

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Registration Private, Domains By Proxy, LLC / Bogdan Andriychenko
Case No. D2022-1938

1. The Parties

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

Respondent is Registration Private, Domains By Proxy, LLC, United States / Bogdan Andriychenko, United States, self-represented.

2. The Domain Name and Registrar

The disputed domain name <gprepclub.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 27, 2022. On May 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 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 Complainant on June 2, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on June 2, 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 Respondent of the Complaint, and the proceedings commenced on June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. On July 1, Respondent requested a 15-day suspension of the proceeding. On July 5, 2022, Complainant consented to Respondent’s suspension request. On July 6, 2022, the Center sent a Notification of Suspension to the Parties, confirming the proceeding was suspended until July 19, 2022. Respondent filed its Response on July 18, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on July 28, 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

Complainant is a non-profit educational testing and assessment organization that develops, administers, and scores more than 50 million tests per year, in more than 180 countries and 9,000 locations worldwide, including the GRE® test, in which Complainant has trademark and copyright rights. Complainant also offers information and practice questions under the GRE trademark (“GRE Mark”). Complainant owns valid and subsisting registrations for the GRE Mark worldwide, including the following in the United States:

-GRE, United States Trademark Reg. No. 1,146,134, registered on January 20, 1981, in International Class 16 and 41;

-GRE, United States Trademark Reg. No. 1,756,582, registered on March 9, 1993, in International Class 9;

-GRE, United States Trademark Reg. No. 1,943,796, registered on December 26, 1995, in International Class 9, 16, 41 and 42.

Complainant owns and operates its primary website in connection with its testing goods and services at the domain name <ets.org>, and Complainant has a dedicated webpage for its GRE test at <ets.org/gre>. Complainant also owns several other domain names incorporating its GRE Mark, including <gre.com> and <gre.org>, which redirect to Complainant’s website at “www.ets.org/gre”.

The disputed domain name was created on March 9, 2010, and resolves to a website titled “Online GRE Prep English & Free GRE Study Material | GREPrepClub” (“Respondent’s Website”) which uses the capitalized letters “GRE” as a favicon. Respondent’s Website uses a “greprepclub” logo and offers free resources, including links to download a “GRE Prep Club” mobile app, test preparation services, and a discussion forum relating to Complainant’s GRE test. Respondent’s Website utilizes prominent headers such as “4 main reasons to join GRE Prep Club”, “Welcome to GRE Prep Club!”, “Latest GRE Discussions”, “GRE Prep Club Partners”, “Admissions Consulting Partners”, and “Student Loans & Financial Services”. At the bottom of the landing page on Respondent’s Website there are shortcuts in small type to various interior webpages, including *inter alia* “GRE Forum”, “General GRE Questions & Strategies,” “Free GRE Tests”, and “What is a Good GRE Score?” Underneath a copyright notice (“Copyright © 2022 GRE Prep Club”), in small type, are disclaimers, which read as follows: “GRE® is a registered trademark of the Education Testing Services® (ETS®). GRE Prep Club’s website has not been reviewed or endorsed by ETS”. Below that, at the very bottom of the landing page, is a link to Complainant’s official website, next to “About”, “Terms and Conditions and Privacy Policy” and “GRE Prep Club Rules” and “Contact” categories.

5. Parties’ Contentions

A. Complainant

Complainant argues the disputed domain name is confusingly similar to and incorporates the entirety of Complainant’s GRE Mark, a famous trademark, in which it has rights through its numerous trademark registrations worldwide for the same. Complainant argues consumers are likely to believe the disputed domain name is affiliated with, authorized, or endorsed by Complainant, and that the added terms “prepclub” do not alleviate the confusing similarity.

According to Complainant, Respondent has no rights or legitimate interests in the disputed domain name. Complainant asserts it never licensed or permitted Respondent to use Complainant’s GRE Mark or register a

domain name incorporating it, and Respondent's purpose in choosing the disputed domain name was plainly to use the fame of Complainant's GRE Mark to attract web traffic and confuse Internet users searching for Complainant and its products and services. Complainant asserts Respondent is not making a legitimate fair use of the disputed domain name as it incorporates Complainant's GRE Mark and users are likely to believe the disputed domain name owned by Complainant. Moreover, Complainant argues the resolving website at the disputed domain name uses Complainant's GRE Mark in the service mark and logo on each webpage, and that given the extensive advertising on the disputed domain name, the website is clearly for a commercial purposes, including the distribution and display of infringing copies of Complainant's copyrighted content.

