

**ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTER  
(Beijing Office)**

**Administrative Panel Decision**

**Case No. CN-1100505**

---

---

**Complainant: PAUL SMITH GROUP HOLDINGS LIMITED**

**Respondent: sle**

**Domain Name: paulsmithworld.com**

**Registrar: NAME.COM LLC**

---

---

**1. Procedural History**

On October 13, 2011, the Complainant submitted a Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the "ADNDRC Beijing Office"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") approved by ICANN, and Asian Domain Name Dispute Resolution Center Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "ADNDRC Supplemental Rules").

On October 19, 2011, the ADNDRC Beijing Office confirmed the receipt of the Complaint. On October 19, 2011, the ADNDRC Beijing Office transmitted by email to ICANN and NAME.COM LLC (the Registrar of the domain name) a request for verification of registration information in connection with the domain name in dispute. On October 24, 2011, NAME.COM LLC transmitted by email to the ADNDRC Beijing Office its verification response confirming that, the domain name in dispute was registered under its domain registrar and the Respondent is listed as the registrant.

The ADNDRC Beijing Office sent by email the Transmittal of Claims attached by the Complaint to the Respondent on October 31, 2011.

On November 4, 2011, the ADNDRC Beijing Office notified the Complainant that the Complaint had been confirmed and forwarded and the proceedings commenced on November 4, 2011. On the same day, the Notifications of

Commencement of Proceedings were notified to the Respondent, ICANN and the Registrar.

On November 25, 2011, having received no response from the Respondent, the ADNDRC Beijing Office notified the Complainant that the hearing will take place by default.

On November 28, 2011, the ADNDRC Beijing Office notified the Proposed Panelist Dr. GAO Lulin to see whether he is available to act as the Panelist in this case and if so, whether he is in a position to act independently and impartially between the parties. Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Dr. GAO Lulin, on November 28, 2011, the ADNDRC Beijing Office informed the Complainant and the Respondent of the appointment of the Panelist and the constitution of the Panel, transferred the case file to the Panel, and asked the Panel to submit a decision on or before December 12, 2011.

## **2. Factual Background**

### **For the Complainant**

The Complainant is PAUL SMITH GROUP HOLDINGS LIMITED. Its address is the Riverside Building, Riverside Way, Nottingham, NG2 1 UK. Its authorized representative is Alex ZHU(朱长远), employee of S&F INTELLECTUAL PROPERTY CHINA.

### **For the Respondent**

The Respondent is sle with the address at Andy Huang, sle.skels,eksl, als, sla, 361000, US. The Respondent is the current registrant of the disputed domain names “paulsmithworld.com” according to the Whois information.

## **3. Parties' Contentions**

### **The Complainant**

The Complainant's contentions are as follows:

The Complainant, PAUL SMITH GROUP HOLDINGS LIMITED, is a renowned designer and manufacturer of fashion goods. The Complainant's

products and services have acquired high fame throughout the world through long established marketing and sales, and well-known amongst relevant consumers. The Complainant had registered the PAUL SMITH, *Paul Smith*, *PS · Paul Smith* trademarks throughout the world, including in UK, China, US, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro, etc., covering a large range of goods and services in classes 03, 09, 14, 16, 18, 20, 24, 25, 27 and etc.

The specific goods/services designated are as follows:

03 Perfumery, colognes; cosmetics; soaps, shampoo, preparations for use and after shaving, toilet preparations, skin care and hair care preparations, deodorants, anti-perspirants, dentifrices, bath and shower preparations; talcum powder; shoe cleaning preparations.

09 Spectacle frames, sunglasses frames, sunglasses, lenses, clips, cases and containers for spectacles and sunglasses, radios, calculators, parts and accessories for all the aforesaid goods.

14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery, precious stones, horological and chronometric instruments, imitation jewellery, brooches, cuff links, ornamental pins, tie pins, watches, watch straps, clocks, money clips; key rings.

16 Paper; cardboard and cardboard articles; stationery, printed matter, printed publications, calendars, albums, writing materials and writing implements, notebooks, note pads, diaries, address books, posters, loose-leaf binders, files, folders; pen and pencil sets, cases and stands; letter racks, paper knives, cards, playing cards, paperweights, parts and fittings for all the aforesaid goods.

18 Leather and imitations of leather and goods made of these materials not included in other classes; animals skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage; rucksacks, bags, briefcases, pocket wallets, purses, pouches, credit card holders, chewing gum holders, notebook holders, coin holders, key cases.

