



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1500737
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Zhao Xiqing
Disputed Domain Name(s):	<paulsmithboutiqueprix.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 Complainant's Authorized Representatives are S & P Legal Limited of 29 Austen Road, Guildford, Surrey GUI 3NP, United Kingdom.

The Respondent is Zhao Xiqing, of Zhengzhou City, Henan Province, P.R. China.

The domain name at issue is <paulsmithboutiqueprix.com>, registered by Respondent with Beijing Innovative Linkage Technology Limited, of 20/F., Block A, SP Tower, Tsinghua Science Park Building 8, No. 1 Zhongguancun East Road, Haidian District, Beijing 100084, P.R. China.

2. Procedural History

On 17 March 2015, the Complainant submitted a Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (“ADNDRC”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October 1999. On that same day, the ADNDRC confirmed receipt of the Complaint. The Complainant elected that this case to be dealt with by a one-person panel.

On 18 March 2015, the ADNDRC transmitted by email to the Registrar, Beijing Innovative Linkage Technology Limited, a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the ADNDRC its verification response in Chinese, confirming that the Respondent is listed as the Registrant and that the language of the registration agreement is the Chinese language.

On 19 March 2015, the ADNDRC advised the Complainant by email that, given that the language of the registration agreement is Chinese, therefore, pursuant to paragraph 11 of the Rules, the language of the proceedings would ordinarily be Chinese. The ADNDRC

requested that the Complainant submit its Complaint in the language of the registration agreement on or before 24 March 2015 or, alternatively, that the Complainant provide reasons why English should be used as the language of the administrative proceeding by that date.

On 30 March 2015, the ADNDRC sent the Complainant a notice of termination of the original action. On the same day, the Complainant submitted a new Complaint to the Hong Kong Office of the ADNDRC. The ADNDRC confirmed receipt of the Complaint, which was written in English. The Complainant elected that this case to be dealt with by a one-person panel. The ADNDRC transmitted by email to the Registrar, Beijing Innovative Linkage Technology Limited, a notification that this administrative proceeding would go forward under a new case number.

The Complaint was accompanied by an email, in the following terms, requesting that English be used as the language of the proceedings:

"There would be an additional cost to the Complainant to translate this Complaint and this would be inequitable given the damage that has been suffered to date in this matter by the operation of the infringing website. Further, it is unnecessary to incur such cost since we have written to the Registrar on several occasions, we have called and we know that the Registrar can conduct these proceedings in English. Furthermore, the Registrar has been given numerous opportunities to assist us in taking action against the infringing website but has, to date, not acknowledged our emails or telephone calls. It is for this reason that we have sought the assistance of the ADNDRC in this matter and trust that our reasons for conducting proceedings in English will satisfy the Panelist in this instance".

On 2 April 2015, the ADNDRC transmitted a Written Notice of Complaint, written in both Chinese and in English, forwarding the Complaint along with annexures to the Respondent, requesting that the Respondent submit a Response within 20 calendar days. The Notice specified the due date for the Response as being on or before 22 April 2015.

Thereafter, on 23 April 2015, the ADNDRC confirmed in an email to the parties that it had not received a Response from the Respondent within the required period of time.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the ADNDRC notified the parties that the panel in this case had been selected, with Mr. David KREIDER acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 28 April 2015, the Panel received the file from the ADNDRC and should render the Decision on or before 12 May 2015, if there are no exceptional circumstances.

In view of the Respondent's default and failure to submit timely a response to the Complaint, the panel, having discretion in the matter, agrees to the Complainant's request that English be used as the language of these administrative proceedings.

3. Factual background

The Complainant asserts that it is the true owner to the exclusive rights of the serial trademarks of PAUL SMITH. The Complainant registered the trademark “PAUL SMITH” (International Registration No.755406) through WIPO on March 20, 2001. The trademark “PAUL SMITH” has granted 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 (International Registration No. 988039) through WIPO on June 5, 2008. The trademark has granted 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 (International Registration No. 708450) through WIPO on February 11, 1999. The trademark has granted 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, and ties.

