

ADMINISTRATIVE PANEL DECISION

Taojing International Limited and Zenni Optical, Inc. v. Carolina Rodrigues,
Fundacion Comercio Electronico
Case No. D2022-4227

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 Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The domain name and Registrar

The disputed domain name <zenniophcal.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 November 8, 2022. On November 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 9, 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 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2022.

The Center appointed Cherise Valles as the sole panelist in this matter on December 5, 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

There are two Complainants in this proceeding. The owner of the relevant trademarks is Taojing International Limited (“Taojing International”) located in Hong Kong, China (the “First Complainant”). The First Complainant is the owner of trademark registrations in several jurisdictions including Australia, Canada, Mexico, and Spain for ZENNI, ZENNI OPTICAL and ZENNIOPTICAL.COM among others (the “ZENNI OPTICAL Marks”), including a registration in the United States from March 31, 2009 (registration number 3597735) (Annex 7 to the Complaint) for “Eyeglass cases; Eyeglass frames; Eyeglass lenses; Eyeglasses; Reading eyeglasses”. The Second Complainant, Zenni Optical, Inc. (“Zenni Optical”) located in California, United States, is “the exclusive licensed operator of the web sites known as ZENNIOPTICAL.COM and ZENNI.COM, upon which this Complaint is in part based”.

The Complaint states that “[t]he Complainants have a common legal interest in a relevant right or rights that are allegedly affected by the Respondent’s conduct, because Taojing International, Limited is the owner of the Marks and Zenni Optical, Inc. is the international licensee of these marks for marketing on the internet”. It further states that the two Complainants are the subject of common conduct by the Respondent that has affected their individual and joint legal interests.

The disputed domain name was registered on January 17, 2020. The Registrar with which the disputed domain name is registered is GoDaddy.com, LLC.

The disputed domain name currently resolves to a website that includes pay-per-click links to the Complainant’s competitors such as Eyebuydirect, Warby Parker, Lens.com, Gogglesforu, and Simplyeyeglasses.com.

5. Parties’ Contentions

A. Complainants

The Complainants assert that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainants assert that:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainants have rights.

- The disputed domain name is confusingly similar to the Complainants’ registered ZENNI trademark, in light of the fact that it wholly incorporates the Complainants’ mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

- The Complainants state that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainants have never licensed or otherwise permitted the Respondent to use their trademarks or to register any domain name that included their trademarks.

The Complainants assert that the disputed domain name was registered and is being used in bad faith.

- The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use. Furthermore, the Respondent’s impersonating and/or competing use of the disputed domain name is clear evidence of bad faith.

The Complainants request the Panel to issue a decision finding that the disputed domain name be transferred to the Complainants in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a Complaint to succeed, the Complainants must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have 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.

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainants.

A. Identical or Confusingly Similar

An initial question arises as to whether a trademark owner's affiliate or licensee such as the Second Complainant has standing to file a UDRP complaint. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states at section 1.4.1:

"A trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint."

In the present case, the First Complainant is the owner of the trademark, and the Second Complainant is the licensee of the trademark. The Second Complainant is bringing this Complaint with the authorization of the trademark owner. Thus, both Complainants have standing to file this Complaint.

To prove this element, the Complainants must have relevant rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark. Given the First Complainant's trademark registrations as detailed above, the Panel finds that the First Complainant has established its trademark rights in ZENNI and ZENNI OPTICAL for the purposes of paragraph 4(a)(i) of the Policy.

The Complainants assert that the Respondent is using a calculated misspelling of the ZENNI OPTICAL mark in the disputed domain name. The disputed domain name incorporates the said trademark in its entirety with the addition of the misspelled word "ophcal" instead of "optical". As stated in section 1.9 of the [WIPO Overview 3.0](#), "[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element". Thus, the misspelled word "ophcal" does not prevent a finding of confusing similarity between the disputed domain name and the ZENNI OPTICAL trademark.

