

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. a
Case No. D2023-5310

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 a, Åland Islands, Finland.

2. The Domain Name and Registrar

The disputed domain name <etsglobal-t.org> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 21, 2023. On December 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 27, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 3, 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 January 4, 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").

On January 2, 2024, the Center also sent an email communication to the Complainant inviting them to amend the Mutual Jurisdiction selection in the Complaint. The same day, the Complainant informed the Center that they chose "Ontario, Canada" as mutual jurisdiction, as they believe that the Registrar is located in "Ontario, Canada".

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 29, 2024.

On January 30, 2024, February 6, 2024, and February 12, 2024, the Center transmitted by email to the Registrar a request to confirm their headquarters' location. On February 12, 2024, the Registrar transmitted by email to the Center its response disclosing that their principal headquarters are located in the Netherlands (Kingdom of). The Center sent an email to the Complainant on February 14, 2024, providing said information and inviting the Complainant to submit an amendment to the Complaint. The Complainant sent an amendment to the Complaint on February 15, 2024.

The Center appointed Fabrice Bircker as the sole panelist in this matter on March 5, 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, Educational Testing Service, a 1947-formed company, is a world-leading organization in educational testing and assessment.

According to undisputed elements, the Complaint develops, administers and scores more than 50 million tests per year, in more than 180 countries and 9,000 locations worldwide.

Among the products and services provided for by the Complainant, is a measurement of English-language proficiency, named TOEIC.

The Complainant's activities are notably protected by the following trademarks registrations:

- ETS, United States trademark registration No. 1166461 filed on January 2, 1979, registered on August 25, 1981, duly renewed since then, and covering products and services of Classes 16 and 41 (with first use in commerce in 1948),
- ETS, French trademark registration No. 95586027 filed on August 29, 1995, registered on September 12, 1997, duly renewed since then, and covering products and services of Classes 9, 16, 41 and 42,
- TOEIC, European Union trademark registration No. 000103010 filed on April 1, 1996, registered on November 16, 1998, duly renewed since then, and covering products and services of Classes 9, 16, 41 and 42.

The Complainant has also an online presence, in particular through the <etsglobal.org> domain name, which has been registered on July 23, 2001. The corresponding website enables the access to the digital score reports to the tests developed and administered by the Complainant. Indeed, all score reports issued by the Complainant bear a QR-code which, once scanned, redirects to the above-mentioned website and offers the possibility to obtain a digital version of thereof.

The disputed domain name, <etsglobal-t.org>, was registered on July 17, 2023.

It was brought to the Complainant's attention by a French university requesting the verification of a TOEIC score report - which finally turned out to be forged - bearing a QR-code that redirected to a website accessible through the <etsglobal-t.org> disputed domain name (instead of the <etsglobal.org> domain name). The website available through the disputed domain name mimicked the Complainant's website and provided a fake digital TOEIC score report.

At the time of drafting this decision, the disputed domain name redirects to an URL address belonging to the Complainant's <etsglobal.org> domain name and displays an error page (www.etsglobal.org/fr/fr/error).

Very little is known about the Respondent, except that he is apparently located in Åland Islands, Finland, based on the information disclosed by the Registrar.

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 the disputed domain name is confusingly similar to its ETS trademark, because it reproduces the later, and the added elements do not prevent it from being recognizable.

Besides, the Complainant argues that the Respondent has no rights or legitimate interests in respect with the disputed domain name, in substance because:

- it is unaware of any prior rights that the Respondent may have in the disputed domain name or in the ETS mark,
- it is not aware of any relationship between it and the Respondent that would give rise to any license, permission, or authorization by which the latter could own or use the disputed domain name,
- the Respondent does not appear commonly known by the disputed domain name,
- the disputed domain name has been used intentionally to mislead consumers that the website to which it resolved was an official website of the Complainant, and it is of constant case law that the use of a domain name for illegal activity such as impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent.

