

## **ADMINISTRATIVE PANEL DECISION**

Taojing International Limited, Zenni Optical, Inc. v. Suhail Mirza  
Case No. D2022-4023

### **1. The Parties**

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

Respondent is Suhail Mirza, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <zennycreative.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Registration Private / Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email to Complainant on November 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 2, 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 Respondent of the Complaint, and the proceedings commenced on November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Response, in the form of a brief email, was filed with the Center on November 22, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on November 30, 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.

On December 5, 2022, the Panel issued Procedural Order No. 1, stating as follows:

“In view of Respondent’s November 22, 2022 email to the Center, the Panel orders Respondent to provide to the Center, on or before December 16, 2022:

1. Documentary evidence that Respondent’s wife is named Zenny;
2. Documentary evidence that Respondent’s wife is a “UX designer” (including samples of such work, receipts to purchase supplies, correspondence reflecting wife’s status as such); and
3. Documentary evidence that the website in question is being developed (including receipts reflecting web development).

In addition, Respondent shall state under oath, in a sworn affidavit, on or before December 16, 2022, that the documentary evidence submitted in response to this Procedural Order No. 1 is genuine and existed at the time this Procedural Order No. 1 was received, and Respondent shall state in such affidavit whether he was aware of Complainant or its ZENNI or ZENNI OPTICAL trademarks when he registered the Domain Name <zennycreative.com>.

Complainant shall have until December 23, 2022 to reply to Respondent’s response to this Procedural Order No. 1. [...]

The Panel reserves the right to seek additional information.”

Respondent did not respond to Procedural Order No. 1.

#### **4. Factual Background**

Complainant Taojing International, Limited is the owner of the trademarks discussed below. Complainant Zenni Optical, Inc. is the “international licensee of these marks for marketing on the Internet”. The Panel will refer to these Parties jointly as “Complainant”.

Complainant manufactures and sells eyeglasses, frames, and related accessories, and does so under the trademarks ZENNI and ZENNI OPTICAL. Complainant holds several registered trademarks for ZENNI or ZENNI OPTICAL, including United States Reg. No. 3,389,855 (registered on February 26, 2008) for ZENNI, United States Reg. No. 4,345,783 (registered on June 4, 2013) for ZENNI, and United States Reg. No. 3,597,735 (registered on March 31, 2009) for ZENNI OPTICAL.

Complainant operates a commercial website at the domain name <zennioptical.com>, and also owns the domain name <zenni.com>, which domain name is redirected to Complainant’s main website.

Annexed to the Complaint are several articles which discuss ZENNI eyeglasses and Complainant’s website. These articles suggest that the ZENNI brand enjoys a fair measure of consumer recognition.

The Domain Name was registered on September 4, 2022. The Domain Name resolves to a parking page created by the Registrar. The parking page states that the Domain Name is for sale, and the page contains hyperlinks such as “Zenni Glasses” and “Zenni Optical”. These hyperlinks, if followed, lead the user to websites offering eyeglasses made by Complainant’s competitors.

According to Respondent:

“I purchased the URL [the disputed domain name] for my wife. Her name is Zenny and she is a UX designer, hence ZennyCreative. I bought it so she can use it to put her portfolio. We have no intention of using this URL

for anything other than that. This was not purchased with the intent to use it for anything related to Zenni Optical's business. We are putting together the website now. If it is the intention to purchase the domain name from us, please let us know. Otherwise, we are going to be using it for her portfolio.”

As noted above, the Panel asked Respondent for evidence to corroborate the foregoing assertions, but Respondent provided no evidence to support them.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

### **B. Respondent**

The entirety of Respondent's Response is a November 22, 2022 email is quoted above in the “Factual Background” section.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has rights in the trademark ZENNI through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The word “Zenny” is visually very similar to the ZENNI mark, and the word “Zenny” is aurally identical to that mark. The additional word “creative” does nothing to dispel a finding of confusing similarity.

Complainant has established Policy paragraph 4(a)(i).

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

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

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Respondent sent the Center an email, quoted in full above, to explain his alleged reason for registering the Domain Name. The Panel asked Respondent for contemporaneous evidence to document his statement, but Respondent offered none. The addition of the word “creative” to the term “Zenny” (a typo of the ZENNI mark) creates a likelihood of confusion, since the word “creative” may easily be associated with a purveyor of eyeglasses having various designs. This leaves the Panel with little option but to conclude, on the record provided, that Respondent has no rights or legitimate interests in the Domain Name, and fabricated a story to explain his motives and conduct.

Complainant has established Policy paragraph 4(a)(ii).

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section.

Based on the undisputed record – which it is recalled included a second chance for Respondent to corroborate its motivations, the Panel concludes, on a balance of probabilities, that Respondent more likely than not had Complainant’s registered trademark ZENNI in mind when registering the Domain Name.

The Panel also concludes, based on the hyperlinks at the website which lead to the websites of Complainant’s direct competitors, that Respondent has engaged in bad faith use under the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

### **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 Domain Name <zennycreative.com> be transferred to Complainant Taojing International, Limited.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: December 23, 2022