20 Pillows and cushions

24 handkerchiefs; towels

25 Articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces,

ties

27 rugs, wall coverings, namely, wallpaper

The factual and legal grounds on which the complaint is made:

(1) Respondent's domain name is confusingly similar to trademarks in which the Complainant has rights

① The complainant is the true owner to the exclusive rights of the serial trademarks of PAUL SMITH, *Paul Smith*, *PS · Paul Smith*.

The Complainant registered the trademark "PAUL SMITH" (International Registration No. 755406) through WIPO on March 20, 2001. The trademark "PAUL SMITH" is granted for protection 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 Complainant registered the trademark *Paul Smith* (International Registration No. 988039) through WIPO on June 5, 2008. The trademark *Paul Smith* is granted for protection in many countries including UK and Bahrain, covering the goods in Classes 03, 09, 14, 16, 18 and 25.

The Complainant registered the trademark *PS · Paul Smith* (International Registration No. 988039) through WIPO on February 11, 1999. The trademark *PS · Paul Smith* is granted for protection in many countries/areas including UK, China, Benelux, Switzerland, Czech Republic, Germany, Denmark, Finland, France, Hungary, Iceland, South Korea, Monaco, Norway, Poland, Portugal, Romania, Sweden, Turkey and Serbia and Montenegro, covering the goods in Class 25, i.e. articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties.

The Complainant registered the trademark PAUL SMITH in US (Registration No. 1306038) on February 25, 1983, covering the goods in class 25.

The Complainant registered the trademark PAUL SMITH in US (Registration No. 1511432) on February 2, 1988, covering the goods in class 3.

The Complainant registered the trademark PAUL SMITH in US (Registration No. 1703997) on April 19, 1990, covering the goods in class 14.

The Complainant registered the trademark PAUL SMITH in US (Registration No. 1661631) on June 4, 1990, covering the goods in classes 14 and 18.

The Complainant registered the trademark PAUL SMITH in US (Registration No. 1899650) on March 16, 1993, covering the goods in class 9.

The Complainant registered the trademark PAUL SMITH in US (Registration No. 3327649) on April 13, 2006, covering the goods in classes 24, 25 and 27.

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

The Complainant registered the trademark *PS · Paul Smith* in US (Registration No. 2439173) on January 21, 1999, covering the goods in class 25.

The Complainant registered long before the registration date (September 12, 2009) of the Disputed Domain Name the trademark PAUL SMITH, covering the goods in 9, 14 and 18.

The Complainant registered long before the registration date (September 12, 2009) of the Disputed Domain Name the trademark *Paul Smith*, covering the goods in 3, 9, 14, 16, 18 and 25.

The Complainant registered long before the registration date (September 12, 2009) of the Disputed Domain Name the trademark *PS · Paul Smith*, covering the goods in 3, 9, 14, 16, 18 and 25.

The registered PAUL SMITH, *Paul Smith* and *PS · Paul Smith* trademarks, designating a large range of goods, such as clothes, leather products, shoes, scarves, etc., have become worldwide reputed after continuous extensive uses and marketing throughout the world.

Using WWW.GOOGLE.COM.HK the Complainant searched for“PAUL SMITH” and obtained 163,000,000 results. All the information on the first page of the search result is associated to the Complainant.

②The Disputed Domain Name is confusingly similar to the Complainant’s trademarks PAUL SMITH and *Paul Smith*.

Since the “.com” is not taken into account in the comparison, “paulsmithworld” is the main part of the Disputed Domain Name, of which “paulsmith” is identical to the Complainant’s worldwide reputed PAUL SMITH

and *Paul Smith* trademarks. Thus the relevant public would easily separate it into “paulsmith” + “world” when identifying the Disputed Domain Name. Further, as “world” is a general English word. When placed after “paulsmith”, a trademark wording, “paulsmithworld”, as a domain name, can be easily understood as “the world of PAUL SMITH goods”. It is obvious that “paulsmith” is the central and distinguishing element of the Disputed Domain Name.

Meanwhile, the website linked by the Disputed Domain Name itself is blatantly selling fake PAUL SMITH goods in large quantities. This serves as good evidence proving that “paulsmithworld” is actually viewed by the Respondent too as “the world of PAUL SMITH goods”.

Thus, the Disputed Domain Name “paulsmithworld.com” can easily mislead consumers to mistakenly believe the Disputed Domain Name is owned or operated by the Complainant, or the Respondent has certain relation with the Complainant. Therefore, the Disputed Domain Name is confusingly similar to the Complainant’s trademarks PAUL SMITH and *Paul Smith*.

