

ADMINISTRATIVE PANEL DECISION

Taojing International Ltd., and Zenni Optical, Inc. v. Tung Tr\u01b0\u01a1ng, 33086406860; Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico; and PAUL DORIS
Case No. D2022-1576

1. The Parties

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

The Respondents are Tung Tr\u01b0\u01a1ng, 33086406860, Viet Nam; Registration Private, Domains By Proxy, LLC, United States / Carolina Rodrigues, Fundacion Comercio Electronico, Panama; and PAUL DORIS, United States.

2. The Domain Names and Registrar

The disputed domain names <zenbniptical.com>, <zenimarketing.com>, <zenniaptical.com>, <zenniaptical.com>, <zenniapticala.com>, <zenniapticalk.com>, <zenniapticqal.com>, <zenniapticxal.com>, <zenniaptisal.com>, <zenniaptiucal.com>, <zenniaptixcal.com>, <zenniaptical.com>, <zennyinc.com>, <zernniptical.com>, and <zewnnioptical.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 30, 2022 regarding 17 domain names, namely: <zenbniptical.com>, <zenimarketing.com>, <zenniaptical.com>, <zenniaptical.com>, <zenniapticala.com>, <zenniapticalk.com>, <zenniapticqal.com>, <zenniapticxal.com>, <zenniaptisal.com>, <zenniaptiucal.com>, <zenniaptixcal.com>, <zenniaptical.com>, <zennyinc.com>, <zernniptical.com>, <zewnnioptical.com>, <zeniprint.com>, and <maiazennie.com>. On May 4, 2022, the Center transmitted by email to NameCheap, Inc., and the Registrar requests for registrar verification in connection with the disputed domain names. On May 4, 2022, and May 5, 2022, NameCheap, Inc., and the Registrar transmitted by email to the Center their respective verification responses, disclosing registrant and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to the Complainants on May 10, 2022, notifying them that the Complaint was administratively deficient, providing the registrant and contact information disclosed by NameCheap, Inc. and the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on May 11, 2022, withdrawing

the domain names <zeniprint.com> and <maiazennie.com> from the current proceedings. The Center sent the Notification of Withdrawal on May 17, 2022, and the proceeding continued with the remaining 15 disputed domain names.

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 Respondents of the Complaint, and the proceedings commenced on May 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on June 20, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on July 4, 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. Procedural issue: Joint complaints

The First and Second Complainants have asserted that it is appropriate for their respective complaints to be dealt with within a single Complaint as the First Complainant is the owner of the trade marks relied on in the Complaint and the Second Complainant is the exclusive licensee of those marks and the operator of the Complainants’ websites.

Paragraph 10(e) of the UDRP Rules provides that a panel has the power to consolidate multiple domain name disputes. Paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder (as to which, see below). Section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) considers the position of multiple complainants filing against a single respondent and explains that: “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”.

In circumstances where both Complainants are members of the same group of companies and have advanced the same complaint against the Respondents arising from the same conduct, it is appropriate for their assertions to be dealt with within the same proceedings under the Policy and the Panel therefore accepts that the Complaint is properly brought in its current form. In the remainder of this decision, it is unnecessary to distinguish between the Complainants and they are referred to as “the Complainant”.

5. Procedural issue – Complaint filed against multiple Respondents

The underlying registrants of the disputed domain names <zennyinc.com> and <zenimarketing.com> are Tung Tr\u01b0\u01a1ng, 33086406860 and Paul Doris respectively. The underlying registrant of the remaining disputed domain names is Carolina Rodrigues, Fundacion Comercio Electronico.

Whilst neither the Policy nor the Rules expressly provides for the consolidation of claims against multiple respondents into a single administrative proceeding, the principles applied by panels considering requests for consolidation are set out at section 4.11.2 of the [WIPO Overview 3.0](#). This explains that: “Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable

to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.” See also *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

As is explained below, the use made of each of the disputed domain names has been essentially the same and the disputed domain names all comprise typo-squat variations of the Complainant’s marks. Furthermore, all the disputed domain names were registered within the same six week period, in early 2022, and with the same Registrar. These factors, in combination, point to the disputed domain names being under common control. The Panel notes also that none of the Respondents has challenged the Complainant’s assertions in this respect.

