

## ADMINISTRATIVE PANEL DECISION

### Taojing International Limited and Zenni Optical, Inc. v. Casey Lewis Case No. D2022-2934

#### 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, United States.

The Respondent is Casey Lewis, Canada.

#### 2. The Domain Name and Registrar

The disputed domain name <zeni.exchange> is registered with NameCheap, Inc. (the “Registrar”).

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 8, 2022. On August 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 11, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on August 31, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on September 9, 2022.

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 September 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2022. The Response due date was extended to October 24, 2022 as requested by the Complainant. The Center received informal communications from the Respondent on September 7, September 8, October 21, November 7, and November 8, 2022. The Center notified the Commencement of Panel Appointment Process to the Parties on November 7, 2022.

The Respondent's email dated November 8, 2022 requested an extension of the due date for the Response until November 10, 2022. The Center advised the Respondent, in accordance with paragraph 5(e) of the Rules, that since the request had been received after the due date for the Response and since there did not appear to be any exceptional circumstances, the period for the Response would not be extended.

The Center appointed Steven A. Maier as the sole panelist in this matter on November 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.

The Panel notes that the Complaint as filed (being the fourth amended Complaint) originally included four other disputed domain names in addition to the disputed domain name in this proceeding. Those four other disputed domain names were in the common ownership of a party other than the Respondent and were withdrawn from the proceeding following a settlement agreement between the relevant parties. The prior inclusion of these other disputed domain names is relevant to the communications received from the Respondent as further referenced below.

#### **4. Factual Background**

The Complainant Taojing International Limited ("Taojing") is a corporation registered in Hong Kong, China. The Complainant Zenni Optical, Inc ("Zenni Optical") is a corporation registered in California, United States. Taojing is the owner and Zenni Optical a licensee of the trademark registrations referred to below. For convenience, Taojing and Zenni Optical will be referred to collectively as "the Complainant" in the remainder of this Decision.

The Complainant is the owner of trademark registrations for the marks ZENNI and ZENNI OPTICAL, including for example the following:

- United States trademark registration number 4345783 for the word mark ZENNI, registered on June 4, 2013 for goods comprising "Eyeglasses; Frames for eyeglasses and pince-nez; Spectacles" in International Class 09.
- United States trademark registration number 3597735 for the word mark ZENNI OPTICAL, registered on March 31, 2009 for goods and services comprising "Eyeglass cases; Eyeglass frames; Eyeglass lenses; Eyeglasses; Reading eyeglasses" in International Class 09 and "On-line retail store services featuring eyeglasses" in International Class 35.

The disputed domain name was registered on May 2, 2018.

The Complainant exhibits evidence that the disputed domain name has resolved to a Registrar-operated "parking page" website headed "zeni.exchange" and which appears to comprise sponsored links. The links are of significance in this case and are as follows:

"Zenni Eyeglasses  
Zenni Optical  
Zenni Optical Glasses  
Zenni  
Eyeglasses  
Order Wines Online  
Optical Glasses  
Wine to Buy Online  
Wine Delivered"

The website concludes with a disclaimer stating “The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers.”

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant submits that it is one of the world’s leading retailers of eyeglasses, having sold over 20 million pairs of mostly prescription glasses. It exhibits evidence of media coverage relating to its services and business profile. It also provides evidence of its online retail operations at “www.zenni.com” and “www.zennioptical.com”.

The Complainant submits that the disputed domain name is identical or confusingly similar to its trademarks ZENNI and ZENNI OPTICAL. It contends in particular that the term “zeni” is identical to its mark ZENNI, but for the omission of one letter “n” which is a common typing error, and that it has a similar look and feel to the ZENNI trademark. It further submits that including of the term “exchange” will lead Internet users to believe that the disputed domain name links to a website for exchanging the Complainant’s eyeglasses.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that the Respondent has no trademark or other rights in respect of the ZENNI mark and is making neither *bona fide* offering goods or services nor legitimate noncommercial or fair use of the disputed domain name. The Complainant says that using the disputed domain name to link to a parking page comprising pay-per-click (“PPC”) links cannot amount to legitimate use of the disputed domain name, since certain of these links compete with the Complainant and seek to capitalize on its goodwill. It refers to the Respondent’s website as “an online shopping mall of the Complainant’s competitors as catalogs of eyeglass sellers for the user.” It exhibits in this regard pages from the websites to which the PPC links resolve, which include online eyewear retailers named “Eyebuydirect”, “Glassesshop.com”, and “Warby Parker”, as well as pages from the Complainant’s own website. The Complainant adds that the other PPC links, to e.g. “Wines Delivered”, have no connection with the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that its ZENNI and ZENNI OPTICAL trademarks are widely known and that the Respondent has carefully engineered the disputed domain name to “typosquat” upon those trademarks. The Complainant submits that the deliberately confusing use of a domain name to lure Internet users to a website is in itself evidence of bad faith. The Complainant further submits that the positioning of the disputed domain name on the Respondent’s webpage, together with the fact that certain of the sponsored links refer to, and on occasions link to, the Complainant itself, creates the impression that the Complainant is endorsing or sponsoring those links, which are in fact to its competitors’ websites. The Complainant states that the Respondent is using the disputed domain name to exploit the reputation of the Complainant and cannot disclaim responsibility for the relevant PPC links by claiming they are automatically generated.

