

## **ADMINISTRATIVE PANEL DECISION**

ASOS Plc v. Lidan Amsalem

Case No. D2022-2192

### **1. The Parties**

Complainant is ASOS Plc, United Kingdom (“U.K.”), represented by Stobbs IP Limited, U.K.

Respondent is Lidan Amsalem<sup>1</sup>, Israel.

### **2. The Domain Name and Registrar**

The disputed domain name <topshopmetaverse.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint concerning the Domain Name and <asosmetaverse.com> was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 16, 2022. On June 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name and <asosmetaverse.com>. On June 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 23, 2022, providing the multiple underlying registrants and contact information disclosed by the Registrar, and inviting Complainant either to submit an amendment to the Complaint or to file a separate complaint. Complainant filed an amended Complaint concerning the Domain Name on June 27, 2022. The Center notified the Parties of the Partial Withdrawal of the Complaint on June 29, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on June 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 20, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 21, 2022.

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<sup>1</sup> At the time of the filing of the Complaint, the Respondent’s identity was masked by a privacy service.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on August 12, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

Complainant is the parent company of the ASOS group of online fashion retail companies, which includes the subsidiary ASOS.com Ltd under which the ASOS brand primarily trades. The ASOS group (“ASOS”) operates an online retail destination at “www.asos.com” together with eight country specific websites and its mobile platforms. ASOS’ business commenced in 1999, when the founders had the idea of starting an Internet enterprise through which customers could source products (such as clothing and accessories) which they had seen worn or used by television and film stars.

On February 1, 2021, Complainant acquired the “TOPSHOP” Mark from a multinational retail company. The TOPSHOP Mark dates back to 1964. In 1965, the UK publication, the Times reported on the TOPSHOP Mark as fashion for the “young and different generation”. In the 1990s, Topshop pioneered online fashion, launching an online fashion store at “www.topshop.com”, which it registered in 1998. In 1994, the flagship Topshop store was opened in Oxford Circus, London, which had become one of the most iconic stores in London, inhabiting a 90,000 square ft. space, and attracting visitors worldwide. The TOPSHOP Mark has been associated with many famous names over the years including British supermodel Kate Moss, who designed her first collection under the Mark in May 2007 and made 13 subsequent collections.

Complainant owns rights in the TOPSHOP Mark (or the “Mark”) including, but not limited to, International Trademark Registration No. 1,351,292, registered on November 4, 2016, U.S. Registration No. 5,718,445, registered on April 9, 2019, U.S. Registration No. 5,897,519, registered on October 29, 2019, U.K. Registration No. UK00003163327, registered October 7, 2016, and U.S. Registration No. 4,420,216, registered on October 22, 2013.

ASOS employs a variety of marketing channels to promote its trademarks including Internet marketing, social media (as of May 2022, ASOS has 13.1 million followers on Instagram, 7.3 million followers on Facebook, 1 million followers on Twitter, 1.1 million followers on Pinterest, and 1.3 million followers on TikTok), and magazines. ASOS has also been widely reported in the media and received awards and accolades.

Following Complainant’s acquisition of rights in the Mark in 2021, the collection under the Mark has been offered exclusively via Complainant’s ASOS domain name at “www.asos.com/topshop” and continues to feature the iconic TOPSHOP collections of clothing, shoes and accessories.

The Domain Name was registered on January 22, 2022. It resolves to a webpage that is advertising the sale of the Domain Name by GoDaddy.com for USD 650,000. Searches on the Domain Name using specialist threat profiling software, indicate evidence of phishing and malware, based on existing indicators of malware and spam activity at the Domain Name.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The above-mentioned trademark registrations, demonstrate Complainant’s rights in the TOPSHOP Mark. Complainant has built up a reputation and goodwill in the Mark in the U.K. and abroad in relation to a wide range of goods and services, including for its own-label range of men and women’s fashion together with online fashion retail services at large. Complainant submits that the generic Top-Level Domain (“gTLD”) “.com” suffix, which is an integral technical part of the Domain Name may be disregarded in determining confusing similarity under the Policy.

The Domain Name comprises the TOPSHOP Mark in its entirety, with the addition of the descriptive word “metaverse”. The term was coined in 1992 and has widely been adopted since as a generic term within the computing and gaming field, referring to “a virtual-reality space in which users can interact with a computer-generated environment and other users”.

Respondent has never been known as “TOPSHOP”. Considering the reputation of Complainant’s business and the Mark, there is no believable or realistic reason for registering or using the Domain Name other than to take advantage of Complainant’s rights in the Mark. The Domain Name was created on January 22, 2022, and by this time Complainant already had extensive rights in the Mark not only in the U.K. but also worldwide. The Domain Name fails to resolve to any relevant or legitimate content. Instead, it has been openly listed for sale on a domain name marketplace. This substantiates that Respondent has not made any *bona fide* offering of goods and services or legitimate non-commercial or fair use under the Policy. Furthermore, searches on the Domain Name using specialist threat profiling software, have revealed these to contain evidence of phishing, based on existing indicators relating to malware and spam activity at the Domain Name.

