

## **ADMINISTRATIVE PANEL DECISION**

Taojing International Limited, and Zenni Optical, Inc. v. PremiumDomains ForSale, Tropic Management Systems Ltd.

Case No. D2022-4049

### **1. The Parties**

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

The Respondent is PremiumDomains ForSale, Tropic Management Systems Ltd., United Kingdom.

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

The disputed domain name <zenniapp.com> 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 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2022.

The Center appointed Kaya Köklü as the sole panelist in this matter on December 14, 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 is the exclusive licensee of the Second Complainant for the sale of eyeglasses under the brand “Zenni” via the Internet.

The Second Complainant is the owner of various ZENNI trademarks (Annex 9 to the Complaint), including the United States Trademark No. 3,389,855 for the word mark ZENNI, registered on February 26, 2008, and covering protection for eyeglasses and related products as protected in class 9 (Annex 8 to the Complaint).

The First Complainant further operates domain names comprising the ZENNI trademark, namely <zenni.com> and <zennioptical.com>.

The Respondent is reportedly a company from Cayman Islands, Overseas Territory of the United Kingdom.

The disputed domain name was registered on May 30, 2022.

At the time of the Decision, the disputed domain name resolves to a parking page, which is used in connection with pay-per-click (“PPC”) links, whereas all provided links lead to eyewear and contact lenses of competitors of the Complainants (Annex 11 to the Complaint).

#### **5. Parties’ Contentions**

##### **A. Complainants**

The Complainants request the transfer of the disputed domain name.

The Complainants are of the opinion that the disputed domain name is confusingly similar to the registered ZENNI trademark of the Second Complainant.

Furthermore, the Complainants argue that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that that the Respondent has registered and is using the disputed domain name in bad faith.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

##### **6.1. Consolidation of Multiple Complainants**

The Complaint contains a request for consolidation of the First Complainant and the Second Complainant on the basis that they are related companies with a common grievance against the Respondent.

Taking into consideration that the Respondent has not rebutted the requested consolidation, the Panel finds that the First Complainant and the Second Complainant have established a *prima facie* case that the Complaint can be consolidated based on a common grievance and interest of both Complainants, in particular as the First Complainant is an exclusive licensee of the Second Complainant for the ZENNI trademark in the online environment. Hence, both of them are affected in their company name and trademark rights by the disputed domain name. The Panel is convinced that it is fair and equitable in the circumstances of the case to order the consolidation as requested (see section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

Consequently, the Panel accepts the consolidation request in this administrative proceeding and, for the ease of reference, refers to the First Complainant and the Second Complainant as “the Complainant” in the Decision, whenever appropriate.

## 6.2. Substantive Issues

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

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

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

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not formally replied to the Complaint. See *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#).

For the evaluation of this case, the Panel has further taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views stated therein.

### A. Identical or Confusingly Similar

To begin with, the Panel confirms that the Complainant has satisfied the threshold requirement of having trademark rights in ZENNI.

The Panel further finds that the disputed domain name is confusingly similar to the Complainant’s registered trademarks, as it is fully incorporating the Complainant’s ZENNI trademark.

As stated at 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 would generally not prevent a finding of confusing similarity. The mere addition of “app” does not, in view of the Panel, serve to prevent a finding of confusing similarity between the disputed domain name and the Complainant’s ZENNI trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of proving a negative, in particular as the evidence needed to show the Respondent’s rights or legitimate interests is primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy. *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

With its Complaint, the Complainant has provided *prima facie* evidence that the Respondent has no rights or legitimate interests, particularly no license to use the Complainant's trademarks within the disputed domain name.

Further, the Panel finds that the disputed domain name, which is confusingly similar to the Complainant's ZENNI trademark due to incorporating the ZENNI trademark in its entirety together with the commonly known abbreviation "app" for "smart phone application" obviously targeting the Complainant's trademark and business, carries a risk of implied affiliation or association, as stated in section 2.5.1 of the [WIPO Overview 3.0](#).

In the absence of a Response, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or provide any other evidence of a right or legitimate interest in the disputed domain name. Bearing in mind that the disputed domain name is yet not being actively used by the Respondent except for PPC's, the Panel does also not see any basis for assessing a *bona fide* offering of goods or services by the Respondent.

Hence, the Panel concludes that the Respondent does not have a right or legitimate interest in the disputed domain name according to the Policy, paragraph 4(a)(ii) and 4(c).

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

In the Panel's view, the Respondent has registered and is using the disputed domain name in bad faith.

The Panel is convinced that the Respondent must have had the Complainant's ZENNI trademark in mind when registering the disputed domain name. The Panel believes that the Respondent deliberately attempted to create a likelihood of confusion among Internet users and/or to free-ride on the goodwill of the Complainant's ZENNI trademark, likely for commercial gain and/or to disrupt the Complainant's business.

Consequently, the Panel has no doubt that the Respondent has registered the disputed domain name in bad faith.

As to bad faith use by the Respondent, the Panel notes that the disputed domain name is currently used for PPC links only, which explicitly provide for links to goods of competitors of the Complainant (Annex 11 to the Complaint). In line with the opinion of numerous UDRP panels before and section 3.5 of the [WIPO Overview 3.0](#), the Panel believes that the current use of the disputed domain name for PPC links only does not prevent a finding of bad faith use. In view of the Panel, the submissions and evidence provided by the Complainant rather support an inference of bad faith registration with the purpose of attempting to trade off the Complainant's goodwill in the trademark, and the Respondent has failed to rebut this presumption.

In this regard, the Panel also notes that it cannot conceive of any plausible and legitimate use of the disputed domain name that would be in good faith, except with an authorization of the Complainant. Particularly, as the disputed domain name comprises the Complainant's ZENNI trademark in its entirety (with the mere addition of "app"), the Panel is of the opinion that any website linked to the disputed domain name would likely cause the false impression that it is operated or at least endorsed or authorized by the Complainant.

In addition, the Panel accepts the failure of the Respondent to submit a response to the Complainant's contentions as an additional indication for bad faith use. The Panel is convinced that, if the Respondent had legitimate purposes in registering and using the disputed domain name, it would have substantially responded.

Taking all facts of the case into consideration, the Panel believes that this is a typical cybersquatting case, which the UDRP was designed to stop.

The Panel therefore concludes that the disputed domain name was registered and is being used in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(iii) of the Policy.

## **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 <zenniapp.com> be transferred to the Complainant.

*/Kaya Köklü/*

**Kaya Köklü**

Sole Panelist

Date: December 28, 2022