The registered trademarks PAUL SMITH (printed and in handwritten script) designate a large range of goods, such as clothes, leather products, shoes, scarves, etc., have gained a worldwide reputation after continuous extensive use and marketing throughout the world. A GOOGLE search for “PAUL SMITH” and obtained 776,000,000 results.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

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

The Disputed Domain Name is confusingly similar to the Complainant’s trademarks PAUL SMITH (printed and in handwritten script). Since the “.com” is not taken into account in the comparison, “paulsmithboutiqueprix.com” is the main part of the Disputed Domain Name, of which “paulsmith” is identical to the Complainant’s worldwide reputed PAUL SMITH and trademarks. Thus, the relevant public would easily separate it into “paulsmith” + “boutiqueprix”, when identifying the Disputed Domain Name. Further, as “boutique” and “prix” are general French words meaning “shop” and “price”, “paulsmithboutiqueprix”, as a domain name, can be easily understood as “the French website for PAUL SMITH goods”. It is obvious that “paulsmith” is the central and distinguishing element of the Disputed Domain Name.

Meanwhile, the website to which the Disputed Domain Name resolves is blatantly selling fake counterfeit PAUL SMITH goods in large quantities. This serves as good evidence proving that “paulsmithboutiqueprix” is actually viewed by the Respondent too as “the French website for PAUL SMITH goods”.

Furthermore, the images and models used on the Disputed Domain Name website are substantially similar to those used by the Complainant's trademarks PAUL SMITH (printed and in handwritten script). This is also evidence that the Respondent is promoting this website as the official Paul Smith French website for goods. Thus, the Disputed Domain Name "paulsmithboutiqueprix.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 (printed and in handwritten script).

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 (printed and in handwritten script) under any circumstances. Furthermore, the Respondent has no business relationship with the Complainant. Thus, the Respondent does not have any rights with regard to the trademark PAUL SMITH.

Secondly, the Respondent's name, address and 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

The Respondent is using the Disputed Domain Name to sell fake counterfeit products bearing the Complainant's prior registered trademarks PAUL SMITH (printed and in handwritten script). It can be easily found that the goods sold on the website by the Disputed Domain Name are also named PAUL SMITH products. The Respondent's conduct should be regarded as evidence of bad faith as prescribed in 4(b) (iv) of the Policy.

The Respondent was aware of PAUL SMITH and trademarks well before registering the Disputed Domain Name. The Complainant's PAUL SMITH (printed and handwritten script) 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 (printed and in handwritten script) trademarks, designating a large range of goods, such as clothes, leather products, shoes, scarves, have attained worldwide repute after continuous extensive uses and marketing throughout the world.

The Respondent is using the Disputed Domain Name to sell fake counterfeit products bearing the Complainant's prior registered trademarks PAUL SMITH (printed and in handwritten script), which additionally proves that the Respondent's awareness of PAUL SMITH and 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 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 the transfer of the Disputed Domain Name to Paul Smith Group Holdings Limited.

B. Respondent

The Respondent's contentions may be summarized as follows:

The Respondent, Zhao Xiqing, has defaulted and failed timely to submit a response to the Complaint.

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 Disputed Domain Name registered by the Respondent incorporates the Complainant's registered mark in its entirety and is, therefore, confusingly similar. The first element of the Policy has been established.

B) Rights and Legitimate Interests

The Respondent, Zhao Xiqing, has never been authorized by the Complainant to use the trademarks PAUL SMITH (printed and in handwritten script); has no business relationship with the Complainant; and is not generally known by the name Paul Smith. The Respondent has no rights or legitimate interests in the Complainant's marks. The second element of the Policy has been established.

C) Bad Faith

The Complainant has submitted no evidence or proof to evidence, other than the unsworn assertions of its Authorized Representative, that the Respondent registered and is using the Disputed Domain Name in bad faith, as alleged in the Complaint.

UDRP proceedings make no provision for default judgments, such as are permitted under the rules of some national courts. Paragraph 4 of the Policy mandates: "*In the*

administrative proceeding, the complainant must prove that each of these three elements are present". Such proof requires evidence beyond bare assertions by counsel.

6. Decision

The Complaint in relation to the Disputed Domain Name <paulsmithboutiqueprix.com> is dismissed **without prejudice**, should the Complainant wish to institute a new UDRP administrative proceeding.

David L. Kreider, Esq.
Panelist

Dated: 4 May 2015