

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Alza Octomiora, Universitas Sriwijaya and Pakar Toefl

Case No. D2023-3467

1. The Parties

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

Respondents are Alza Octomiora, Universitas Sriwijaya, and Pakar Toefl, Indonesia. Respondents will hereinafter be collectively referred to as the “Respondent”.

2. The Domain Names and Registrars

The disputed domain name <pakartoeft.com> (the “Domain Name 1”) is registered with CV. Jogjacamp (“Registrar 1”) and the disputed domain name <pakartoeft.site> (the “Domain Name 2”) is registered with CV. Rumahweb Indonesia (“Registrar 2”). Domain Names 1 and 2 will hereinafter be collectively referred to as the “Domain Names”. Registrars 1 and 2 will hereinafter be collectively referred to as the “Registrar”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2023. On August 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On August 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on August 25, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint or to file a separate complaint for each Domain Name. Complainant filed an amended Complaint on August 28, 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 Respondent of the Complaint, and the proceedings commenced on August 30, 2023. In accordance with the Rules, paragraph 5, the due

date for Response was September 19, 2023. The Center received an informal communication from the Respondent, in Indonesian, on August 30, 2023. Accordingly, the Center notified the Commencement of Panel Appointment Process on October 10, 2023.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on October 23, 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

Complainant provides learning solutions, assessment programs and tests, including the TOEFL and TOEIC exams, and the GRE and the Praxis family of assessments. Complainant's TOEFL exams are standardized tests to measure the English language ability of non-native speakers wishing to enroll in English-speaking schools and universities.

Complainant is the owner of numerous registered trademarks in the United States and internationally for the TOEFL mark, including:

- United States registered trademark number 1103427 for the TOEFL word mark, registered on October 3, 1978;
- United States registered trademark number 3168050 for the TOEFL word mark, registered on November 7, 2006;
- United States registered trademark number 5059810 for the TOEFL word mark, registered on October 11, 2016; and
- United States registered trademark number 4595363 for the TOEFL word mark, registered on September 2, 2014;
- Canadian registered trademark number TMA268049 for the TOEFL word mark, registered on May 14, 1982;
- Brazilian registered trademark number 810581817 for the TOEFL word mark, registered on May 10, 1983;
- Russian Federation registered trademark number 119520 for the TOEFL word mark, registered on August 25, 1994; and
- China registered trademark number 176265 for the TOEFL word mark registered on April 30, 1983.

The Domain Name 1 and the Domain Name 2 were respectively registered on April 10 and April 20, 2023, and each diverts to websites offering proxy test-taking services - referred to as "joki" in Indonesian – which offer customers to pay individuals to take examinations in their place. The term "pakar" in each of the Domain Names, means "expert" in Indonesian.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) each of the Domain Names is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Names; and (iii) Respondent registered and is using the Domain Names in bad faith.

In particular, Complainant contends that it has trademark registrations for TOEFL and that Respondent registered and is using the Domain Names with the intention to confuse Internet users looking for *bona fide* and well-known TOEFL products and services.

Complainant notes that it has no affiliation with Respondent, and contends that Respondent has used Complainant's reputation to sell counterfeit TOEFL products on the website associated with the Domain Names. Complainant further contends that Respondent is using the Domain Names as a tool to exploit Complainant's reputation for its own commercial gain, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Names other than trademark infringement. Further, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Names, when Respondent clearly knew of Complainant's rights.

B. Respondent

On August 30, 2023, Respondent sent an informal communication to the Center in Indonesian stating: "what is this problem? I have purchased this domain and it is my property. Likewise the domain Pakartoeftl.site. Sorry, I will no longer respond to this email. I officially bought it and it becomes my property."

6. Discussion and Findings

6.1. Preliminary Issue: Consolidation of possible Multiple Respondents

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. However, the Panel does not consider that paragraph 3(c) was intended to enable a single person or entity to put a complainant to the unnecessary time, expense and effort of initiating multiple proceedings against technically different domain name registrants, particularly when each registration raises the same issues. In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

Complainant asserts that: each of the Domain Names incorporates the TOEFL trademark in its entirety; the Domain Names were both registered 10 days apart to registrars in Indonesia, and each diverts to websites offering proxy test-taking services - referred to as "joki" in Indonesian – which offer customers to pay individuals to take examinations in their place. The term "pakar" in each of the Domain Names, means "expert" in Indonesian.

The Center has also notified Respondent of the Complaint corresponding to the Domain Names. Respondent did not reply to Complainant's contentions and only mentioned that the acquisition of the Domain Names was legal and thus, there is a legitimate interest.

The above circumstances, when considered together, indicate that Complainant and Complainant's trademarks are the common and sole target for the registration and use of the Domain Names by probably the same individual (operating with different aliases) or two individuals acting in a concerted manner.

It is more likely than not that the Domain Names are under common control. In addition, it would be cumbersome, costly and result in delay if Complainant would be required to initiate separate proceedings for each Domain Name, noting that Respondent did not object to Complainant's reasoned allegation of consolidation of multiple named registrants in a single proceeding.

