

## **ADMINISTRATIVE PANEL DECISION**

ASOS Plc v. 陈砚军 (Chen Yan Jun)

Case No. D2022-2608

### **1. The Parties**

The Complainant is ASOS Plc, United Kingdom, represented by Stobbs IP Limited, United Kingdom.

The Respondent is 陈砚军 (Chen Yan Jun), China.

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

The disputed domain names <missselfridgegb.com> and <missselfridgeuk.cc> (“Disputed Domain Names”) are registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2022. On July 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On July 20, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 20, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on July 21, 2022. Another amended Complaint was received on July 25, 2022 in response to a notification by the Center that several paragraphs in the amended Complaint were missing.

On July 20, 2022, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. On July 21, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 the Respondent in Chinese and English of the Complaint, and the proceedings commenced on July 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 21, 2022.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on August 26, 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**

The Complainant is the parent company of the ASOS group of online fashion retail companies, which includes ASOS Holdings Limited and ASOS.com Ltd under which the ASOS brand primarily trades.

The Complainant acquired the "MISS SELFRIDGE" brand from Arcadia Group Ltd in 2021. Following the 2021 acquisition of the brand by the Complainant, the MISS SELFRIDGE collection has been offered exclusively via the Complainant's "ASOS" domain name at: "www.asos.com/missselfridge" and continues to feature the MISS SELFRIDGE collections of clothing, shoes, and accessories.

The Complainant, through its subsidiary ASOS Holdings Limited, owns the following trademarks (each, a "MISS SELFRIDGE Trademark" and collectively the "MISS SELFRIDGE Trademarks"):

- United Kingdom trademark MISS SELFRIDGE, trademark number UK00000945589, registered since July 15, 1969;
- United Kingdom trademark MISS SELFRIDGE, trademark number UK00002002266, registered since February 23, 1996; and
- International trademark MISS SELFRIDGE, registration number 864102, registered since June 22, 2005.

The Complainant owns (via its subsidiary, ASOS.com Ltd) the domain name <missselfridge.com>.

The Complainant has a body of previous decisions relating to domain names comprising of MISS SELFRIDGE. These decisions support the ASOS group's significant portfolio of trademark applications, registrations, and reputation in the MISS SELFRIDGE brand.

Both the Disputed Domain Names <missselfridgegb.com> and <missselfridgeuk.cc> were registered on February 1, 2022. The Disputed Domain Names resolve to live websites that include the Complainant's MISS SELFRIDGE logo, and offer for sale clothing under the MISS SELFRIDGE Trademarks and further utilizes the Complainant's copyrighted images.

#### **5. Parties' Contentions**

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

The Complainant requests the Panel appointed in this administrative proceeding that the Disputed Domain Names be transferred to the Complainant.

- (i) The Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant has registered trademarks for the MISS SELFRIDGE Trademarks. The Complainant has built up substantial recognition in the MISS SELFRIDGE brand among the public. The MISS SELFRIDGE

Trademarks hold substantial reputation and goodwill, particularly when used in relation to clothing and fashion accessories and the retail of those accessories either online or via physical stores.

The addition of the Top-Level Domain (“TLD”) “.com” or “.cc” is merely a technical part of the Disputed Domain Names and may be disregarded in the determination of confusing similarity of the MISS SELFRIDGE Trademark and the Disputed Domain Names.

The Disputed Domain Names comprise of the MISS SELFRIDGE Trademark in full, with the addition of the descriptive words “GB” and “UK”. These terms are commonly used acronyms for Great Britain and the United Kingdom, the country where the Complainant and their MISS SELFRIDGE fashion brand have originated and are currently headquartered.

Considering the above, the Complainant contends that the Disputed Domain Names must be considered as confusingly similar to the earlier trademarks of the Complainant.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names

The Disputed Domain Names were both created on February 1, 2022. By this point, the Complainant already had extensive registered rights in MISS SELFRIDGE Trademark worldwide.

The Respondent is not using the Disputed Domain Names for a *bona fide* offering of goods or services.

