



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2301716
Complainant:	Paul Smith Group Holdings Limited
Respondent:	Jbde Ybehje
Disputed Domain Name(s):	<salepaulsmith.com>

1. The Parties and Contested Domain Name

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

The Respondent is Jbde Ybehje (“**Respondent**”), of Choi Hung Road Market, Hong Kong SAR.

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

2. Procedural History

On 20 January 2023, the Complainant filed a complaint (“**Complaint**”) in respect of the Disputed Domain Name with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (“**Centre**”), pursuant to (i) the Uniform Domain Name Dispute Resolution Policy (“**Policy**”) approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999; (ii) the Rules for UDRP (“**Rules**”) approved by the ICANN Board of Directors on 28 September 2013; and (iii) the ADNDRC Supplemental Rules for the UDRP (“**Supplemental Rules**”) effective from 31 July 2015.

By email of 26 January 2023, the Centre requested from the Registrar the WHOIS information regarding the Disputed Domain Name and other related information (set out below).

By email of 27 January 2023, the Registrar provided to the Centre the Respondent’s email address and other WHOIS contact information in respect of the Disputed Domain Name. The Registrar also confirmed that (i) the Disputed Domain Name was registered by the Respondent with the Registrar; (ii) the Policy is applicable to the dispute relating to the Disputed Domain Name; (iii) English is the language of the Disputed Domain Name’s Registration Agreement; (iv) the Disputed Domain Name was registered on 27 May 2022

with an expiration date of 27 May 2023; and (v) the Disputed Domain Name was locked in accordance with paragraph 8 of the Policy.

By email of 27 January 2023, following the Centre's review of the Complaint for administrative compliance in accordance with the Policy and the Rules, the Centre advised the Complainant that the information relating to the Respondent in the Complaint did not match the information in the WHOIS records provided by the Registrar. The Centre requested the Complainant to update the information of the Respondent in the Complaint with reference to the WHOIS information by 1 February 2023.

By email of 31 January 2023, the Complainant re-submitted the Complaint amended to include the WHOIS information of the Respondent. By email of 2 February 2023, the Centre advised the Complainant that the Complaint was in administrative compliance with the Policy.

On 2 February 2023, in accordance with Articles 2(a) and 4(a) of the Rules, the Centre issued a Written Notice of the Complaint (“**Notice**”), formally notifying the Respondent of the commencement of these proceedings. The Centre advised the Respondent, *inter alia*, that, pursuant to Article 5(a) of the Rules, the Respondent was required to submit a Response to the Complaint within 20 days from the date of the Notice, i.e., by 22 February 2023. The Respondent did not submit a response by that date (or at any time prior to the issuance of this Decision).

On 23 February 2023, the Centre issued a notification of the Respondent in Default, confirming that the Centre had not received a response to the Complaint from the Respondent within the required time.

On 23 February 2023, the Centre appointed Ms. Sarah Grimmer as the sole Panelist in this matter. Prior to the appointment, Ms. Grimmer had confirmed to the Centre her availability and independence and impartiality to serve as sole Panelist in accordance with Article 7 of the Rules.

3. Factual background

The Complainant is an internationally renowned designer and trader of high-end fashion clothing, shoes, and accessories. The Complainant is the owner of the “PAUL SMITH” *Paul Smith*, and *PS · Paul Smith* trademarks which have been registered in numerous countries around the world, the first two since at least 1983 when they were first registered in the UK and the USA. The trademarks designate a large range of goods in a broad variety of international classes and have gained a worldwide reputation after continuous extensive use and marketing throughout the world.

The Respondent registered the Disputed Domain Name on 27 May 2022. The Disputed Domain Name has been locked by the Registrar and is currently active.

4. Parties' Contentions

A. The Complainant

The Complainant seeks the transfer of the Disputed Domain Name to it pursuant to paragraphs 3(c) and 4(a) of the Policy. Its contentions may be summarised as follows:

i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant contends that it is “*the true owner to the exclusive rights of the serial trademarks*” of PAUL SMITH, *Paul Smith* and *PS · Paul Smith*. In support it provides 17 registration certificates.

