

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Whois Privacy, Private by Design, LLC / Son Ngo Dinh
Case No. D2022-1255

1. The Parties

The Complainant is Educational Testing Service, United States of America (“USA”), represented by Jones Day, USA.

The Respondent is Whois Privacy, Private by Design, LLC, USA / Son Ngo Dinh, Viet Nam.

2. The Domain Names and Registrar

The disputed domain names <toeic24.com> and <toeic24.net> are registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 11, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 2022, 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 April 12, 2022.

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 April 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 4, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on May 10, 2022. 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 non-profit educational testing and assessment organization, developing, administering and scoring well-known tests such as the TOEFL and TOEIC tests. It is the owner of, amongst dozens of others, the following registrations (Annexes 11 and 12 to the Complaint):

- USA Trademark Registration No. 1,191,669 for the word mark TOEIC, registered on March 9, 1982 and successively renewed;
- USA Trademark Registration No. 4,466,074 for the word mark TOEIC, registered on January 14, 2014; and
- Vietnamese Trademark Registration No. 14,847 for the word mark TOEIC, registered on December 31, 1994 and successively renewed.

The disputed domain names, <toeic24.com> and <toeic24.net> were respectively registered on February 1, 2020, and October 26, 2021, and previously resolved to the same content targeting the Vietnamese market and offering “free TOEIC online test”, presenting itself as “a reliable website for TOEIC test”.

5. Parties' Contentions

A. Complainant

The Complainant asserts to develop, administer and score more than 50 million tests per year, in more than 180 countries and 9,000 locations worldwide, including the TOEFL test, the TOEIC test, the PRAXIS test and the GRE test. Also according to the Complainant, it has, since 1979, administered the TOEIC test to measure English-language proficiency, being TOEIC test scores used by over 14,000 organizations, government agencies and English-language learning programs across more than 160 countries, including Viet Nam, where the Respondent is located (Annex 9 to the Complaint).

According to the Complainant, in view of its efforts and long-standing continuous use of the TOEIC mark for over 40 years the TOEIC mark has acquired immense goodwill and a valuable reputation across the globe, having become a famous within the educational testing services industry in the USA and throughout the world, having past panels consistently remarked upon the fame and distinctiveness of the Complainant's TOEIC mark (*Educational Testing Service v. santa riiid, Riiid*, WIPO Case No. [D2020-2634](#); *Educational Testing Service v. Xabier Le Courtier, Toefl-madrid / Javier Octavio de Toledo Salvatierra*, WIPO Case No. [D2016-0858](#); *Educational Testing Service v. ISITE, Inc., Masuo Santo*, WIPO Case No. [D2008-1980](#) and *Educational Testing Service v. Jong-Cheol Seo*, WIPO Case No. [D2006-0056](#)).

The Complainant further notes that on August 2021, having learned of the Respondent's use of the disputed domain names purporting to offer “FREE TOEIC ONLINE TEST[S]”, the Complainant submitted takedown notices pursuant to the Digital Millennium Copyright Act (“DMCA”), related to over 2,400 links to infringing TOEIC tests that were made available on the disputed domain names (Annexes 14 and 15 to the Complaint), having the Respondent replied on September 10, 2021 (Annex 4 to the Complaint) stating “Yes, I will remove all ETS exam in my website. Thanks.” Nevertheless, the Respondent has re-uploaded infringing TOEIC tests on the disputed domain names at different links (Annexes 3 and 5 to the Complaint).

According to the Complainant the disputed domain names incorporate the TOEIC mark in its entirety, not being the addition of the number "24" sufficient to avoid a finding of confusing similarity under the Policy.

As to the absence of rights or legitimate interests, the Complainant submits that:

- i. the Respondent is not a licensee of or otherwise affiliated with the Complainant, never having the Complainant authorized, otherwise condoned, or consented to the Respondent's registration of the disputed domain names;
- ii. to the Complainant's knowledge, the Respondent is not commonly known by the disputed domain names; and
- iii. the Respondent has not used the disputed domain names in connection with a *bona fide* offering of goods or services, rather having used them to provide infringing copies of the Complainant's TOEIC tests.

As to bad faith registration of the disputed domain names the Complainant submits that the Respondent had actual knowledge of the Complainant's well-known mark, what is evident from the content on the websites that resolved from the disputed domain names which were intentionally registered to attract for commercial gain Internet users by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website at the disputed domain names. Furthermore, the Complainant submits that it attempted to solve the matter amicably, having the Respondent agreed to remove the infringing contents to later re-uploaded them, which further supports a finding of the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain names.

A. Identical or Confusingly Similar

The Complainant has established rights in the TOEIC trademark.

The Panel finds that the disputed domain names <toeic24.com> and <toeic24.net> reproduce the Complainant's mark in its entirety.

The addition of the number "24" does not prevent a finding of confusing similarity. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the

disputed domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Therefore, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate a respondent's rights to or legitimate interests in a domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has not acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to the evidence submitted, the Respondent has used both of the disputed domain names to intentionally mislead and confuse the public into believing that there might be some connection or affiliation with the Complainant given the purported "free TOEIC online test" and affirmation to be "a reliable website for TOEIC test".

The Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain names in bad faith can be found in view of the use of the disputed domain names seeking to create a direct affiliation with the Complainant and its business, as seen above.

Other factors that corroborate the Panel's finding of bad faith of the Respondent are:

- a. the existence of over 2,400 links to infringing TOEIC tests that were made available on the disputed domain names;
- b. the indication of what appears to be false or incorrect Whois information, not being the Center able to contact the Respondent at the address indicated;
- c. the Respondent's lack of compliance reply to his undertaking to take off the infringing content; and
- d. the absence of a formal Response by the Respondent.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain names pursuant to paragraph 4(b)(iv) 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 names, <toeic24.com> and <toeic24.net> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: May 24, 2022