

DISPUTE RESOLUTION SERVICE

D00009171

Decision of Independent Expert

Asos Plc

and

Mr Lee Dolby

1. The Parties:

Lead Complainant: Asos Plc
Second Floor
Greater London House
Hampstead Road
London
NW1 7FB
United Kingdom

Respondent: Mr Lee Dolby
5 Goldfinch Road
Uppingham
Oakham
RUT
LE15 9UJ
United Kingdom

2. The Domain Name(s):

asos-usa.co.uk

3. Procedural History:

The Complaint was validated by Nominet on 14 October 2010, and was sent to the Respondent on 19 October 2010. Nominet informed the Respondent that he had until 9 November 2010 to respond to the Complaint.

No Response was filed. On 10 November 2010 the Complainant was notified that it had until 24 November 2010 to pay the requisite fee for an Expert Decision, which it duly paid.

I was thereafter contacted by Nominet and asked to confirm that I was able to provide an Expert Decision. I responded to Nominet confirming that I was able to provide a decision.

4. Outstanding Procedural Matters

The Respondent has not submitted a response to the Complaint. From the papers that have been submitted to me by Nominet, it is apparent that they have sent the Complaint to the Respondent using the contact details held on Nominet's Register.

When registering a .uk domain name applicants agree to be bound by Nominet's Terms and Conditions. Clause 4.1 of those terms and conditions states that the registrant of the domain name shall:-

*"4.1 give and keep us **notified of your correct** name, postal address and any phone, fax or e-mail information and those of your contacts (if you appoint any, see condition 5.2). This duty includes responding quickly and correctly to any request from us to confirm or correct the information on the **register**"*

In addition paragraph 2(e) of the Dispute Resolution Service Procedure (the "Procedure") states that:-

"e. Except as otherwise provided in this Procedure or as otherwise decided by us or if appointed, the Expert, all communications provided for under this Procedure shall be deemed to have been received:

i. if sent by facsimile, on the date transmitted; or

ii. if sent by first class post, on the second Day after posting; or

iii. if sent via the Internet, on the date that the communication was transmitted;

iv. and, unless otherwise provided in this Procedure, the time periods provided for under the Policy and this Procedure shall be calculated accordingly."

In light of the above it is my view that Nominet has done everything that it is obliged to do to bring the Complaint to the attention of the Respondent.

I now move on to consider the consequences of the Respondent not submitting a response.

The Procedure envisages just such a situation and provides in Paragraph 15 that:-

“c. If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party’s non compliance as he or she considers appropriate.”

I am not aware of any exceptional circumstances to explain why the Respondent should not have responded to the Complaint, and as such believe it appropriate to proceed to a Decision.

I will draw such inferences from the Respondent’s failure to respond as I think appropriate, but must keep in mind that there may be a number of reasons why a respondent might fail to serve a response, for example that they have nothing useful to say.

5. Factual Background

The Complainant was established in June 2000 under the name As Seen On Screen. It was listed on the London Stock Exchange via AIM in 2001. It subsequently abbreviated its name to ASOS in 2002. It is a substantial retailer of fashion and beauty products online. Its target audience is primarily 16-34 year olds, and it attracts over 6.9 million “unique visitors” each month to its website located at <asos.com>. According to the ranking system operated by Alexa.com, the website is ranked at position 100 in the list of the most visited websites in the UK. The Complainant has grown substantially, increasing its turnover from £19m in 2005/6, to £222m in 2009/10. Its business is not confined to the UK, and in 2010 its turnover in the USA exceeded £3.5m. It has also spent substantial sums on advertising its ASOS brand, £8m in 2008/9 and £11m in 2009/10.

The Complainant has also featured extensively in the press for a number of years, and embraced new media in the form of Facebook, where it has 319,056 “friends”, and Twitter where it has 55,197 “followers”.

The Domain Name was registered by the Respondent on 24 January 2010. It is presently operating as an affiliate site or “pay per click” site, seemingly being operated by 1&1 Internet Ltd, such that there appears on the site a number of links to third party sites, most of which appear to offer similar goods to those of the Complainant, and indeed one link is to the Complainant’s site.

6. Parties’ Contentions

I would summarise the contentions as follows –

The Complaint

The Complainant asserts that it has Rights (as defined in the Dispute Resolution Service Policy (the “Policy”)) in a name or mark identical or similar to the Domain Name as a result of its extensive reputation and goodwill in the ASOS mark which arises from its use and promotion of that mark, and which is protected by common law in the UK. It says that the Domain Name is identical or similar to its trade mark, as the Domain Name

consists of the mark in its entirety, with the addition of a hyphen and the non distinctive suffix "USA".

