

ADMINISTRATIVE PANEL DECISION

Warby Parker Inc. v. guang zheng
Case No. D2024-2933

1. The Parties

The Complainant is Warby Parker Inc., United States of America (“U.S.”), represented by Cowan, Liebowitz & Latman, P.C., U.S.

The Respondent is guang zheng, China.

2. The Domain Name and Registrar

The disputed domain name <warbyparkerusa.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 17, 2024. On July 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 18, 2024, 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 (WARBYPARKERUSA.COM) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 22, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint July 23, 2024.

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 August 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 27, 2024.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on September 6, 2024. 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 Complainant is an eyewear company that provides eyewear, sunglasses, eyewear accessories and retail and online retail store services under the trademark WARBY PARKER since 2009. The Complainant sells its products online and through over 200 retail stores in U.S. and Canada.

The Complainant is the owner of the trademark WARBY PARKER, registered in various jurisdictions worldwide. In particular, the Complainant is the owner of the following trademark registrations:

- WARBY PARKER (word), U.S. registration No. 3908784, registered on January 18, 2011 and claiming first use in commerce since November 14, 2009, for goods in class 9;
- WARBY PARKER (figurative), U.S. registration No. 5523848, registered on July 24, 2018 and claiming first use in commerce since May 27, 2016 for goods in class 9, and claiming first use in commerce since April 13, 2013 for services in classes 35 and 44; and
- WARBY PARKER (word), U.S. registration No. 6284023, registered on March 2, 2021 and claiming first use in commerce since November 19, 2019, for goods and services in classes 9 and 35.

The Complainant is also the owner of the domain name <warbyparker.com>, registered in 2009 and resolving to the Complainant's official website.

The disputed domain name has been registered on January 9, 2024 by the Respondent and resolves to a website purportedly offering for sale unauthorized goods bearing the Complainant's WARBY PARKER mark.

On April 26, 2024, the Complainant sent a cease and desist letter to the Registrar of the disputed domain name. On May 2, 2024, the Registrar responded and advised the Complainant to reach out to the Respondent and/or the hosting provider of the website linked to the disputed domain name directly, or start a UDRP proceeding, if applicable.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its WARBY PARKER mark, as it incorporates it entirely and the addition of the geographical element "usa" cannot prevent a finding of confusing similarity.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name. To the best of the Complainant's knowledge, the Respondent is not commonly known by the disputed domain name. The Respondent's personal name does not coincide with the disputed domain name. The Respondent is not a licensee of the Complainant, nor has any other type of relationship with the Complainant. The Complainant has never authorized the Respondent to register or use the Complainant's mark, including as part of the disputed domain name. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services. The disputed domain name resolves to

a website that exploits and infringes the Complainant's trademark and copyright materials and engages in fraudulent and/or phishing activities, all in an apparent attempt to mislead consumers into thinking that the Complainant has authorized the website and the disputed domain name, when in fact this is not the case. The Respondent is probably receiving monetary benefits from the use of the disputed domain name. Accordingly, the use of the disputed domain name is not a use in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use under the Policy.

Finally, the Complainant maintains that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant has extensively promoted its goods and services. Because of the long and continuous use of the WARBY PARKER mark, and substantial investment of time, money and effort in promoting its goods and services, the Complainant has developed substantial public recognition and relevant goodwill in its WARBY PARKER mark. The mere fact that the Respondent has registered and is using a disputed domain name virtually identical to the Complainant's well-known trademark is evidence of registration and use in bad faith. Furthermore, considering that, WARBY PARKER is a registered mark at the United States Patent and Trademark Office ("USPTO"), the Respondent is presumed to have had constructive notice of the WARBY PARKER mark at the time it registered the disputed domain name. This is further evidence of registration and use of the disputed domain name in bad faith.

The Respondent has used the disputed domain name to direct traffic to a website, which features and prominently displays the Complainant's WARBY PARKER mark and copyrighted materials. The Respondent's website is likely to mislead consumers into thinking that the Complainant has authorized the Respondent's website and disputed domain, when in fact they are not. Such use of the disputed domain name amounts to use in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of the WARBY PARKER trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced and recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "usa", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In light of the above, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that the Complainant is not engaged in any business or other type of relationship with the Respondent. Moreover, the Complainant did not authorize the Respondent to register and make use of its WARBY PARKER mark, including as part of the disputed domain name. Finally, the Respondent does not appear to be commonly known by the disputed domain name

The disputed domain name consists of the Complainant’s trademark followed by the geographical abbreviation “usa”, which stands for “United States of America” that is the country of origin of the Complainant and one of the two countries where the Complainant operates. UDRP panels have largely held that such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#) section 2.5.1.

The disputed domain name resolves to a website, which displays the WARBY PARKER trademark and explains the history of the Complainant. The website advertises for sale eyewear products bearing the WARBY PARKER mark and includes copyrighted images taken from the Complainant’s website. The Respondent’s website is highly misleading and the Complainant’s potential consumers are likely to perceive the Respondent’s website as the Complainant’s official website dedicated to U.S. customers. Visitors of the Respondent’s website wishing to buy an alleged WARBY PARKER product will have to reveal their sensitive information, such as their personal names, addresses, passwords and credit card details.

The Panel does not know whether the goods offered for sale on the Respondent’s website are counterfeit or genuine. However, there are circumstances that suggest the non-originality of the products, such as the fact that the Complainant’s products are only sold through the Complainant’s website and selected stores, and that the Respondent has misappropriated copyrighted images from the Complainant’s website. Panels have held that the use of a domain name for illegal activity, such as impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In light of the above circumstances, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name, which incorporates the Complainant’s trademark followed by the descriptive geographical indicator “usa”, which designates the country of origin of the Complainant and one of the two countries where the Complainant operates. The disputed domain name resolves to a website on which the Complainant’s mark is prominently displayed, and where products, allegedly originating from the Complainant, are offered for sale. To promote these goods,

the Respondent is using copyrighted materials from the Complainant's website. A section of the Respondent's website is dedicated to the Complainant's history.

It is therefore clear that the Respondent had clearly in mind the Complainant's mark and activity when it registered the disputed domain name. The registration of the disputed domain name, which is confusingly similar to the Complainant's mark, without rights or legitimate interests amounts to registration in bad faith.

The Respondent has been using the disputed domain name to attract the Complainant's potential consumers to its website, by luring them into believing that the Respondent's website originates from (or is affiliated to, or sponsored by), the Complainant, while it is not. The aim of the Respondent was clearly that of obtaining a commercial gain from the sale of the products purchased through its website or from the insertion, on the Respondent's website, of the lured customers' sensitive information.

As mentioned above, although the Panel cannot say whether the products offered for sale on the Respondent's website are counterfeit, there are several factual circumstances, as listed above, which lean towards the non-originality of these goods. As the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing, impersonation/passing off can never confer rights or legitimate interests on a respondent, such behavior is manifest evidence of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Accordingly, the Panel finds that the Complainant has established the third element 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 <warbyparkerusa.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: September 19, 2024.