In these circumstances, it is procedurally efficient, as well as fair and equitable to all parties, for the Complainant’s case in respect of all the disputed domain names to be dealt by means of a single Complaint. The Panel accordingly grants the Complainant’s request for consolidation and the Respondents are referred to in the remainder of this decision as “the Respondent”.

6. Factual Background

The Complainant is a large, international supplier and online retailer of eyewear. Its primary brands are ZENNI and ZENNI OPTICAL and it owns trade marks in various jurisdictions in relation to each of these marks (“ZENNI Marks”), including, by way of example;

- United States trade mark for ZENNI in class 9, registration number 3,389,855, registered on February 6, 2008;

- United States trade and service mark for ZENNI OPTICAL in classes 9 and 35, registration number 3,597,735, registered on March 31, 2009.

The Complainant also owns and operates the domain name <zennioptical.com>, which resolves to a website at which the Complainant’s products are offered for sale, and <zenni.com>, which redirects to the Complainant’s website at “www.zennioptical.com”.

Each of the disputed domain names was registered between January 1, 2022, and February 10, 2022. At the time of filing the Complaint, all the disputed domain names, save for <zennioptical.com>, which redirected to a page within the Complainant’s website, displaying oval-shaped glasses for sale, linked through to directory webpages comprising pay-per-click (“PPC”) links. The webpages were headed with the name of the respective disputed domain name and featured links which usually related exclusively to eyewear products although, in one or two cases, unrelated links, such as “B2b Marketing” and “Custom Print” also featured. Many links were clearly referable to the Complainant and its products, such as “Zenni Optical Eyeglasses”, “Zenni Eyewear”, and “Zenni Optical”. Some webpages included or comprised more generic links, which related to the types of products sold by, or likely to be associated with, the Complainant, such as “Affordable Eyewear”, “Order Free Trial Contact Lenses Online”, and “Prescription Eyeglasses”. The style of the directory pages was generally very similar. Clicking on the links usually took the Internet users to the website of a competitor of the Complainant but, in some instances, redirected to a page within the Complainant’s website which displayed a particular product or range of products.

Since the filing of the Complaint, the nature of the websites to which some of the disputed domain names resolve has changed. In particular, <zenbniptical.com>, <zennioptical.com>, <zennioptical.com> and <zennioptical.com> have more recently resolved or redirected to webpages which invite the Internet users to download software which, most likely, comprises malware. <zenniopticala.com>, <zenniopticalq.com>, <zenniopticalx.com>, <zennioptical.com>, <zennioptical.com>, and <zenniopticalk.com> have redirected to an unrelated third party entertainment website. <zenrniptical.com> has redirected to a Microsoft Bing

search engine page containing the results of a search for this disputed domain name and <zewnnioptical.com> has redirected to a third party website selling holidays¹.

7. Parties' Contentions

A. Complainant

The Complainant says that each of the disputed domain names is confusingly similar to one or both of its ZENNI Marks. Each comprises a typo-squat variation intended to divert Internet users who may mis-type the Complainant's name into the address bar of their Internet browser when seeking the Complainant's website and thereby be diverted to the website to which the respective disputed domain name resolves.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent has not had any licence from the Complainant to use its marks. The use of the disputed domain names for the purpose of resolving to webpages containing links which take Internet users either to websites of the Complainant's competitors, from which the Respondent will derive click-through income, and/or to parts of the Complainant's own website, is damaging to the Complainant and its reputation. Such use of the disputed domain names by the Respondent does not comprise a legitimate noncommercial or fair use of them and is depriving the Complainant's customers of the full benefits of the Complainant's goods and services.

The Complainant says finally that the disputed domain names were registered and are being used in bad faith. The Respondent has registered the disputed domain names in order to undertake click fraud and to disrupt the business of the Complainant and it has not responded to the Complainant's cease and desist letters. The disputed domain names were registered in order to prevent the Complainant from registering its marks in a corresponding domain name and the Complainant believes the Respondent has engaged in a pattern of such conduct. Additionally, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its websites and its use of the disputed domain names. In particular, it is well established that the use of a domain name in order to generate revenue in respect of click-through traffic, in these circumstances, is in bad faith.

