

ADMINISTRATIVE PANEL DECISION

Taojing International Limited, Zenni Optical, Inc. v. Joao Pedro Silva Case No. D2023-1866

1. The Parties

The Complainant is Taojing International Limited, China, and Zenni Optical, Inc., United States of America (“United States”), represented by Green & Green Law Offices, United States.

The Respondent is Joao Pedro Silva, United States.

2. The Domain Names and Registrar

The disputed domain names <zenistore.shop>, <zenistyle.com>, and <zeniwear.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2023. On April 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 26, 2023, and on May 10, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 4, 2023, and on May 12, 2023, 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 on May 9, 2023, and on May 12, 2023.

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 June 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 13, 2023. The Center received an email communication from Respondent on June 23, 2023. The Respondent did not submit any formal response. Accordingly, the Center notified the parties that it would proceed to panel appointment on July 18, 2023.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on July 27, 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 Complainants operate in the field of eyeglasses. The Complainants' business consist of computerized online retail store services in the field of eyeglasses, both prescription and non-prescription, and other related accessories, goods and services.

The Complainants operate under the brands ZENNI and ZENNI OPTICAL, owning the Complainant Taojing International Ltd. several trademark registrations for these brands, and being the Complainant Zenni Optical, Inc. its exclusive licensee. These trademark registrations include: United States Registration No. 3389855 for ZENNI, registered on February 26, 2008, in class 9; United States Registration No. 3597735 for ZENNI OPTICAL, registered on March 31, 2009, in classes 9 and 35; United States Registration No. 6438164 for ZENNI.COM, registered on August 3, 2021, in class 9; and United States Registration No. 6543433 for ZENNIOPTICAL.COM, registered on November 2, 2021, in class 9.

Prior decisions under the Policy have recognized the reputation of the ZENNI and ZENNI OPTICAL brands.¹

The Complainant Zenni Optical, Inc. further operates online retail shops for the ZENNI and ZENNI OPTICAL products at the domain names <zenni.com> (registered on May 1, 2002), and <zennioptical.com> (registered on April 19, 2003).

The disputed domain names <zenistore.shop>, <zenistyle.com>, and <zeniwear.com> were registered on January 23, 2023, and resolve to parked pages that offer the purchase of the respective disputed domain names, and comprise pay-per-click ("PPC") advertising links that divert Internet users to various third parties' websites in various fields (related to wine, clothing, etc.). According to the evidence provided by the Complainant, some of the advertising links included in these parked pages were previously related to the Complainants and their trademarks (including the exact spelling of the ZENNI trademark), including links to the Complainants' websites, as well as to competing websites in the field of eyeglasses.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The disputed domain names are confusingly similar to the Complainants' trademark ZENNI. The disputed domain names are calculated misspelling versions of the ZENNI mark that omit one letter "n", and add terms ("store", "style" and "wear") related to the Complainants' business in the eyeglasses field. It is a clear case of typosquatting intended to divert traffic to the Respondent's websites for a commercial gain.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent appears to be an individual that has no trademark rights over the term "zenni", and is not making a legitimate noncommercial or fair use of the disputed domain names. The disputed domain names resolve to parked pages that include PPC links, some of them related to the Complainants, the ZENNI mark, and the Complainants' websites, as well as competing third parties' websites in the eyeglasses field. The

¹ See, among others, *Taojing International Ltd. and Zenni Optical, Inc. v. 杨智超 (yang zhi chao)*, WIPO Case No. [D2023-2215](#), and *Taojing International Limited and Zenni Optical, Inc. v. James J. O'Brien*, WIPO Case No. [D2022-4050](#).

Respondent is making money for every click-through on these sites, and can use these sites to gather user and customer information, which violate the rights of the Complainants' customers.

The disputed domain names were registered and are being used in bad faith. The Respondent has no right to use the Complainants' marks. The Respondent targeted the ZENNI mark to create a catalog in direct competition with the Complainants, including links to the Complainants' websites, and to competitors in the same field. The Respondent cannot disclaim responsibility for the content appearing on the websites associated with the disputed domain names (nor would such links vest the Respondent with rights or legitimate interests). The Respondent is intentionally attempting to attract for commercial gain Internet users to the Respondent's websites and other online locations, by creating a likelihood of confusion with the Complainants' marks, and is disrupting the Complainants' business.

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") that it considers supportive of its position, and requests the transfer of the disputed domain names.

B. Respondent

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

On June 23, 2023, the Respondent sent an unsigned informal email communication to the Center indicating, "If you want to buy my domain I'll sell it".

6. Discussion and Findings

The Complainants have made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Preliminary Issues: Multiple Complainants

The present proceeding involves two Complainants bringing a single complaint against a common Respondent. The Panel is satisfied, based on the evidence on the record, that the Complainants have a specific common grievance against the Respondent, in that the Complainants have a common legal interest, as the Complainant Taojing International Limited is the owner of the relevant trademarks, and the Complainant Zenni Optical, Inc. is the exclusive licensee of these marks. The Respondent's conduct affects the Complainants in a similar fashion, and the Panel considers that it is equitable and procedurally efficient to permit the consolidation. The Panel, therefore, grants the Complainants' request for consolidation. See section 4.11.1, [WIPO Overview 3.0](#).

