

## **ADMINISTRATIVE PANEL DECISION**

Educational Testing Service v. Rahmat Reza, TOEFL VIP  
Case No. D2024-1974

### **1. The Parties**

The Complainant is Educational Testing Service, United States of America (“United States”), represented by Cantor Colburn LLP, United States.

The Respondent is Rahmat Reza, TOEFL VIP, Indonesia.

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

The disputed domain name <birotoefl.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2024. On May 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 13, 2024, 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 for Privacy, service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 15 and 22, 2024, 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 amendment to the Complaint on May 22, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on May 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 13, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on June 18, 2024. 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, formed in 1947 and headquartered in Princeton, is a non-profit corporation organized under the laws of the State of New York, United States, and the home of one of the world's largest private educational testing and measurement organization. The Complainant has nine additional locations in the United States, Canada, France, Germany, Italy, China, and India, plus three additional subsidiaries/acquisitions in Israel, Canada, France.

The Complainant develops, administers and scores more than 50 million tests in more than 180 countries at more than 9000 locations. The TOEFL iBT test is an English-language assessment, used for admissions purposes in more than 160 countries and the test measures a test taker's ability to combine listening, reading, speaking and writing skills for academic purposes.

The Complainant owns worldwide trademark registrations for TOEFL, such as the following:

- the United States trademark registration number 1103427 for the word TOEFL, filed on January 13, 1978 and registered on October 3, 1978, covering goods and services in Nice classes 16 and 41; and
- the Indonesian trademark registration number IDM000159747 for the word TOEFL, filed on August 29, 2006, and registered on April 22, 2008, covering services in Nice class 42.

The disputed domain name was registered on November 6, 2023 and, at the time of filing of the Complaint, it resolved to a website offering for sale TOEFL practice tests and courses, eBooks, guides for practicing for the tests, without the Complainant's approval. Also, on the website under the disputed domain name the Respondent was also offering to provide very likely forged test results and certificates, as the following statements were displayed "We are ready to help you get a TOEFL Certificate in an easy and safe way", "Fast Certificate Process 1 x 24 Hours" as well as providing detailed explanations about the TOEFL test and benefits of "hiring someone to do the TOEFL test for me".

When the Panel visited the website under the disputed domain name, the content has changed, the very scare content suggesting a personal blog about philosophy.

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it has used the mark TOEFL in connection with its business continuously since November 1964, that its TOEFL marks are well-known in particular in connection with educational services; the disputed domain name is identical or confusingly similar to its trademark, adding to the TOEFL trademark the descriptive term "biro", translated from Indonesian to English as "bureau" or "office" and basically suggesting that the Respondent is an office or a department of the government offering TOEFL certificates; that the Respondent has no rights or legitimate interests in the disputed domain name; and that the Respondent registered and is using the disputed domain name in bad faith to disrupt the business of the Complainant and to intentionally mislead consumers to its website by creating a likelihood of confusion with the Complainant by inserting the TOEFL trademark in the disputed domain name, and by using the trademark on the website under the disputed domain name for illegal activities, to circumvent the

Complainant's legitimate business and provide fake TOEFL certificates, as well as to sell counterfeit copies of the Complainant's practice tests, courses and other products.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term (here, "biro", translated in English "office"), may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has

not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain name in connection with a website containing the Complainant's trademark and claiming to provide products of the Complainant, as well as, very likely, forged TOEFL certificates, without providing any disclaimer or statement disclosing its (lack of) relationship with the Complainant. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Furthermore, the composition of the disputed domain name, consisting of the Complainants' mark plus an additional dictionary term, carries a risk of implied affiliation. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name in bad faith since the TOEFL mark is registered since at least 1978 and it is well-known worldwide, and furthermore the Respondent used the name of the Complainant's trademark as listed contact organization in the WhoIs.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "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" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark with an additional non-distinctive term, and the website operated under the disputed domain name displays the Complainant's trademark and claims to provide products of the Complainant including very likely false certificates, along with the lack of reliable information about the entity operating the website under the disputed domain name, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark can, by itself, constitute a presumption of bad faith for the purpose of Policy. [WIPO Overview 3.0](#), section 3.1.4.

Lastly, the Panel also finds that the change of content of the website to which the disputed domain name resolves and the timing thereof; and the provision of false or inaccurate contact information in the WhoIs underlying a privacy or proxy service, as further indications of bad faith. [WIPO Overview 3.0](#), sections 3.2.1 and 3.6.

The Panel finds that the Complainant has established the third element 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 <birotoefl.com> be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: June 21, 2024