



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2301764
Complainant:	Paul Smith Group Holdings Limited
Respondent:	baoyu4 zhu
Disputed Domain Name(s):	<pspaulsoldes.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.

The Respondent is **baoyu4 zhu**, of Yidu/Jilin/365485, Jilin Province, China, .

The domain name at issue is **<pspaulsoldes.com>** (“*Disputed Domain Name*”), registered by Respondent with Name.com, Inc., of 414 14th Street #200, Denver, Colorado 80202, USA.

2. Procedural History

On 16 June 2023, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On 19 June 2023, the ADNDRC-HK notified Name.com, Inc. (“Registrar”) of the Disputed Domain Name of the proceedings by email and requested registrar verification in connection with the domain name at issue. On 20 June 2023, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that baoyu4 zhu is the holder of the Disputed Domain Name, and provided contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “policy”), the Rules of Procedure under the Policy (the “Rules”), and the Center’s Supplemental Rules.

In accordance with the Rules, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the Respondent on 27 June 2023. The Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 17 July 2023).

The Panel comprising of Steven M. Levy, Esq. as a single panelist was appointed by the ADNDRC-HK on 24 July 2023. The papers pertaining to the case were delivered to the Panel

by email on 26 July 2023. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

For the Complainant

The Complainant, Paul Smith Group Holdings Limited, who owns the registered trademark PAUL SMITH, is internationally known for design, fashion clothing and accessories. The Complainant registered its trademark at the United States Patent and Trademark Office as early as 1983 and through the WIPO as early as 1999. The trademark PAUL SMITH has also been granted protection in many other jurisdictions including the UK and the PRC for a range of goods and services including clothing, footwear, accessories, soaps, spectacle frames, jewelry and stationery.

For the Respondent

The Respondent did not respond to the ADNDRC-HK within the stipulated timeframe (i.e. on or before 17 July 2023). As such the Respondent has not contested the allegations of the Complaint and is in default.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The domain name in dispute is confusingly similar to the trademark PAUL SMITH in which Complainant has rights in many countries.
- ii. Respondent has no rights or legitimate interests in the registration of the domain names in dispute as it is used to offer counterfeit goods.
- iii. Respondent has registered and used the domain name in bad faith as evidenced by its offering counterfeit goods.

B. Respondent

The Respondent registered the disputed domain name on 21 June 2022. It did not file a Response to the ADNDRC-HK within the required timeframe stipulated by the ADNDRC-HK (i.e., on or before 17 July 2023) and as such has not contested the allegations of the Complaint and is in default.

5. Findings

Having considered all the documentary evidence before me, and the Respondent's nonparticipation in these proceedings after being afforded every opportunity to do so in accordance with Paragraph 14 of the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") the Panel is of the view that it should proceed to decide on the Disputed Domain Name <pspaulsoldes.com> based upon the Complaint and evidence submitted by the Complainant.

In accordance with Paragraph 4(a) of the Policy, the Panel finds that:

- i. Complainant owns rights in the PAUL SMITH trademark and that Respondent's <pspaulsoldes.com> domain name is confusingly similar to such mark;
- ii. Respondent has no rights or legitimate interests in respect of the Disputed Domain Name as it is not commonly known thereby and, by impersonating Complainant, it is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use thereof; and
- iii. The Disputed Domain Name has been registered and is being used in bad faith where it is used to impersonate Complainant and perhaps sell counterfeit goods or otherwise perpetrate fraud on users.

A) Identical / Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights. Complainant has submitted screenshots from various trademark offices and, to the satisfaction of the Panel, demonstrated its ownership of rights in its claimed PAUL SMITH trademark. See *Red Hat, Inc. v. Muhammad Shahzad*, FA 1787738 (FORUM June 19, 2018) (“Registration of a mark with multiple trademark agencies is sufficient to demonstrate rights to a mark per Policy ¶ 4(a)(i).”).

