

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Kun Ren, Renkun
Case No. D2023-0702

1. The Parties

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

The Respondent is Kun Ren, Renkun, China.

2. The Domain Name and Registrar

The disputed domain name <gre-toefl.com> (the “Disputed Domain Name”) is registered with CNOBIN Information Technology Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2023. On February 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 17, 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 (REDACTED) 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 on February 21, 2023. In response to a notification by the Center regarding an administrative deficiency in the Complaint, the Complainant filed a second amended Complaint on February 27, 2023.

The Center verified that the Complaint together with the amended Complaints 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 March 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on March 30, 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, founded in 1947, is one of the world's largest private nonprofit educational testing and assessment organizations, which develops various standardized tests primarily in the United States for school and higher education, and also administers international tests including the TOEFL (Test of English as a Foreign Language), TOEIC (Test of English for International Communication), Graduate Record Examination (GRE) General and Subject Tests, HiSET and The Praxis test Series. The Complainant operates in more than 180 countries, and at over 9,000 locations worldwide, administering annually in total 20 million exams in the United States and in another countries.

The Complainant's TOEFL exam is 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 Complainant's GRE exams the world's most widely used admissions tests for graduate & professional school. The GRE exams aim to measure verbal reasoning, quantitative reasoning, analytical writing, and critical thinking skills that have been acquired over a long period of learning and have been administered by the Complainant and its predecessors in interest since 1936.

The Complainant is the owner of many TOEFL and GRE trademarks registrations (collectively, the "TOEFL and GRE Trademarks") in numerous countries throughout the world, among which are:

- United States TOEFL Trademark Registration No. 1103427, registered on October 3, 1978, in respect of goods and services in classes 16 and 41;
- United States TOEFL Trademark Registration No. 3168050, registered on November 7, 2006, in respect of goods and services in classes 16, 41 and 42;
- United States GRE Trademark Registration No. 1146134, registered on January 20, 1981, in respect of goods and services in classes 16 and 41;
- International GRE Trademark Registration No. 906402, registered on September 14, 2006, in respect of goods and services in classes 9, 16, 41 and 42.

The Complainant has a significant online presence, operating, among others, the main domain names <toefl.com> and <gre.com> reflecting its TOEFL and GRE Trademarks in order to sale and promote the Complainant's goods and services; and being active on social-media platforms such as Facebook, LinkedIn, Instagram, WeChat, Weibo, Zhili, Naver, and YouTube.

The Disputed Domain Name was registered on December 6, 2022. As at the date of this Decision and when the Complaint was filed, the Disputed Domain Name resolves to a parked page containing links to pornographic websites.

5. Parties' Contentions

A. Complainant

The Complainant contends that through long and exclusive use and a significant investment of time, money and effort over many years, and as a result of the quality of its products and services, it has developed

enormous goodwill in the TOEFL and GRE Trademarks, and these Trademarks have come to be identified exclusively with the products and services of the Complainant.

The Complainant claims that the Disputed Domain Name, reproducing the entirety of the TOEFL and GRE Trademarks, is confusingly similar to the Complainant's Trademarks. Visitors to the website under the Disputed Domain Name are therefore likely to believe, falsely, that the Disputed Domain Name identifies a website of the Complainant, as the Respondent plainly intends.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Respondent's registration of the Disputed Domain Name occurred after the Complainant had made extensive use of the TOEFL and GRE Trademarks, after the Complainant had secured registrations for the TOEFL and GRE Trademarks in the United States and elsewhere around the world, and after the TOEFL and GRE Trademarks had become incontestable in the United States.

The Complainant also asserts that there exists no relationship between the Complainant and the Respondent that would give rise to any license, permission, or other right by which the Respondent could own or use any domain name incorporating the TOEFL and GRE Trademarks. The Complainant has never authorized the Respondent to use the TOEFL and GRE Trademarks, or any marks confusingly similar thereto, for any purpose, including in a domain name.

The website associated with the Disputed Domain Name is equivalent to a pay-per-click ("PPC") site with links to pornographic videos appearing at third-party websites. Use of the Disputed Domain Name in this manner does not establish any right or legitimate interest in the Disputed Domain Name by the Respondent.

The Complainant contends that the Respondent registered and is using the Disputed Domain Name in bad faith based on the following:

- the Respondent has no connection with the Complainant and has never been authorized by the Complainant to use or register the Disputed Domain Name, the very fact that the Respondent has registered the Disputed Domain Name which incorporates the TOEFL and GRE Trademarks establishes opportunistic bad-faith use and registration;
- given the reputation and renown of the TOEFL and GRE Trademarks, most Internet users who see the Disputed Domain Name are likely to recognize the Complainant's Trademarks and assume that the Disputed Domain Name and any website associated with it is owned, controlled, or approved by the Complainant. In addition, consumers and other third parties who search the Internet for legitimate information about the Complainant may be directed to the website under the Disputed Domain Name that creates a probability of confusion;
- in view that the Disputed Domain Name is confusingly similar to the TOEFL and GRE Trademarks and that the ultimate effect of any use of the Disputed Domain Name will be to cause confusion with the Complainant, it is evident that the selection of the Disputed Domain Name was intentional and designed to divert internet traffic from the Complainant's website to the Respondent's website where nothing but pornography appears;
- the Respondent is using the Disputed Domain Name in connection with pornography;
- the evidence shows that the only reason for the Respondent's use of the Complainant's TOEFL and GRE Trademarks in the Disputed Domain Name is to intentionally confuse consumers and to trade on the Complainant's rights and reputation, and to profit from the pornographic website, all for the Respondent's own commercial benefit.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed 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) the 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

The Complainant has properly asserted its rights in the TOEFL and GRE Trademarks due to the long use and registrations worldwide.