For the foregoing reasons, the Complainant believes that paragraph 4(a)(i) of the Policy has been satisfied.

(2) The Respondent has no right or legitimate interest in respect of the Disputed Domain Name

Firstly, the Respondent has never been authorized by the Complainant to use the trademarks PAUL SMITH and *Paul Smith* under any circumstances. Furthermore, the Respondent has no business relationship with the Complainant. Thus, the Respondent does not have any rights with regards to the trademark PAUL SMITH.

Secondly, the Respondent 's name, address and any other information cannot be linked with PAUL SMITH.

Thirdly, further searches by the Complainant do not prove that the Respondent has any other rights for PAUL SMITH.

For the foregoing reasons, the Complainant believes that paragraph 4(a)(ii) of the Policy has been satisfied.

(3) The Respondent has shown bad faith in registering and using the domain

name

①The Respondent is using the Disputed Domain Name to offer links to websites selling fake products bearing the Complainant's prior registered trademarks PAUL SMITH and *Paul Smith*.

The website linked by the Disputed Domain Name is blatantly selling fake products bearing the Complainant's registered trademarks PAUL SMITH and *Paul Smith*. It can be easily found that the goods sold on the website linked by the Disputed Domain Name are also named PAUL SMITH products by the owner of the website. The Respondent's conduct should be regarded as evidence of bad faith as prescribed in 4(b) iv) of the Policy.

②The Respondent was aware of PAUL SMITH and *Paul Smith* trademarks well before registering the Disputed Domain Name.

The Complainant's PAUL SMITH and *Paul Smith* trademarks had been extensively registered throughout the world including UK, US and China, etc., long before the registration of the Disputed Domain Name. The registered PAUL SMITH and *Paul Smith* trademarks, designating a large range of goods, such as clothes, leather products, shoes, scarves, have become worldwide reputed after continuous extensive uses and marketing throughout the world.

Meanwhile, the Respondent is using the Disputed Domain Name to offer links to webpages selling fake products bearing the Complainant's prior registered trademarks PAUL SMITH and *Paul Smith*, which additionally proves that the Respondent's awareness of PAUL SMITH and *Paul Smith* before registering the Disputed Domain Name.

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 Name.

For the foregoing reasons, the Complainant believes that paragraph 4(a)(iii) of the Policy has been satisfied.

Therefore, the Complainant asks for transferring the Disputed Domain Name to it.

## **For the Respondent**

After being served of the claim and all the accompanying documents submitted by the Complainant, and of all the procedural documents by the ADNDRC Beijing Office, the Respondent makes no response by any means in the whole course of the proceeding.

## **4. Panel's Findings**

As stipulated in the Paragraph 4(a) of the Policy, when claiming a domain name registered by Respondent, the Complainant must prove each of the followings:

- (i) that the domain name of the Respondent's is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Based on the relevant stipulations under the Policy, the Rules and ADNDRC Supplemental Rules, the Panel needs to determine whether the Complainant satisfies each of the afore-said prerequisites. If the answer is yes, the Panel will make a final decision in accordance with the facts and relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules; if not, the Complainant's claims shall be rejected.

### **Identity or Confusing Similarity**

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has right to. The Panel notes that the Complainant mainly proves the rights on the trademarks "PAUL SMITH", "*Paul Smith*" and "*PS · Paul Smith*" to claim the Disputed Domain Name is identical or confusingly similar to above trademarks. So the Panel has to first analyze and decide if the Complainant owns prior trademark rights on aforesaid marks.

According to the information printout of the Complainant's trademarks in China, USA and WIPO provided by the Complainant, the Complainant has registered



many “PAUL SMITH”, “*Paul Smith*” and “*PS · Paul Smith*” trademarks in Classes 3, 9, 14, 16, 18 and 25. For example, as early as September 7, 1995, the Complainant registered “PAUL SMITH” trademark on designed goods “Spectacle frames; Sunglasses; etc.” in Class 9 (Reg. No.: 764679); on December 21, 1995, the Complainant registered “*Paul Smith*” trademark on designed goods “Clothing; shoes; boots; etc.” in Class 25 (Reg. No.: 801433); on September 21, 2010, the Complainant registered “*PS · Paul Smith*” trademark on designed goods “Handbags; Purses; Pocket wallets” in Class 18 (Reg. No.: 7109213).

All of the above trademarks are in validity period, and the registration dates are much earlier than the registration date of the Disputed Domain Name. Thus, the Panel is of the view the Complainant enjoys prior trademark right on the marks “PAUL SMITH”, “*Paul Smith*” and “*PS · Paul Smith*”.

