



ADNDRC

Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2101561
Complainant:	Paul Smith Group Holdings
Respondent:	coco2019 toto
Disputed Domain Name(s):	<cheapsmithuk.com>, <cheapsmithus.com>, and <cheapsmithonlines.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 coco2019 toto, of 704 Room No.704, Building m, Block n, a street, Xicheng District, Beijing, China 100000.

The domain name at issue is <www.cheapsmithuk.com>, <www.cheapsmithus.com>, and <www.cheapsmithonlines.com>, registered by Respondent with Dynadot, LLC, of 210 S Ellsworth Ave #345 San Mateo, CA 94401 USA.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center” or “ADNDRC”) on October 15, 2021. On October 18, 2021, the Center transmitted by email to the Registrar a request for registrar verification for the Domain Name. On October 21, 2021, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name.

The Center sent an email communication to the Complainant on October 21, 2021 providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules to the ICANN

Uniform Domain Name Dispute Resolution Policy and the Rules for the Uniform Domain Name Dispute Resolution Policy effective from July 31, 2015 (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the ADNDRC Hong Kong office notified the Respondent of the Complaint on October 29, 2021. In accordance with the Rules, paragraph 5(a), the due date for Response was November 18, 2021. The Respondent did not submit any response by this deadline date. Accordingly, the Center notified the Respondent's default on November 19, 2021.

Marie-Emmanuelle Haas has been appointed in this matter on November 23, 2021 by the ADNDRC Hong Kong Office as the Panelist, pursuant to the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Domain Name Dispute Resolution Policy, the Rules for ICANN Uniform Domain Name Dispute Resolution Policy, and the ADNDRC Supplemental Rules in respect of the above Domain Name.

The Panel noticed that the three disputed domain names <cheapsmithuk.com>, <cheapsmithus.com> and <cheapsmithonline.com> ("Disputed Domain Names") were not mentioned in the factual and legal grounds on which the complaint is founded.

Therefore, the Panel submitted a Panel Order on November 30, 2021, asking the Complainant to amend its complaint until December 5, 2021 at the latest.

The Respondent was given the possibility to respond until December 12, 2021 at the latest.

The Complainant answered to the Panel Order, submitting an amended complaint on December 3, 2021.

The Respondent did not submit any response to the amended complaint.

The deadline granted to render the decision has been extended until December 14, 2021.

3. Factual background

Paul Smith Group Holdings is internationally known for design, fashion, clothing and accessories. It has developed a significant reputation as a designer both in the UK and abroad. It trades at the top end of the retail market producing high quality products using the finest raw material and innovative techniques.

It sells fashion clothing under its own "Paul Smith" clothing trademark which is sold through numerous retail outlets in the UK and throughout the world through their own retail outlets.

Paul Smith Group Holdings Limited have registered several trademarks "PAUL SMITH" that have gained a worldwide reputation after continuous extensive use and marketing throughout the world.

The complainant alleges that it owns:

- The international trademark "PAUL SMITH" No. 755406, registered through WIPO on March 20, 2001, protected in many countries including UK, China, Czech Republic, Hungary, Iceland,

Monaco, Poland, Romania, Serbia and Montenegro, etc., covering a large range of goods/services in classes 03, 09, 14, 16, 18 and 25;

- The international trademark No. 988039 registered through WIPO on June 5, 2008, protected in many countries including UK and Bahrain, covering the goods in Classes 03, 09, 14, 16, 18 and 25;

- The international trademark No. 708450 registered through WIPO on February 11, 1999, protected in many countries including UK, China, Benelux, Switzerland, Czech Republic, Germany, Denmark, Finland, France, Hungary, Iceland, South Korea, Monaco, Norway, Poland, Portugal, Romania, Sweden, Turkey, Serbia and Montenegro, covering the goods in Class 25, such as articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties;

- The US trademark PAUL SMITH No. 1306038 registered on February 25, 1983, covering the goods in class 25;

