

ADMINISTRATIVE PANEL DECISION

ACT, Inc. v. 马程遥 (Max Will)

Case No. D2022-1700

1. The Parties

The Complainant is ACT, Inc., United States of America (“United States”), represented by Davis Graham & Stubbs LLP, United States.

The Respondent is 马程遥 (Max Will), China.

2. The Domain Name and Registrar

The disputed domain name <maintests.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2022. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 19, 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 amended Complaint in English on May 24, 2022.

On May 19, 2022, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. On May 20, 2022, the Respondent requested that Chinese be the language of the proceeding. On May 21, 2022, the Complainant requested that English be the language of the proceeding.

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 in English and Chinese the Respondent of the Complaint, and the proceedings commenced on June 1, 2022. In accordance with the Rules, paragraph 5, the original due date for Response was June 21, 2022. Upon request from the Respondent, the due date for Response was extended to June 25, 2022 in accordance with paragraph 5(b) of the Rules. The Respondent sent an email setting out an informal Response in Chinese on June 24, 2022. Accordingly, the Center notified the Parties that it would proceed with the panel appointment process on June 27, 2022.

The Complainant made an unsolicited supplemental filing in English on July 1, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on July 13, 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 provider of assessments and related services to assist with higher education admission. It holds multiple trademark registrations for ACT including United States trademark registrations number 2,888,069 and number 4,517,656, registered on September 28, 2004 and April 22, 2014, respectively, specifying goods and services in classes 9, 16, 41, and 42, and class 35, respectively. Those trademark registrations remain valid. The Complainant has also registered the domain name <act.org> that it uses in connection with a website where it provides information about itself and its goods and services.

The Respondent is an individual resident in China.

The disputed domain name was registered on July 8, 2015. It resolves to a website in English that used to make available for download copies of ACT practice tests and that currently makes available for downloads copies of practice tests from other providers. A notice claims that the holder of copyright in all content of the site and practice tests is “Max”.

According to evidence presented by the Complainant, a panel in a prior proceeding under the Policy between the same Parties found that the Respondent had registered and used the domain name <crackact.com> in bad faith. See *ACT, Inc. v. 马程遥 (Max Will)*, WIPO Case No. [D2021-3128](#).

5. Parties' Contentions

A. Complainant

The disputed domain name is part of a network of infringing domain names. The Complainant has already prevailed against the Respondent as regards the domain name <crackact.com>. See *ACT, Inc. v. 马程遥 (Max Will)*, *supra*. The disputed domain name infringes upon the Complainant's trademarks and copyright in the precise way that other domain name did and therefore the prior panel's decision should be dispositive here. The Complainant believes that the same or related individuals are running websites associated with other domain names as well, three of which are the subject of pending proceedings brought by the Complainant under the Policy. The Complainant requests that the Panel view this Complaint in light of the broader network of infringing domains and stop the Respondent from using an interconnected web of domains to infringe the Complainant's rights.

The disputed domain name infringes on the Complainant's ACT marks for the same reasons cited by the panel in *ACT, Inc. v. 马程遥 (Max Will)*, *supra*. The disputed domain name claims to offer ACT practice tests. The hyperlinks resolve to the Complainant's website. The disputed domain name constitutes trademark infringement. The disputed domain name also infringes upon ACT's copyright by offering its

practice tests for download.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is trying to deceive consumers into believing that the disputed domain name and related products and services are somehow affiliated with the Complainant. The Respondent has not received any authorization or license to use any of the ACT marks or any other copyrighted work or intellectual property owned by the Complainant. The Respondent is not an authorized reseller of any products or services offered under the ACT marks.

The disputed domain name was registered and is being used in bad faith. The Respondent is attempting to profit from the goodwill and fame of the ACT marks. The sole purpose of the disputed domain name is to trick unsuspecting customers who are looking for the Complainant's ACT college and career preparation products and services into purchasing products and services that are not, in fact, affiliated with the Complainant in any way.

