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NATIONAL INTERNET EXCHANGE OF INDIA

9th Floor, B-Wing, Statesman House
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ASOS plc Greater London House, London vs. Ding Ding, Dingcorp, China
INDRP Case no. 1540
Arbitrator: Mr. P.K.Agrawal

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AWARD

1. The Parties

The Complainant is M/s ASOS plc, Greater London House, Hampstead Road, London, NW1 7FB, United Kingdom.

The Respondent is Ding Ding, Dingcorp, A3, JiaZhaoYe, JiangBei, Huicheng District, HuiZhou, GuangDong, China

2. The Domain Name and Registrar

The disputed domain name is <TOPSHOP.CO.IN>. The said domain name is registered with the Registrar – Dynadot LLC (IANA ID: 472).

The details of registration of the disputed domain name (as per WHOIS details relevant to the Complaint) are as follows:

- a. Domain ROID: D4EEE656BDF424E41B6DEF41BF4B94996-IN
- b. Date of creation: January 04, 2022
- c. Expiry date: January 04, 2025

3. Procedural History

- (a) A Complaint dated 25th April, 2022 has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the “Policy”) and the Rules framed thereunder.
- (b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Advocate and former Addl. Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.



- (c) In accordance with the Policy and the Rules, the copies of complaint with annexures were sent by the National Internet Exchange of India on 05.05.2022 by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint and annexures to the parties through email on 05.5.2022. The Respondent was given 14 days for reply to the complaint. Though the Notice email was served upon the Respondent email id given in WHOIS details, it could not be served upon the postmaster@topshop.co.in as it returned undelivered by Gmail due to non- acceptance by the recipient's server. Several efforts made afterwards to send emails failed for the same reason. The Complainant, through his email dated 11.5.2022 has submitted the proof of dispatch of his Complaint to the Respondent through Royal Mail. In view of this, the Complaint and its annexures may be deemed to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. The Respondent has not responded to the Complaint served to him. Since the Respondent has not responded and presented any grounds in his defence, the present proceedings have to be conducted *ex parte* as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

4. Factual Background

The Complainant in this arbitration proceedings is M/s ASOS plc, Greater London House, Hampstead Road, London, NW1 7FB, United Kingdom. The 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.

Founded in the year 1999, by Quentin Griffiths and Nick Robertson, they 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 stars of television or film.

The ASOS group (collectively "ASOS"), operates a unique online retail (including fashion) destination at www.asos.com together with eight country specific websites and its mobile platforms. As of 2021, ASOS is a leading global online fashion, beauty, gifting and living retailer and one of the UK's largest online-only fashion retailer. ASOS claims to have 24.9 million active customers, offers over 85,000 products and ships to 196 countries.

On 1 February 2021, the Complainant acquired the 'MISS SELFRIDGE', 'TOPSHOP', 'TOPMAN' and 'HIIT' brands from multinational retailing company, Arcadia Group Ltd, for £330 million.

The Complainant, (via its subsidiary, ASOS.com Ltd) owns a substantial list of top-level domain names, including for different jurisdictions (ccTLDs), which demonstrates the Complainant's vast international outreach in terms of its online presence. These domains include topshop.com, registered and used by the Complainant's predecessor for over 20 years.

The TOPSHOP brand dates back to 1964, established as a youth brand called 'Peter Robinson's Top Shop', a brand extension of the department store Peter Robinson, originally selling fashion by young British designers, such as Mary Quant and Stirling Cooper, pioneers of the 1960s British 'mod' fashion movement. In 1965, the UK publication, the *Times* reported on the TOPSHOP brand as fashion for the "young and different generation". The male clothing counterpart, 'Topman', was launched in 1978

In 1973, parent company Burton Group launched a major expansion of its womenswear division, splitting Top Shop by Peter Robinson into two chains to be known as Peter Robinson and Top Shop. Within two years, Top Shop had 55 standalone branches and by 1978, Top Shop accounted for a third of Burton's operating profits. By the start of the 1980s, the brand was commonly being referred to as 'Topshop'.