Then, the Complainant contends that the disputed domain name has been registered and is being used in bad faith, notably because:

- in view of the notoriety of the ETS trademark, the inclusion of same in the disputed domain name with the mere addition of the descriptive term "global", and the use of said disputed domain name to redirect to a website displaying a forged TOEIC score test, evidence that the Respondent was aware of the ETS trademark at the time of the registration of the disputed domain name,
- the Respondent acted with opportunistic bad faith by registering and using the disputed domain name that is confusingly similar to the well-known ETS trademarks and in using it to redirect toward a website mimicking the Complainant's website for fraudulent purposes,
- the Respondent has violated the domain name registration agreement notably because in registering the disputed domain name, the Respondent represented and warranted that neither its registration nor the manner in which it is used infringes on the legal rights of any third party, whereas it is using it to infringe upon the Complainant's rights.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, for obtaining the transfer of the disputed domain name, the Complainant must establish each of the following three elements:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

Besides, paragraph 15(a) of the Rules provides that “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraphs 10(b) and 10(d) of the Rules also provide that “[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case” and that “[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence”.

Besides, the Respondent’s failure to reply to the Complainant’s contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.3).

Taking the foregoing provisions into consideration the Panel finds as follows.

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 3.0](#), section 1.7.

Based on the available record (Annexes 5a, 5b and 5c of the Complaint) and on the Panel verifications¹, 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 entirety of the mark is reproduced 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.

Indeed, although the addition of other terms (here, “global” and “-t”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy because the ETS trademark remains recognizable within said disputed domain name. [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.

¹ It is well established that the general powers of a panel as articulated inter alia in paragraphs 10 and 12 of the Rules include, among others, the possibility to undertake limited factual research into matters of public record if the panel considers such information useful to assessing the case merits and reaching a decision. These limited factual researches notably include visiting the website linked to the disputed domain name (see for instance, [WIPO Overview 3.0](#), section 4.8).

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.

Indeed, the Complainant contends that it has not given its consent for the Respondent to use its ETS trademark in a domain name registration or in any other manner.

Besides, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain name.

Furthermore, it results from the available records that the disputed domain name was used in connection with i) a forged score report to a test developed and administered by the Complainant (namely TOEIC), and ii) a website that mimicked the Complainant’s one. Likely, the purpose of this scheme was to mislead any person to whom the forged TOEIC score test was presented, as to the level in English proficiency of the holder of said score test.

In this respect, panels have held that the use of a domain name for illegal activity (such as 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.

At last, even if the disputed domain name now redirects to an error page, it nevertheless remains that i) this redirection points toward the Complainant’s website, ii) and the disputed domain name was previously used in a fraudulent scheme. In such a context, the Panel hardly sees how such a redirection could be considered as conferring to the Respondent a legitimate interest in the disputed domain name, all the more that it is extremely close to the Complainant’s own domain name (namely <etsglobal.org>) and therefore carries a risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

In view of all the above, 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.

The composition of the domain name and its conditions of use demonstrate per themselves that the Respondent was necessarily aware of the Complainant’s prior rights.

Indeed, not only the disputed domain name reproduces the ETS Complainant’s prior trademark which is well-known (see for instance *Educational Testing Service v. Ndip Junior Arrey Johnson, Johnson Empire and Jamie Chaviers*, WIPO Case No. [D2022-0495](#)), but it was also used to redirect to a website that mimicked the Complainant’s one and that provided a forged score test to a test developed and administered by the Complainant, and therefore bearing its ETS and TOEIC trademarks.

Additionally, it is obvious according to the information provided further to the Registrar verification that the Respondent has proceeded with the registration of the disputed domain name in communicating inaccurate identity and contact details, what is a further indication of bad faith (see [WIPO Overview 3.0](#), sections 3.6).

In view of all the above, the Panel finds that the disputed domain name was registered in bad faith.

Besides, the disputed domain name has been used in a fraudulent scheme consisting in impersonating the Complainant and its services in order to mislead the person (here a French university) to which the forged TOEIC score certificate was communicated.

Such conduct is per nature deceptive and illegal. In that regard, it is consistently held that the use of a domain name for illegitimate activity, such as fraudulent scheme or sale of counterfeit goods or services, is considered as manifest evidence of bad faith (see [WIPO Overview 3.0](#), sections 3.1.4 and 3.4).

At last, and for sake of completeness, the Panel adds that the current use of the disputed domain name to redirect toward an error page related with the Complainant's website does not prevent a finding of bad faith use.

Indeed, nothing justifies that the Respondent, which is not authorized by the Complainant, holds a domain name confusingly similar to the Complainant's trademark and almost identical to one of its domain names, to redirect to an URL belonging to the latter, all the more that the Respondent previously used the disputed domain name fraudulently.

As a consequence, 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 <etsglobal-t.org> be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: March 19, 2024