Complainant contends the disputed domain name was registered and used in bad faith because Respondent clearly knew of Complainant's GRE Mark when Respondent registered the disputed domain name more than 60 years after Complainant began using the GRE Mark, which supports an inference of bad faith. In addition, Complainant argues Respondent registered and used the disputed domain name in connection with a website providing infringing copies of Complainant's copyrighted test materials and other mock examination materials for Complainant's GRE exam, in a bad faith attempt to usurp Complainant's offering of the same goods and services. Complainant also argues Respondent has continued to use Complainant's GRE Mark on Respondent's website, including as part of its service mark and logo, and in connection with links to download Respondent's mobile application titled "GRE Prep Club", which was released by "GMAT Club", thus creating the false impression Complainant offers, sponsors, or is affiliated with the GMAT exam, an exam offered by the Graduate Management Admission Council, Complainant's primary competitor in the graduate admissions testing market. Complainant concludes that Respondent is clearly holding the disputed domain name willfully, in bad faith, and in complete disregard of Complainant's exclusive rights to use the GRE Mark.

B. Respondent

Respondent states that the disputed domain name is owned and operated by a company named The GMAT Club, which was founded in December 2002. Respondent claims the disputed domain name was founded in May 2014 to provide a collaborative community and "prep club" for GRE test-takers to discuss their preparation for the GRE test.

Respondent contends the disputed domain name is not confusingly similar to Complainant's GRE Mark. Respondent contends a club for people preparing to take the GRE test is unlikely to be associated with the test provider itself, and analogizes by asserting that one would not buy a BMW car from a "BMW Club". Respondent argues that the name "GRE Prep Club" is distinct from Complainant's website hosted at its ".org" domain name (<ets.org>). Respondent also points out it has disclaimers on its websites, and that Respondent's Website uses a different logo that belongs to The GMAT Club, with "a group of students holding hands up, pointing to the type of union that its community foments" whereas Complainant's logo "consists exclusively of a dark blue italicized text." Respondent argues the "club" in the disputed domain name clarifies its goal of encouraging unity and collaboration amongst persons seeking to be successful at Complainant's graduate tests, and that if this was prohibited, all domain names related to common interest clubs would have to be cancelled. Respondent also argues it is not promoting Complainant's competitor, GMAT, as web traffic data shows more GMAT Club visitors visit Respondent's Website than vice versa. Respondent argues the GRE Prep Club mobile application was developed by The GMAT Club and that therefore there is no false impression that Complainant is affiliated with the GMAT test.

Respondent argues that before receiving notice of the dispute, Respondent had been using the disputed domain name for a long time in connection with a *bona fide* offering of goods or services, and that cancelling or transferring the disputed domain name would harm more than 100,000 graduate students that comprise the GRE Prep Club community. Respondent also argues it has been commonly known by Respondent's main domain name <gmatclub.com>, its mother company The GMAT Club, and the disputed domain name itself, GRE Prep Club. Respondent argues his goal to "operate a legitimate business and of not cybersquatting" is clear because Complainant is a test creation and test taking service offering distinct and different services with different domain names and logos.

Respondent asserts the disputed domain name was established with the *bona fide* goal of helping graduate test takers succeed, and that Complainant already has its own domain name at <ets.org> that is very different and not confusingly similar to the disputed domain name. Respondent argues it is not a competitor to Complainant and does not disrupt Complainant's business, based on web traffic analysis from Google's algorithm. Respondent argues postings of copyrighted material come from individual users on Respondent's Website, and not Respondent itself, similar to social media platforms, which like Respondent allow owners to request the removal of improper content. Respondent asserts Complainant in 2019 contacted Respondent to seek to advertise with Respondent, and this shows the disputed domain name does not harm Complainant's business but instead encourages Respondent's community to provide additional business to Complainant. Respondent also argues The GMAT Club website, which was reviewed by the owners of GMAT, the GMAC, was not deemed confusing or conflicting with the GMAT domain name, and that therefore there is no reason to assume that GRE Prep Club would be different, as it is not competitive and serves the community at large.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

A. Identical or Confusingly Similar

A complainant's ownership of a nationally or internationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Here, Complainant has provided evidence that it has rights in the GRE Mark through its U.S. trademark registrations.

The remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's GRE Mark (typically disregarding the Top-Level Domain ("TLD") in which the domain name is registered). It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name fully incorporates the GRE Mark. The addition of the terms "prep" and "club" and the TLD ".com" do not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), section 1.8; see, e.g., *SAP SE v. Anil Kumar Shetty, Zoreza Global Business Pvt. Ltd.*, WIPO Case No. [D2020-2985](#) (finding the addition of "prep" to a complainant's mark in <sapprep.com> did not prevent a finding of confusing similarity); *Bayerische Motoren Werke AG v. RC a/k/a Sami Salem*, WIPO Case No. [D2012-0366](#) (finding the addition of the term "club" to a complainant's mark in <bmwclub.net> did not detract from a finding of confusing similarity). Respondent's arguments about the significance of the added terms in the disputed domain name and elements of Respondent's Website, such as the disclaimers there, will be considered under the second and third elements *infra*, as they are inapposite under the first element, which focuses on a comparison of the textual elements of a complainant's trademark and the disputed domain name itself. See [WIPO Overview 3.0](#), section 1.7.

The Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to Complainant's GRE Mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent to produce evidence demonstrating rights or legitimate interests in the domain name, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained their burden under the second element of the UDRP. See [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the domain name:

- (i) before any notice of the dispute, the respondent's 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) the respondent (as an individual, business or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is 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.

Complainant did not grant Respondent a license, permission, or other right to use a domain name incorporating Complainant's GRE Mark, and Complainant has provided evidence lending itself to a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. The burden of production shifts to Respondent to produce evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent does not deny he makes commercial use of the disputed domain name, but states his is a "legitimate business", and contends he has rights or legitimate interests in the disputed domain name because he uses it in connection with *bona fide* offering of goods or services, namely, to provide a community to help graduate students succeed at the GRE test, and provide a club for discussion.

Respondent has provided evidence that it has used the disputed domain name and Respondent's Website for discussion of Complainant's GRE test and the provision of test-related resources. However, the disputed domain name incorporates Complainant's GRE Mark in its entirety, and the added term "prep", a common shorthand for "preparation" relates to testing, and thus Complainant's goods and services, whereas "club" arguably suggests a membership of some kind, and does not dispel confusing similarity. Accordingly, it is the view of the Panel that the disputed domain name implies an affiliation of some sort with Complainant. Domain names consisting of a trademark plus an additional term cannot constitute fair use if they effectively impersonate or suggest sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), sections 2.5 and 2.5.1.

The likelihood of confusion is also increased by Respondent's Website, which makes prominent, repeated use of Complainant's GRE Mark, including in its title ("Online GRE Prep English & Free GRE Study Material | GREPrepClub"); notably, Respondent's Website also makes intentional use of the "GRE" favicon, and logo, which wholly incorporates Complainant's GRE Mark. Though Respondent's logo differs from Complainant's GRE logo, Respondent's logo nonetheless wholly incorporates Complainant's GRE Mark without the addition whatsoever of any branding of the Respondent itself (e.g., "GRE prep by Respondent" or "Respondent's

GRE prep”), thus leaving it open for users to misunderstand the source of the services provided. Respondent has pointed to disclaimers on Respondent’s Website, but the disclaimers are in miniscule text at the bottom of the landing page, beneath much larger headers making prominent use of Complainant’s GRE Mark to promote Respondent’s services, such as “4 main reasons to join GRE Prep Club”, “Welcome to GRE Prep Club!”, “Latest GRE Discussions”, and “GRE Prep Club Partners”. Looking at Respondent’s Website holistically (see e.g., *Everytown for Gun Safety Action Fund, Inc. v. Contact Privacy Inc. Customer 1249561463 / Steve Coffman*, WIPO Case No. [D2022-0473](#) and cases cited therein) the disclaimers do not dispel the overall impression that Respondent’s Website is sponsored or endorsed by Complainant. Moreover, Respondent’s Website provides resources relating to Complainant’s GRE test, including links to Respondent’s “GRE Prep Club” mobile app, and a link to Complainant’s official website, which furthers the false impression that Respondent is sponsored by or affiliated with Complainant. The Panel accordingly finds that Respondent intended to use the disputed domain name to benefit from confusion with Complainant’s GRE Mark, and accordingly, Respondent’s use of the disputed domain name cannot be said to overcome Complainant’s *prima facie* case. See [WIPO Overview 3.0](#), section 2.5.2 (noting that panels look to circumstances beyond the domain name itself to assess a claimed fair use, such as whether it is clear to Internet users visiting the respondent’s website that it is not operated by the complainant, and whether the domain name registration and use by the respondent is consistent with a pattern of *bona fide* activity).