B. Respondent

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

8. Discussion and Findings

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission, as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

(i) the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

¹ As explained at section 4.8 of the [WIPO Overview 3.0](#), UDRP panels may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. The Panel has accordingly visited the websites to which each of the disputed domain names resolve to establish the use which is presently being made of them.

- (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.

A. Identical or Confusingly Similar

The Complainant has provided evidence of its trade and service mark registrations for ZENNI and ZENNI OPTICAL, example registrations for each of these marks having been set out above. It has thereby established its rights in these marks.

For the purpose of considering whether the disputed domain names are identical or confusingly similar to the ZENNI Marks, the generic Top-Level Domain (“gTLD”) “.com” is typically disregarded as this is a technical requirement of registration. Ten of the disputed domain names have, as their opening portion, the Complainant’s ZENNI mark in full. The additional components of each of these disputed domain names would not prevent them from being considered confusingly similar to the Complainant’s mark; see section 1.8 of the [WIPO Overview 3.0](#): “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. The remaining disputed domain names, namely <zennyinc.com>, <zernnioptical.com>, <zewnnioptical.com>, <zenbnioptical.com>, and <zenimarketing.com>, do not reproduce either of the Complainant’s ZENNI Marks exactly. However, notwithstanding the misspellings, all the disputed domain names are recognizably typo-squat variations of one or both of them. As explained at section 1.9 of the [WIPO Overview 3.0](#): “A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element”.

Moreover, the content of the websites to which each of the disputed domain names has resolved establishes that the Respondent has been seeking to target the Complainant’s marks and business and has registered them because it believes them to be confusingly similar to the Complainant’s mark, thereby affirming their confusing similarity; see *Golden Goose S.p.A. v. Phillip Fischer*, WIPO Case No. [D2017-1010](#).

The Panel therefore finds that each of the disputed domain names is confusingly similar to a trade or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, without limitation, examples of circumstances whereby a respondent might demonstrate that it has rights or legitimate interests in a domain name. In summary, these are if a respondent has used, or made demonstrable preparations to use, the domain name in connection with a *bona fide* offering of goods and services, if a respondent has been commonly known by the domain name or a name corresponding to the domain name, or if a respondent has made a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark in issue.

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 capitalise upon, the reputation and goodwill of a complainant’s trade mark. Whilst, as at the time of filing the Complaint, each of the disputed domain names, save for <zennioptisal.com> contained links which took Internet users to competitors of the Complainant, which clearly capitalize upon the Complainant’s reputation, the same principle applies to those links which have no obvious connection with the Complainant because the Respondent has been using, without the Complainant’s consent, the fame of its marks in order to attract Internet users to its webpage, and thereby derive an unfair commercial benefit from its use of the Complainant’s marks. Nor did the earlier use of the disputed domain name <zennioptisal.com> simply to redirect to the Complainant’s own website establish rights and a legitimate interest on the part of the Respondent; see *CMA CGM v. Domains By Proxy, LLC / Jeanne Dedit*, WIPO Case No. [D2021-2733](#).

So far as the more recent uses of to which some of the disputed domain names have been put are concerned, the use of a website featuring a notice inviting Internet users to download software likely to be malware is concerned, does not confer any rights or legitimate interests on a respondent; see section 2.13.1 of the [WIPO Overview 3.0](#) and, by way of example, *Royal Caribbean Cruises Ltd. v. Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-2049](#). Nor does the use of the disputed domain names to unrelated third party websites comprise use connection with a *bona fide* offering of goods and services; see, for example, *U.S. Smokeless Tobacco Company LLC v. Host Master, 1337 Services LLC*, WIPO Case No. [D2021-2854](#).

There is no evidence that the Respondent has been commonly known by any of the disputed domain names and the second circumstance under paragraph 4(c) of the Policy is therefore inapplicable. The third circumstance is also inapplicable; the Respondent has been making a commercial use of each of the disputed domain names and such use is, for the reasons outlined above, not fair.