- The US trademark PAUL SMITH No. 1511432, registered on February 2, 1988, covering the goods in class 3;

- The US trademark PAUL SMITH No. 1703997, registered on April 19, 1990, covering the goods in class 14;

- The US trademark PAUL SMITH No. 1661631, registered on June 4, 1990, covering the goods in classes 14 and 18;

- The US trademark PAUL SMITH No. 1899650, registered on March 16, 1993, covering the goods in class 9;

- The US trademark PAUL SMITH No. 3327649, registered on April 13, 2006, covering the goods in classes 24, 25 and 27;

- The US trademark PAUL SMITH No. 4024727, registered on July 12, 2010, covering the goods in classes 3, 20, 25 and 27;

- The US trademark No. 2439173, registered on January 21, 1999, covering the goods in class 25;

- The US trademark No. 1190572, registered on February 16, 1983, covering the goods in class 25;

The UK trademark PAUL SMITH No. 2051161, registered on May 16, 1997, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34;

- The UK trademark No. 2184370, registered on June 4, 1999, covering the goods in class 25;

- The EU trademark PAUL SMITH No. 45393, registered on September 4, 2001, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34;

- The EU trademark No. 8673451, registered on May 27, 2010, covering the goods in classes 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34.

All pieces of evidence produced by the Complainant to justify its trademarks' rights were generated in 2013.

These trademarks had to be renewed and no updated evidence was produced.

According to Par 7 (a) "General Powers of the Panel" of the UDRP Rules,

The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

On this basis, the Panel conducted its own research on the WIPO and EUIPO official trademarks databases, in order to check the status of the cited IR and EU trademarks.

It did not pursue its research on the UK and US trademarks databases.

From the Panelist's own research in these trademarks databases, it is apparent that two international registrations are still valid, and that both EU trademarks are still valid as well.

The International trademark No. 988039 has not been renewed on 5 June, 2018, and therefore won't be taken into consideration.

Given this situation, the Panel relies on the following trademarks:

- The international trademark "PAUL SMITH" No. 755406;
- The international trademark No. 708450;
- The EU trademark PAUL SMITH No. 45393;
- The EU trademark No. 8673451.

The Disputed Domain Names are:

- <cheapsmithuk.com> registered on May 10, 2021;
- <cheapsmithus.com> registered on May 10, 2021;
- <cheapsmithonlines.com> registered on 1 May, 2021.

The images and models used on the Disputed Domain Names websites are substantially similar to those used by the Complainant's trademarks PAUL SMITH and *Paul Smith*.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The Complainant contends that the Disputed Domain Names are confusingly similar to the Complainant's trademarks PAUL SMITH.

The Complainant asserts that the main part of the Disputed Domain Names is identical to the Complainant's trademark. It contends that the relevant public will easily recognize its PAUL SMITH trademark in the Disputed Domain Names.

It contends that the Disputed Domain Names website are selling fake counterfeit PAUL SMITH goods in large quantities, and with cheaper prices.

It adds that the Respondent is promoting the Disputed Domain Names websites as the official Paul Smith website for buying goods, given that the images and models used are substantially similar to those used by the Complainant's trademarks PAUL SMITH.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain names given that it has never been authorized by the Complainant to use the PAUL SMITH trademark under any circumstances and that the Respondent has no business relationship with the Complainant. It adds that the Respondent's name, address and any other information cannot be linked with PAUL SMITH and that further searches by the Complainant do not prove that the Respondent has any other rights for PAUL SMITH.

The Complainant contends that the Respondent is promoting its website as the official Paul Smith website and that the Disputed Domain Names can easily mislead consumers to mistakenly believe the Disputed Domain Names are owned or operated by the Complainant, or the Respondent has certain relation with the Complainant.

The Respondent is using the Disputed Domain Names to sell fake counterfeit products bearing the Complainant's prior registered trademarks PAUL SMITH and, which additionally proves that the Respondent's awareness of PAUL SMITH and before registering the Disputed Domain Names.