The Complainant argues that the main part of the Disputed Domain Name includes “paulsmith” which is identical to the Complainant’s PAUL SMITH and *Paul Smith* trademarks. The Complainant contends that “paulsmith” is the central and distinguishing element of the domain name and that the relevant public would easily distinguish between “paulsmith” and “sale”. The “.com” is not relevant for comparison purposes.

Further, the Disputed Domain Name resolves to a website containing images and models that are substantially similar to those used by the Complainant’s trademarks PAUL SMITH and *Paul Smith*. It is the Complainant’s case that the Disputed Domain Name can easily mislead consumers to mistakenly believe that it is owned or operated by the Complainant, or that the Respondent has a relationship with the Complainant.

For these reasons, the Complainant argues that the Disputed Domain Names are confusingly similar to its trademarks PAUL SMITH and *Paul Smith* and thus satisfy paragraph 4(a)(i) of the Policy.

ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name

The Complainant states that under no circumstances has the Respondent ever been authorised by the Complainant to use the trademarks PAUL SMITH and *Paul Smith*. Further, the Respondent has no business relationship with the Complainant. The Respondent’s name, address, and other related information cannot be linked with PAUL SMITH and searches undertaken by the Complainant do not establish that the Respondent has any other rights in respect of the relevant trademarks.

Therefore, the Complainant contends that the Respondent does not have any rights with regard to the trademark PAUL SMITH and accordingly, paragraph 4(a)(ii) of the Policy has been satisfied.

iii. The Dispute Domain Name has been registered and is being used in bad faith

According to the Complainant, the Disputed Domain Name resolves to a website that is blatantly selling fake counterfeit products in large quantities bearing the Complainant’s registered trademarks PAUL SMITH and *Paul Smith*, and using images and models that are substantially similar to those used by the Complainant’s trademarks PAUL SMITH and *Paul Smith*. The Complainant argues that this demonstrates that the Disputed Domain Name “*[is] actually viewed by the Respondent too as ‘the website for buying cheap PAUL SMITH goods’*”.

The Complainant submits that it can be reasonably inferred that the Respondent was aware of the PAUL SMITH and *Paul Smith* trademarks well before registering the Disputed Domain Name. The trademarks have been extensively registered throughout the world and enjoy a worldwide reputation after continuous extensive use and international marketing.

The Complainant argues that the fact that the Respondent is using the Disputed Domain Name to sell counterfeit products bearing the Complainant's prior registered trademarks is added evidence that the Respondent was aware of the relevant trademarks before registering the Disputed Domain Name.

In light of the foregoing, the Complainant submits that the Respondent's conduct should be regarded as evidence of bad faith as prescribed in 4(b)(iv) of the Policy, and that paragraph 4(a)(iii) of the Policy has been satisfied.

B. The Respondent

The Respondent has not submitted a Response to the Complaint or otherwise participated in these proceedings as of the date of issuance of this Decision.

5. Findings

The Policy provides, at paragraph 4(a), that in order for a Complainant to prevail, each of the following three conditions must be established:

- 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 Panel finds that the Complainant has established each of the three conditions, for the reasons that follow.

i. Whether the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Panel finds that the Complainant has rights in the trademarks "PAUL SMITH", *Paul Smith* and *PS · Paul Smith* through multiple registrations covering many countries and a broad range of international classes.

The Disputed Domain Name incorporates the entirety of the Complainant's "Paul Smith" trademark. The only difference is that the Disputed Domain Name includes the word "sale" before "paulsmith". "[P]aulsmith" is the distinctive and central element of the Disputed Domain Name. The addition of the word "sale" as a prefix does not distinguish it from the Paul Smith trademarks. It is well-established that in cases where the distinctive and central element of a disputed domain name is the complainant's mark and the only addition is a generic term that adds no distinctive element, the addition does not negate the confusing similarity between the disputed domain name and the mark (see, for example, ADNDRC Case HK-18010114 *Paul Smith Group Holdings Limited v Gueijuan Xu* <paulsmithsalecheaps.com>, <shopspaulsmithclearance.com>; ADNDRC Case HK-18010155 *Disney Enterprises, Inc. v. Bai Xing You* <disneysale.net>; ADNDRC Case HK-

18010188 *Paul Smith Group Holdings Limited v Xu Gueijuan* <uspaulsmithshop.com>, <paulsmithonsalestore.com>).