In the 1990s, Topshop pioneered online fashion, launching an online fashion store at www.topshop.com, registered in 1998. Topshop has been among the few chain shops to work with high-fashion brands on capsule collections. In 1994, it launched a collection with Red or Dead. The TOPSHOP brand has been associated with many famous names over the years. In May 2007, British supermodel Kate Moss, designed her first collection for the brand and made a total of 13 subsequent collections.

Following the Complainant's acquisition of Arcadia Group Limited in February 2021, the Complainant also now owns rights in the name TOPSHOP, registered in the name of the Complainant's subsidiary, Asos Holdings Limited. As such, the Complainant has satisfied the requirement of 'rights' in accordance with the Dispute Policy Rules

In 2015, Indian fashion e-tailer Jabong.com had announced an exclusive partnership with Arcadia Group Brands Limited, which saw the start of sales in India in relation to 'TOPSHOP' and 'TOPMAN'. This was widely reported in local branches of world-renowned publications like Elle.in.

TOPSHOP trademark has been registered for various fashion items in various jurisdictions including WIPO.

In light of the above, it is clear that the marks ASOS and TOPSHOP hold substantial reputation and goodwill, particularly when used in relation to online fashion retailing.

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Respondent's Identity and Activities

The Respondent's activities are not known. He has submitted false contact details / address on WHOIS. The Respondent has not responded to the Notice and complaint served upon him through emails and couriers.

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to **element (i)**, the Complainant submits that they have registered trademarks for TOPSHOP pre-dating the registration of the Disputed Domain Name, substantial, goodwill in the TOPSHOP name dating as far back as 1964 and evidence of commercial activity in India since 2015.

The Complainant submits that the INDRP does not explicitly mention where the trade mark rights need to be registered, but merely requires rights to be present at the time of filing the INDRP complaint. The Complainant submits that there have been recent decisions where the complaining party has relied on UK and EUTM rights, which were held to be sufficient for the purposes of establishing 'rights' in a INDRP dispute concerning the domain <what3words.in> (What3Words Limited v. Vinit Saxena. INDRP Case No. 1229/2020). The Complainant owns earlier UK and EU rights in the TOPSHOP name.

Further or in the alternative, the Complainant submits that it is evident from the TOPSHOP brand's active trading in India since as early as 2015 that it enjoys goodwill and a reputation and *ergo* unregistered or common law trademark rights. The TOPSHOP mark has become a distinctive identifier which consumers associate with the Complainant's goods and/or services. Accordingly, TOPSHOP is the name in which the Complainant has rights.

The Complainant submits that the Disputed Domain Name is identical to the Complainant's TOPSHOP mark as it incorporates the TOPSHOP term verbatim. The Complainant requests that the Panel omit the suffix extension 'in' as this is merely a technical requirement for domain names in India (Urban Outfitters, Inc. v. Machang. INDRP Case No. 601/2014).

Accordingly, the Complainant contends that the first condition that Respondent's domain name is identical or confusingly similar to a name,

trademark or service mark in which the Complainant has rights, as per Paragraph 4 (a) of the Policy has been satisfied.

In relation to **element (ii)**, the Complainant contends that the Respondent does not have any legitimate interest in using the disputed domain name. Based on the Complainant's reputation, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights. The Respondent can demonstrate no legitimate interest in the Disputed Domain Name. The Respondent registered the Disputed Domain Name after the Complainant had established rights in its well-known trademarks through extensive use and registration in various countries.

The Complainant submits that to the best of their knowledge, the Respondent has never legitimately been known as 'TOPSHOP' at any point in time. The use of the Complainant's TOPSHOP trade mark in the domain name which in an indicator of trade origin of the Complainant and the Complainant alone, further used to host a website featuring pay-per-click ads mentioning the Complainant as promoting related goods and services leads the Complainant to conclude that the only reason why the Respondent registered the Disputed Domain Name was to take advantage of the Complainant's goodwill and valuable reputation. No other logical or reasonable conclusion can be gleaned.

