

ADMINISTRATIVE PANEL DECISION

Taojing International Ltd. and Zenni Optical, Inc. v. Domain Admin,
Privacy Protect, LLC (PrivacyProtect.org) / Domain Admin,
TotalDomain Privacy Ltd
Case No. D2022-2599

1. The Parties

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

The Respondent is Domain Admin, Privacy Protect, LLC (PrivacyProtect.org), United States / Domain Admin, TotalDomain Privacy Ltd, Panama.

2. The Domain Names and Registrar

The disputed domain names <zeniopticals.com>, <zenniopical.com>, <zennioptcal.com>, <zenniopticals.com>, <zenniopitic.com>, <zenniopiticial.com>, <zenniopitcl.com>, <zennioptics.com>, and <zennioptoval.com> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 16, 2022. On July 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 20, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainants on July 20, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on July 22, 2022.

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 July 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 12, 2022.

The Center appointed John Swinson as the sole panelist in this matter on August 23, 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

The First Complainant owns trademark registrations for ZENNI and ZENNI OPTICAL. For example, the First Complainant owns United States Trademark Registration No. 3389855 for ZENNI that was registered on February 26, 2008; and United States Registration No. 3597735 for ZENNI OPTICAL that was registered on March 31, 2009.

The Second Complainant has been licensed these trademarks from the First Complainant.

The Second Complainant is the exclusive licensed operator of the websites known as "www.zennioptical.com" and "www.zenni.com". These websites sell eyewear, including prescription glasses.

The Respondent did not file a Response, so little is known about the Respondent. The name and contact details of the Respondent in the Registrar's records are a privacy service.

The disputed domain names were registered on the following dates:

<zeniopticals.com> - March 31, 2008;
<zennioptical.com> - November 22, 2006;
<zennioptcal.com> - December 14, 2006;
<zennioptic.com> - June 8, 2007;
<zenniopticals.com> - December 17, 2005;
<zennioptical.com> - June 19, 2007;
<zenniopticl.com> - October 10, 2007;
<zennioptics.com> - January 16, 2007; and
<zennioptoval.com> - December 6, 2021.

At the date of this decision, the disputed domain names resolve as follows:

<zeniopticals.com> - pay-per-click website with links to eyeglasses;
<zennioptical.com> - pay-per-click website with links to eyeglasses and clothing;
<zennioptcal.com> - redirects to pay-per-click website listing domain name for sale;
<zennioptic.com> - pay-per-click website with links to eyeglasses;
<zenniopticals.com> - pay-per-click website with links to eyeglasses;
<zennioptical.com> - pay-per-click website with links to eyeglasses;
<zenniopticl.com> - redirects to pay-per-click website listing domain name for sale;
<zennioptics.com> - redirects to pay-per-click website listing domain name for sale; and
<zennioptoval.com> - redirects to Chinese website displaying pornographic content with links to gambling websites.

5. Parties' Contentions

A. Complainants

In summary, the Complainants make the following submissions:

The Complainants are the owner of trademarks ZENNI, ZENNI OPTICAL, ZENNI OPTICAL.COM, and ZENNI.COM include international uses, registrations, and applications in various jurisdictions since 2002.

The Complainants intend to continue to use the trademarks ZENNI and ZENNI OPTICAL for its medical devices (eyeglasses) business. The Complainants' only current outlets are its online shops at <zenni.com> and <zennioptical.com>. The Second Complainant also sells eyeglasses and accessories through common carriers such as Amazon.com under the ZENNI OPTICAL trademark.

The Respondent is using many clever and calculated carefully engineered misspelling versions of the main words of the Complainants' trademarks.

The Complainants' customers consist of ordinary people who want to use the Complainants' internationally famous eyeglasses-purchasing website to buy ZENNI's relatively low-cost, high quality, and US-FDA inspected eyeglasses, including, but not limited to, elderly and retired, students, and young people trying to save money on eyeglasses. Thus the Complainants' typical customer may easily mistype ZENNI or OPTICAL and then be sent off to a competitor by misdirection.

Many of the Respondent websites acts like a referral catalog of competing eyeglasses sellers and direct Internet users and enables them to just click on the Complainants' competitors' websites.

The Respondent has no license or any permission to use the Complainants' trademarks in any form. Before any notice to the Respondent of the dispute, the Respondent created its infringing websites not for any *bona fide* offering of goods or services. There was no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the domain names in connection with a *bona fide* offering of goods or services, until the Complainants were notified by its Web URL Search Services vendor. Based on information and belief, the Respondent has never been commonly known by any of the disputed domain names. The Respondent does not appear to be making any legitimate uses of the disputed domain names and has parked them into these "referral" sites.

The Complainants believe from the willful nature of the multiple carefully assembled similar businesses selling eyeglasses that the Respondent registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registration(s) to or for the use of the Respondent and other person(s) or entity(ies) related to the Respondent, and to use the Complainants' trademarks to make money. A Cease-and-Desist letter inviting settlement has not stopped the Respondent. Neither the Respondent, nor its Registrar, have gotten in touch with the Complainants or their attorney.