The Complainant requests the transfer of the disputed domain name.

### **B. Respondent**

The Respondent did not file a formal Response to the Complainant’s contentions. In his emails referred to above, however, he refers to the other disputed domain names which were originally included in the proceedings, all of which referred to finance, and questions why an eyeglass company has a claim to domain names of this nature. He also contends that “zeni” and the Complainant’s trademark ZENNI are completely different terms, the former being a Japanese word for “money” and the latter being an invented term. The Respondent seeks clarification of whether the Complainant claims trademark rights in “zeni” or only ZENNI. He states that he is being subjected to a “domain hijacking attempt” by the Complainant.

## 6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant has established that it has registered trademark rights in the mark ZENNI. The disputed domain name comprises the term “zeni” together with the generic Top-Level Domain (“gTLD”) “.exchange”. The Panel finds that the term “zeni” is both visually and aurally similar to the Complainant’s trademark ZENNI. Further, while the gTLD may be disregarded for the purposes of paragraph 4(a)(i) of the Policy, the Panel considers that this would not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

### B. Rights or Legitimate Interests

In the view of the Panel, the Complainant’s submissions set out above give rise to a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, the Respondent has failed to rebut the Complainant’s *prima facie* case and has not submitted any relevant explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise.

Furthermore, the Panel finds that the Respondent has used the disputed domain name for the purpose of a parking page containing PPC links, including those which name the Complainant, which resolve to the websites of competitors of the Complainant and in some cases to the Complainant’s own website. While it may be legitimate to use a domain name comprising a “dictionary” word to offer goods or services genuinely related to that term and not to target a third-party trademark<sup>1</sup>, the Panel does not find the term “zeni” to be a dictionary word or that the Respondent has used it in connection with any such alleged meaning, e.g. for the purpose of goods or services relating to Japanese money. Instead, the Panel finds that the Respondent has used the disputed domain name for the purposes of a website which is likely to confuse Internet users into believing it is owned or operated by, or otherwise legitimately associated with, the Complainant, in order to redirect such Internet users to competing websites and others unrelated to the Complainant. This cannot constitute either *bona fide* commercial use or legitimate noncommercial or fair use of the disputed domain name and the Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

### C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy includes the conjunctive requirements that the Respondent must both have registered and used the disputed domain name in bad faith. Based on the Respondent’s use of the disputed domain name and his failure to provide any credible explanation for his registration and use of the disputed domain name, the Panel infers that the Respondent is more likely than not to have registered the disputed domain name in the knowledge of the Complainant’s trademark and business with the intention of using it for the purpose of the PPC links referred to above.

---

<sup>1</sup> See e.g. section 2.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))

The Panel repeats its findings set out above with regard to the Respondent's use of the disputed domain name. The Panel finds not only that the Respondent has used the disputed domain name to attract Internet users to its website, but also that it has named the Complainant on that website and included links to the Complainant's own website, with the effect of exacerbating the confusion between the Complainant and its trademarks and the PPC links offered by the Respondent. The Panel endorses the Complainant's submission that the Respondent cannot disclaim responsibility for the material appearing on his website by claiming (as is stated on the website itself) that the relevant links are automatically generated and that the relevant advertisers are not connected with the Respondent<sup>2</sup>.

The Panel therefore finds particular that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

## 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, <zeni.exchange>, be transferred to the Complainant.

*/Steven A. Maier/*

**Steven A. Maier**

Sole Panelist

Date: November 14, 2022

---

<sup>2</sup> See e.g. section 3.5 of [WIPO Overview 3.0](#)