

ADMINISTRATIVE PANEL DECISION

Taojing International Ltd. and Zenni Optical, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-0183

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Names and Registrar

The disputed domain names <zenniopjical.com>, <zennioprtical.com>, and <zennioptional.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 14, 2022. On January 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on January 25, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint and consolidation arguments.

The Complainants filed an amended Complaint and withdrew eleven domain names from their original complaint on January 25, 2022, and confirmed that they wish to continue the proceeding for the domain names <zenniopjical.com>, <zennioprtical.com>, and <zennioptional.com>.

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 the Respondent of the Complaint, and the proceedings commenced on January 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Commencement of Panel Appointment Process on February 17, 2022.

The Center appointed Rachel Tan as the sole panelist in this matter on February 24, 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 operate in the field of eyeglasses. The Complainants' businesses consist of computerized on-line retail store services in the field of eyeglasses, most of which are prescription, ophthalmic, vision correcting medical devices, also called spectacles, and other related goods and services.

The Complainant, Taojing International Ltd., is the owner of a range of trade mark registrations that consists of the element ZENNI in numerous jurisdictions since 2002, including United States Registration No. 3389855 for ZENNI, registered on February 26, 2008 in class 9; United States Registration No. 3597735 for ZENNI OPTICAL, registered on March 31, 2009 in classes 9 and 35; and United States Registration No. 6438164 for ZENNI.COM, registered on August 3, 2021 in class 9.

The Complainant, Zenni Optical, Inc., is the exclusive licensee of the Complainant, Taojing International Ltd., and is the operator of the online retail shops at the domain names <zennioptical.com> and <zenni.com>.

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

The disputed domain names <zenniopjical.com>, <zennioprtical.com>, and <zennioptional.com> were registered on May 3, 2021, February 10, 2020, and November 15, 2019, respectively. At the date of the Complaint, all the disputed domain names resolved to a parked page comprising pay-per-click advertising links. However, at the date of this decision, the disputed domain <zennioprtical.com> resolves to an inactive website, only the disputed domain names <zenniopjical.com> and <zennioptional.com> continue to resolve to parked pages comprising pay-per-click advertising links that divert Internet users to various third parties' websites, some of which relate to the Complainants' business such as "Eye Fashion", "Eyeglasses Frames", "Eyeglasses", and "Buy Prescription Eyeglasses Online".

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain names are identical or confusingly similar to their trade marks. The disputed domain names are obvious misspellings of the ZENNI OPTICAL mark and the domain name <zennioptical.com> used by the Complainants since 2002. The Complainants also allege that the Respondent is infringing their copyright because the websites using the disputed domain names have links to the Complainants' sites and photographs of their glasses but are presented as if they are part of the Respondent's unlicensed unregulated sites.

The Complainants further allege that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent copied and misspelled the names of the Complainants' websites to form a virtual catalog of the Complainants' competitors. The Respondent makes an illicit offering of competitive and similar goods or services as those of the Complainants'. The Complainant believes the Respondent is making money for every click-through on its sites. The Respondent can also use its websites to gather user and customer information which violate the rights of their customers.

The Complainants finally assert that the disputed domain names were registered and are being used in bad faith. The Respondent has no right to use the Complainants' marks. The Respondent uses the Complainants' marks to create a catalog of their direct competition in the same market. It is certain that the Respondent is intentionally attempting to attract for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainants' marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or location or of a product or service on the Respondent's websites or location.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Consolidation of Multiple Complainants

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides at section 4.11.1, in respect of the issue "Multiple complainants filing against a single respondent" that:

"In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants 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 present proceeding involves two Complainants bringing a single complaint against a common Respondent. The Panel is satisfied, based on the material filed, that the Complainants have a specific common grievance against the Respondent, in that the Complainants have a common legal interest as the Complainant, Taojing International Limited is the owner of the relevant ZENNI and ZENNI OPTICAL trade marks and exclusively licenses such marks to the other Complainant, Zenni Optical, Inc.

The Panel considers that it would be equitable and procedurally efficient to permit the consolidation. The Panel therefore grants the Complainants' request for consolidation.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainants have adduced evidence to demonstrate their established rights in the ZENNI and ZENNI OPTICAL trade marks.

The Panel notes that the disputed domain names all comprise the ZENNI mark in its entirety. In cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the [WIPO Overview 3.0](#).