As such, what the panel needs to do is to make a conclusion on the identity or confusing similarity between the Complainant’s registered trademarks and the Disputed Domain Name.

The identifying part “paulsmithworld” of the Disputed Domain Name consists of “paulsmith” and “world”. The part “paulsmith” is identical to the Complainant’s trademarks “PAUL SMITH” and “*Paul Smith*”. And the other part “world” is a general word, which is a generic term bearing less distinctiveness, and can hardly distinguish the Disputed Domain Name from the Complainant’s registered trademarks. Meanwhile, the word “world” used together with “paulsmith” will easily make the relevant public associate the Disputed Domain Name with the Complainant and believe that the website is created by the Complainant to sell its goods, or is related to the Complainant in a certain way and thus cause confusion.

Therefore, the Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant’s trademarks, and the Complainant has satisfied the first condition under Paragraph 4(a) of the Policy.

### **Rights or Legitimate Interests of the Respondent**

The Complainant claims that the Respondent has never been authorized by the Complainant to use the trademarks PAUL SMITH and *Paul Smith* under any circumstances. Furthermore, the Respondent has no business relationship with

the Complainant. The Panel finds that the Complainant has already fulfilled the burden of proof required by the second condition under Paragraph 4(a) of the Policy, thus the burden of proof regarding “rights or legitimate interests” is generally on the party making the defense in the dispute resolution of a domain name, the Respondent.

The Respondent did not make any response within the scheduled time, nor did it make any explanation or provide any evidence to prove its trademark rights or any other legal rights.

In view of the foregoing facts, the Panel comes to the conclusion that the Complainant has provided preliminary evidence required by 4(a) (ii), and the burden of proof should be transferred to the Respondent, who has to prove its rights or legitimate interests over the Disputed Domain Name. However, the Respondent did not make any response or provide any evidence, and failed to furnish the proof responsibility. So the Panel can not come to the conclusion that the Respondent has legitimate rights or interest in respect of the Disputed Domain Name based on the evidence in hand.

Accordingly, the panel finds the Complainant has satisfied the second condition under Paragraph 4(a) of the Policy.

### **Bad Faith**

The Complainant also needs to establish the Respondent’s bad faith as set forth in the Paragraph 4(a)(iii) of the Policy. Under Paragraph 4(b) of the Policy, the following circumstances in particular shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) Circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have 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 you have engaged in a pattern of such conduct; or

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

(iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your 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 your web site or location or of a product or service on your web site or location.

The evidence submitted by the Complainant shows that the Complainant's trademarks "PAUL SMITH", "*Paul Smith*" and "*PS · Paul Smith*" have been registered in many countries before the registration date of the Disputed Domain Name in China, USA and other countries, and enjoy certain fame in the fashion industry. Thus, the Respondent knew or should have known the Complainant and its trademarks.

As demonstrated by the evidence submitted by the Complainant, various goods like clothing, bags, shoes and belts, which are identical or similar to the Complainant's products, are offered for sale on the website of the Disputed Domain Name. What's more, the mark "PAUL SMITH" displayed on the website of the Disputed Domain Name is nearly identical with the Complainant's "*Paul Smith*" mark in style. Based on this, the Panel may reasonably infer that the Respondent knew the Complainant and its "PAUL SMITH" mark when it created the Disputed Domain Name.

The Panel is of the view that, the Respondent registered the Disputed Domain Name similar to the renowned trademarks of the Complainant and offered for sale the products identical or similar to the Complainant's products under the circumstance that it had no legitimate interests over the Disputed Domain Name. This act will not only prevent the Complainant from reflecting its trademark in such corresponding domain name, but also mislead the public into believing that the website is the website of the Complainant, or is authorized by the Complainant, and thus cause confusion and prejudice the Complainant's legitimate interests. The Panel holds that the Respondent has registered and used the Disputed Domain Name in bad faith in accordance with the Paragraph 4(b) (ii) and (iv) of the Policy.

In light of all the above circumstances, the Panel concludes that the Complainant

has satisfied the third condition under Paragraph 4(a) of the Policy.

## **5. Decision**

For all the forgoing reasons, the Panel has decided that the Complainant has proved sufficiently all the three elements of Paragraph 4(a) of the Policy. Accordingly, the Panel rules that the Disputed Domain Name “paulsmithworld.com” should be transferred to the Complainant “PAUL SMITH GROUP HOLDINGS LIMITED” .

Sole Panelist: 

Dated: December 12,2011