

ADMINISTRATIVE PANEL DECISION

Taojing International Ltd. and Zenni Optical, Inc. v. 杨智超 (yang zhi chao)
Case No. D2023-2215

1. The Parties

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

The Respondent is 杨智超 (yang zhi chao), China.

2. The Domain Names and Registrar

The disputed domain names <zebnnioptical.com>, <zeneioptical.com>, <zenniopicam.com>, <zenniopiclal.com>, <zenniopicpal.com>, <zenniopicval.com>, <zenniopicxl.com>, <zenniopicpal.com>, <zenniopytical.com>, and <zenniopytical.com> (collectively, the “Disputed Domain Names”) are registered with Xin Net Technology Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 22, 2023. On May 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On May 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Redacted For Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on May 31, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint.

On May 31, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. The Complainants filed an amended Complaint in both English and Chinese on June 3, 2023. In the amended Complaint, the Complainants requested that the language of proceedings be in English. The Respondent did not comment on the language of proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 28, 2023.

The Center appointed Rosita Li as the sole panelist in this matter on July 3, 2023. 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 First Complainant is a Hong Kong limited company, and is the owner of the following trademarks:

- 1) United States Trademark Registration No. 4345783 for ZENNI registered on June 4, 2013;
- 2) United States Trademark Registration No. 85706049 for ZENNI registered on June 4, 2013;
- 3) United States Trademark Registration No. 3597735 for ZENNI OPTICAL registered on March 31, 2009;
- 4) United States Trademark Registration No. 3389855 for ZENNI registered on February 26, 2008;
- 5) United States Trademark Registration No. 5413386 for ZENNI registered on February 27, 2018;
- 6) United States Trademark Registration No. 6543433 for ZENNI OPTICAL.COM registered on November 2, 2021; and
- 7) United States Trademark Registration No. 6438164 for ZENNI.COM registered on August 3, 2021.

(Collectively, the "ZENNI trademarks").

The Complainants submitted that they have extended the use, registration and application of the ZENNI trademarks in various jurisdictions including the European Union, Spain, Mexico, China, Hong Kong, China, Canada, Australia, etc. since 2002 on the sale of eyeglasses and its accessories.

The Second Complainant is a corporation established in the United States. It is the First Complainant's international licensee of the ZENNI trademarks and is their exclusive licensed operator of the Complainants' web sites. The Complainants operate their Zenni Optical business under the domains <zenni.com> and <zennioptical.com> (the "Complainants' Domain Names").

The Disputed Domain Names were registered by the Respondent on March 29, 2023 and they resolve to websites containing pay-per-click links to similar goods or services as the Complainants.

5. Parties' Contentions

A. Complainant

The Complainants contend, among others, the followings:

- i) The Disputed Domain Names are confusingly similar to the ZENNI trademarks.

The Complainants submitted that the Respondent is using many carefully calculated and engineered misspelt versions of the Complainants' ZENNI trademarks to imitate "Zenni" and "Optical" to form the Disputed Domain Names. Parts of the words "Zenni" and "Optical" are repeatedly used to pick up the Qwerty key locations to create the misspelt versions of "Zenni" and "Optical" to form the Disputed Domain Names. The Complainants submitted that the words "Zenni" and "Optical" have a very similar look, reading, sound and meaning as the Disputed Domain Names and to the general public who are extremely likely to be mistyping the Disputed Domain Names with confusion with the Complainants' Domain Names. The Disputed Domain Names are all typosquatting uses intended to cause a confusing version of the actual words "Zenni Optical".

ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names as the Respondent is not making any legitimate noncommercial or fair use of the Disputed Domain Names.

The Complainants submitted that there was no evidence of the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Names. The Complainants asserts 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.

iii) The Disputed Domain Names were registered and are being used in bad faith.

The Complainants contended that the Respondent's use of the confusingly similar Disputed Domain Names were to lure Internet users to third-party websites and is making money by misdirecting users to click on the pay-per-click links.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary Issues

A. Consolidation of Multiple Complainants

The principles to assess a request to consolidate multiple complainants are set forth in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.1.

Noting the circumstances of the case, the Panel finds that the Complainants have a specific common grievance against the Respondent, and that it would be equitable and procedurally efficient to permit the consolidation. The Panel finds that the Complainants have a common legal interest, as the First Complainant is the proprietor of the ZENNI trademarks and the Second Complainant is the exclusive licensed operator of the Complainants' Domain Names, upon which this Complaint is in part, based. Moreover, considering the composition of the Disputed Domain Names, the Panel finds that the Complainants are the target of common conduct by the Respondent, which has affected their individual legal interests in a similar fashion.