The Panel also notes that the disputed domain names are misspelling of the ZENNI OPTICAL mark. In cases where a domain name consists of a common, obvious, or intentional misspelling of a trade mark, the domain name will normally be considered confusingly similar to the relevant mark for purposes of UDRP standing. See section 1.9 of the [WIPO Overview 3.0](#); *Mediarex Enterprises Limited v. Yong Woon Chin, Webolutions*, WIPO Case No. [DCO2020-0014](#).

Lastly, it is permissible for the Panel to ignore the generic Top-Level Domain (“gTLD”), in this case “.com”. See section 1.11.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainants have satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the Complainants possess exclusive rights to the ZENNI and ZENNI OPTICAL marks whereas the Respondent seems to have no trade mark rights, and considering the facts and arguments set out above, the Panel is satisfied that the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, and the burden of production shifts to the Respondent. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate use of the disputed domain names or reasons to justify the choice of domain names that are confusing similar to the Complainants’ ZENNI and ZENNI OPTICAL marks. Further, there is no indication to show that the Respondent is commonly known by the disputed domain names or otherwise has rights or legitimate interests in any of them. In addition, the Complainants have not granted the Respondent a license or authorization to use the Complainants’ ZENNI and ZENNI OPTICAL marks or register the disputed domain names. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names in the terms of paragraph 4(c)(iii) of the Policy since at the date of the Complaint, the disputed domain names all resolved to a pay-per-click website with links to third-party websites, some of which are directly related to the Complainants’ business. Such usage may reasonably be assumed to be commercial in its intent and effect. Prior UDRP panels have found that the use of a 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 complainant’s mark or otherwise mislead Internet users. See section 2.9 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names. Accordingly, the Panel finds that the Complainants have satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainants’ ZENNI and ZENNI OPTICAL marks have been registered in the various jurisdictions. The disputed domain names were registered long after the registration of the Complainants’ ZENNI and ZENNI OPTICAL marks. The Complainants have extensively used and advertised the ZENNI and ZENNI OPTICAL marks in relation to products which are sold throughout the world. Search results using the key words “zenni” and “zenni optical” on the Internet search engine direct Internet users to the Complainants and their businesses, which indicates that an exclusive connection between the ZENNI and ZENNI OPTICAL marks and the Complainants have been established. Further, the disputed domain names are similar to the Complainants’ online retail websites “www.zennioptical.com” and “www.zenni.com”. As such, the Respondent either knew or should have known of the Complainants’ ZENNI and ZENNI OPTICAL marks when registering the disputed domain names, and has exercised “the kind of willful blindness that numerous panels have held support a finding of bad faith”. See *eBay Inc. v. Renbu Bai*, WIPO Case No. [D2014-1693](#); *Barclays Bank PLC v. Andrew Barnes*, WIPO Case No. [D2011-0874](#).

Section 3.1.4 of the [WIPO Overview 3.0](#) states that “[...] mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith”. In this case, the disputed domain names are confusingly similar to the widely known ZENNI and ZENNI OPTICAL marks and were registered by the Respondent who has no relationship with the Complainants, which means that a presumption of bad faith can be created.

Section 3.5 of the [WIPO Overview 3.0](#) states that “particularly with respect to ‘automatically’ generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests)”. The Panel notes that at the date of the Complaint, the disputed domain names all resolved to a parked page comprising pay-per-click advertising links that divert Internet users to various contents, some of which are directly related to and competing against the Complainants’ businesses. The Panel finds the use of the confusingly similar disputed domain names to lure Internet users to third-party websites is evidence of bad faith. See *Sodexo v. 杨智超 (Zhi Chao Yang)*, WIPO Case No. [D2020-1171](#).

In addition, the Panel finds that the current inactive use of the disputed domain name <zennioprtical.com> in this case would not prevent a finding of bad faith under the doctrine of passive holding.

The Respondent has kept silent in the face of the Complainants’ allegations of bad faith. Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainants before registering the disputed domain names and, considering the Respondent’s lack of rights or legitimate interests, and by registering and using the disputed domain names as discussed above, the Panel is led to conclude that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the Complainants have satisfied the third element under paragraph 4(a) 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 names, <zenniopjical.com>, <zennioprtical.com>, and <zennioprtical.com>, be transferred to the Complainants.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: March 10, 2022