Next, the Disputed Domain Name incorporates certain elements of the Complainant's PAUL SMITH trademark. Where a trademark is recognizable within a Disputed Domain Name confusing similarity may be found. For guidance, the WIPO Overview 3.0, at Par. 1.7, states that “[t]his test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.” It goes on to note that “[i]n some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. In specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel would benefit from affirmation as to confusingly similarity with the complainant's mark, the broader case context such as website content trading off the complainant's reputation ... may support a finding of confusing similarity.” *Id.*

In the present case, the Disputed Domain Name does not incorporate the entirety of the PAUL SMITH trademark. However, it does clearly invoke the mark by its use of the letters “ps”, the word “Paul”, and the generic term “soldes” which begins with the same letter “s” as is found in the word “Smith” and translates, from the Spanish language, to the word “sales” (a reference to the offering of goods at a discount). This, combined with the impersonation website content that resolves from the <pspaulsoldes.com> domain name and includes a graphic logo version of Complainant's trademark, tips the scales in favor of a finding of confusing similarity and leads the Panel to conclude that Complainant's trademark is recognizable within the Disputed Domain Name.

Furthermore, the addition of the “.com” gTLD does not distinguish the Disputed Domain Name from the Mark. *Genting Americas, Inc. v. Michael Shaya*, ADNDRC-779-2019

(AIAC 6 January 2020) (“the part “.com”, as top level domain name, does not feature out to likewise extent” in the analysis under Paragraph 4(a)(i) of the Policy).

Considered as a whole, the Disputed Domain Name would be likely regarded by potential customers of the Complainant as a reference to the Complainant’s business. As such, it is the view of this Panel that the Complainant has discharged its burden of proof in establishing that the Disputed Domain Name is confusingly similar to the Complainant’s trademark under Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii). Should it succeed in this effort, the burden then shifts to Respondent to show that it does have rights or legitimate interests. See *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy ¶ 4(a)(ii)); see also *Neal & Massey Holdings Limited v. Gregory Ricks*, FA 1549327 (FORUM Apr. 12, 2014) (“Under Policy ¶ 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests”).

While the Complaint makes no specific reference to Paragraph 4(c) of the Policy, in the interest of providing a full analysis of the case, the Panel notes that Respondent’s name, as revealed by the concerned Registrar, is “baoyu4 zhu u” and there is no evidence that it is known otherwise. There is also nothing to indicate that Respondent is operating a legitimate business at the <pspaulsoldes.com> website and Complainant does assert that “Respondent’s name, address and any other information cannot be linked with “PAUL SMITH” and that “Respondent has no business relationship with the Complainant”. As such, the Panel finds no ground upon which to conclude that Respondent is commonly known by the disputed domain name under Paragraph 4(c)(ii) of the Policy.

Next, it does not appear that Respondent uses the disputed domain name for any *bona fide* offering of goods or services. Instead, Respondent uses the disputed domain name to impersonate Complainant. Using a disputed domain name to pass oneself off as a complainant is not a *bona fide* offering of goods or services, nor is it a legitimate noncommercial or fair use under Paragraph 4(c)(i) or (iii) of the Policy. See *iFinex Inc. v. Yuri Hefetz / Genie-Solution*, FA 1789385 (FORUM July 9, 2018) (holding that the respondent’s mimicking the complainant’s website in order to cause existing or potential customers to falsely believe they are setting up a new account with the complainant is *prima facie* evidence of the respondent’s lack of rights and legitimate interests in the disputed domain name). Here, Complainant asserts that Respondent is “blatantly selling fake counterfeit products bearing the Complainant’s registered trademarks” and it provides a screenshot of the <pspaulsoldes.com> webpage. This incorporates Complainant’s graphic PAUL SMITH logo as well as pictures of fashion models wearing colorful clothing. The bottom of the page displays the phrase “Top Selling Products”. The use of a confusingly similar domain name to resolve a website that displays Complainant’s graphic logo and photographs displaying goods which compete with those offered by Complainant altogether present a profile of an enterprise that either sells counterfeit products or commits fraud on users. As Complainant has made a *prima facie* case that has not been rebutted by the absent Respondent, the Panel finds that Respondent has failed to make a *bona fide* offering of

goods or services and that it is not making a legitimate noncommercial or fair use of the disputed domain name per Paragraph 4(c)(i) or (iii) of the Policy.