It asserts that the Domain Name is an Abusive Registration because –

- i) Contrary to paragraph 3(a)(i)(C) of the Policy, the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant. The Respondent has registered and uses the Domain Name to link directly to, and to route traffic to, websites which promote and provide products and services which compete directly with those of the Complainant.
- ii) Contrary to paragraph 3(a)(ii) of the Policy, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its own website by creating a likelihood of confusion with the Complainant's Trade Mark as to the source, sponsorship, affiliation or endorsement of its website. In this regard the Complainant relies on the fact that the Respondent has registered a Domain Name which is identical or similar to the Trade Mark and in which it has no legitimate interest, deliberately to attract users to its website, where there are click through links to sites which compete with the Complainant.
- iii) Contrary to paragraph 3(a)(iii) of the Policy, the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known trade names or trade marks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern. On the same date that the Respondent registered the Domain Name he also registered asos-usa.com.
- iv) The Domain Name has also been used in a way that is likely to dilute the reputation of the Trade Mark and as such is evidence of being unfairly detrimental to the Complainant's rights. The mere registration alone of the Domain Name by the Respondent and not the Complainant has meant that the Trade Mark is not as unique as it was prior to the registration of the Domain Name.
- v) The Respondent has no legitimate interest in the Domain Name and its registration and use of the Domain Name would give rise to an action of passing off under UK law.
- vi) The Domain Name has not been used for any legitimate purpose. The lack of any legitimate, good faith use suggests bad faith.
- vii) The Domain Name was registered more than 7 years after the Complainant started trading under the Trade Mark and the Complainant has substantial goodwill and reputation in the Trade Mark. Accordingly, in the absence of any legitimate interests in the Domain Name, the registration of the Domain Name by the Respondent cannot have been in good faith.
- viii) The Respondent's bad faith is exacerbated by the fact that the Complainant's Trade Mark is widely promoted, well known and famous.
- ix) Due to the fame and reputation of the Trade Mark, the Respondent has both the requisite knowledge of the Complainant and its brand/rights and the necessary abusive intention to satisfy paragraph 3(a)(i) of the Policy.
- x) The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant requests that the Domain Name be transferred to it.

The Response

No Response was filed.

7. Discussions and Findings

General

To succeed in this Complaint, the Complainant must, in accordance with paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

The Complainant must make out its case to the Expert on the balance of probabilities.

Complainant's Rights

The Policy defines Rights as follows -

"Rights includes, but is not limited to, rights enforceable under English law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business"

The Policy requires such Rights to be in a name or mark identical or similar to the Domain Name. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which rights are claimed, one must ignore the .co.uk suffix. The comparison is therefore between 'ASOS' on the one hand, and 'ASOS-USA' on the other. The only difference between the two is the use of a hyphen and the additional letters 'USA', which I think would universally be taken by users of the Domain Name to refer to the United States of America. In my opinion the mark 'ASOS' is similar to the Domain Name. Furthermore, and as a result of the extensive use of the mark, the Complainant has in my view established that it has Rights in a mark similar to the disputed Domain Name.

Abusive Registration

I now go on to consider the extent to which the Domain Name is an Abusive Registration.

The Complainant asserts that the registration of the Domain Name is an Abusive Registration for the reasons identified above. Those reasons seem to be a combination of points made in respect of the Policy; those made as a result of decisions made in the Uniform Dispute Resolution Procedure ("UDRP"); and the law at large. My own view is

that the DRS is a stand alone administrative procedure, and as such I do not find references to complaints decided under the UDRP of any great assistance, and have a similar view in respect of authorities that are cited in respect of principles of trade mark law or otherwise.

The Policy defines an Abusive Registration as -

"a Domain Name which either:

- (iii) *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR*
- (iv) *has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration. An extract from that list is as follows -

"3 a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

....

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;"

It is clear from the evidence that has been submitted by the Complainant that it has built up a significant business under the 'ASOS' mark and further that it has achieved a high level of notoriety of the mark amongst the public, at least in the UK. That notoriety was achieved prior to the registration of the Domain Name. Insofar as ASOS is a distinctive mark, it raises the obvious question as to why the Respondent should choose to register a domain name incorporating such a mark and a geographic reference relevant to the Complainant's business, and direct it to a site that shows links to third parties that compete with the Complainant. The Complainant would like me to infer from such conduct that the Domain Name was intentionally chosen so as to cause unfair detriment to and/or take unfair advantage of its Rights.

In the absence of any explanation as to why the Respondent chose the Domain Name and thereafter used it in the manner described, I believe that the inference I am being asked to draw is entirely proper. It is my view that the Domain Name was registered with the intention to confuse people into believing that it was associated with the Complainant, and thereby will likely cause disruption to the Complainant's business and/or will take unfair advantage of the Complainant's Rights.

I am unaware of any grounds that the Respondent could rely upon to show that the Domain Name is not an Abusive Registration, and the inference that I draw from the Respondent's failure to respond to the Complaint is that there are none.

8. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name or mark which is similar to the Domain Name <asos-usa.co.uk>, and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds.

The disputed Domain Name should be transferred to the Complainant.

Signed: Simon Chapman

Dated: 13 December 2010