

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Domain Administrator, See
PrivacyGuardian.org / SEEK TOMM
Case No. D2022-1424

1. The Parties

The Complainant is Educational Testing Service, United States of America (“United States” or “U.S.”), represented by Jones Day, United States.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / SEEK TOMM, United States.

2. The Domain Name and Registrar

The disputed domain name <gretoefl.org> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2022. On April 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 21, 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 Complainant on April 22, 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 amendment to the Complaint on April 22, 2022.

The Center verified that the Complaint together with the amendment to 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 April 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2022.

The Center appointed Anne Gundelfinger as sole panelist in this matter on May 20, 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 Complainant, Educational Testing Service (“ETS”), is one of the world’s largest private non-profit educational testing and assessment organizations. The Complainant’s products and services measure knowledge and skills, promote learning and educational performance, and support education and professional development for people around the world. The Complainant develops, administers and scores more than 50 million tests per year, in more than 180 countries and 9,000 locations worldwide. In addition to assessments, the Complainant conducts educational research, analysis and policy studies and develops a variety of customized services and products for teacher certification, English language learning and elementary, secondary and postsecondary education. Furthermore, ETS maintains an extensive worldwide network of local test administrators and authorized testing centers.

Among the many tests and assessments developed and administered by the Complainant or its related companies are the well-known GRE and TOEFL tests. Since 1941, the Complainant has administered the GRE General Test and GRE Subject Tests (collectively, the “GRE tests”) to evaluate the abilities of prospective graduate and business school applicants. The GRE General Test is a comprehensive examination that evaluates various fields of common analytical thinking and writing abilities, reading comprehension and mathematical skills, while the GRE Subject Tests measure a student’s knowledge of a particular field of study.

Since 1964, the Complainant has administered the TOEFL test to evaluate the English proficiency of people whose native language is not English. Academic institutions around the world, as well as various independent organizations, agencies and foreign governments rely on TOEFL test scores to evaluate a person’s English-language proficiency. In addition, several medical certification and licensing agencies accept TOEFL test scores for admission and licensure purposes.

The Complainant’s GRE and TOEFL marks have been used and registered for decades for educational testing and related goods and services around the world. Among the Complainant’s registrations are the following registrations in the U.S. and China:

- GRE: U.S. Reg. No. 1,146,134, registered January 1981 in International Classes 16 and 41;
- GRE: U.S. Reg. No. 1,756,582, registered March 1993 in International Class 9;
- GRE: U.S. Reg. No. 1,943,796, registered December 1995 in International Classes 9, 16, 41 and 42;
- GRE: U.S. Reg. No. 4,400,269, registered September 2013 in International Class 9;

- GRE: China Reg. No. 176266, registered April 1983 in International Class 16;
- GRE: China Reg. No. 746675, registered May 1995 in International Class 9;
- GRE: China Reg. No. 771201, registered November 1994 in International Class 41;

- TOEFL: U.S. Reg. No. 1,103,427, registered October 1978 in International Classes 16 and 41;
- TOEFL: U.S. Reg. No. 2,461,224, registered June 2001 in International Class 9;
- TOEFL: U.S. Reg. No. 3,168,050, registered November 2006 in International Classes 16, 41 and 42;

- TOEFL: China Reg. No. 176265, registered April 1983 in International Class 16;
- TOEFL: China Reg. No. 771160, registered November 1994 in International Class 41; and
- TOEFL: China Reg. No. 746636, registered May 1995 in International Class 9.

Finally, the Complainant owns the domain names <gre.org> and <gre.com> both of which redirect to its website at “www.ets.org/gre” where it promotes goods and services under the GRE mark. The Complainant also owns the domain names <toefl.org>, <toefl.com>, and <toefl.net>, all of which redirect to its website at “www.ets.org/toefl” where it promotes goods and services under the TOEFL Mark.

On November 26, 2021, the Respondent registered the disputed domain name <gretoefl.org>, which currently resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name <gretoefl.org> is confusingly similar to its well-known and widely registered GRE and TOEFL marks, as well as its various domain names, because the disputed domain name incorporates the Complainant's GRE and TOEFL marks in their entirety.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name, since the Complainant has given no authorization for its use, the Respondent is not commonly known by the disputed domain name, and the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, but rather has registered and used it in bad faith.

In support of its allegation of bad faith the Complainant has submitted screen shot evidence that the disputed domain name resolved to a Chinese-language website offering cheating services for the GRE and TOEFL tests at the time of registration and at the time of filing its Complaint in this proceeding.

The Complainant asserts that, upon discovery of the Respondent's website under the disputed domain name, it sent a demand letter to the Respondent by using the email address found on the website at the disputed domain name. In response, the Respondent replied stating (among other things) as follows:

"Regarding any content on the website that infringes the intellectual property rights of ETS, such as logo trademarks, word trademarks, etc., I will immediately rectify and delete them. It is guaranteed that the content in question will not mislead others, that it will not confuse the public, and that it will not infringe on the goodwill of ETS. Sorry for all the inconvenience the website has caused to ETS!" (Translation from Chinese to English provided by the Complainant.)

Because the infringing and cheating content on the website continued to remain available, the Complainant sent a follow-up demand letter reiterating its request for the immediate takedown of the website and requesting the transfer of the disputed domain name. The Respondent did not reply to this second demand letter but apparently updated the website to include the following disclaimer:

"Disclaimer: This website and the domain name gretoefl.org have no substantive relationship with ETS.org, ETS official or GRE official. All opinions and remarks displayed on this website have nothing to do with ETS official. It is hereby explained to avoid confusion!" (Translation from Chinese to English provided by the Complainant.)