The Disputed Domain Name reproduces the Complainant's registered TOEFL and GRE Trademarks in their entirety, separated by a hyphen, and the generic Top-Level domain ("gTLD") ".com". According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Also, the use of hyphens in the Disputed Domain Name is irrelevant in a finding of confusing similarity, see *e.g. Royale Indian Rail Tours Limited v. Divino Indian Memoirz Tours Pvt. Ltd.*, WIPO Case No. [D2010-2107](#).

In light of the above, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's TOEFL and GRE Trademarks and that the Complainant has established the first condition of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

The Panel finds that the Complainant has made a *prima facie* case and the Respondent has failed to come forward with any evidence to rebut such *prima facie* case. The Respondent registered the Disputed Domain Name more than 40 years after the TOEFL and GRE Trademarks had been registered. There is no evidence that the Respondent owns any TOEFL and GRE Trademarks, nor that it is commonly known by the Disputed Domain Name. Moreover, the Complainant has never authorized in any way, licensed, or permitted the Respondent to use its TOEFL and GRE Trademarks.

Furthermore, the Panel concludes that in view of the reputation of the TOEFL and GRE Trademarks it is highly unlikely that anybody could legitimately adopt the Disputed Domain Name for commercial use other than for an intent to create confusion with the Complainant.

Also, the Panel accepts that the way of use of the Disputed Domain Name indicates clear bad faith registration and use. Namely, at the date of this Decision, the Disputed Domain Name resolves to a parked page containing PPC links that redirected to different websites with pornographic content. Such use of the

the confusingly similar Disputed Domain Name hardly amounts to a *bona fide* offering, particularly given the potential for commercial gain for the Respondent due to sponsored PPC links.

The Respondent did not file any response to the Complaint and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Respondent lacks rights or legitimate interests in the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that indicate bad faith conduct on the part of the respondent, namely:

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

The TOEFL and GRE Trademarks have been in use more than 40 years before the Disputed Domain Name was registered and the Complainant has actively promoted its TOEFL and GRE Trademarks all these years. Furthermore, the Complainant's TOEFL and GRE Trademarks are original and highly distinctive, and it is obvious that the Respondent could not have registered the Disputed Domain Name, which incorporates the Complainant's TOEFL and GRE Trademarks in their entirety, accidentally. Therefore, the Panel is of opinion that the Respondent was likely well aware of the Complainant's TOEFL and GRE Trademarks when it registered the Disputed Domain Name and obviously chose to register the Disputed Domain Name with the only intention to benefit from the Complainant's reputation.

The use of a domain name to tarnish a complainant's trademark, including for commercial purposes in connection with pornographic content, constitutes evidence of a respondent's bad faith, [WIPO Overview 3.0](#), section 3.12. See *Red Bull GmbH v. Whois Agent, Domain Protection Services, Inc. / esco escortlar, escort sitesi*, WIPO Case No. [D2017-1639](#) (finding the respondent's use of the domain for a pornographic website constituted "a strong indication of bad faith registration and use," because it showed respondent's main purpose was "to create a likelihood of confusion among customers and/or to tarnish the Complainant's RED BULL trademark for commercial gain or any other illegitimate benefit"); *Bank of Jerusalem Ltd. v. Shek Cheung Chung*, WIPO Case No. [D2017-1153](#) (finding bad faith where the domain resolved to a website "at which adult content and links to websites at which pornographic contact [was] being offered, tarnishing Complainant and its trademark, and for which Respondent [was] likely receiving commercial gain"). In this case, the Panel finds that the Respondent's use of the Disputed Domain Name to resolve, for commercial

gain, to a Chinese-language parked page with pornographic content and hyperlinks, constitutes evidence of bad faith registration and use and is tarnishing the Complainant's TOEFL and GRE Trademarks.

Furthermore, in accordance with section 3.1.4. of the WIPO Overview, the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (particularly where no conceivable good faith use could be made). As such, the Panel finds it is unconceivable that the Respondent could have registered the Disputed Domain Name without knowledge of the Complainant's TOEFL and GRE Trademarks, without any intention to benefit from confusion with the Complainant's TOEFL and GRE Trademarks, and without intent to tarnish the Complainant's TOEFL and GRE Trademarks through association with pornographic website content and hyperlinks.

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show the good faith registration and use of the Disputed Domain Name.

In all the circumstances, the Panel is satisfied that the Complainant has proved both the bad faith registration and the bad faith use 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 Disputed Domain Name <gre-toefl.com> be transferred to the Complainant.

/Mariya Koval/
Mariya Koval
Sole Panelist
Date: April 13, 2023