

ADMINISTRATIVE PANEL DECISION

ASOS plc, ASOS.com Limited v. Jonathan Aston
Case No. D2023-0816

1. The Parties

The Complainants are ASOS plc, and ASOS.com Limited, United Kingdom, represented by Stobbs IP Limited, United Kingdom.

The Respondent is Jonathan Aston, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <asos.kids> (the “Disputed Domain Name”) is registered with Marcaria.com International, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 23, 2023. On February 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing additional registrant and contact information for the Disputed Domain Name. The Center sent an email communication to the Complainant on February 28, 2023, 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 on March 1, 2023.

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 of the Complaint, and the proceedings commenced on March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 3, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on April 11, 2023. 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 First Complainant is ASOS plc the parent company of the ASOS group of online fashion retail companies. The Second Complainant is ASOS.com which is a subsidiary of the first Complainant and the principal trading entity in the ASOS group. For present purposes nothing turns on the distinction between the two Complainants who will be referred to as “the Complainant” in this decision.

The Complainant is a leading company in the online fashion retail industry. It has a market capitalization of around GBP 3.8 billion. In the financial year ending August 31, 2021, the Complainant's underlying profit before tax was GBP 177.1 million. The Complainant is very well known. It has 6.9 million followers on Facebook, 14.2 million followers on Instagram and 1 million followers on Twitter. Currently operates an online retail destination at the website linked to the domain name <asos.com> together with eight country specific web sites and various mobile platforms, whereas it currently boasts 24.9 million active customers, offers over 85,000 products and ships to more than 239 countries.

The Complainant trades under the name ASOS and has an extensive global portfolio of trademarks for or including the term ASOS, (see for example UK registration No. 3097973 registered on August 7, 2015). These trademarks are referred to as the “ASOS trademark” in this decision.

The Disputed Domain Name was registered on December 1, 2022. This was two days after registration of domain names in the generic Top-Level domain (“gTLD”) “.kids” became generally available. There is no evidence of any use of the Disputed Domain Name by the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it has prior rights in the ASOS trademark and that the Disputed Domain Name is identical to the Complainant's ASOS trademark, given that the gTLD “.kids” does not affect the analysis as to whether the Disputed Domain Name is identical or confusingly similar to the Complainant's trade mark.

The Complainant asserts that it has not authorized the Respondent to use the ASOS mark and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

The Complainant also asserts that there is no evidence suggesting that the Respondent has any connection to the ASOS trademark in any way, and that there is no plausible good faith reason for the Respondent to have registered the Disputed Domain Name, especially after considering the relevant circumstances specifically the timing. The Complainant therefore concludes that the registration and the passive holding of the Disputed Domain Name are in bad faith.

B. Respondent

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

6. Discussion and Findings

Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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 Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the ASOS trademark. It is well established that the gTLD, in this case “.kids”, is not generally taken into account for the purpose of determining whether a domain name is identical or confusingly similar – see for example *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is identical to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the ASOS trademark. The Complainant has prior rights in the ASOS trademark which precede the Respondent’s acquisition of the Disputed Domain Name. The Complainant has, therefore, established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (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.

On the evidence the Respondent has made no use of the Disputed Domain Name in the time he has owned it. The Panel however notes that the Complainant is extremely well known and the Disputed Domain Name was registered very shortly after registration in the gTLD “.kids” became possible. In those circumstances, the Panel infers it is more likely than not that the Respondent was aware of the Complainant and its ASOS trademark and his registration was within (i) and/or (ii) of paragraph 4(b) (see above), and/or some other illegitimate purpose (paragraph 4(b) of the Policy provides a non-exhaustive list of factors).

In any event the ‘passive holding’ of a domain name corresponding to a well-known trademark may itself support a finding of bad faith - see the approach set out in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) at section 3.3 as follows:

“Can the ‘passive holding’ or non-use of a domain name support a finding of bad faith?”

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

Overall it does not generally matter that the Respondent has not as yet used the Disputed Domain Name. “Passive holding” can itself amount to bad faith registration and use where the holding involves a domain name deliberately chosen because of its association with the Complainant. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#); *Westdev Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#); *Advance Magazine Publishers Inc. and Les Publications Conde Nast S.A. v. ChinaVogue.com* WIPO Case No. [D2005-0615](#). In this case the Disputed Domain Name is identical to the Complainant's

trademark and inevitably implies an association with the Complainant. The Disputed Domain Name is therefore inherently deceptive.

Further the Panel notes the Respondent has not provided any credible explanation for any case of good faith he may have.

Accordingly, and applying the principles in the above noted UDRP decisions the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) 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 Name, <asos.kids> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: April 25, 2023