Based on the evidence submitted, the Complainant argues that the Respondent unfairly traded off of the Complainant's well-known GRE and TOEFL marks to offer cheating services to individuals seeking an unfair advantage to obtain a higher score on the GRE and TOEFL tests, and thereby interfered with the Complainant's offering of goods and services by intercepting, misdirecting and misleading members of the consuming public in bad faith.

Finally, the Complainant notes that the Respondent used a privacy service to shield its identity, which the Complainant argues is further evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove the following three elements to be successful in this action: (i) the disputed domain name is identical or confusingly similar to trademarks or service marks in which the Complainant has rights; (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.

A. Identical or Confusingly Similar

The disputed domain name <gretoefl.org> wholly incorporates not one but two of the Complainant's well-known marks, GRE and TOEFL, simply combining them without any other additions, deletions, or modifications. Given that each of the Complainant's marks is entirely incorporated and is recognizable within the disputed domain name, the test for confusing similarity is satisfied. See, section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and cases cited therein. The fact that the disputed domain name incorporates two of the Complainant's marks does not alter the Panel's conclusion under this test that both marks are recognizable, and the disputed domain name is confusingly similar to each of the Complainant's GRE and TOEFL marks.

Accordingly, the Panel finds that the Complainant has met its burden under the first element of the test.

B. Rights or Legitimate Interests

It is well established that a complainant must present a *prima facie* case in relation to the second element of the Policy, not mere allegations. Once a *prima facie* showing is made, the burden of production shifts to the respondent to come forward with evidence of rights or legitimate interests in the disputed domain name. This burden-shifting is appropriate given that the respondent is often the only party with access to evidence of its own rights or legitimate interests. Accordingly, where a respondent fails to file a response a UDRP panel may draw inferences from the failure to respond as appropriate under the circumstances of the case and while still weighing all available evidence irrespective of whether a response is filed. See, section 2.1 of the [WIPO Overview 3.0](#) and cases cited therein. See also, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here the Complainant has averred that there is no relationship between it and the Respondent, and that it did not authorize the Respondent's use of the disputed domain name. The Complainant further argues that the Respondent is not commonly known by the disputed domain name and is not using it in connection with a *bona fide* offering of goods and services but rather to offer cheating services, which the Complainant argues does not constitute a fair use or legitimate interest.

In the absence of a response or countervailing evidence from the Respondent, combined with the evidence of bad faith (discussed below), the Panel accepts the Complainant's arguments. The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks any rights or legitimate interests in the disputed domain name and that the Respondent has not rebutted that *prima facie* showing. In particular, the Panel agrees with the Complainant that the offering of cheating services under the disputed domain name does not establish any rights or legitimate interests, as discussed more fully below in the section regarding bad faith.

Accordingly, the Panel concludes that the Complainant has met its burden under the second element of the test.

C. Registered and Used in Bad Faith

The Complainant has submitted substantial, persuasive, and uncontested evidence that the Respondent registered and used the disputed domain name to host a website offering cheating services for the Complainant's GRE and TOEFL exams. Given the content of the Respondent's website, there can be no question that the Respondent knew of and targeted the Complainant's marks in the offering of cheating services for the GRE and TOEFL tests.

The question that may come to mind is whether the use of the Complainant's marks by the Respondent can be considered a nominative fair use, or whether such use is a use in bad faith. While the Respondent did not file a response in this proceeding, it did respond to the Complainant's demand letters through the email address listed on the website at the disputed domain name with statements and actions (e.g., removing logos, posting a disclaimer) that suggest that it may have intended to make only a nominative fair use by referencing the Complainant's marks only to the extent necessary to offer cheating services for the tests in question.

But does the use of the Complainant's marks to offer cheating services constitute fair or noncommercial legitimate use under the UDRP? This Panel finds it does not. This is not a case where the Respondent is making an arguably fair use of the Complainant's marks in offering legitimate preparation services for the Complainant's tests. Rather, it is the Panel's view that offering cheating services for the Complainant's exams under the Complainant's marks is far closer to counterfeiting than it is to fair use, given the damage it does to both the trademark owner and to the public. Specifically, offering cheating services interferes with and disrupts the Complainant's business by damaging the credibility and integrity of its exams and assessment services. It also harms the public by enabling cheaters to mislead and deceive potential private and public employers and academic institutions and thereby fraudulently gain employment or admission over those who actually have the required skills.

Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith to attract users to its website for commercial gain by creating a likelihood of confusion with the Complainant's GRE and TOEFL marks. See, paragraph 4(b)(iv) of the UDRP. The Respondent also disrupts the business of the Complainant by offering GRE and TOEFL cheating services. See, *National Council of State Boards of Nursing, Inc. v. Registration Private Domains By Proxy, LLC / NCLEX Office*, WIPO Case No. [D2020-2925](#) (finding bad faith where the respondent offered cheating services under the disputed domain name). See also, *Upwork Global Inc., Upwork Inc. v. Imran Khan, All Education info. / Md Abdul Malek, 1Links.in / Aman Shah, BollyJoGot.com / Rubel SbS, Hostsbs*, WIPO Case No. [D2017-1104](#).

Accordingly, the Panel concludes that the Complainant has met its burden under the third element of the test.

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 <gretoefl.org> be transferred to the Complainant.

/Anne Gundelfinger/

Anne Gundelfinger

Sole Panelist

Date: June 3, 2022