Complainant: ASOS plc
Respondent: YE LI
Case Number: DHK-1700139
Contested Domain Name: <asos.hk>
Panel Member: M. Scott Donahey

1. Parties and Contested Domain Name

The Complainant in this case is ASOS plc, a company organized under the laws of England and Wales, whose address is listed as Second Floor, Greater London House, Hampstead Road, London, NW1 7FB, United Kingdom (“Complainant”). Its authorized representative is So Keung Yip & Sin, 1009-1012, 10/F, Nan Fung Tower, 173 Des Voeux Road, Central, Hong Kong.

The respondent is YE LI, whose status is unknown and whose address is unknown (“Respondent”). Respondent gives an email address as namepros@163.com.

The domain name in dispute is <asos.hk>. The registrar of the domain name is 1API GmbH (the “Registrar”).

2. Procedural History

On 14 March 2017, pursuant to the Hong Kong Internet Registration Corporation Limited (HKIRC) Domain Name Dispute Resolution Policy (the “Policy”), the HKIRC Rules of Procedure (the “Rules” and the Hong Kong International Arbitration Centre Domain Name Dispute Supplemental Rules (the “HKIAC Supplemental Rules”), the Complainant submitted a complaint in the English language to the Hong Kong International Arbitration Centre (the “HKIAC”) and elected this case to be dealt with by a one-person panel.

On 15 March 2017 the HKIAC sent an acknowledgement of receipt of the complaint to Complainant and sent a copy of the complaint to the Registrar, requesting that the Registrar verify that Respondent was the registrant of the domain name at issue and that the Registrar confirm the contact details. On that same date, the Registrar
confirmed that Respondent was the registrant of the domain name and confirmed Respondent’s email address.

On 17 March 2017, the HKIAC notified Respondent of the commencement of the proceedings in Chinese and English, informing Respondent that a response must be filed no later than 10 April 2017. On that same date, the HKIAC requested that the Registrar confirm that a lock had been put on the disputed domain name and the Registrar so confirmed.

On 11 April 2017, the HKIAC notified the parties in Chinese and English that Respondent had failed to respond to the complaint and that Respondent was therefore in default. On 18 April 2017, the HKIAC notified M. Scott Donaher that he had been selected to act as the sole panelist in this matter, subject to his confirmation that he could act independently and impartially between the parties, and he did so confirm. On 19 April 2017, the HKIAC notified the parties of the Panel’s appointment. The Panel determines that the appointment was made in accordance with the Supplemental Rules.

3. Factual Background

For the Complainant

Complainant produced evidence that on 3 March 2011 the Hong Kong Trademark Registry had issued a registration to Complainant of the mark ASOS, and subsequent registrations of the mark ASOS on 15 June 2015. Complaint, Annex 3. Complainant also has trademark registrations for the ASOS and related marks in various other jurisdictions. Complaint, Annex 4.

Complainant is the parent company of the ASOS group of online fashion retail companies under which the ASOS brand primarily trades. The ASOS group operates a fashion destination having five language-specific websites, and also offers magazine social media channels, including Instagram, Facebook, and Twitter. Since 2000, Complainant’s trademarked products have been sold worldwide through the web site to which the domain name <asos.com> resolves.

In 1998 when the business was first established the enterprise was called “AsSeenOnScreen” and Complainant was originally known as As-Seen-On-Screen.com Limited. The initial domain name used in conjunction with Complainant’s business was <asseenonscreen.com>. Almost immediately Complainant’s personnel began to refer to the business in abbreviated fashion (no pun intended) as “ASOS.” This was followed by the registration of the domain name <asos.com> and of the trademark and service mark ASOS.

Complainant had total worldwide sales in 2012 totaling more than 481.6 million British Pounds, and during the period 2007 through January 2017, visits to the web site to which <asos.com> resolves grew from 46,411 in 2011 for the year 2007-2008
to 4,464,395 during the period 2015 through January 2017. Complainant has received various awards and accolades for its products. Complaint, Annex 6.

