

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. cheng liang

Case No. D2023-0320

1. The Parties

The Complainant is Educational Testing Service, United States of America (“USA”), represented by Fross Zelnick Lehrman & Zissu, P.C., USA.

The Respondent is cheng liang, China.

2. The Domain Name and Registrar

The disputed domain name <toeicmethod.com> is registered with Gname 008 Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2023. On January 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2023, 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 February 2, 2023, 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 amended Complaint on February 2, 2023.

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 February 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 24, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on March 14, 2023. 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 is a company active in the education sector and is headquartered in the USA. The Complainant particularly provides learning solutions, research and assessments, including the TOEIC and TOEFL exams and the GRE and the Praxis family of assessments. The Complainant uses the TOEIC mark since 1979 for exams used to assess intermediate to advanced English-language listening and reading skills needed in the workplace and the Complainant states that such TOEIC exams are now the most widely used exams for assessing English-language skills around the world.

The Complainant provides evidence that it owns an international trademark portfolio for TOEIC, including, but not limited to, USA trademark registration number 1191669 for the TOEIC word mark, registered on March 9, 1982, and USA trademark registration number 3180166 for the TOEIC logo mark registered on December 5, 2006. The Complainant also has a strong online presence on social media and video sharing platforms and also owns a portfolio of official domain names incorporating the TOEIC mark.

The disputed domain name was registered on May 23, 2022, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name previously directed to an active website with links to pornographic videos appearing at other third-party websites and with gambling advertisements. However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its trademark for TOEIC, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's active pay-per-click website containing links to pornographic videos appearing at other third-party websites.

The Complainant essentially contends that the disputed domain name is confusingly similar to the Complainant's intensively used trademark, as it incorporates the Complainant's TOEIC trademark in its entirety, with the only differing element being the addition of the non-distinctive word "method" to the disputed domain name. The Complainant also provides evidence that the disputed domain name is linked to an active webpage containing links to pornographic videos appearing at other third-party websites, which, the Complainant argues, confers no rights or legitimate interests in the disputed domain name on the Respondent. The Complainant also argues that the Respondent had or can be expected to have had prior notice of the Complainant's trademarks at the time the disputed domain name was registered, and that the selection of the disputed domain name was therefore intentional and designed to divert Internet traffic from the Complainant's site to the Respondent's website at which nothing but pornography appears. The Complainant essentially contends that the registration and use of the disputed domain name in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark 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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has shown that it has valid rights in the mark TOEIC, based on its use and registration of the same as a trademark in multiple jurisdictions.

As to confusing similarity of the disputed domain name with the Complainant's marks, the Panel considers that the disputed domain name consists of the combination of two elements, respectively, the Complainant's TOEIC trademark combined with the term "method". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)"), section 1.8, "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". The Panel concludes that the disputed domain name contains the entirety of the Complainant's trademarks for TOEIC, which remains easily recognizable, and that the addition of the term "method" does not prevent a finding of confusing similarity. The Panel also notes that the applicable generic Top-Level Domain ("gTLD") (".com" in this case) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademarks for TOEIC, and concludes that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a *bona fide* provider of goods or services under the disputed domain name and is not making legitimate noncommercial or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Moreover, upon review of the facts and evidence, the Panel notes that the disputed domain name resolved to an active website with links to pornographic videos appearing at other third-party websites as well as with gambling advertisements. In the Panel's view, no rights or legitimate interests derive from using a third-party trademark to divert Internet users for commercial gain to a pornographic website, see in this regard also several prior UDRP decisions such as *Barnes Europe Consulting Kft., and Heidi Barnes-Watson v. jianhua Wang*, WIPO Case No. [D2022-3059](#); *Seintec Norte, S.L. v. yu Liu, wangluochuanmei*, WIPO Case No. [D2021-1815](#); *Andrey Ternovskiy dba Chatroulette v. Protection of Private Person / Aleksandr Katkov*, WIPO Case No. [D2017-0381](#); and *Averitt Express, Inc. v. Protection of Private Person / Roman Emec*, WIPO Case No. [D2018-0249](#). However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive webpage. In this regard, the Panel finds that holding a domain name passively, without

making any use of it, also does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel considers that by registering the disputed domain name, which the Panel sees as a clear attempt to obtain a domain name confusingly similar to the Complainant's widely-known trademarks, the Respondent deliberately and consciously targeted the Complainant's prior trademarks for TOEIC. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anelists have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Furthermore, the Panel also notes that the Complainant's trademarks for TOEIC were registered decades before the registration date of the disputed domain name and also considers that the selection of the descriptive word "method" in the disputed domain name suggests a clear connection between the website linked to the disputed domain name and the Complainant. The Panel deducts from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. The Panel also notes that even a cursory Internet search at the time of registration of the disputed domain name would have made it clear to the Respondent that the Complainant owned prior rights in its trademarks for TOEIC. In the Panel's view, these elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the website linked to the disputed domain name displayed pornographic content and gambling advertisements, which shows that the Respondent was abusing the Complainant's trademark to mislead and divert Internet users for commercial gain to such website, and thereby also tarnished the Complainant's marks (see in this regard also previous UDRP decisions where domain names were linked to websites containing adult content such as *Barnes Europe Consulting Kft., and Heidi Barnes-Watson v. jianhua Wang*, WIPO Case No. [D2022-3059](#), *Seintec Norte, S.L. v. yu Liu, wangluochuanmei*, WIPO Case No. [D2021-1815](#), and *Averitt Express, Inc. v. Protection of Private Person / Roman Emec*, WIPO Case No. [D2018-0249](#)). However, on the date of this decision, the disputed domain name links to an inactive website. In this regard, the [WIPO Overview 3.0](#), section 3.3 provides: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding". The Panel has reviewed all elements of this case, and attributes particular relevance to the following elements: the fact that the disputed domain name contains the entirety of the Complainant's trademark, the high degree of distinctiveness, the widely-known nature and the intensive use of the Complainant's trademarks and the unlikelihood of any good faith use to which the disputed domain name might be put by the Respondent. In these circumstances, the Panel considers that the passive holding of the disputed domain name by the Respondent constitutes use of the disputed domain name in bad faith. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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 <toeicmethod.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: March 28, 2023