

## **ADMINISTRATIVE PANEL DECISION**

Educational Testing Service v. duan you gang  
Case No. D2023-0683

### **1. The Parties**

The Complainant is Educational Testing Service, United States of America, represented by Fross Zelnick Lehrman & Zissu, PC, United States of America.

The Respondent is duan you gang, China.

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

The disputed domain name <toeftown.com> (the “Domain Name”) is registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 17, 2023, 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 (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 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 in English on February 21, 2023.

On February 17, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 22, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on February 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 23, 2023.

The Center appointed Karen Fong as the sole panelist in this matter on April 3, 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 provides learning solutions, research and assessments that help guide learners around the world on a variety of subjects. This includes the TOEFL exams which are a standardized test to measure the English language ability of non-native speakers wishing to enroll in English speaking schools and universities. The TOEFL exams have been a trusted measure of English proficiency since 1964 and are now the most widely used exams for assessing English-language skills around the world.

The TOEFL trade mark is registered in many jurisdictions around the world. The earliest trade mark registration submitted in evidence is United States of America Trade Mark Registration No 1103427 which was registered on October 3, 1978.

The Complainant manages a number of social media accounts dedicated to the TOEFL exams including on Facebook, Instagram, LinkedIn, WeChat, Weibo, Zhihu, Naver and YouTube.

The Respondent which appears to be based in China registered or acquired the Domain Name on August 28, 2022. The Domain Name is connected to a website which displays pornographic materials and gambling advertisements and also has links to other pornographic websites (the "Website").

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name has been registered and is being used in bad faith. The Complainant requests transfer of the Domain Name to the Complainant.

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

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

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

##### **A. General**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) The Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and

- (iii) The Domain Name was registered and is being used in bad faith.

## **B. Language of the Proceeding**

The Rules, paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Name is Chinese.

The Complainant submits that the language of the proceeding should be English for the Domain Name is in the English language incorporating the English word “town” indicating that the registrant is familiar with the English language.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties’ ability to understand and use the proposed language, time, and costs.

The Panel accepts the Complainant’s submissions regarding the language of the proceeding. The Respondent has not challenged the Complainant’s request and in fact has failed to file a Response in either Chinese or English. The Panel is also mindful of the need to ensure the proceeding is conducted in a timely and cost effective manner. In this case, the Complainant may be unduly disadvantaged by having to conduct the proceeding in Chinese. The Panel notes that all of the communications from the Center to the Parties were transmitted in both Chinese and English. In view of all the circumstances, the Panel determines that English be the language of the proceeding.

## **C. Identical or Confusingly Similar**

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Name contains the Complainant’s Trade Mark in its entirety with the addition of the word “town” as a suffix to the Trade Mark. The addition of this word does not prevent a finding of confusing similarity. For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain (“gTLD”) which in this case is “.com”. It is viewed as a standard registration requirement (section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

## **D. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the domain name by demonstrating any of the following:

- (i) before any notice to it 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 has been commonly known by the domain name, even if it has acquired no trade mark 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 trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does not come forward with such allegations and evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that there is no evidence that the Respondent is commonly known by the Domain Name nor has any trade mark rights to the Trade Mark. Further, it has not authorised, licensed, sponsored, or otherwise permitted the Respondent to use the Trade Mark in the Domain Name or for any other purpose. The Respondent's unauthorised use of the Trade Mark in the Domain Name in relation to pornography with gambling advertisements is not *bona fide* or legitimate noncommercial or fair use of the Domain Name.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not provided any explanation of its rights or legitimate interests in relation to the Domain Name, and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

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

To succeed under the Policy, the Complainant must show that the Domain Name has been registered and is being used in bad faith.

The Panel is satisfied that the Respondent was aware of the Trade Mark when it registered the Domain Name given the reputation of the Trade Mark and the fact that it has no common dictionary significance other than that of the Trade Mark. It is therefore implausible that the Respondent was unaware of the Complainant when it registered the Domain Name.

In the [WIPO Overview 3.0](#), section 3.2.2 states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark.”

The fact that there is a clear absence of rights or legitimate interests coupled with the Respondent's choice of the Domain Name (clearly targeting the Complainant's Trade Mark) is also a significant factor to consider (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Domain Name falls into the category stated above and the Panel finds that registration was in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The pornographic content on the Website presents a risk of tarnishment. The Respondent clearly intended to trade off the Complainant's reputation by setting up the Website for the commercial benefit of the Respondent. It is highly likely that Internet users when typing the Domain Name into their browser or finding it through a search engine would have been looking for a website operated by the Complainant or connected to the Complainant rather than the Respondent's pornographic Website with gambling advertisements.

The Domain Name is likely to confuse Internet users trying to find the Complainant's official website. Such confusion will inevitably result due to the complete incorporation of the Trade Mark in the Domain Name. The Respondent employs the reputation of the Trade Mark to mislead Internet users into visiting the website connected to the Domain Name instead of the Complainant's. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Respondent's Domain Name is somehow connected to the Complainant.

The Panel therefore concludes that the Domain Name was registered and is being used in bad faith under paragraph 4(b)(iv) of the Policy.

In all the circumstances, the Panel finds that the Complainant has fulfilled the requirements of 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 Domain Name, <toeftown.com>, be transferred to the Complainant.

*/Karen Fong/*

**Karen Fong**

Sole Panelist

Date: April 14, 2023