

## **ADMINISTRATIVE PANEL DECISION**

ASOS Plc, ASOS Holdings Limited, ASOS.com Limited v. 刘兵 (liu bing)  
Case No. D2022-0604

### **1. The Parties**

The first complainant is ASOS Plc., United Kingdom (the “First Complainant”). The second complainant is ASOS Holdings Limited, United Kingdom (the “Second Complainant”). The third complainant is ASOS.com Limited, United Kingdom (the “Third Complainant” and together with the First Complainant and the Second Complainant, the “Complainants,” and each a “Complainant”). The Complainants are represented by Stobbs IP Ltd, United Kingdom.

The Respondent is 刘兵 (liu bing), China.

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

The disputed domain name <missselfridgeshop.com> (the “Disputed Domain Name”) is registered with Xin Net Technology Corp. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2022. On February 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 23, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on February 23, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint in English on February 24, 2022.

On February 23, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 24, 2022, the Complainants submitted a 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.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on March 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 22, 2022.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on April 6, 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 First Complainant is the parent company of the Second Complainant and the Third Complainant. The First Complainant, which now operates exclusively as an online store part of ASOS.com, acquired the Miss Selfridge brand on February 1, 2021.

The Second Complainant is the owner of the MISS SELFRIDGE trademarks including:

United Kingdom trademark MISS SELFRIDGE *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, which designates Croatia, Monaco, and Serbia.

The Third Complainant is the owner of <missselfridge.com>.

The Disputed Domain Name <missselfridgeshop.com> was registered on August 27, 2021. The Disputed Domain Name resolved to a live site until January 21, 2022. The Respondent used the Disputed Domain Name for the purpose of luring consumers in to purchase unauthorized products from the website.

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

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

The Complainants request the Panel appointed in this administrative proceeding that the Disputed Domain Name be transferred to the Complainants. The Complaint did not specify to which Complainant the Disputed Domain Name shall be transferred.

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Second Complainant has registered trademarks for the MISS SELFRIDGE trademarks and the Complainants have developed substantial recognition with respect to the MISS SELFRIDGE trademarks through use. The use of the MISS SELFRIDGE trademarks pre-dates the registration of the Disputed Domain Name. The Disputed Domain Name wholly incorporates the MISS SELFRIDGE trademark with the addition of the descriptive term of "shop". The additional term does nothing to alter the impression of an ordinary Internet user that the Disputed Domain Name has a connection with the Complainants. The addition of the Top-Level Domain ("TLD") ".com" is also irrelevant.

(ii) The Respondent has no rights or legitimate interests in respect of the domain name

The Complainants have built reputation in the MISS SELFRIDGE brand before the Disputed Domain Name was registered. The Respondent used the Disputed Domain Name for the purpose of luring consumers to purchase unauthorized products from the website and placed the public at significant risk of phishing and cybercrime. To the best knowledge of the Complainants, the Respondent has never been known as MISS SELFRIDGE at any point in time. Nothing from the content of the Disputed Domain Name suggests that the Respondent is making a legitimate noncommercial or fair use.

(iii) The Disputed Domain Name was registered and is being used in bad faith

The MISS SELFRIDGE trademarks have a distinctive nature and the Complainants' have a colossal scope of business, it could therefore be deduced that the Respondent registered the Disputed Domain Name in order to prevent the Complainants, including the Second Complainant, the owner of the MISS SELFRIDGE trademarks, from reflecting the MISS SELFRIDGE trademarks in a corresponding domain name. It would not be a plausible argument that the Respondent had no knowledge of the Complainants and their rights in the MISS SELFRIDGE brand. The Respondent has no evidence of any actual or contemplated good faith use of the Disputed Domain Name. Based on the above, the Complainants submitted that the Disputed Domain Name was registered and used in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainants' 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 Complainants 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 Name resolved in English. The website to which the Disputed Domain Name resolved accepted payment in British Pound Sterling and targeted English-speaking customers. 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 Complainants 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

As stated in paragraph 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, in order for multiple complainants to file a single complaint against a respondent, the complainants must establish the following criteria:

“In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.”

