

ADMINISTRATIVE PANEL DECISION

Taojing International Limited and Zenni Optical, Inc. v. Katie Zenisek,
zeni_light
Case No. D2022-4056

1. The Parties

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

Respondent is Katie Zenisek, zeni_light, United States.

2. The Domain Name and Registrar

The disputed domain name <zenilight777.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 28, 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 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 Respondent of the Complaint, and the proceedings commenced on November 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 24, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on November 30, 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

Complainants state in its Complaint and provide evidence in the respective Annexes sufficient to support that Complainant Taojing International Ltd., a Hong Kong Limited Company and its international trademark licensee for Internet marketing, Zenni Optical, Inc., a California corporation based in Novato, California (collectively “Complainant”) is a well-known global online retailer of prescription glasses offered under the trademarks ZENNI and the same term incorporated into its trademark ZENNI OPTICAL (collectively, the “ZENNI Marks”), and also the exclusive licensed operator of the websites accessed through Complainant’s official domain names which incorporate the ZENNI Marks, <zennioptical.com> and <zenni.com>, registered on April 19, 2003 and May 1, 2002 respectively, used to promote the same online prescription glasses products and services on its official websites at “www.zenni.com” and “www.zennioptical.com” (the “Official ZENNI Marks Websites”).

Complainant has used the ZENNI Marks for online retail stores for prescription glasses and a range of optical and prescription glasses products and services for over 20 years and owns multiple trademark registrations in the U.S., where Respondent appears to be located, and around the world, including U.S. Trademark Registration No. 3389855 ZENNI, registered on February 26, 2008, and claiming a first use date of September 30, 2002; and U.S. Trademark Registration No. 3597735 ZENNI OPTICAL, registered on March 31, 2009 for a range of prescription eyeglasses products and online retail store services, and claiming a first use date of September 30, 2002.

The disputed domain name was registered on June 21, 2022, and resolves to a parked page that includes links to Complainant’s competitors in its online retail optical products industry.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant’s trademark; that 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

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint, notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall “draw such inferences therefrom as it considers appropriate”.

Where no Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that the requirements for each of the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these elements in more detail below.

The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected

UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.2.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the ZENNI Marks for its prescription eyeglasses products and online retail optical services in its registrations for the ZENNI Marks registered as early as 2008 claiming use dating back to 2002. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting trademark registration documents in the name of the entities comprising Complainant and assignments through predecessors in interest to Complainant the Panel has reviewed at the U.S. Patent and Trademark Office online “Assignments on the Web” database and therefore, Complainant has demonstrated it has rights in the ZENNI Marks. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

Complainant also contends the ZENNI Marks to be “well-known”. The Panel finds Complainant has provided sufficient evidence in the Annexes submitted for the Panel to reasonably conclude the ZENNI Marks are well known based on the substantial recognition of Complainant and its products and services identified by the ZENNI Marks in leading national and international trade and general consumer publications featuring articles on leading providers of online prescription eyeglasses and optical product services.

With Complainant’s rights in the ZENNI Marks established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant’s ZENNI Marks. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7.

Prior UDRP panels have held that in cases where a domain name wholly incorporates a complainant’s registered mark, or where at least a dominant feature of a complainant’s registered mark is recognizable in the domain name, the domain name will normally be considered confusingly similar for purposes of the Policy despite the addition of other words to such marks. [WIPO Overview 3.0](#), section 1.8 (“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”). See also *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#).

A side-by-side comparison between the disputed domain name and Complainant’s ZENNI mark shows the ZENNI mark is essentially incorporated in its entirety phonetically and serves as the dominant feature of the disputed domain name. The appended term that follows the misspelled ZENNI mark, “light777” appears either meaningless or possibly as Complainant contends an intentional misspelling related to Complainant’s ZENNI OPTICAL mark, but the Panel is not persuaded and need not be for the first element to be satisfied.

Complainant’s ZENNI mark as incorporated into the disputed domain name has one minor distinction, the deletion of a second occurrence of the letter “n” in the mark, an obvious misspelling. This omitted letter does not significantly affect the appearance or pronunciation of the ZENNI mark. The disputed domain name, therefore, encompasses the registered ZENNI mark deleting only the second letter “n”. This is thus a clear case of “typosquatting”, *i.e.*, the disputed domain name contains an obvious misspelling of Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.9 (common, obvious, or intentional misspelling of a trademark considered by panels to be confusingly similar for purposes of the first element). See also, *Electronic Arts Inc. v. John Zuccarini*, WIPO Case No. [D2003-0141](#) (<simscity.com> “the domain name differs from [SIMCITY] trademark in only one letter; this small difference establishes the confusingly similarity with [the complainant’s trademark]”). The addition of the generic Top-Level Domain “.com” is irrelevant in determining whether the disputed domain name is confusingly similar. See, *Research in Motion Limited v. thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#); [WIPO Overview 3.0](#), section 1.11.