The Complainant submits that the Disputed Domain Names resolve to live websites that include the Complainant’s MISS SELFRIDGE logo, an offer for sale clothing under the MISS SELFRIDGE Trademarks and further utilize the Complainant’s copyrighted images.

The Complainant mentioned threat profiling searches using Domain Tools software ranks both Disputed Domain Names over 98/100 respectively in terms of overall threat on the basis of phishing as well as proximity (*i.e.*, how connected the Disputed Domain Names are to other threat actors). Based on such use, the Complainant submits that the Respondent has been using the Disputed Domain Names for the purpose of luring consumers in to purchase unauthorized products from the websites at the Disputed Domain Names and places the public at significant risk of phishing and cybercrime.

The Respondent has not been commonly known by the Disputed Domain Names.

To the best of the Complainant’s knowledge, the Respondent has not been known as “MISS SELFRIDGE” at any point in time.

The only reason that the Respondent registered the Disputed Domain Names was to take advantage of the Complainant’s goodwill and valuable reputation.

The Disputed Domain Names do not resolve to any relevant or legitimate content, instead, resolve to websites that not only monetise the MISS SELFRIDGE Trademark, but also contain evidence of phishing and malware indicative of malicious targeting of the Complainant with the intention of causing damage to the MISS SELFRIDGE Trademarks and the brand.

(iii) The Disputed Domain Names were registered and are being used in bad faith

The MISS SELFRIDGE Trademarks, as well as the trading and commercial activities of the Complainant’s business significantly pre-date the registration of the Disputed Domain Names on February 1, 2022. Conducting a simple check on any of the Internet search engines would have revealed the Complainant’s brands and business.

The Complainant therefore submits that the Respondent had actual knowledge of the Complainant's brand before and at the time of the registration, and that the Disputed Domain Names were registered with prior knowledge of the Complainant's MISS SELFRIDGE Trademarks.

Using a trademark to divert traffic to the Respondent's own website has consistently been held by panelists to amount to bad faith use under the Policy.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

Paragraph 11(a) of the Rules provides that "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

Paragraph 10(b) of the Rules provides that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case"; and Paragraph 10(c) of the Rules provides that "[t]he Panel shall ensure that the administrative proceeding takes place with due expedition [...]."

The Registration Agreement is in Chinese. The Complainant requested that the language of the proceeding be English.

The Panel notes that the Respondent conducted its business at a website to which the Disputed Domain Names resolved in English. The Panel is satisfied that the Respondent has sufficient familiarity with English that the Respondent should be able to understand the language of the Complaint and has chosen not to respond. Moreover, the Respondent was given an opportunity to comment on the language of the proceeding and failed to do so.

Therefore, it will not be prejudicial to the Respondent in its abilities to articulate its arguments in English in the administrative proceeding, whereas requiring the Complainant to translate the Complaint and all supporting materials into Chinese would cause unnecessary delay to the administrative proceeding. (*Dolce & Gabbana S.r.l. v. Zhang Yali*, WIPO Case No. [D2013-1101](#)).

In order to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes, the Panel determines under paragraph 11(a) of the Rules that English shall be the language of the proceeding and the decision will be rendered in English.

### **6.2 Consolidated complaint**

Under paragraph 3(c) of the Rules that apply to both of the Disputed Domain Names, a single Complaint may relate to more than one domain name, provided that the registrant of the domain names specified in the Complaint is the same.

As the Respondent is the registrant of both of the Disputed Domain Names, the Panel finds it appropriate for the Complainant to consolidate the actions against both the Disputed Domain Names in a single Complaint.

### 6.3 Substantive Issues

The Complainant must prove, by evidence, each of the following UDRP elements:

- (i) the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) the Disputed Domain Names have been registered and are being used in bad faith.

#### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that (i) [the Disputed Domain Name] is identical or confusingly similar to a trademark or service mark in which the complainant has rights[.]”

The Complainant has established that it has rights in the MISS SELFRIDGE Trademarks. The Disputed Domain Names are a combination of the MISS SELFRIDGE Trademark, the term “GB” or “UK”, and the TLD “.com” or “.cc”. The Disputed Domain Names incorporate the MISS SELFRIDGE Trademark in its entirety. The Disputed Domain Names are similar to the domain name owned by the Complainant, <missselfridge.com>.

