s submissions as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437, and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000 0403).

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 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

The Panel accepts that the Complainant has rights in the Paul Smith Trade Marks, based on its multiple trade mark registrations across various jurisdictions.

It is well established that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the generic Top-Level Domain ("gTLD") extension, ".com" in this case, may be disregarded (see section 1.11 of the WIPO Overview of Panel views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")).

The Disputed Domain Name incorporates the Complainant's "PAUL SMITH" trade mark in its entirety with the addition of the generic term "store" as a suffix. Where the distinctive and prominent element of a disputed domain name is the complainant's mark, and the only difference is a generic term that adds no distinctive element, such a generic term does not negate the confusing similarity between the disputed domain name and the mark (see section 1.8 of the WIPO Overview 3.0).

The Panel finds that "paulsmith" is the distinctive element of the Disputed Domain Name, and the addition of the word "store" does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Paul Smith Trade Marks.

The Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant's Paul Smith Trade Marks and, accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B) Rights and Legitimate Interests

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see section 2.1 of the WIPO Overview 3.0; *Shutterstock, Inc. v. Rahele Mahdavi*, WIPO Case No. DIR2014-0004; and *Giorgio Armani S.p.A., Milan, Swiss Branch Mendrisio v. Hessamaldin Varposjty*, WIPO Case No. DIR2014-0001).

The Panel accepts that the Complainant has not authorised the Respondent to use the Paul Smith Trade Marks, and there is no relationship between the Complainant and the Respondent which would otherwise entitle the Respondent to use the Paul Smith Trade Marks. Accordingly, the Panel is of the view that a *prima facie* case has been established

and it is for the Respondent to prove that it has rights or legitimate interests in the Disputed Domain Name. As the Respondent has not submitted a Response, the Panel will assess the case based on the reasonable inferences that can be drawn from the Complainant's evidence.

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to them of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Names or a name corresponding to the Disputed Domain Names was in connection with a bona fide offering of goods or services; or
- (ii) the Respondent has been commonly known by the Disputed Domain Names, even if she has acquired no trade mark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

No evidence has been provided to demonstrate that the Respondent has trade mark rights corresponding to the Disputed Domain Name, or that she has become commonly known by the Disputed Domain Name.

The Disputed Domain Name resolves to a website that offers counterfeit products for sale under the Complainant's Paul Smith Trade Marks ("the Respondent's website"). The Respondent's website incorporates the Paul Smith Trade Marks at the top of the webpage, and claims to be the "official Japanese online shop of Paul Smith". This suggests that the Disputed Domain Name has not been used by the Respondent in connection with a *bona fide* offering of goods or services or for noncommercial or fair use purposes.

The Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) Bad Faith

The Panel accepts that the Disputed Domain Name was registered and has been used in bad faith by the Respondent based on the following:

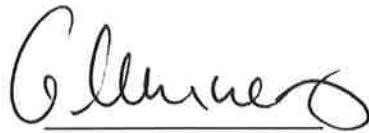
- (a) the Complainant's Paul Smith Trade Marks are well-known. An Internet search shows that the top search results returned for the keyword "PAUL SMITH" largely relate to the Complainant;
- (b) the fact that the Disputed Domain Name fully incorporates the Complainant's "Paul Smith" trade mark in its entirety is a further indication of bad faith and unscrupulous intentions;
- (c) the Respondent's website reproduces the Paul Smith Trade Marks and images similar to those used by the Complainant, thereby giving an impression that it is the official website of the Complainant; and
- (d) the Respondent's website purports to sell counterfeit products under the Paul Smith Trade Marks.

In the circumstances, the Panel concludes that the Respondent must have been aware of the Complainant and the Paul Smith Trade Marks when she registered the Disputed Domain Name and has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's Paul Smith Trade Marks.

The Panel therefore finds that the Respondent registered and is using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy is satisfied.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name be transferred to the Complainant.

A handwritten signature in black ink, appearing to read 'G. Kennedy', written over a horizontal line.

Gabriela Kennedy
Panelist

Dated: 15 May 2020