The Panel finds that consolidation in this case is proper. On February 21, 2022, the Complaint was filed with the Center on February 21, 2022 by the Complainants and the Complainants filed the amended Complaint on February 24, 2022 against the Respondent.

As set forth above, the First Complainant is the parent company of the Second Complainant and the Third Complainant. The First Complainant, which now operates exclusively as an online store part of ASOS.com, acquired the Miss Selfridge brand on February 1, 2021. The Second Complainant is the owner of MISS SELFRIDGE trademarks. The Third Complainant is the owner of <missselfridge.com>.

Based on the above, Panel is satisfied that the three Complainants have a specific common grievance against the Respondent. Panel also sees no inequity to Respondent, who had full opportunity to object to the consolidation but failed to do so. It is therefore equitable and procedurally efficient to permit the consolidation.

## 6.3 Substantive Issues

In this UDRP proceeding, the Complainants must prove, by evidence, each of the following UDRP elements:

(i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

(iii) the Disputed Domain Name has been registered and is 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 Second Complainant has established that it is the owner of the MISS SELFRIDGE Trademarks.

The Disputed Domain Name is a combination of the Second Complainant’s MISS SELFRIDGE Trademark, the term “shop”, and the TLD “.com”. The Disputed Domain Name incorporates the MISS SELFRIDGE trademark in its entirety. The Disputed Domain Name is similar to the domain name owned by the Third Complainant, <missselfridge.com>. The term “shop” is merely a descriptive term and thus does not prevent a finding of confusing similarity between the Disputed Domain Name and the Second Complainant’s MISS SELFRIDGE trademark. Moreover, the addition of the TLD “.com” does not prevent a finding of confusing similarity between the Disputed Domain Name and the Second Complainant’s MISS SELFRIDGE trademark.

For the above reasons, the Panel finds that the Disputed Domain Name is confusingly similar to the Second Complainant's trademark and the Third Complainant's domain name, 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 Name] 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 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 [Disputed Domain Name], 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 Complainants are required to first establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. 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 Name.

The Second Complainant has established that it is the owner of the MISS SELFRIDGE trademarks, and that the Complainants have not licensed or otherwise permitted the Respondent to use any of their trademarks, nor have they permitted the Respondent to apply for or use any domain name incorporating the MISS SELFRIDGE trademarks. Furthermore, the record shows that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name, because the website to which the Disputed Domain Name resolved was used for sales of allegedly counterfeit Complainants' goods. Such use is not a legitimate noncommercial or fair use.

The Panel finds that the Complainants have made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. 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 Name. The Respondent did not submit any evidence or allegation to show that it has rights or legitimate interests in the Disputed Domain Name.

Having considered the above, the Panel finds that the Complainants have 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 online 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.”

The Complainants operate and own a well-known fashion brand. The MISS SELFRIDGE trademarks were registered by the Second Complainant long before the registration of the Disputed Domain Name. The Respondent knew or should have known the MISS SELFRIDGE trademarks when registering the Disputed Domain Name. A quick search of the term “Miss Selfridge” would have revealed to the Respondent the existence of the Complainants and the Second Complainant’s MISS SELFRIDGE trademarks, but the Respondent failed to do so. Having considered the above, the Panel finds that the Disputed Domain Name has been registered in bad faith.

The Respondent was using the Disputed Domain Name to direct Internet users to a website that sells allegedly unauthorized products. The website prominently features the Second Complainant’s MISS SELFRIDGE trademarks and offers no disclosure as to the absence of any relationship between the Complainants and the Respondent. It is evident that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Second 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 Name has been used in bad faith.

Having considered the above, the Panel finds that the Disputed Domain Name has been registered and is 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 Name <missselfridgeshop.com> be transferred to the Complainant.

*/Peter J. Dernbach/*

**Peter J. Dernbach**

Sole Panelist

Date: April 20, 2022