The Panel notes that the terms “GB” and “UK” are commonly used acronyms for Great Britain and the United Kingdom, the country where the Complainant and their “Miss Selfridge” fashion brand have originated and are currently headquartered.

Moreover, the addition of the TLD “.com” or “.cc” does not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant’s MISS SELFRIDGE Trademark.

For the above reasons, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant’s trademark, and the condition of paragraph 4(a)(i) of the Policy has been fulfilled.

#### B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the [disputed] domain name[.]”

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, the Disputed Domain Name, for the purposes of paragraph 4(a)(ii) of the Policy:

- “(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [Disputed Domain Names] or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed Domain Names], even if [the Respondent has] acquired no trademark or service mark rights; or
- (iii) [the Respondent is] making a legitimate noncommercial or fair use of the [Disputed Domain Names], without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy, the Complainant is required to first establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The burden of production would then shift to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Names.

The Complainant has established that it has rights in the MISS SELFRIDGE Trademarks. The Complainant has not licensed or otherwise permitted the Respondent to use any of the MISS SELFRIDGE Trademarks, nor have they permitted the Respondent to apply for or use any domain name incorporating the MISS SELFRIDGE Trademarks.

There is no evidence showing that the Respondent has been commonly known by the Disputed Domain Names at any point in time. The Respondent's name, 陈砚军 (Chen Yan Jun), does not appear to have any relation to the Disputed Domain Names. Merely registering the Disputed Domain Names is not sufficient to establish rights or legitimate interests.

Furthermore, the record shows that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names, because the websites to which the Disputed Domain Names resolve include the use of the Complainant's MISS SELFRIDGE logo, and offer for sale clothing under the Complainant's MISS SELFRIDGE Trademarks and further utilizes the Complainant's copyrighted images.

It appears that the Respondent is intending to monetise the MISS SELFRIDGE Trademark. The Complainant also suggested that there is evidence of phishing and malware indicative of malicious targeting of the Complainant with the intention of causing damage to their MISS SELFRIDGE Trademark and brand.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names.

The burden of production thus shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Names. The Respondent did not submit any evidence or allegation to show that it has rights or legitimate interests in the Disputed Domain Names.

Having considered the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(a)(iii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable Provider, in compliance with the Rules of Procedure, that [...] (iii) [the respondent's] domain name has been registered and is being used in bad faith.”

The relevant part of Paragraph 4(b) of the Policy explicitly states that “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: [...] (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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.”

#### *Registered in bad faith*

The MISS SELFRIDGE Trademarks were registered by the Complainant before the registration of the Disputed Domain Names.

The Respondent knew or should have known the MISS SELFRIDGE Trademarks when registering the Disputed Domain Names. A quick search of the term "MISS SELFRIDGE" would have revealed to the Respondent the existence of the Complainant and the Complainant's MISS SELFRIDGE Trademarks.

Having considered the above, the Panel finds that the Disputed Domain Name has been registered in bad faith.

*Used in bad faith*

The websites to which the Disputed Domain Names resolve include use of the Complainant's MISS SELFRIDGE logo, and offer for sale clothing under the MISS SELFRIDGE Trademark and further utilize the Complainant's copyrighted images.

The websites prominently feature the Complainant's MISS SELFRIDGE Trademarks and offer no disclosure as to the absence of any relationship between the Complainant and the Respondent. It is evident that the Respondent has intentionally attempted to attract Internet users to his website for commercial gain by creating a likelihood of confusion with the Complainant's MISS SELFRIDGE Trademarks as to the source, sponsorship, or affiliation of his website.

Having considered the above, the Panel finds that the Disputed Domain Names have been used in bad faith.

The Panel therefore finds that the Disputed Domain Names have been registered and are being used in bad faith, and thus the condition of paragraph 4(a)(iii) of the Policy has been fulfilled.

## **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 Disputed Domain Names, <missselfridgegb.com> and <missselfridgeuk.cc>, be transferred to the Complainant.

*/Peter J. Dernbach/*

**Peter J. Dernbach**

Sole Panelist

Date: September 7, 2022