

## **ADMINISTRATIVE PANEL DECISION**

Vision Service Plan d/b/a VSP v. wai po  
Case No. D2024-3858

### **1. The Parties**

The Complainant is Vision Service Plan d/b/a VSP, United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is wai po, China.

### **2. The Domain Name and Registrar**

The disputed domain name <eyeconicglass.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 September 20, 2024. On September 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 23, 2024, 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 September 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 17, 2024.

The Center appointed Roger Staub as the sole panelist in this matter on October 29, 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 a California (United States) corporation. The Complainant submits that it was founded by a group of optometrists in 1955 and that it is the first national not-for-profit vision benefits company in the United States.

The Complainant further submit that the Complainant provides products and services to eye care professionals, employers, and more than 85 million members worldwide through a network of more than 42,000 doctors. The Complainant's "Eyeconic" business offers an online eyewear store known as "Eyeconic", which users can access via the domain name <eyeconic.com> (created on September 11, 1999). In this online store, consumers can shop for eyeglasses, contacts, and sunglasses using their VSP vision insurance benefits.

The Complainant owns the following trademark registrations for the EYECONIC trademark:

- United States Registration No. 4268635 EYECONIC, registered on January 1, 2013, in Class 35; and
- United States Registration No. 5893293 EYECONIC, registered on October 22, 2019, in Classes 35 and 44.

The Complainant submits that it has registered more than 60 domain names in 11 Top-Level Domains that include the EYECONIC trademark, including <eyeconic.com>, <eyeconicglasses.com>, <eyeconic-sunglasses.com>, <eyeconicsunglasses.com>, and <eyeconic-glasses.com>.

The disputed domain name was registered on January 9, 2024.

At the time the Complaint was filed, the disputed domain name resolved to an active website. That website displays the Complainant's EYECONIC trademark and contains information about a company "Eyeconic" and its products and services. It uses the exact same all-caps tagline that appears on the Complainant's website at the domain name <eyeconic.com>, which includes the Complainant's VSP trademark ("GOT VSP INSURANCE? WE'VE GOT SAVINGS ON CONTACTS AND GLASSES").

#### **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:

First, the disputed domain name is confusingly similar to the Complainant's trademark EYECONIC. The disputed domain name contains the Complainant's EYECONIC trademark in its entirety, simply adding the descriptive word "glass". Addition of the descriptive word "glass" in the disputed domain name does nothing to diminish confusing similarity; it actually increases confusing similarity between the trademark and the disputed domain name. Further, it was well-established that the Top-Level Domain (i.e., ".com") may be disregarded for the purpose of the comparison.

Second, the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the EYECONIC trademark in any manner. The Respondent is not commonly known by the disputed domain name. By using the disputed domain name in connection with a website that falsely appears to be a website for, or otherwise associated with, the Complainant, the Respondent cannot establish rights or legitimate interests in the disputed domain name. By engaging in such activity, the

Respondent has failed to create a bona fide offering of goods or services under the Policy, and, therefore, the Respondent cannot demonstrate rights or legitimate interests.

Third, the disputed domain name should be considered as having been registered and being used in bad faith by the Respondent. Given the disputed domain name's similarity to the Complainant's own domain names <eyeconic.com> etc., it is inconceivable that the Respondent chose the disputed domain name without knowledge of the Complainant's activities and the name and trademark under which the Complainant is doing business. By using the disputed domain name in connection with a website that falsely appears to be a website for, or associated with, the Complainant, the Respondent is clearly creating a likelihood of confusion with the EYECONIC trademark, constituting bad faith. Creating a website that appears to be a website for the Complainant, as the Respondent has done in the instant case, is likely fraudulent and indicates an intent to deceive or, at a minimum, act in bad faith with the intent for commercial gain. Another indication of bad faith under the Policy is the fact that the Complainant's registrations for the EYECONIC trademark were registered before the Respondent's registration of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to the Policy, to qualify for a cancellation or transfer, the Complainant must prove each of the following:

First, the disputed domain name is identical or confusingly similar to a trademark or service mark to which the Complainant has rights.

Second, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Third, the disputed domain name has been registered and is being used in bad faith.

Since the Respondent did not submit a reply, the Panel may choose to accept the reasonable contentions of the Complainant as true. This Panel will determine whether those facts constitute a violation of the Policy that is sufficient to order the transfer of the disputed domain name (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

### **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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced 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: "glass") 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.

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.

Panels have held that the use of a domain name for illegitimate activity (here, claimed: impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 disputed domain name incorporates the Complainant’s trademark, which has a certain reputation. This trademark has been combined with a descriptive term (“glass”) only, which is a descriptive term for the products offered by the Complainant under its EYECONIC mark, suggesting that the disputed domain name is one of the Complainant’s Internet addresses, where the consumers can purchase the products from the Complainant. On the website, which is accessible under the disputed domain name, consumers can see a logo containing the Complainant’s word mark and the exact same all-caps tagline that appears on the Complainant’s website accessible under the domain name <eyeconic.com>. All these create a likelihood of confusion. There are no plausible indications for a possible good faith use of the disputed domain name by the Respondent. The Respondent failed to submit a response and, thus, any evidence of an actual or contemplated good faith use.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegitimate activity (here, claimed: impersonation/passing off) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <eyeconicglass.com> be transferred to the Complainant.

*/Roger Staub/*

**Roger Staub**

Sole Panelist

Date: November 12, 2024