The Complainant submits that the Disputed Domain Name, since the date of its registration by the Respondent on 4 January 2022 has been used to host click-ads referencing the Complainant's TOPSHOP and ASOS brands. No other use has been exemplified. Such use does not constitute a bona fide offering of goods and/or services

The use of the pay—per click advertisement creates monetization revenue for the Respondent from internet users' visits to content featured at the Disputed Domain Name. Therefore, the Respondent cannot come within Policy, Paragraph 6(c) of the INDRP Policy. The Complainant submits that nothing about the Disputed Domain Name suggests that the Respondent is making a legitimate non-commercial or fair use of it.

Based on the above-mentioned arguments, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as per Paragraph 4 (b) of the Policy.

Regarding the **element (iii)**, the Complainant contends that the bad faith is implicit in the registration of the Disputed Domain Name. The Complainant reiterates their comments that the TOPSHOP brand is established worldwide and has demonstrated commercial presence in India for many years prior to the registration of the Disputed Domain Name.

Therefore, the Complainant submits that the Respondent had knowledge of the Complainant's TOPSHOP brand and that the Disputed Domain Name was registered with the Complainant in mind.

The Complainant submits that the Respondent has registered the Disputed Domain Name in bad faith by intentionally attempting to attract Internet users to the content hosted at the Disputed Domain Name, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (as per INDRP Policy Paragraph 7(c)).

The Complainant submits that the TOPSHOP trade mark, as well as the trading and commercial activities of the Complainant's business around the mark, both globally as well as in India, significantly pre-date the registration of the Disputed Domain Name in January 2022. As evidenced in the Complaint, the Complainant's business, as well as the TOPSHOP brand at the date of the registration of the Disputed Domain Name undoubtedly had widespread global recognition, supported by various worldwide news commentary, social media activity, endorsements and collaborations. Indeed, a simple check on any of the most commonly used Internet search engines for 'TOPSHOP' would have revealed the Complainant's business and the reputation of the TOPSHOP name.

The Complainant therefore submits that the Respondent had actual knowledge of the Complainant before and at the time of the registration, and that the Disputed Domain Name was registered with prior knowledge of the Complainant's TOPSHOP's brand. Moreover, it is submitted that the Disputed Domain Name was registered with the sole purpose of creating an association with the Complainant, which is highlighted by the Respondent's use of the Disputed Domain Name for the purposes of pay-per-click advertisements which expressly mention the Complainant's brand.

On these facts, the Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith.

B. Respondent

The Respondent did not submit any response (evidence or argument) indicating his relation with the disputed domain name <TOPSHOP.CO.IN> or any trademark right, domain name right or contractual right.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance

with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable”.

According to the Policy, the Complainant must prove that:

- (i) The Registrant’s domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant’s has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant’s domain name has been registered or is being used in bad faith.

Although Respondent has not offered any arguments to defend himself on this complaint, the default does not automatically result in a decision in favour of the Complainant. The burden remains with Complainant to establish the three elements of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

The disputed domain name <TOPSHOP.CO.IN> was registered by the Respondent on January 04, 2022.

The Complainant is an owner of the registered trademark “TOPSHOP” for the last many years. The Complainant is also the owner of the similar domains as referred to in the Complaint. These domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is <TOPSHOP.CO.IN>. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon’ble Supreme Court of India has held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for “TOPSHOP” products would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that “When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” it is identical or confusingly similar for purposes of the Policy.



Therefore, I hold that the domain name <TOPSHOP.CO.IN> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's 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 Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or
- (iii) The Registrant is making a legitimate non-commercial 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.

In Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

The Respondent has not responded in this case despite sufficient notice. There is also no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant / Respondent is not TOPSHOP as per WHOIS details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "TOPSHOP" or to apply for or use the domain name incorporating said trademark. The

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domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <TOPSHOP.CO.IN> under INDRP Policy, Para-4(ii).

C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant has 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 the Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.



The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

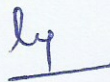
In WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <TOPSHOP.CO.IN> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal

Sole Arbitrator

Dated: 19th May, 2022