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainants have adduced evidence to demonstrate their established rights in the ZENNI and ZENNI OPTICAL trademarks.

The disputed domain names incorporate most of the ZENNI mark, omitting one of the letters "n", and adding one of the terms "store", "style" or "wear". The first element of the Policy functions as a standing (or threshold) requirement. The Complainant's trademark ZENNI is recognizable in each of the disputed domain names, and the generic Top-Level Domains, ".shop" or ".com", are a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, 1.8, and 1.11 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainants' trademarks, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

C. Rights or Legitimate Interests

The Complainants' assertions and evidence effectively shift the burden to the Respondent of producing evidence of rights or legitimate interests in the disputed domain names (providing the circumstances of paragraph 4(c) of the Policy, without limitation), in order to rebut the Complainants' *prima facie* case. See section 2.1, [WIPO Overview 3.0](#).

However, the Respondent has not replied to the Complainants' contentions, not providing any explanation and evidence of rights or legitimate interests in the disputed domain names. In one informal email communication to the Center, the Respondent simply indicated an intention to sell the disputed domain names or one of the disputed domain names. The Complainants' representatives requested more information in this respect, but the Respondent did not reply to their request.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel considers that the Complainants have constructed a strong *prima facie* case evidencing that the Respondent is neither commonly known nor holds any intellectual property rights over the terms "zenni", or "zeni", has not been authorized to use the Complainants' trademarks, and there is no relationship between the Parties. In this respect, the Panel, under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has corroborated through a search over the Global Brand Database that the Respondent holds no trademark rights over the terms "zenni" or "zeni".

The Panel further notes that the terms "zenni" or "zeni" have no meaning in the English dictionary, and the Respondent's name, revealed by the Registrar verification, shares no resemblance with these terms.

The Panel has further corroborated that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names in the terms of paragraph 4(c)(iii) of the Policy. In this respect, according to the evidence provided by the Complainants, the disputed domain names resolve to PPC websites including links to third-party websites, some directly related to the Complainants' eyeglasses business, or to competitors in the same field. It may be reasonably assumed that such usage is commercial in its intent and effect, and does not represent a *bona fide* offering of goods or services, since such links compete with or capitalize on the reputation and goodwill of the Complainants and their marks, and may mislead Internet users. See section 2.9, [WIPO Overview 3.0](#).

Therefore, the circumstances of this case lead the Panel to conclude that nothing in the case file gives any reason to believe that the Respondent has any rights or legitimate interests in respect of the disputed domain names, and the second element of the Policy under paragraph 4(a)(ii) has been established.

D. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establishes that the disputed domain names have been registered and are being used in bad faith.

The applicable standard of proof is, likewise, the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain names:

- (i) the reputation of the ZENNI and ZENNI OPTICAL brands has been recognized by prior decisions under the Policy, and the Panel has corroborated that these trademarks have a strong presence over the Internet, so that any search over the Internet reveals these marks and the Complainants' online stores at "www.zenni.com" and "www.zennioptical.com";
- (ii) the number of three disputed domain names, all following a similar composition, incorporating the ZENNI mark, omitting one of its letters "n", which can be considered as a common misspelling of the mark, and adding terms commonly used in the same industry where the Complainant operates, all three disputed domain names generating an implied affiliation and risk of confusion;
- (iii) the three disputed domain names resolve to parked pages that offer the transfer of the respective disputed domain name, and comprise PPC links in various fields, including links (at one stage) to the Complainants' websites and/or to competing third parties' websites in the same sector of eyeglasses;
- (iv) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain names, and has not come forward to deny the Complainants' assertions of bad faith, choosing not to reply to the Complainants' contentions; and
- (v) the Respondent's reaction to the Complaint has been to offer the transfer of the disputed domain names (or of one/some of the disputed domain names, the Respondent did not clarify this offer).

The mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos 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, [WIPO Overview 3.0](#).

Furthermore, this presumption of bad faith is corroborated by the use of the disputed domain names that points to a specific target to the Complainants' trademarks to divert traffic to the Respondent's PPC sites competing with the Complainants' business for commercial gain.

Therefore, on the balance of probabilities, taking into consideration all cumulative circumstances of this case, the Panel considers that the disputed domain names were registered targeting the Complainants' trademarks in bad faith, in an effort to take unfair advantage and commercial gain by creating a false affiliation to these brands, which constitutes bad faith under the Policy; and/or to sell for a profit the disputed domain names (to the Complainants or to their competitors), which may also constitute bad faith under the Policy considering the circumstances of this case. See section 3.1.1, [WIPO Overview 3.0](#).

All of the above-mentioned circumstances lead the Panel to conclude that the disputed domain names were registered and used in bad faith. Accordingly, the Panel concludes that the Complainants have met their burden of establishing that the Respondent registered and used the disputed domain names in bad faith under 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 names, <zenistore.shop>, <zenistyle.com>, and <zeniwear.com>, be transferred to the Complainant Taojing International Limited.

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Sole Panelist

Date: August 10, 2023