Based on the above, this Panel finds that the omitted letter “n” and the term “light777” does not prevent a finding of confusing similarity between the disputed domain name and Complainant’s ZENNI mark, because Complainant’s well-known ZENNI mark is fully recognizable in the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar to the ZENNI mark in which Complainant has rights and Complainant has thus satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, upon which the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the dispute domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) of the Policy lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under paragraph 4(c)(i), is where “before any notice to you of the dispute, your 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”.

Here, the Annex to the Complaint shows the disputed domain name resolves to a parking page targeting Complainant’s field of activity with links to competitors. Complainant contends these links were created to trick Internet users into believing that the disputed domain name would direct them to an official website offering Complainant’s products and services.

Prior UDRP panels have specifically found use of a disputed domain name to resolve to a parking page competing with or capitalizing on Complainant’s trademark does not represent a *bona fide* use of the disputed domain name pursuant to paragraph 4(c)(i) of the Policy nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) of the Policy. See *Microsoft Corporation v. Charilaos Chrisochou*, WIPO Case No. [D2004-0186](#); [WIPO Overview 3.0](#), section 2.9.

Based on the foregoing decisions and evidence submitted, this Panel finds that the disputed domain name is not being used in connection with a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraphs 4(c)(i) or (c)(iii) of the Policy.

Complainant’s evidence of use in the Complaint, also supports Complainant’s contention that Respondent cannot claim prior rights or legitimate interests in the disputed domain name because Complainant’s use of the ZENNI Marks precedes the registration of the disputed domain name by over 14 years.

The second example, under paragraph 4(c)(ii) of the Policy, is a scenario in which a respondent is commonly known by the domain name. Complainant states that Respondent is not related in any way to Complainant, does not carry out any activity for, nor have any business with Respondent. Neither has Complainant granted Respondent any license, permission, or authorization to use the ZENNI mark, that is used and clearly recognizable in the disputed domain name or to apply for registration of the disputed domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#). The Panel also finds no evidence on record showing that Respondent is commonly known by the disputed domain name.

Prior UDRP panels have also found that “use which intentionally trades on the fame of another cannot constitute a *bona fide* offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.” (See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, WIPO Case No. [D2000-0847](#)). See also in *Advance Magazine Publishers, Inc. v. Lisa Whaley*, WIPO Case No. [D2001-0248](#) (finding that “intentionally infringing use should not be viewed as *bona fide* use”). The disputed domain name clearly features unauthorized use of terms that are confusingly similar to Complainant’s ZENNI mark and its domain name used for the Official ZENNI Marks Website. Thus, Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain.

In light of the above, and with no Response in this case to rebut Complainant’s assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

Complainant contends that there is no other explanation for Respondent to register the disputed domain name other than to target Complainant. Given its ZENNI Marks are well known in their industry in the United States, and the disputed domain name incorporates essentially the identical term in its entirety, the Panel finds bad faith registration based on Respondent’s actual knowledge of the ZENNI Marks given its widespread recognition in the United States where Respondent is located, and where the mark has been in use and registered for many years before Respondent registered the disputed domain name. Prior UDRP panels have found that where it would be implausible to believe that Respondent selected and was using the disputed domain name for any purpose other than to trade on Complainant’s trademark rights and reputation, establishes a fact pattern that repeatedly has been held to constitute bad faith registration. See *Alstom v. Domain Investments LLC*, WIPO Case No. [D2008-0287](#); see also *Houghton Mifflin Co. v. Weathermen, Inc.*, WIPO Case No. [D2001-0211](#).

Prior UDRP panels have also found where a respondent’s actions indicate that respondent’s primary intent with respect to the disputed domain name is to trade off the value of complainant’s marks, constitutes bad faith. See *Herbalife International, Inc. v. Surinder S. Farmaha*, WIPO Case No. [D2005-0765](#).

Given the widespread recognition of Complainant’s ZENNI Marks in the United States, where Respondent is located, and almost 20 years of use of the ZENNI Marks prior to Respondent’s registration of the disputed domain name on June 21, 2022, the use of the disputed domain name has been to cause confusion with Complainant and therefore, the use and registration of the disputed domain name must be considered to be in bad faith. See *Empresa Brasileira de Telecomunicações S.A. Embratel v. Kevin McCarthy*, WIPO Case No. [D2000-0164](#). Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

As found by prior UDRP panels, use of the disputed domain name for a parking page competing with or capitalizing on Complainant’s trademark demonstrates an indication that Respondent intentionally attempted

to attract, for commercial gain, Internet users to its disputed domain name, by creating a likelihood of confusion with Complainant's ZENNI Marks as to the source, sponsorship, affiliation or endorsement of Respondent's website, and, therefore is evidence of registration and use of the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy. See *Association des Centres Distributeurs E. Leclerc - A.C.D Lec v. Milen Radumilo*, WIPO Case No. [D2017-2003](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no Response or arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied 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 <zenilight777.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: December 16, 2022