The Mark, as well as the trading and commercial activities of Complainant’s business, significantly pre-date the registration of the Domain Name in January 2022. Complainant’s brand undoubtedly had widespread global recognition, supported by various worldwide news commentary and social media activity, when the Domain Name was registered. A simple check on any of the most commonly used Internet search engines would have revealed Complainant’s brand and business.

Respondent’s registration of the Domain Name must have been to prevent Complainant from reflecting the Mark in a corresponding domain name. In view of the widespread fame and extensive use of the Mark, it would not be a plausible argument that Respondent had no knowledge of Complainant and its rights in the Mark. This, combined with the fact that Respondent incorporated into the Domain Name terms which have gained particular prominence over the course of the past months, serving as marketing buzzwords across various industries, including fashion and retail, goes to evidence that the registration of the Domain Name was an opportunistic attempt at preventing Complainant from securing the Domain Name, should they have decided to do so in accordance with any existing domain name ownership policies.

The Domain Name has been listed on a domain name marketplace, GoDaddy.com, for USD 650,000, a sum which is undoubtedly in excess of any out-of-pocket costs relating to Respondent’s registration or management of the Domain Name. Such activity further highlights Respondent’s actions as opportunistic, specifically targeting Complainant’s Mark in the midst of the media’s intensified reporting around brands and “metaverse”, with the intention of profiting should Complainant at any point decide to venture into this space.

## **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is uncontroverted that Complainant has established rights in the TOPSHOP Mark based on the aforementioned trademark registrations for it.

Furthermore, the Domain Name <topshopmetaverse.com> is confusingly similar to the TOPSHOP Mark because it incorporates that Mark in its entirety and adds the term “metaverse”, which does not prevent a finding of confusingly similarity. See *Government Employees Insurance Company v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Edward Jarman, MONSOON BLOCKCHAIN*, WIPO Case No. [D2021-4023](#).

It is also well settled that adding the gTLD, here “.com”, is not significant in determining whether a domain name is identical or confusingly similar to a trademark. See *CBS Broadcasting Inc. v. Worldwide Webs, Inc.*, WIPO Case No. [D2000-0834](#).

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

## **B. Rights or Legitimate Interests**

It is uncontroverted that Respondent is not a licensee or authorized agent of Complainant or in any other way authorized to use the TOPSHOP Mark. And Complainant maintains that to the best of its knowledge, Respondent has never been known as “TOPSHOP”.

Also, Complainant argues that considering the reputation of its business and the Mark, there is no believable or realistic reason for registering or using the Domain Name other than to take advantage of Complainant’s rights in the Mark. It points out that the Domain Name fails to resolve to any relevant or legitimate content and it has been openly listed for sale on GoDaddy. Furthermore, Complainant argues that Respondent lacks any rights or legitimate interests in the Domain Name because searches on the Domain Name using specialist threat profiling software, have revealed these to contain evidence of phishing, based on existing indicators relating to malware and spam activity at the Domain Name. See [WIPO Overview 3.0](#), Paragraph 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”).

Where, as here, Complainant has raised a *prima facie* presumption of Respondent’s lack of any rights or legitimate interests in the Domain Name, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondent has no rights or legitimate interests in the Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

It is undisputed that Complainant was using the TOPSHOP Mark before Respondent registered the Domain Name on January 22, 2022. Although Complainant was a relatively new owner of the Mark at that time, acquiring its rights in the Mark on February 1, 2021, the TOPSHOP Mark was already well-known for clothing before that time by the Mark’s prior owner. Furthermore, it is undisputed that ASOS uses a variety of marketing channels to promote its trademarks including Internet marketing, social media, and magazines, and it has received media attention. Given the renown of the Mark before and after Complainant acquired it and ASOS’s reputation, the Panel finds it is highly unlikely Respondent was unaware of the Mark when registering the Domain Name. Respondent’s bad faith registration is also evidenced by the facts that: (1) Respondent has not shown any rights or legitimate interests in the Domain Name; (2) Respondent registered a Domain Name that is exactly the same as Complainant’s registered TOPSHOP Mark merely adding a popular descriptive term; and (3) the Domain Name is a close approximation of one of Complainant’s domain names <topshop.com> that was registered in 1998.

Respondent has also been using the Domain Name in bad faith. “Parking” a domain name, as Respondent has done here, can constitute bad faith use. See, e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (holding that “passive holding” of the domain name could constitute use of the domain name in bad faith). The Panel has already found that Respondent incorporated in the Domain Name Complainant’s registered TOPSHOP Mark (which was in use for many years before the Domain Name was registered) for which Respondent lacks any rights or legitimate interests. Respondent has parked the Domain Name without using it and without submitting any evidence of any good faith use of or intention to use it. Furthermore, Complainant has adduced un rebutted evidence from searches on the Domain Name using specialist threat profiling software, of phishing and malware, based on existing indicators of malware and spam activity at the Domain Name. In use, the Domain Name will inevitably lead to confusion or disruption of Complainant’s business. For all of the aforementioned reasons, “it is not

possible to conceive of a plausible circumstance in which the Respondent could legitimately use the domain name". See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

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

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <topshopmetaverse.com> be transferred to Complainant.

*/Harrie R. Samaras/*

**Harrie R. Samaras**

Sole Panelist

Date: August 26, 2022