

ADMINISTRATIVE PANEL DECISION

Taojing International Limited and Zenni Optical, Inc. v. James J. O'Brien Case No. D2022-4050

1. The Parties

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

The Respondent is James J. O'Brien, United States.

2. The Domain Name and Registrar

The disputed domain name <zenniopticalrheem.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 the Respondent of the Complaint, and the proceedings commenced on November 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 25, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on December 9, 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 Complainants are in the eyeglasses business. The Complainant, Taojing International Limited, owns the trademark ZENNI OPTICAL (and other marks with the word “Zenni”) and enjoys the benefits of registration of that mark in multiple countries, including the United States (e.g., Registration No. 3,597,735, registered on March 31, 2009). The Complainant, Zenni Optical, Inc., is the international licensee of this mark for marketing on the Internet, and is the exclusive operator of the online retail shops at the domain names <zennioptical.com> and <zenni.com>.

According to the Whois records, the disputed domain name was registered on June 7, 2022. The Respondent has used the disputed domain name to display pay-per-click advertisements, including links to providers of goods and services competitive to the Complainants.

5. Parties’ Contentions

A. Complainants

The Complainants contend that the disputed domain name is identical or confusingly similar to the Complainants’ trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

A. Procedural Issue – Consolidation of Multiple Complainants

UDRP panels have articulated principles in accordance with paragraph 10(e) of the Rules governing the question of whether a complaint filed by multiple Complainants may be brought against one or more respondents. These criteria encompass situations in which: (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 in a similar fashion; and (ii) it would be equitable and procedurally efficient to permit the consolidation. The burden of showing that consolidation is proper falls on the Complainants.

The Complainants have provided sufficient evidence to support consolidating them. They share a legal interest and grievance. Specifically, the Complainant, Taojing International Limited, is the owner of the mark ZENNI OPTICAL (among others), and the Complainant, Zenni Optical, Inc., is the international licensee of this mark for marketing on the Internet. As such, both of the Complainants have a common legal interest in a relevant right or rights that are affected by the Respondent’s conduct regarding registration and use of the disputed domain name, and both of the Complainants are the target of common conduct by the Respondent that has affected their individual legal interests. Further, it is procedurally efficient to consolidate them.

Accordingly, the Panel will consolidate the Complainants.

B. Identical or Confusingly Similar

This first element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainants have rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainants have demonstrated its rights in the ZENNI OPTICAL mark by providing evidence of a trademark registration for the mark.

This test for confusing similarity typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. In this case, the disputed domain name incorporates the ZENNI OPTICAL mark in its entirety. Though the disputed domain name also contains the term “rheem,” the ZENNI OPTICAL mark remains clearly recognizable for a showing of confusing similarity under the Policy.

The Complainants have satisfied this first element under the Policy.

C. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainants have made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainants make that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainants). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainants assert, among other things, that: (1) the use of the disputed domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering of goods or services where such links compete with or capitalize on the reputation and goodwill of the Complainants’ mark or otherwise mislead Internet users, (2) the Respondent has no trademark rights corresponding to the disputed domain name, and (3) the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

The Panel finds that the Complainants have made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent’s favor. Accordingly, the Panel finds that the Complainants have established this second element under the Policy.

D. Registered and Used in Bad Faith

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent’s bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent uses the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent’s 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 the respondent’s website or location or a product or service on the respondent’s website or location.

Because the ZENNI OPTICAL mark is well known and because it is subject to registrations in countries around the world, the Panel finds it likely that the Respondent was aware of it when he registered the disputed domain name, and indeed targeted the Complainants and their marks when he registered the disputed domain name. In the circumstances of this case, the mere registration of a domain name that is confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. *Government Employees Insurance Company v. Joel Rosenzweig, RegC*, WIPO Case No. [D2021-1221](#). Bad faith use is shown from the Respondent’s activities of using the disputed domain name to present pay-per-click links for commercial gain. *Id.* For these reasons, the Panel finds that the Complainant has successfully met this third element.

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 <zenniopticalrheem.com> be transferred to the Complainants.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: December 23, 2022