Accordingly, the Panel accepts the Complainants' submission on the consolidation of the present proceedings pursuant to the paragraph 10(e) of the Rules.

B. Language of the Proceeding

Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. In the present case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the Disputed Domain Names is Chinese. The Complainants filed an amended Complaint in both English and Chinese but nonetheless requested that English be adopted as the language of the proceeding for the reasons summarized below:

- (a) the websites associated with the Disputed Domain Names are all in English only; and
- (b) the Disputed Domain Names are misspelled words with clever manipulation of the English words Zenni and Optical.

The Respondent did not comment on the language of the proceeding.

Having considered the above circumstances and the fact that:

- (i) the ZENNI trademarks that this Complaint is relied upon are all word marks in English language; and
- (ii) the websites associated with the Disputed Domain Names direct visitors to other websites for the purchase of goods are targeting the United States market and are quoting prices in the United States currency;

the Panel considers that the Respondent is familiar with the English language. Accordingly, the Panel determines that English shall be the language of this proceeding.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must satisfy each of the following three elements in a complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; and
- (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

According to section 1.11 of [WIPO Overview 3.0](#), generic Top-Level Domains such as “.com” in a disputed domain name do not typically form part of the relevant assessment in the test of confusing similarity. The Panel will accordingly consider the second level parts of the Disputed Domain Names.

The Complainants demonstrated their trademark rights in the ZENNI trademarks, and that the ZENNI trademarks were registered earlier than the Disputed Domain Name.

The Panel agrees that the second level parts of the Disputed Domain Names are in misspelled forms of the words “zenni” and/or “optical” in miniscule differences, particularly with respect to the trademark ZENNI/OPTICAL.COM of the First Complainant. Accordingly, the Panel is of the view that the Disputed Domain Names are confusingly similar to the ZENNI trademarks and the Complainants have satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

According to section 2.1 of the [WIPO Overview 3.0](#), “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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

According to section 2.9 of the [WIPO Overview 3.0](#), “Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.”. The Panel notes and accepts the Complainants’ submissions that the Respondent is resolving the Disputed Domain Names to parked pages containing pay-per-click links. The Panel finds that such use of the Disputed Domain Names will not create any legitimate interests in the Respondent nor represent a *bona fide* offering of goods or services by the Respondent.

Moreover, the Panel notes that the Disputed Domain Names are leading to websites that make offerings of goods similar to the Zenni brand, and even explicitly directing to the Zenni brand, like a catalog of competitive and link to similar goods and services like those of the Complainants. It appears that the Respondent is seeking to obtain commercial gain by misleadingly divert consumers or to tarnish the ZENNI trademarks at issue.

In the circumstances, the Panel is satisfied that the Complainants established a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the Disputed Domain Names. As the Respondent failed to come forward with any relevant evidence to demonstrate rights or legitimate interests in the Disputed Domain Names, the Panel deems that the Complainants have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have “consistently found that the mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith”.

The Panel accepts that at the time of registration of the Disputed Domain Names on March 29, 2023, the ZENNI trademarks were already registered, the Complainants also provided supporting documents such as excerpts from magazines and websites to show that the ZENNI brand is well known and reputable amongst the general public. The Panel finds that it would not be plausible for the Respondent to claim that it was unaware of the Complainants and the ZENNI trademarks. The Panel is prepared to infer that the Respondent knew or should have known that its registration of the Disputed Domain Names would be confusingly similar to the ZENNI trademarks ([WIPO Overview 3.0](#), section 3.2.2.). Accordingly, the Panel finds that the Respondent registering the Disputed Domain Names, which are confusingly similar to the ZENNI trademarks, which are well-known and registered earlier, is a clear indicator of bad faith.

Moreover, factors such as domain names incorporating a trademark in its entirety with typos, and a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent’s choice of the domain names are all indicators of bad faith ([WIPO Overview 3.0](#), section 3.2.1.). The Panel accordingly considers its findings in the above sections 6.2.A. and 6.2.B. (including the Respondent’s use of the Disputed Domain Names to host pay-per-click links), coupled with the fact that the Respondent failed to explain its choice of the Disputed Domain Names to be indicators of the Respondent’s bad faith.

In view of the foregoing, the Panel is of the view that paragraph 4(a)(iii) of the Policy has been satisfied.

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, <zebnnioptical.com>, <zeneioptical.com>, <zennopticam.com>, <zennopticalal.com>, <zennopticpal.com>, <zennopticval.com>, <zennopticxl.com>, <zennoptipcal.com>, <zennoptyical.com>, and <zennoptyical.com> be transferred to the Complainants.

/Rosita Li/

Rosita Li

Sole Panelist

Date: July 17, 2023