Thus, it can be reasonably inferred that the Respondent was aware of the Complainant's prior trademarks on PAUL SMITH and *Paul Smith* trademarks well before registering the Disputed Domain Names.

The Disputed Domain Names have been registered and are being used in bad faith, given that it is using the Disputed Domain Names to sell fake counterfeit products under the PAUL SMITH trademark, and that the Respondent was aware of PAUL SMITH and its trademarks well before registering the Disputed Domain Names.

The Complainant requests that the Disputed Domain Names be transferred to the Complainant.

B. Respondent

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

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has submitted evidence of its prior registered PAUL SMITH trademarks.

The Disputed Domain Names <cheapsmithuk.com>, <cheapsmithus.com> and <cheapsmithonlines.com>, incorporates the word "smith", which is the main part of the Complainant's PAUL SMITH trademarks.

The addition of the word "cheap" to "smith" in the 3 Disputed Domain Names does not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant's trademark. The relevant public will consider that the websites associated with the Disputed Domain Names sell cheaper PAUL SMITH branded products.

Moreover, the addition of the two letters "uk" and "us" to "smith" in the Disputed Domain Names <cheapsmithuk.com>, <cheapsmithus.com> does not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant's trademark. The internet users will consider that this is the country where the PAUL SMITH branded products are sold or available.

The addition of the term "onlines" will also lead the relevant public to consider that the website offers to sell its PAUL SMITH products online.

The extension ".com" is a standard registration requirement, and is disregarded when determining identity or confusing similarity under the first element.

The Complainant has, to the satisfaction of the Panel, shown each of the Disputed Domain Names is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

B) Rights and Legitimate Interests

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 it of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

The Respondent did not respond to the Complaint to rebut the Complainant's prima facie case. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the Disputed Domain Names.

It has not been licensed or authorized to use the well-known PAUL SMITH trademark or to register the Disputed Domain Names.

There is no indication that the Respondent is known under the Disputed Domain Names.

The Panel further finds that the Respondent is neither making a bona fide offering of goods or services or a legitimate noncommercial or fair use of the Disputed Domain Names as the Disputed Domain Names websites are selling fake counterfeit PAUL SMITH goods in large quantities.

The evidence put forward by the Complainant consists of a screen shot of the websites showing that the Disputed Domain Names resolve to websites selling fake PAUL SMITH goods.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent's lack of rights or legitimate interests in relation to the Disputed Domain Names, which the Respondent has not rebutted.

The Complainants have therefore satisfied paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainants to demonstrate that the Domain Name was registered and is being used in bad faith. Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that may indicate bad faith, including but not limited to:

(i) circumstances indicating that the Respondent has registered or the Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, 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 location or of a product or service on the Respondent's website or location.

Registration in bad faith

Given the Complainant's long established and widespread use of its well-known PAUL SMITH trademark in several countries of the world, its worldwide reputation in the sectors of design, fashion, clothing and accessories, and as a designer both in the UK and abroad, and its high quality products using the finest raw material and innovative techniques, the Panel finds that the Respondent was perfectly aware of the Complainant's rights in the PAUL SMITH trademark, and that it targeted the Complainant when it registered the Disputed Domain Names.

Used in bad faith

The Disputed Domain Names websites are selling fake counterfeited PAUL SMITH goods in large quantities and at cheaper price than the original product.

The Respondent is attempting to attract, for commercial gain, Internet users to Respondent's own 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 location or of a product or service on the respondent's website or location" in the meaning of Par. 4(b) (iv) of the Policy.

The Complainants have therefore satisfied paragraph 4(a)(iii) of the Policy.

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 names <cheapsmithuk.com>, <cheapsmithus.com>, and <cheapsmithonline.com> be transferred to the Complainant.

Marie-Emmanuelle HAAS
Panelist

Dated: December 15, 2021

