



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-22016369
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Ling Xie
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 GB.

The Respondent is Ling Xie of An ding Lu 26hao 6038, Dang Cheng District, Beijing 100029 CHINA.

The domain name at issue is <www.paulsmithstore.com> registered by Respondent with Name.com, Inc, of 414 14th Street #200, Denver, Colorado 80202 USA.

2. Procedural History

On 19 July 2022, the Complainant filed a Complaint involving the Disputed Domain Name <www.paulsmithstore.com> with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“Centre”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“Supplemental Rules”) effective from 31 July 2015.

On 20 July 2022, the Centre transmitted by email to the Registrar a request for confirmation of the WHOIS records of the Disputed Domain Name and other related information.

On 21 July 2022, the Registrar confirmed by email that it is the registrar of the Disputed Domain Name that was registered by the Respondent; and that the Policy is applicable to the dispute

relating to the Disputed Domain Name and the language of the Registration Agreement of the Disputed Domain Name is English and provided to the Centre the Respondent's email address and other WHOIS information of the Disputed Domain Name.

On 29 July 2022, in accordance with Articles 2(a) and 4(a) of the Rules, the Centre issued a Written Notice of the Complaint and formally notified the Respondent of the commencement of the proceedings in this dispute. In accordance with Article 5(a) of the Rules, the due date for the Respondent to submit a Response to the Complaint was 18 August 2022.

On 19 August 2022, the Centre issued a notification of the Respondent in Default, confirming that the Centre did not receive response forms from the Respondent in respect of the complaint concerning the Disputed Domain Name within the required time.

On 23 August 2022, the Centre appointed Ms. Sandra J. Franklin as the sole panelist of the Panel in this matter. Prior to the appointment, the said sole panelist had submitted to the Centre her Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Article 7 of the Rules.

3. Factual background

Complainant Paul Smith sells fashion clothing and other goods under the PAUL SMITH mark in the UK and throughout the world through retail outlets. Complainant holds numerous registrations for the PAUL SMITH mark, including in the UK, China, US, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro (*e.g.* International Registration No. 755406, with the World Intellectual Property Organization ("WIPO"), registered March 20, 2001.)

Respondent registered the <www.paulsmithstore.com> domain name on 16 January 2017.

4. Parties' Contentions

A. Complainant

- i. Respondent's <www.paulsmithstore.com> domain name is confusingly similar to Complainant's PAUL SMITH mark.
- ii. Respondent has no rights or legitimate interests in the <www.paulsmithstore.com> domain name.
- iii. Respondent registered the <www.paulsmithstore.com> domain name in bad faith.

B. Respondent failed to file a Response.

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 finds that Complainant has rights in the PAUL SMITH mark based on registration of the mark with WIPO, among other trademark authorities. *See WIPO Overview of WIPO Panel Views on Selected UDRP Questions*, Third Edition ("WIPO Jurisprudential Overview 3.0") at 1.2 ("Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case."); *See also Eauto, LLC v. Triple S. Auto Parts*, D2000-0047 (WIPO Mar. 24, 2000) (accepting registration as *prima facie* evidence of validity even for a mark that appears descriptive).

Respondent's <www.paulsmithstore.com> domain name uses the entire PAUL SMITH mark and simply adds the descriptive word "store" and the ".com" gTLD. These changes do not distinguish a disputed domain name from a complainant's mark under Policy ¶ 4(a)(i). *See Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); *see also Bloomberg Finance L.P. v. Nexperian Holding Limited*, FA 1782013 (Forum June 4, 2018) ("Where a relevant trademark is recognisable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.") Therefore, the Panel finds that Respondent's <www.paulsmithstore.com> domain name is confusingly similar to Complainant's PAUL SMITH mark.

The Panel finds that Complainant has satisfied Policy ¶ 4(a)(i).

B) Rights and Legitimate Interests

Complainant claims that Respondent does not have rights or legitimate interests in the <www.paulsmithstore.com> domain name because Respondent is not commonly known by the disputed domain name and is not associated with Complainant or authorized to use the PAUL SMITH mark. The Registrar lists the registrant of the disputed domain name as "Ling Xie," which bears no resemblance to the PAUL SMITH mark. Therefore, the Panel finds that Respondent is not commonly known by the disputed domain name, and thus has no rights under Policy ¶ 4(c)(ii). *See LLC v. Bhawana Chandel / Admission Virus*, FA 1799694 (Forum Sep. 4, 2018) (concluding that Respondent was not commonly known by the disputed domain name where "the WHOIS of record identifies the Respondent as "Bhawana Chandel," and no information in the record shows that Respondent was authorized to use Complainant's mark in any way.")

Respondent also does not use the <www.paulsmithstore.com> domain name for a *bona fide* offering of goods or services or a legitimate noncommercial or fair use because Respondent uses the domain name to pass off as Complainant and sell counterfeit goods. Passing off as a complainant is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. See *Dell Inc. v. Devesh Tyagi*, FA 1785301 (Forum June 2, 2018) (“Respondent replicates Complainant’s website and displays Complainant’s products. The Panel finds that this use is not a *bona fide* offering of goods or services under Policy ¶¶ 4(c)(i) & (iii).”) Complainant provides a screenshot showing that the website at <www.paulsmithstore.com> features Complainant’s mark and logo, and allegedly offers PAUL SMITH goods. The Panel finds that this use is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use, and thus Respondent has no rights under Policy ¶ 4(c)(i) or (iii).

The Panel finds that Complainant has satisfied Policy ¶ 4(a)(ii).

C) **Bad Faith**

Complainant argues that Respondent registered and uses the <www.paulsmithstore.com> domain name in bad faith because to disrupt Complainant’s business by passing off as Complainant and selling counterfeit goods. A respondent’s registration and use of a disputed domain name to pass off as affiliated with the complainant and offer competing goods is evidence of bad faith under Policy ¶ 4(b)(iii) and (iv). See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (Forum July 9, 2018) (finding bad faith per Policy ¶¶ 4(b)(iii) and (iv) where the respondent used the disputed domain name to resolve to a website upon which the respondent passes off as the complainant and offers online cryptocurrency services in direct competition with the complainant’s business). Respondent attempts to pass off as affiliated with Complainant by mimicking Complainant’s website, and offering competing goods. The Panel therefore finds that Respondent registered and uses the disputed domain in bad faith under Policy ¶ 4(b)(iii) and (iv).

Complainant also contends that Respondent registered the <www.paulsmithstore.com> domain name in bad faith with knowledge of Complainant’s rights in the PAUL SMITH mark. Since Respondent passes off as Complainant and, due to the widespread registration of the PAUL SMITH mark, the Panel agrees and finds that Respondent had actual notice of Complainant’s rights in the PAUL SMITH mark and thus registered the disputed domain name in bad faith under Policy ¶ 4(a)(iii). See *Yahoo! Inc. v. Butler*, FA 744444 (Forum Aug. 17, 2006) (finding bad faith where the respondent was “well-aware of the complainant's YAHOO! mark at the time of registration”).

The Panel finds that Complainant has satisfied Policy ¶ 4(a)(iii).

6. **Decision**

Complainant has satisfied all three elements required under Paragraph 4 of the Policy. Therefore, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <www.paulsmithstore.com> domain name be **TRANSFERRED** from Respondent to Complainant.

A handwritten signature in black ink that reads "Sandra J. Franklin". The signature is written in a cursive style with a large initial 'S'.

Sandra J. Franklin, Panelist

Dated: September 1, 2022