C) Bad Faith

The Complaint asserts that Respondent registered the <pspaulsoldes.com> domain name with actual knowledge of Complainant's rights in the PAUL SMITH trademark. Actual knowledge, when proven by evidence, can create a foundation upon which to build an assertion of bad faith registration per Policy ¶ 4(a)(iii). See *VIOOH Limited v. 吳清儒 (wu qing ru)*, D2023-2155 (WIPO 13 July 2023) (“the registration of the Domain Name incorporating Complainant's VIOOH trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the VIOOH trademarks at the time of registration of the Domain Name and its effort to opportunistically capitalize on the registration and use of the Domain Name.”) Here, Complainant contends that its mark “is internationally known” and has “developed a significant reputation”. However, no evidence to support this is provided. Complainant further claims that “[t]he information on the first page of the [Google] search result is associated to the Complainant” but such results have not been provided. While trademark registrations can demonstrate rights to a mark, they do not show the scope or reputation of the mark or how it is perceived by customers, business partners, and others. Further, assertions which are unsupported by evidence are typically not accepted by Panels. See WIPO Jurisprudential Overview 3.0 at Par. 4.3 (assertions which are wholly unsupported and conclusory may be disregarded).

Nevertheless, Respondent's actual knowledge of Complainant's PAUL SMITH trademark may be demonstrated by its use of the graphic logo in the provided screenshot of the <pspaulsoldes.com> website. Based on this evidence of Respondent's use of the <pspaulsoldes.com> domain name, the Panel finds it highly likely that Respondent registered the name with knowledge of Complainant's trademark.

Next, Complainant sets forth an argument that Respondent registered and uses the <pspaulsoldes.com> domain name in bad faith because Respondent seeks commercial gain based on confusion with the PAUL SMITH mark. Use of a disputed domain name to display a fraudulent or competing website can be evidence of bad faith disruption of a complainant's business under Policy ¶ 4(b)(iii). See *DatingDirect.com Ltd. v. Aston*, FA 593977 (FORUM Dec. 28, 2005) (“Respondent is appropriating Complainant's mark to divert Complainant's customers to Respondent's competing business. The Panel finds this diversion is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iii).”) Further, impersonating and passing oneself off as a complainant is a clear indication of bad faith. See *The Optimism Foundation v. Anastasia Semenov*, FA 2025625 (FORUM Jan. 24, 2023) (“Respondent uses the disputed domain name's resolving webpage in order to impersonate Complainant.”) Complainant states that the <pspaulsoldes.com> website is “blatantly selling fake counterfeit PAUL SMITH goods in large quantities” and that the images and models used on the website are “substantially similar to those used by the Complainant”. The Panel references the screenshot provided by Complainant which shows that the disputed domain name resolves to a webpage displaying the graphic PAUL SMITH logo and fashion models promoting apparel seemingly in competition with Complainant. Respondent has not filed a Response or made any other submission in this case and so the Panel finds, by a preponderance of available evidence, the existence of bad faith registration and use of the Disputed Domain Name under Paragraph 4(b)(iv) of the Policy.

6. Decision

The Complainant has proved its case. It has a registered trademark in the name “PAUL SMITH” to which the contested domain name is confusingly similar. The Respondent has provided no evidence showing rights or legitimate interest in the Disputed Domain Name. The Complainant has shown that the Respondent registered and used the Disputed Domain Name in bad faith.

For the foregoing reasons and in accordance with Paragraph 4 of the Policy, the Panel concludes that the relief requested by the Complainant be granted and orders that the Disputed Domain Name <pspaulsoldes.com> be transferred to the Complainant Paul Smith Group Holdings Limited.

Steven M. Levy

Steven M. Levy, Esq.
Panelist

Dated: 27 July 2023