It is standard practice when comparing a disputed domain name to a complainant's trademark not to take the Top-Level Domain ("TLD") into account. See section 1.11.1 of the [WIPO Overview 3.0](#), which states that the "applicable [TLD] in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element of the confusing similarity test". In the present case, the TLD ".com," is disregarded under the first element of the confusing similarity test.

In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainants' registered trademarks and that the Complainants have met their burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

"[a]ny of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) 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; or
- (ii) you (as an individual, business or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a 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 Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognized in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned (see, for example, *Paris Saint-Germain Football v. Daniel Macias Barajas, International Camps Network*, WIPO Case No. [D2021-0019](#); *Spinrite Inc. v. WhoisGuard, Inc. / Gabriella Garlo*, WIPO Case No. [D2021-0012](#); and the discussion in section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainants assert that the Respondent is offering pay-per-click links to similar goods as those of the Complainants. They further assert 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 Complainants' mark. See section 2.9 of the [WIPO Overview 3.0](#).

None of these allegations were rebutted by the Respondent, as noted above. In this case, it appears that the Complainants have established the requisite *prima facie* case.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainants and the Respondent. The Respondent does not seem to be licensed, or otherwise authorized, be it directly or indirectly, to register or use the ZENNI OPTICAL Marks in any manner, including in, or as part of, the disputed domain name.

The Complainants assert that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, the Respondent cannot assert that, prior to any notice of this dispute, it was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy.

In light of the foregoing, the Panel finds that the Complainants have established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it is being used in bad faith. The term “bad faith” is “broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. See section 3.1 of the [WIPO Overview 3.0](#). Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 of a product or service on its website or location.

In this case, the Complainants’ submissions relate to paragraph 4(b)(iv) of the Policy.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typographical errors 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. See section 3.1.4 of the [WIPO Overview 3.0](#).

1) Registration in bad faith

Given the well-known nature of the ZENNI OPTICAL Marks, it is implausible that the Respondent was unaware of these trademarks when it registered the disputed domain name.

Bad faith can be found where a respondent “knew or should have known” of a complainant’s trademark rights but nevertheless registered a particular domain name in which it has no rights or legitimate interests (see *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. [D2009-0320](#); *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

The composition of the disputed domain name is virtually identical to the reputable ZENNI OPTICAL trademark. The fact that the disputed domain name incorporates the misspelled trademark ZENNI OPTICAL, *i.e.*, misspelling the word “optical” to “ophcal”, indicates that the Respondent registered the disputed domain name in order to divert Internet traffic to its website. Prior UDRP panels have held that bad faith can be found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith (see *LEGO Juris A/S v. store24hour*, WIPO Case No. [D2013-0091](#)). Given the strong reputation and distinctiveness of the Complainants’ trademarks, registration in bad faith can be inferred.

As noted above, the Complainants trademark rights in the ZENNI OPTICAL Marks predate the registration date of the disputed domain name. Knowledge of a corresponding trademark at the time of the registration of the domain name suggests bad faith (see *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#)).

2) Use in bad faith

The Complainants also assert that the Respondent's use of the 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](#). The Respondent is using the disputed domain name with the apparent intent of commercial gain to direct Internet users to a webpage with pay-per-click links to the Complainants' competitors and to divert consumers away from the Complainants' products.

Previous UDRP panels have held that the use of a domain name to divert Internet users to a webpage for commercial gain is evidence of bad faith. (See *F Hoffmann-La Roche AG v. Anna Valdier*, WIPO Case No. [D2007-0956](#)).

The Respondent has not participated in the administrative proceeding and has not answered the Complainants' contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration or use of the disputed domain name in the face of the Complainants' contentions can be regarded as an indicator of bad faith.

Accordingly, the Panel concludes that the Complainants have satisfied their burden of showing bad faith registration and use of the disputed domain name under 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 <zenniophcal.com> be transferred to the Complainants.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: December 19, 2022