Respondent also argues that he has rights or legitimate interests in the disputed domain name because he is commonly known by the disputed domain name. A respondent can show it is commonly known by the domain name or a name corresponding to the domain name by producing independent and sustained examples of secondary material such as websites or blogs, news articles, correspondence with independent third parties; publications referring to the respondent being commonly known by the relevant name; bills/invoices; or articles of incorporation. [WIPO Overview 3.0](#), section 2.3. Respondent holds himself out as “GRE Prep Club” on Respondent’s Website, including in a copyright notice at the bottom of the landing page, but Respondent has not provided secondary material showing he is commonly known by the disputed domain name or a name corresponding to the disputed domain name. More to the point, Respondent has instead submitted evidence in its Annex 6 showing it is known by the “GMAT Club” moniker, in the form of an article dating to 2003 from the Graduate Management Admission Council, Complainant’s competitor in educational testing, which contains an interview with Respondent. Respondent tries to have it both ways by claiming to be commonly known by the disputed domain name and “The GMAT Club” name, but Respondent’s own references to the owner of the disputed domain name in its Response consistently name the owner as “The GMAT Club”, rather than a name corresponding to the disputed domain name.

Accordingly, the Panel finds that Complainant has sustained its burden of proof under the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

- “(i) circumstances indicating that you have registered or you have 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 your documented out of pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith, particularly domain names incorporating a complainant's mark plus a descriptive term. [WIPO Overview 3.0](#), section 3.1.4.

The Panel finds the evidence on the record indicates Complainant's GRE Mark is famous or widely-known and Respondent's registration of a domain name confusingly similar to – and bearing only Complainant's GRE Mark without any *indicia* of Respondent's branding or lack of affiliation with Complainant. Respondent does not contest Complainant's claim that Respondent was aware of Complainant's GRE Mark when Respondent registered the disputed domain name, and the evidence on record suggests the presumption of bad faith is well-founded. As discussed *supra*, the disputed domain name suggests sponsorship by or affiliation with Complainant because it wholly incorporates Complainant's GRE Mark, and the added term "prep" relates to Complainant's goods and services, while the added term "club" does not dispel the confusing similarity to Complainant's GRE Mark and there is no indication as to Respondent's brand name or otherwise. Respondent's Website also makes frequent, prominent use of Complainant's GRE Mark in connection with resources and services relating to Complainant's GRE test, and thus Respondent's Website also suggests sponsorship by or affiliation with Complainant.

Respondent's arguments regarding differences between Complainant's GRE logo and Respondent's logo on Respondent's Website, as well as the disclaimers on Respondent's Website, and the ownership of the disputed domain name by "The GMAT Club" do not avail Respondent, as these elements do not dispel the confusing similarity created by the prominent use of Complainant's GRE Mark in the disputed domain name and Respondent's Website. See, e.g., *On AG, On Clouds GmbH v. Nguyen Luu, Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf, Vuong Hoang, AN NGUYEN, NEO CORP., and Ngoc Tam Nguyen*, WIPO Case No. [D2021-1714](#) (finding unconvincing a respondent's arguments that the goods offered on its website used a different design and logo and that therefore they were unlikely to be confused with complainant's goods, in light of the disputed domain names' incorporation of the complainant's trademark); *SAP SE v. Anil Kumar Shetty, Zoreza Global Business Pvt. Ltd.*, WIPO Case No. [D2020-2985](#) (finding a respondent's addition of a disclaimer to its website does not change the analysis that the respondent targeted the complainant and its mark by registering a domain name incorporating the trademark in its entirety along with the abbreviation "prep" in connection with a website purporting to offer education and training programs similar to those offered by the complainant or its partners); [WIPO Overview 3.0](#), section 3.7 (noting "where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith"). Respondent has also argued that because Complainant's competitor who owns the GMAT exam, found a purportedly similar <gmatclub.com> domain name not to be confusing or conflicting with their domain name, and that therefore the disputed domain name should pose no issues here, but the approval of a third-party and competitor to Complainant has no bearing on whether the disputed domain name here was registered and used in bad faith.

Respondent has the right to register a domain name and use it for a website serving as a "club", discussion forum, and resource hub for individuals seeking to excel at Complainant's GRE test, but under the Policy, any such domain name (and resolving website) must not impersonate or suggest sponsorship or endorsement by the trademark owner.

The Panel finds Respondent obtained the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's GRE Mark as to the source, sponsorship, affiliation, or endorsement of Respondent's Website or of a product or services on Respondent's Website, within the meaning of Policy paragraph 4(b)(iv). See [WIPO Overview 3.0](#), section 3.1.4.

Accordingly, the Panel finds that Respondent registered and used the disputed domain name in bad faith, and Complainant succeeds under 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 <greprepclub.com> be transferred to Complainant.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: August 31, 2022