



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2201694
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Rui Gao
Disputed Domain Name:	<ps-paulsmith.com>

1. The Parties and Contested Domain Name

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

The Respondent is Rui Gao of Block P, Xia Street, Shashi, Lei County, Shanxi Province, 362229, China.

The domain name at issue is <ps-paulsmith.com>, registered by the Respondent with Name.com, Inc, of 414 14th Street #200, Denver, Colorado 80202, United States of America.

2. Procedural History

The Complainant filed the Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre on 18 November 2022 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”). On 21 November 2022, the Hong Kong Office acknowledged receipt of the Complaint and sent an email to the Registrar requesting verification of information regarding the domain name at issue. On 22 November 2022, the Registrar sent a confirmation email disclosing registrant and contact information for the disputed domain name that differed from the named respondent and contact information in the Complaint. On the same day, the Center sent an email to the Complainant providing the registrant and contact information disclosed by the Registrar and requiring the Complainant to update the information regarding the Respondent in the Complaint. On 1 December 2022, the Complainant filed an amended Complaint.

The Hong Kong Office confirmed that the Complaint, as amended, was in administrative compliance with the Policy and the Rules. On 2 December 2022, the Hong Kong Office sent the Respondent a written notice of the Complaint, informing it that it was required to submit a Response within 20 days (that is, on or before 22 December 2022). The Hong Kong Office did not receive a Response from the Respondent regarding the Complaint. Accordingly, on 23 December 2022, the Hong Kong Office notified the parties of the Respondent's default.

On 23 December 2022, the Hong Kong Office appointed Scott Donahey 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. The original Decision due date was 6 January 2023, which was later extended to 19 January 2023. As the original Panelist was no longer able to act in this dispute due to illness, on 18 January 2023 the Hong Kong Office appointed Matthew Kennedy as the substitute 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 company group designs and produces fashion and accessories. The Complainant holds multiple trademark registrations, including the following:

- United Kingdom trade mark registration number UK00002051161 for PAUL SMITH in standard characters and PAUL SMITH in a fancy script (the "Paul Smith Signature Mark"), entered in the register on 16 May 1997, and specifying goods in multiple classes including clothing and footwear in class 25;
- International trade mark registration number 708450 for PS • PAUL SMITH in a fancy script (the "PS • Paul Smith Signature Mark"), registered on 11 February 1999, designating multiple jurisdictions including China, and specifying clothing, footwear and other goods in class 25; and
- International trade mark registration number 755406 for PAUL SMITH, registered on 20 March 2001, designating multiple jurisdictions including China, and specifying goods in multiple classes including clothing and footwear in class 25.

The above trademark registrations remain current.

The Respondent is an individual resident in China.

The disputed domain name was registered on 14 June 2022. It resolves to a website in Italian that prominently displays the Paul Smith Signature Mark in the same fancy script as the Complainant's registered trademark. The website offers for sale clothing, accessories, and shoes.

The Registrar confirmed that the language of the Registration Agreement is English.

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 mark and Paul Smith Signature Mark.
- 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 marks under any circumstances. The Respondent has no business relationship with the Complainant. The Respondent's name, address and any other information cannot be linked with the PAUL SMITH mark. Further searches by the Complainant do not prove that the Respondent has any other rights for PAUL SMITH.
- iii. The disputed domain name has been registered and is being used in bad faith. The associated website is blatantly selling counterfeit products bearing the Complainant's PAUL SMITH mark and Paul Smith Signature Mark. It can reasonably be inferred that the Respondent was aware of these marks at the time of registering the disputed domain name.

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.

The burden of proof of each of the above three elements is borne by the Complainant. The Respondent's default does not automatically result in a decision in favour of the Complainant.

A) Identical / Confusingly Similar

Based on the evidence submitted, the Panel finds that the Complainant has rights in the PS • Paul Smith Signature Mark and the PAUL SMITH mark, among others. Given that the figurative elements in the PS • Paul Smith Signature Mark cannot be reflected in a domain name for technical reasons, the Panel will not take them into account in the comparison with the disputed domain name for the purposes of the first element of paragraph 4(a) of the Policy.

The disputed domain name incorporates the PS • Paul Smith Signature Mark, but substitutes a hyphen for the median dot in the mark. This difference is so minor that it does not prevent a finding of confusing similarity as the PS • Paul Smith Signature Mark is clearly recognizable in the disputed domain name. The disputed domain name also wholly incorporates the PAUL SMITH mark, adding the letters "ps" and a hyphen before the mark. The addition of these letters and hyphen does not prevent a finding of confusing similarity as the PAUL SMITH mark is clearly recognizable in the disputed domain name.

The only other element in the disputed domain name is a generic Top-Level Domain (“gTLD”) suffix (“.com”). As a standard requirement of domain name registration, this element may be disregarded in the comparison between the disputed domain name and the Complainant’s mark for the purposes of the first element of paragraph 4(a) of the Policy.

Therefore, 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 in paragraph 4(a) of the Policy.

B) Rights and Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that a respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, the disputed domain name incorporates the Complainant’s PS • Paul Smith Signature Mark (but substitutes a hyphen for the median dot in the mark) and wholly incorporates the PAUL SMITH mark. It resolves to a website that prominently displays the Paul Smith Signature Mark as its title and offers for sale what are purported to be the Complainant’s products. Further, the fact that the operational element is almost identical to the Complainant’s PS • Paul Smith Signature Mark creates a high risk of implied affiliation. The Complainant submits that it has never authorized the Respondent to use its marks under any circumstances, and that the Respondent has no business relationship with it. Regardless of whether the products offered for sale on the website are genuine or counterfeit, the website does not accurately disclose the Respondent’s lack of relationship with the Complainant. On the contrary, it gives the false impression that the website is somehow affiliated with, or endorsed by, the Complainant. Accordingly, the Panel does not consider this offering of goods or services to be *bona fide* for the purposes of paragraph 4(c)(i) of the Policy. Given that the website offers goods for sale, the Panel does not consider that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name either.

As regards the second circumstance set out above, the Respondent’s name is listed in the Registrar’s WhoIs database as “Rui Gao”, and her email username is “monicazimmerman”, not “Paul Smith” or the disputed domain name. Nothing in the record indicates that the Respondent has been commonly known by the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because she did not respond to the Complainant’s contentions.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C) Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

“(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [the respondent’s] web site or location.”

The disputed domain name was registered in 2022, many years after the registration of the Complainant’s PS • Paul Smith Signature Mark and PAUL SMITH mark, including in China where the Respondent is resident. The disputed domain name incorporates both marks. The website to which the disputed domain name resolves prominently displays the Complainant’s Paul Smith Signature Mark as its title and offers for sale what are purported to be the Complainant’s products. In view of these circumstances, the Panel has reason to find that the Respondent had the Complainant’s PS • Paul Smith Signature Mark and PAUL SMITH mark in mind when she registered the disputed domain name.

The Respondent uses the disputed domain name in connection with a website that prominently displays the Paul Smith Signature Mark as its title and offers for sale what are purported to be the Complainant’s products, giving the false impression that it is somehow affiliated with, or endorsed by, the Complainant. Given these circumstances, the Panel finds that the disputed domain name operates by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation or endorsement of the website or the products offered for sale on it. This use of the disputed domain name is intended to attract Internet users to the Respondent’s website for commercial gain as contemplated by paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 name <ps-paulsmith.com > be transferred to the Complainant.



Matthew Kennedy
Panelist

Dated: 26 January 2023