In fact, the addition of the word “sale” adds further confusion as it is likely to cause the relevant public to believe that the website is connected to the Complainant’s business and is where they may purchase Paul Smith goods at discounted or “sale” prices. This is confirmed by the Disputed Domain Name website content which mimics the Complainant’s legitimate website and trades off the Complainant’s reputation.

It is also well established that the domain extension, in this case “.com”, should not be taken into account when comparing the disputed domain name and the prior trademarks (WIPO Jurisdictional Overview 3.0, section 1.11.1).

For these reasons, the Panel determines that the Complainant has established that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights under paragraph 4(a)(i) of the Policy.

ii. Whether the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name

In order for the Panel to conclude that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, the Complainant must first present a *prima facie* case that Respondent lacks rights or legitimate interests, in which case the burden of proof then shifts to the Respondent to show that it does have rights or legitimate interests in the Disputed Domain Name (*OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. D2015-1149, <ojram.com>).

According to the Complainant, it has never authorised the Respondent to use the trademarks PAUL SMITH and *Paul Smith*, and the Respondent has no business relationship with the Complainant. The Respondent’s name, address, and other related WHOIS information cannot be linked with PAUL SMITH in any way and searches undertaken by the Complainant do not establish that the Respondent has any other rights in respect of the relevant trademarks.

On this basis, the Panel determines that the Complainant has presented *prima facie* evidence that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Therefore, the burden of proof shifts to the Respondent.

The Respondent has not filed a Response in these proceedings. It could have sought to establish that it came within one of the circumstances set forth at Paragraph 4(c) of the Policy which, if proven, could have provided a possible defence. The Respondent has failed to do so.

On the basis of the foregoing, the Panel determines that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name pursuant to Paragraph 4(a)(ii) of the Policy.

iii. Whether the Dispute Domain Name has been registered and is being used in bad faith

Paragraph 4(b) of the Policy provides four circumstances, which, if found to be present, constitute evidence of the registration and use of a domain name in bad faith for the purposes of Paragraph 4(a)(iii) of the Policy. Relevant to the present case, Paragraph 4(b)(iv) provides:

“(iv) by using the domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [its] 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 [its] web site or location.”

The Complainant has a world-wide reputation in its line of business which it has enjoyed for many years. The documents provided by the Complainant indicate that it registered the mark (i) “PAUL SMITH” with WIPO in 2001, in the EU in 2001, the UK in 1997 and in the US as early as 1983; (ii) *Paul Smith* in the UK in 1983 and the EU in 2010; and (iii) *PS · Paul Smith* in the UK and US in 1999.

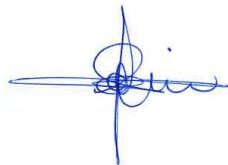
The Respondent registered the Disputed Domain Name on 27 May 2022. At that time, the Respondent must have been aware of the Complainant’s prior rights and interest in the Disputed Domain Name given the Complainant’s worldwide reputation which extended to Hong Kong, the jurisdiction of the Respondent.

It is clear from the content of the Disputed Domain Name that it is intentionally attempting to attract internet users to it by creating a likelihood of confusion with the Complainant’s mark for commercial gain in the form of profits from selling counterfeit goods. Indeed, the nature of the Dispute Domain Name in which the word “sale” precedes “paulsmith” further underscores the intention of the Respondent to attract customers by creating confusion with the Complainant’s mark.

For these reasons, the Panel determines that the Disputed Domain Name has been registered and is being used in bad faith pursuant to Paragraph 4(a)(iii) of the Policy.

6. Decision

The Panel determines that the Complainant has satisfied the requirements of Paragraph 4 of the Policy and that the relief requested by it should be granted. The Panel orders that the Disputed Domain Name <salepaulsmith.com> be transferred to the Complainant.



Ms. Sarah Grimmer
Panelist
Dated: 4 March 2023