

ADMINISTRATIVE PANEL DECISION

Taojing International Limited, Zenni Optical, Inc. v. Jon Tahabsim, Web Street
Case No. D2022-2358

1. The Parties

Complainants are Taojing International Limited, Hong Kong, China, and Zenni Optical, Inc., United States of America (“United States” or “U.S.”), represented by Green & Green Law Offices, United States.

Respondent is Jon Tahabsim, Web Street, United States.

2. The Domain Name and Registrar

The disputed domain name <zenniopticaexpress.com> is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2022. On June 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

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 Respondent of the Complaint, and the proceedings commenced on July 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2022. Respondent submitted an informal communication to the Center on May 4, 2022, before the disputed was formally commenced. Respondent did not submit any response. On August 1, the Center received an informal communication from Respondent. Complainant opted to continue with the proceeding. Accordingly, the Center notified the proceeding to panel appointment.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on August 16, 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

A. Complainants

Complainant Taojing International Limited (“Taojing”), a company based in Hong Kong, China, is the owner of the marks ZENNI and ZENNI OPTICAL for eyeglasses and related goods and services, which Taojing and its predecessors-in-interest have used for over a decade prior to the registration of the disputed domain name. Complainant Zenni Optical, Inc. (“Zenni Optical”), a company based in California, United States, is Taojing’s exclusive licensee for various rights in the ZENNI and ZENNI OPTICAL marks, and particularly as to the websites associated with the domain names <zenni.com> and <zennioptical.com>.

Prior UDRP panels have found under such circumstances that it is appropriate for companies to bring a joint complaint where:

(i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants’ individual rights in a similar fashion; (ii) it would be equitable and procedurally efficient to permit the consolidation; or in the case of complaints brought (whether or not filed by multiple complainants) against more than one respondent, where (i) the domain names or the websites to which they resolve are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.

See Section 4.16 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions ([“WIPO Overview 3.0”](#)).

Complainants Taojing and Zenni Optical (collectively “Complainants”) own trademark registrations for the marks ZENNI and ZENNI OPTICAL. These include, among others, U.S. Registration Nos. 3389855 for ZENNI (registered February 26, 2008) and 3597735 for ZENNI OPTICAL (registered March 31, 2009).

The Panel thus finds that it is appropriate to have joint Complainants in this proceeding.

B. Disputed Domain Name

The disputed domain name was registered on November 4, 2020. The disputed domain name has been linked to a website containing negative assertions regarding the products and services offered by Complainants under the ZENNI and ZENNI OPTICAL marks. At the time the Complaint was filed, the disputed domain name appears to not be linked to an active website. Respondent nevertheless has no affiliation with Complainants, nor any license to use their marks.

5. Parties’ Contentions

A. Complainants

Complainants contend that (i) the disputed domain name is identical or confusingly similar to Complainants’ trademarks, (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

Specifically, Complainants contend that they own the ZENNI and ZENNI OPTICAL marks, which have been prominently featured in global media outlets including Forbes, Newsweek, and Consumer Reports. Complainants contend that Respondent has incorporated Complainants’ well-known ZENNI and ZENNI OPTICAL mark into the disputed domain name and merely added the dictionary term “express”, which consumers will associate with the online retail of Complainants’ ZENNI and ZENNI OPTICAL products.

Complainants contend that Respondent lacks rights or legitimate interests in the disputed domain name, and rather has registered and is using it in bad faith, having simply acquired the disputed domain name for

Respondent's own commercial gain, potentially in a fraudulent scheme.

B. Respondent

As noted, Respondent sent an informal communication to the Center. Respondent did not reply to Complainants' contentions, but rather mentioned that the "account was deleted".

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel must first determine whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainants have rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that it is. The disputed domain name <zenniopticalexpress.com> incorporates in full Complainants' registered ZENNI and ZENNI OPTICAL marks and merely adds the term "express".

Numerous UDRP panels have agreed that supplementing or modifying a trademark with dictionary terms does not make a domain name any less "identical or confusingly similar" for purposes of satisfying this first prong of paragraph (4)(a)(i) of the Policy. See, for example, *Microsoft Corporation v. Step Web*, WIPO Case No. [D2000-1500](#) (<microsofthome.com>); *Wal-Mart Stores, Inc. v. Horoshiy, Inc.*, WIPO Case No. [D2004-0620](#) (<walmartbenefits.com>); *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (<ge-recruiting.com>).

The Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark in which Complainants have rights in accordance with paragraph (4)(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel next considers whether Complainants have shown that Respondent has no "rights or legitimate interests", as must be proven to succeed in a UDRP dispute. Paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name "in connection with a *bona fide* offering of goods or services"; (ii) demonstration that respondent has been "commonly known by the domain name"; or (iii) "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".

The Panel notes that the disputed domain name has been used to resolve to a website containing negative assertions regarding the products and services offered by Complainants under the ZENNI and ZENNI OPTICAL marks. While in some instances, criticism may constitute "fair use", to support that allegation, "the respondent's criticism must be genuine and noncommercial". See Section 2.6.1 of [WIPO Overview 3.0](#). UDRP panels have tended to weigh against making a finding of "rights or legitimate interests" where there is genuine concern about "impersonation." *Id.* at Section 2.6.2.

Respondent in this proceeding did not respond to Complainants' allegation with any arguments or evidence that would support a claim of Respondent's rights or legitimate interests in the disputed domain name. Rather, Respondent merely stated that the "account was deleted".

The Panel finds that Complainants have provided sufficient evidence for a *prima facie* case that Respondent lacks "rights or legitimate interests" in accordance with paragraph 4(a)(ii) of the Policy, which Respondent has not rebutted.

C. Registered and Used in Bad Faith

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. As noted in Section 4 of this Panel's decision, the disputed domain name has been linked to a website containing negative assertions regarding the products and services offered by Complainant's under the ZENNI and ZENNI OPTICAL marks. As further noted above, while genuine criticism may avoid a finding of bad faith under the UDRP, bad faith may be found where there remains a likelihood of confusion.

Respondent did not provide any substantive reply to Complainants' contentions in this proceeding, and instead indicated that the "account was deleted". It further appears that the disputed domain name was no longer linked to an active website at the time that the complaint was filed. It is well established that having a passive website does not necessarily shield a respondent from a finding of bad faith. See [WIPO Overview 3.0](#), Section 3.3, which notes that the "non-use of a domain name" does not necessarily negate a finding of bad faith. Rather, a panel must examine "the totality of the circumstances", including, for example, whether a complainant has a well-known trademark, and whether a respondent conceals his/her identity and/or replies to the complaint." Respondent here used a privacy service and provided apparently inaccurate contact details, rendering the UDRP package from the Center undeliverable. Respondent did not formally respond to the Complaint, nor to prior correspondence from Complainants. Furthermore, Complainants have demonstrated a high level of consumer exposure to their marks. See *Taojing International Limited, Zenni Optical, Inc. v. 杨智超 (Zhichao Yang)*, WIPO Case No. [D2021-4137](#); *Taojing International Limited, Zenni Optical, Inc. v. Yaozhong Chen Yaozhong Chen*, WIPO Case No. [D2022-2169](#).

Therefore, the Panel finds that Respondent registered and is using the disputed domain name in bad faith for purposes of paragraph (4)(a)(iii) of the Policy.

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 <zenniopticaexpress.com> be transferred to Complainants.

/Lorelei Ritchie/

Lorelei Ritchie

Sole Panelist

Date: August 30, 2022