Based on the foregoing, the Panel finds that consolidation would be fair and equitable to all Parties, and therefore grants the request to consolidate the two Domain Names in a single Complaint.

6.2. Preliminary Issue: Language of the Proceeding

The Rules, in 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 1, <pakartoeft.com> is English, while that for Domain Name 2, <pakartoeft.site> is Indonesian.

Complainant submitted its original Complaint in English. In its email dated October 3, 2023, Complainant submitted a request that the language of the proceeding should be English. Complainant contends that both the Domain Names are used in connection with websites designed to help customers cheat on the TOEFL English language proficiency tests, with prices listed in U.S. Dollars and Euros.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Names, 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 Complainant's submissions regarding the language of the proceeding. The Panel notes that the Domain Name 2 is composed of Complainant's trademark plus the word "pakar" – meaning "expert" in Indonesian, and the website is designed to help customers cheat on an English language proficiency test. In addition, the Center notified the Parties regarding the language of the proceeding as well as notified Respondent regarding commencement of the proceeding and indicated that Respondent may file a response. Respondent did not comment on the language of the proceeding.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and Cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Indonesian and to conduct the proceeding in Indonesian, while conducting the proceeding in English would not cause unfairness to either Party in this case.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.3. Substantive Issues

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

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names were registered and are being used in bad faith.

Thus, the burden is with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence of its rights in the TOEFL trademarks, as noted above under section 4. Complainant has also submitted evidence, which supports that the TOEFL trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the TOEFL trademarks.

With Complainant's rights in the TOEFL trademarks established, the remaining question under the first element of the Policy is whether the Domain Names, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case ".com" and ".site" respectively for Domain Names 1 and 2), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, each of the Domain Names is confusingly similar to Complainant's TOEFL trademarks. The TOEFL trademarks are recognizable in the Domain Names. In particular, each of the Domain Names includes Complainant's trademark TOEFL in its entirety, and the addition of the term "pakar" in each of the Domain Names does not prevent a finding of confusing similarity between the Domain Names and the TOEFL trademarks. See [WIPO Overview 3.0](#), section 1.8.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a 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, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its TOEFL trademarks, and does not have any rights or legitimate interests in the Domain Names. In addition, Complainant asserts that Respondent is not an authorized reseller and is not related to Complainant. Respondent is also not known to be associated with the TOEFL trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Names.

In addition, Respondent has not used the Domain Names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of filing of the Complaint, each of the Domain Names reverted to a website that prominently featured Complainant's TOEFL trademark, promoted and offered expert cheating services for Complainant's TOEFL and other exams. This could mislead Internet users into thinking that the website has been authorized or operated by or affiliated with Complainant. At the time of the Decision, the Domain Name 2 reverted to an error or inactive page. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Moreover, the nature of each of the Domain Names is inherently misleading, and carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Names. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Names. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Names and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Names 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 respondent, 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 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 your website or location or of a product or service on your website or location.”

The Panel finds that Complainant has provided ample evidence to show that registration and use of the TOEFL trademarks long predate the registration of the Domain Names. Complainant is also well established and known. Indeed, the record shows that Complainant's TOEFL trademarks and related products and services are widely known and recognized. Therefore, Respondent was likely aware of the TOEFL trademarks when it registered the Domain Names or knew or should have known that each of the Domain Names was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; and see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Names incorporating Complainant's TOEFL trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the TOEFL trademarks at the time of registration of the Domain Names and its effort to opportunistically capitalize on the registration and use of the Domain Names. Moreover, the additional term “pakar” – which means “expert” in Indonesian - in each of the Domain Names is also directly associated with Complainant's business activities in the field of TOEFL testing, further indicating Respondent's actual knowledge of Complainant and its trademarks, and that Respondent's registration of the Domain Names was in bad faith.

In addition, the evidence provided by Complainant indicated that at the time of filing of the Complaint, the Domain Names reverted to a website that promoted and offered expert cheating services for Complainant's

TOEFL and other exams, which could mislead Internet users into thinking that the website has been authorized or operated by or affiliated with Complainant, and offered TOEFL-branded products and services for sale. Such use included Respondent's unauthorized reproduction of Complainant's TOEFL marks - which could mislead Internet users into thinking that the respective website has been authorized or operated by or affiliated with Complainant, and offered TOEFL-branded products and services for sale, all of which have not been rebutted by Respondent. Such use does not prevent a finding of bad faith.

Moreover, the use of the TOEFL mark as the dominant part of the Domain Names is intended to capture Internet traffic from Internet users who are looking for Complainant's products and services. In addition, the use of the additional term "pakar" – meaning "expert" in Indonesian - in the Domain Names only serves to invoke Complainant's business and the industry Complainant operates in. Therefore, by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's webpage by creating a likelihood of confusion with Complainant's TOEFL marks as to the source, sponsorship, affiliation, or endorsement of Respondent's website. In addition, such use of the Domain Names could result in tarnishing Complainant's goodwill and reputation in the industry.

Accordingly, the Panel finds that Respondent registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Names, <pakartoevl.com> and <pakartoevl.site>, be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: November 6, 2023