Once a complainant has made out a *prima facie* case that a respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it does have such rights or legitimate interests. In the absence of any response from the Respondent to the Complaint, it has failed to satisfy that burden. The Panel accordingly finds that the Respondent has no rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

The fact that the each of the disputed domain names comprises a typo-squat variation of the Complainant's ZENNI and ZENNI OPTICAL mark and that they have been used to resolve to directory pages containing links to websites of the Complainant's competitors, and/or which redirect Internet users to the Complainant's website, establishes, that the Respondent was aware of the Complainant as at the date of registration of the disputed domain names and that they were registered in order that the Respondent could profit unfairly from the connection which Internet users would make between them and the Complainant. Moreover, it is well-established under the Policy that typo-squatting comprises evidence of registration of a domain name in bad faith; see, for example, *Wesco Aircraft Hardware Corp. v. Contact Privacy Inc. Customer 1245095601 / Gulf Guns and Gear*, WIPO Case No. [D2019-2131](#). The Panel therefore finds the registration of each of the disputed domain names to have been in bad faith.

Whilst the use of a domain name to point to a parking page hosting PPC sponsored links is not inherently objectionable, previous decisions under the Policy have found that such conduct can constitute bad faith use if the combination of the characteristics of the domain name and the nature of the links on the website to which it resolves are intended to mislead Internet users. The use of the disputed domain names to resolve to webpages containing PPC links exploit the reputation of the Complainant, irrespective of whether the links on the Respondent's webpages are, or have been, clearly referable to the Complainant (such as "Zenni Eyewear") or more generic (such as "Prescription Eyeglasses") or unrelated (such as "B2b Marketing") because in all instances, Internet users will have been drawn to the directory page because of the confusing similarity between the relevant disputed domain name and the Complainant's ZENNI Marks. As explained by the panel in *Yahoo! Inc. v. Hildegard Gruener*, WIPO Case No. [D2016-2491](#): "the use, to which the disputed domain names are put, namely parking pages featuring sponsored advertising links, is calculated to attract Internet users to the site in the mistaken belief that they are visiting a site of or associated with the Complainant. The object has to be commercial gain, namely pay-per-click or referral revenue achieved through the visitors to the site clicking on the sponsored advertising links. Even if visitors arriving at the websites to which the disputed domain name resolve become aware that these websites are not such of the Complainant, the operators of these websites will nonetheless have achieved commercial gain in the form of a business opportunity, namely the possibility that a proportion of those visitors will click on the sponsored links". Such use falls within the circumstance of bad faith use set out at paragraph 4(b)(iv) of the Policy in that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The previous use of the disputed domain name <zennioptisal.com> to redirect to the Complainant's website also comprises bad faith registration and use in that it confirms the Respondent's intention to target the Complainant and creates the potential for confusion as Internet users are likely to consider the disputed domain name is, in some way, associated with the Complainant; see *Accenture Global Services Limited v. Domain Administrator*, See *PrivacyGuardian.org / Tu Do, Nguyen Thi Ha Linh*, WIPO Case No. [D2020-0164](#).

The more recent uses to which some of the disputed domain names have been put, namely to resolve to unrelated third parties websites is essentially the same in its intention and effect as the earlier uses to which they have been put and therefore also comprises bad faith use. Finally, the use of some of the disputed domain names to resolve or redirect to websites likely to contain and distribute malware comprises paradigm bad faith use under the Policy; see, for example; *Sunrise Senior Living, LLC v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1620](#).

The Panel therefore finds, for the above reasons, that the disputed domain names were registered and are being used in bad faith. It is not therefore necessary to consider the Complainant's additional submissions in respect of the third element.

9. 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, <zenbnioptical.com>, <zenimarketing.com>, <zenniaptical.com>, <zenniaptical.com>, <zenniapticala.com>, <zenniapticalk.com>, <zenniapticqal.com>, <zenniapticxal.com>, <zenniaptisal.com>, <zenniaptiucal.com>, <zenniaptixcal.com>, <zenniaptical.com>, <zennyinc.com>, <zernnioptical.com>, and <zewnnioptical.com>, be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: July 18, 2022