

ADMINISTRATIVE PANEL DECISION

Zenni optical, inc. and Taojing International Ltd v. Yaozhong Chen Yaozhong Chen

Case No. D2022-2169

1. The Parties

The Complainants are Zenni optical, inc., United States of America and Taojing International Ltd, China, represented by Green & Green Law Offices, United States of America.

The Respondent is Yaozhong Chen Yaozhong Chen, United States of America (“U.S.”).

2. The Domain Names and Registrar

The disputed domain names <zenniopcital.com>, <zenniopticalai.com>, <zenniopticalcoupon.com>, <zenniopticalcleyeglasses.com>, <zenniopticalpromocode.com>, <zennioptical.com>, <zenniopticalcal.com> and <zennioptical.com> are registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2022. On June 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 16, 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 Complainant on June 17, 2022 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 June 27, 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 June 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2022. The Respondent did not submit any formal response. The

Center received email communications from a third party by email on June 17, 2022 and June 28, 2022. On July 19, 2022, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on August 3, 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

Taojing International, Limited and Zenni Optical, Inc. (the "Complainants") are the licensor and licensee of the following intellectual property:

ZENNI U.S. Registration Number: 4345783, registered on June 4, 2013;
ZENNI OPTICAL U.S. Registration Number: 3597735, registered on March 31, 2009;
ZENNI U.S. Registration Number: 3389855, registered on February 26, 2008; and
ZENNI U.S. Registration Number: 5413386, registered on February 27, 2018.

The Complainants operate the following websites "www.zennioptical.com" and "www.zenni.com".

The disputed domain names were registered on July 30, 2019 and resolve to parking websites offering the disputed domain names for sale.

5. Parties' Contentions

A. Complainants

The Complainants' business focuses on online retail store services in the field of eyeglasses, most of which are prescription, ophthalmic, vision correcting medical devices. The Complainants' only current outlets are its online shops at <zenni.com> and <zennioptical.com>.

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

The disputed domain names are all typosquatting uses intended to cause a confusing version of the Complainants' actual word trademarks and domain names.

The use of the disputed domain names by the Respondent is an egregious use for sale attempted to be sold for prices that are outrageous and an obvious attempt to extort the Complainants, who would want to prevent the disputed domain names from being owned by others. It is extremely likely to cause confusion and to cause the public finding the Respondent's Website(s) to believe that ZENNI, one of the Complainants, would want to sell (or buy) these disputed domain names. It is also a trend that "ZENNI" "OPTICAL" domain names are actioned constantly and seem to be popular for generating false websites.

The Respondent was offering the disputed domain names for exorbitant amounts most of them over USD 2,000 per domain name.

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 disputed domain names in connection with use of the Respondent's disputed domain names, until the Complainants were notified by its Web URL Search Services vendor. The Respondent has received no license or authorization of any kind to use the ZENNI marks, or any URLs like them.

The fact that the parking website itself offered to sell the disputed domain names shows that the Respondent does not intend to operate or begin to operate a legitimate *bona fide* business using the disputed domain names.

The Complainants believe from the willful nature of the copying, 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' marks to make money. Even after the Cease-and-Desist letter inviting settlement, to the Respondent, none of this has stopped.

It is certain from the nature of the Respondent's use of the confusingly similar and almost identical URLs that by using the disputed domain names, the Respondents are intentionally attempting to attract for commercial gain by offering them at huge prices. They attract Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites using color and layout versions of the Complainants' marks. Thus, it is implausible that any good faith use to which the disputed domain names may be put.

B. Respondent

The Respondent did not reply to the Complainants' contentions. As indicated above, the Center received two email communications from a third party claiming to be the registrant and who was stating mainly that "ZenniOptical has never approached me to negotiate anything related to these domains. They can't simply take over all domains "zennixxxxxx.com" without paying anything".

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainants have demonstrated they own registered trademark rights in the ZENNI trademark throughout the world. The addition of the terms incorporating "optical" and misspellings of "optical" does not prevent a finding of confusing similarity as the Complainants ZENNI mark is clearly recognizable in the disputed domain names. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Accordingly, the disputed domain names are confusingly similar to a mark in which the Complainants have rights.

B. Rights or Legitimate Interests

The Complainants have presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain names and has not been commonly known by the disputed domain names. The fact that the Respondent obtained the disputed domain names years after the Complainants had begun using the well-known ZENNI mark indicates the Respondent sought to piggyback on the Complainants for illegitimate reasons specifically to force the Complainants to purchase the disputed domain names for an exorbitant price in order to prevent other bad actors from using the disputed domain names.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain names.

In the absence of any evidence rebutting the Complainants *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Panel finds that the Complainants have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The disputed domain names were registered many years after the Complainants first registered and used the well-known ZENNI mark. The evidence on the record provided by the Complainant is sufficient to satisfy the Panel that, at the time the disputed domain names were registered, the Respondent undoubtedly knew of the Complainants ZENNI mark, and knew that it had no rights or legitimate interests in the disputed domain names. There is no non-benign reason for the Respondent to have registered a domain names containing the ZENNI mark and the term "optical" plus misspellings of "optical", which relate to the Complainants' business.

Further, the use of the disputed domain names by the Respondent is in bad faith. The Respondent was attempting to pressure the Complainants into purchasing the disputed domain names for an exorbitant price far in excess of the cost of registration knowing the Complainants did not want other third parties to use the disputed domain names to sell knockoff versions of the Complainants' ZENNI products.

Accordingly, the Panel finds that the disputed domain names have been registered and are being used in bad faith.

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 <zenniopcital.com>, <zenniopticalai.com>, <zenniopticalcoupon.com>, <zenniopticalteyeglasses.com>, <zenniopticalpromocode.com>, <zennioptical.com>, <zennioptilcal.com> and <zennioptpcal.com> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: August 16, 2022