

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Kalkofnsvegur 3
Case No. D2024-4857

1. The Parties

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

The Respondent is Kalkofnsvegur 3, Israel.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 25, 2024. On November 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 26, 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, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 26, 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 November 26, 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 November 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 20, 2024.

The Center appointed Nicholas Weston as the sole panelist in this matter on January 9, 2025. 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 private organization that was formed in the United States in 1947 and operates an educational training and examination business that develops, administers and scores more than 50 million tests in more than 180 countries at more than 9000 locations. Its TOEFL iBT test is a widely used English-language assessment. The Complainant cites its registrations for the trademarks ETS and TOEFL and variations of these in several countries, including, for example, United States Trademark No. 559686 for the word mark ETS registered on June 3, 1952, and United States Trademark No. 1103427 for the word mark TOEFL registered on October 3, 1978, and United States Trademark No. 3953133 for the word mark TOEFL IBT registered on May 3, 2011.

The Complainant owns the domain names <ets.org> and <toefl.com>.

The Disputed Domain Name was registered on November 19, 2024, and is used to host an unauthorized old version of the Complainant's official website including a pop-up that asks individuals to fill out a form with personal information.

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 cites its trademark registrations in various jurisdictions for the trademarks ETS, TOEFL and TOEFL IBT, as prima facie evidence of ownership.

The Complainant submits that its rights in the marks ETS, TOEFL and TOEFL IBT predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademarks, because the Disputed Domain Name is comprised of the ETS and TOEFL IBT trademarks and that the addition of the generic Top-Level Domain ("gTLD"), ".com" is not sufficient to avoid the confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the "Complainant is not aware of any relationship between it and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the Disputed Domain Name." and infers that none of the circumstances set out in paragraph 4(c) of the Policy apply. It also submits that "[t]he Disputed Domain Name appears to be a phishing site. It resolves to a page that looks like the old TOEFL website and includes a pop-up that asks individuals to fill out a form with personal information" and that this is not bona fide use.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to evidence that points to knowledge of the Complainant and its trademarks, and, it submits that the Disputed Domain "disrupts ETS' business for selling TOEFL practice tests and courses, eBooks, guides for practicing for the tests, and offering the lawfully taking of TOEFL tests." The Complainant also submits that the respondent serving "a page that looks like the old TOEFL website and includes a pop-up that asks individuals to fill out a form with personal information" amounts to illegal phishing and is further evidence of bad faith use.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

The Panel finds that the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the marks ETS, TOEFL and TOEFL IBT.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the ETS, TOEFL and TOEFL IBT trademarks, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark ETS; (b) followed by an exact reproduction of the Complainant's trademark TOEFL IBT; (c) followed by the gTLD ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "etstoeflibt".

The Panel finds that the entirety of each mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 Disputed 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.

The Panel notes that the Complainant has not licensed or otherwise authorized the Respondent to use its trademarks and that there is no relationship between the Complainant and the Respondent, let alone any accurate or prominent disclosure of that relationship, or absence of such, on its website. The use of the Complainant's trademarks on the Respondent's website suggests that the Respondent is actually aware of the Complainant's trademark, and was likely attempting to impersonate the Complainant or to create a likelihood of confusion with the Complainant as to the origin of the Respondent's website. The Panel finds that the Respondent's activities do not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant's mark or capacity to otherwise mislead Internet users.

Panels have held that the use of a domain name for illegal activity such as phishing, 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.

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.

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.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the Complainant's distinctive trademark, the Panel is satisfied that the Respondent deliberately targeted the Complainant's trademarks ETS and TOEFL IBT when it registered the Disputed Domain Name. (See *Educational Testing Service v. Toefl.neea ETS, ETS*, WIPO Case No. [D2024-1457](#) ("the Complainant's trademark TOEFL is well-known"); *Educational Testing Service v. Ndip Junior Arrey Johnson, Johnson Empire and Jamie Chaviers*, WIPO Case No. [D2022-0495](#) ("the Complainant's well-known [ETS] trademarks").

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to trade off the reputation and goodwill of the Complainant's trademarks. [WIPO Overview 3.0](#), section 3.1.4.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name was used to host a website that copied aspects of one of the Complainant's legitimate old websites and solicited sensitive private information from Internet users.

Panels have held that the use of a domain name for unlawful activity here, alleged impersonation or passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

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 <etstoeflibt.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: January 16, 2025