Some of these disputed domain names are for sale such as: <zeniopticals.com> for USD 2,499; <zennioptical.com> for USD 4699; <zennioptical.com> for USD 12,499; and <zennioptics.com> for USD 42,199.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

To succeed, the Complainants must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The onus of proving these elements is on the Complainants.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Procedural Issue: Consolidation

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes where it would be equitable and procedurally efficient to permit the consolidation.

The Complaint has been filed by the two Complainants and relates to multiple domain names.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

Here, the Complainants have a common grievance against the Respondent. Further, it is equitable and procedurally efficient to allow the two Complainants to be parties on the same Complaint as they are the licensor and the licensee of the relevant trademarks.

Paragraph 3(c) of the Rules states that “the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder”.

Here, the disputed domain names are all listed in the Registrar’s records as being owned by the same entity. Moreover, the disputed domain names are all misspellings of the same trademark, have all been registered with the same Registrar, and some resolve to the same or very similar websites.

Accordingly, this Panel, having regard to all relevant circumstances, concludes that the consolidation of the multiple domain name disputes asserted by the Complainants against the Respondent is consistent with the Policy and Rules.

B. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainants must establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights.

The First Complainant owns trademark registrations for ZENNI and ZENNI OPTICAL.

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain names include the trademark, or a confusingly similar approximation. See, for example, *Consumer Reports, Inc. v. Wu Yan, Common Results, Inc.*, WIPO Case No. [D2017-0371](#); and *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

The disputed domain names include ZENNI or its misspelling version in their entirety, and also include OPTICAL or its misspelling versions. This is a classic case of typosquatting. A domain name is typically found to be confusingly similar to the trademark where there is typosquatting. See, for example, *Penningtons Manches Cooper LLP v. John Owens*, WIPO Case No. [D2021-4014](#).

The Panel concludes that the disputed domain names are confusingly similar to the First Complainant's trademarks.

The Complainants succeed on the first element of the Policy.

C. Rights or Legitimate Interests

The second requirement the Complainants must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain names:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainants.

UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case.

None of the circumstances listed in paragraph 4(c) apply in the present circumstances.

The Complainants allege that the Respondent does not have any license or permission to use the First Complainant's trademarks, and that the Respondent's websites are infringing the First Complainant's trademark rights and are therefore not *bona fide*.

Previous UDRP panels have found typosquatting does not constitute a legitimate noncommercial or fair use of a domain name. *Penningtons Manches Cooper LLP v. John Owens*, *supra*; *Akzo Nobel N.V. v. Privacy Service Provided by Withheld for Privacy ehf / jennifer alonso, jennyart*, WIPO Case No. [D2021-4244](#).

The Complainants have rights in the ZENNI trademark which precedes the Respondent's registration of the disputed domain names.

There is no evidence that the Respondent is commonly known by the disputed domain names.

The Complainants have established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain names and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain names.

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain names. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the disputed domain names.

The Complainants succeed on the second element of the Policy in relation to the disputed domain names.

D. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainants must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

The Respondent's conduct demonstrates the Respondent's knowledge of the Complainants and the First Complainant's trademarks. By registering the disputed domain names, which are slight variations and misspelling of the First Complainant's trademarks, and then using the disputed domain names to advertise eyewear products in competition with the Complainants, demonstrates that the Respondent specifically knew of and targeted the Complainants. See *Fédération Française de Tennis (FFT) v. Daniel Hall, dotCHAT, Inc.*, WIPO Case No. [D2016-1941](#).

Moreover, the use of a domain name to divert traffic to a website displaying pornography has been found to constitute bad faith use. See, e.g., *Valvoline Licensing and Intellectual Property LLC v. Andrei Arhipov*, WIPO Case No. [D2017-2453](#).

It is well established that typosquatting is evidence of bad faith under the Policy. See *ZB, N.A. v. Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2018-1959](#).

The Respondent has not filed a Response and hence has not availed itself of the opportunity to present any case of good faith that it might have. Noting the circumstances of this case, the Panel infers that none exists. See *Regal Funds Management Pty Limited v. WhoisGuard Protected, WhoisGuard, Inc. / John Clerk*, WIPO Case No. [D2020-2773](#).

Further, the Respondent has concealed its identity.

The Panel finds that the Respondent has both registered and used the disputed domain names in bad faith.

The Complainants succeed on the third element of the Policy in relation to the disputed domain names.

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, <zeniopticals.com>, <zenniopical.com>, <zennioptcal.com>, <zenniopticals.com>, <zenniopic.com>, <zennioptical.com>, <zenniopticl.com>, <zennioptics.com>, and <zennioptoval.com>, be transferred to the Complainants.

/John Swinson/

John Swinson

Sole Panelist

Date: September 6, 2022