

ADMINISTRATIVE PANEL DECISION

Taojing International Limited, and Zenni Optical, Inc. v. DOMAIN ADMINISTRATOR, Buy this domain on Dan.com ---- c/o Dynadot
Case No. D2022-2964

1. The Parties

The Complainants are 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 Domain Administrator, Buy this domain on Dan.com ---- c/o Dynadot, United States.

2. The Domain Name and Registrar

The disputed domain name <remakesbyzenni.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 10, 2022. On August 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on August 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amended Complaint on August 15, 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 August 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 16, 2022.

The Center appointed Knud Wallberg as the sole panelist in this matter on September 22, 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, Taojing International Ltd., is the owner of a range of trademark registrations that consists of the element ZENNI in numerous jurisdictions since 2002, including 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; and United States Registration No. 6438164 for ZENNI.COM, registered on August 3, 2021, in class 9. The Complainant has also applied for registration of the figurative mark REMAKES BY ZENNI in the United States on May 19, 2022, for goods in class 9.

The Second Complainant, Zenni Optical, Inc., is the exclusive licensee of the Complainant, Taojing International Ltd., and is the operator of the online retail shops at the domain names <zennioptical.com> and <zenni.com>.

The Respondent registered the disputed domain name on May 23, 2002, and it is offered for sale or for lease at the website <dan.com>.

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain name is confusingly similar to the First Complainant's distinctive ZENNI mark, as it contains the mark in its entirety. Furthermore, the disputed domain name is identical to the word elements in the First Complainant's newly filed application for the trademark REMAKES BY ZENNI.

The Complainants further contend that the Respondent has never been commonly known by the disputed domain name, nor has the Respondent any trademark or service mark or any other rights to any ZENNI marks. Furthermore, the Respondent is neither using the disputed domain name in connection with a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the disputed domain name. The Respondent thus uses the disputed domain name solely for commercial gain since the Respondent offers to sell or lease the disputed domain name for profit.

The Complainants finally contend that that the Respondent has registered and is using the disputed domain name in bad faith. The Complainants' ZENNI mark is widely known, and the disputed domain does not only contain this mark in its entirety, but it is also identical to the Complainants' newly filed application for the trademark REMAKES BY ZENNI. The fact that the Respondent offers to sell or to lease the disputed domain name at a price in excess of the Respondent's out of pocket expenses is a clear indication of bad faith use, a view that is supported by the fact that the Respondent's registration of the disputed domain name prevents the Complainants from registering a domain name that is identical to their recently filed trademark REMAKES BY ZENNI.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

- (i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainants. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar (in the sense of the Policy) to the First Complainant's registered trademark because it contains the First Complainant's registered trademark ZENNI in its entirety with the addition of the two words "remakes" and "by" as prefixes. The generic Top-Level Domain ("gTLD") ".com" is a standard registration requirement and as such is disregarded under the first element confusing similarity test. See Section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

It follows from the information that is included in the Complaint, that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark in any way.

Further, given the circumstances of this case, the Panel is of the opinion that the Complainants have established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not rebutted this, and the way the Respondent has been and is using the disputed domain name (see below in Section 6.C) does not support a finding of rights or legitimate interests.

Consequently, the Panel finds that the conditions in paragraph 4(a)(ii) of the Policy are also fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove both registration and use of the disputed domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances, which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name;

or

(ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's website or location or of a product or service on the holder's website or location.

Accordingly, for the Complainants to succeed, the Panel must be satisfied that the disputed domain name has been registered and is being used in bad faith.

The disputed domain name not only contains the Complainants' widely used and distinctive trademark ZENNI, but it is also identical to the word elements of the Complainants' recently filed application for the trademark REMAKES BY ZENNI. Noting that the disputed domain name was registered four days after the Complainants filed the said application, it is therefore inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainants and the Complainants' marks.

The Panel thus finds that the disputed domain name was registered in bad faith.

The disputed domain name is offered for sale or for lease at a price likely in excess of the holder's out-of-pocket costs directly related to the disputed domain name, which is in itself a clear indication of bad faith use. Paragraph 4(b)(i) of the Policy. Furthermore, the Respondent's registration of the disputed domain name prevents the Complainants from registering a domain name that is identical to their recently filed trademark REMAKES BY ZENNI, which supports a finding of bad faith, see paragraph 4(b)(ii) of the Policy.

Noting that the disputed domain name incorporates the Complainants' distinctive trademark ZENNI, that no response has been filed, that there appears to be no conceivable good faith use that could be made by the Respondent of the disputed domain name, that the disputed domain name is offered for sale or lease, and that the Respondent's registration effectively prevents the Complainants from registering the identical domain name and considering all the facts and evidence, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

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 name <remakesbyzenni.com> be transferred to the Complainants.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: October 12, 2022