Respondent registered the disputed domain name on 23 October 2013, some thirteen years after Complainant began selling its goods through the web site to which the domain name <asos.com> resolves and almost 31 months after Complainant had first registered its ASOS trademark in Hong Kong.

Complainant has not authorized or licensed Respondent to use its trademarks in any way, nor does Respondent’s name relate to the disputed domain name.

On 21 August 2014, Complainant received an email from a party reasonably believed to be Respondent, offered to sell the disputed domain name to Complainant. On 9 10 September 2014, Complainant sent Respondent a cease and desist letter by email. Complainant received a response indicating an asking price of US$ 8500, which was reduced to US$ 6500 on 30 September 2014 and admitting that Respondent had also registered the domain name <asos.com.mx>. Complaint, Annex 9. There were several subsequent cease and desist emails and offers to sell exchanged. Complaint, Annexes 10, 11, 12, 15 and 16.

Moreover, Respondent has registered domain names corresponding to other well-known brands and has been ordered to relinquish domain names for such reasons by other panels. Complaint, Annex 19.

For the Respondent

Respondent did not reply to the Complaint.

4. Parties’ Contentions

The Complainant

Complainant contends that the disputed domain name <asos.hk> is identical to or confusingly similar to Complainant’s ASOS trademark in that it consists of Complainant’s ASOS mark and the ccTLD .hk. Complainant asserts that Respondent has no rights or legitimate interests in respect of the domain name at issue in that Complainant has never authorized or licensed Respondent to use its registered marks in any way. Finally, respondent alleges that Respondent has registered and is using the domain name at issue in bad faith in that Respondent has made numerous offers to see the domain name at issue to Complainant, that Respondent has registered domain names corresponding to other well-known brands and that Respondent has been ordered by other domain name panels to transfer the domain names to the respective complainants.

The Respondent
Respondent did not reply nor offer any denial or defense to Complainant’s allegations.

5. Findings

According to Paragraph 4a of the HKDNR Domain Name Dispute Resolution Policy (the "Policy") which is applicable hereto, the Complainant has the burden of proving that:

(i) the Disputed Domain is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights; and

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

(iii) the Disputed Domain has been registered and is being used in bad faith; and

(iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.

(1). Identical/confusing similarity

The disputed domain name consists of Complainant’s registered trademark ASOS and the country code suffix .hk. It has long been established that the TLD suffix is to be disregarded in conducting an analysis of whether the domain name is identical or confusingly similar to a trademark in which the complainant has rights. Accordingly, the Panel finds that the domain name at issue is identical to Complainant’s trademark and service mark which has been registered in Hong Kong.

(2). Rights or Legitimate Interests of Respondent

Complainant alleged that Respondent had no rights or legitimate interests in respect of the domain name at issue in that Complainant never authorized or licensed Respondent to use its mark in any way. Respondent failed to respond and to assert that it has any rights or legitimate interests in respect of the domain name at issue. In such circumstances, Respondent’s failure to meaningfully deny Complainant’s allegations is fatal. The Panel finds that Respondent has no rights or legitimate interests in respect of the domain name at issue.

(3). Bad faith

Complainant has demonstrated that the domain name at issue has resolved to a web site on which the domain name at issue is being offered for sale. Moreover, Complainant has correspondence in which Respondent has made repeated offers to
sell the disputed domain name to Complainant. Moreover, Complainant has cited the Panel to other domain name case decisions in which Respondent has been found to have acted in bad faith concerning the registration of domain names corresponding to the trademarks of others. Finally, the ASOS mark is a coined term. It is inconceivable that it could be used in a domain name without being used in bad faith. See, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Accordingly, the Panel finds that the domain name at issue has been registered and is being used in bad faith.

(4). If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name

It is impossible to determine from the registration record whether Respondent is an individual person, a corporation, an unincorporated business entity or some other organization. Where a respondent has failed to allege or where there are no facts that establish that the respondent is an individual person, this analysis does not apply.

6. Conclusions

For all of the above reasons, the Panel orders that the domain name at issue, <asos.hk>, be transferred to Complainant.

M. Scott Donahey

Dated: 8 May 2017