B. Respondent

The Respondent's website provides GRE and GMAT test materials and only provides a few ACT test-related links on one page on the site. The website does not store or save any ACT-related content. As soon as he received the Complaint, the Respondent deleted the links to ACT tests. The Respondent has no intention of infringing the Complainant's copyright. If the Complainant believes that the hyperlinks regarding ACT tests infringe its copyright, it should send the Respondent a takedown notice instead of filing a complaint against the disputed domain name. The Respondent's website is not related to the Complainant.

6. Discussion and Findings

6.1. Preliminary Issues

A. Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative 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". The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that a prior proceeding between the Parties under the Policy was conducted in English; the Respondent understands English, as everything on the website associated with the disputed domain name is in that language; and the Complainant cannot conduct the proceeding in Chinese without a great deal of additional expense and delay.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and amended Complaint in this proceeding were filed in English while the informal Response was submitted in Chinese. The website associated with the disputed domain name is entirely in English, from which it is reasonable to infer that the Respondent understands that language. The informal Response demonstrates that the Respondent has in fact understood the Complaint. Therefore, the Panel considers that requiring the Complainant to translate the amended Complaint into

Chinese would create an undue burden and delay whereas conducting the proceeding in English and accepting all submissions as filed does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English, but the Panel will accept the informal Response in Chinese without a translation.

B. Unsolicited Supplemental Filing

The Complainant made an unsolicited supplemental filing after receipt of the informal Response and prior to the appointment of the Panel.

Paragraph 10(d) of the Rules provides that “[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence”. Although paragraph 12 of the Rules empowers the Panel, in its sole discretion, to request further statements or documents from either of the Parties, this does not preclude the Panel from accepting unsolicited filings. See *Delikomat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. [D2001-1447](#).

In the present case, the Complainant’s unsolicited supplemental filing provides information about another domain name and website that the Complainant recently discovered and seeks to rebut statements in the informal Response. Given that it has no bearing on the threshold question of identity or confusing similarity between the disputed domain name and the Complainant’s trademarks, it cannot alter the Panel’s conclusion. Therefore, the Panel sees no reason to accept the Complainant’s unsolicited supplemental filing.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

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

Pursuant to paragraph 5 of the Policy, all other disputes and litigation between the Parties shall be resolved through any court, arbitration or other proceeding that may be available.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the ACT trademark. The Complainant provides no evidence that it holds rights in another mark besides ACT.

The disputed domain name <maintests.com> does not resemble the ACT trademark. It is neither identical nor confusingly similar to the ACT mark; it does not even contain any approximation of the mark, *e.g.*, by initials or otherwise, such that the website content could reasonably affirm such resemblance at the level of the disputed domain name. While the content of the website associated with the disputed domain name can in some cases be taken into account to confirm a *prima facie* case that a respondent seeks to target a trademark through a domain name, such content is not a substitute for a notion of confusing similarity between the disputed domain name itself and the trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.15.

The Complainant correctly notes that the panel in *ACT, Inc. v. 马程遥 (Max Will)*, *supra*, referred to the Respondent’s use of its website to trade off the reputation of the Complainant in its trademark. However,

that panel did so in relation to the first element of paragraph 4(a) of the Policy only to support a finding of confusing similarity in circumstances where the domain name (<crackact.com>) incorporated the entirety of the ACT trademark, and the trademark was recognizable within that domain name. Neither of those circumstances applies to the disputed domain name in the present case. While the content of the website associated with the disputed domain name could be taken into account in relation to the second and third elements in paragraph 4(a) of the Policy, that assessment need only be made if the Complainant satisfies the standing requirement in the first element.

The Complainant provides evidence that the Respondent registered and was using another domain name that was confusingly similar to the ACT trademark. See *ACT, Inc. v. 马程遥 (Max Will)*, *supra*. The Complainant also alleges that the Respondent is using an interconnected web of domains to infringe its rights. However, the Complainant must satisfy the three elements in paragraph 4(a) of the Policy with respect to each disputed domain name. The fact that the Complainant prevailed as regards one domain name does not provide standing regarding another domain name, even one held by the same respondent and used in the same or a similar way. The broader context could be relevant if there were a *prima facie* notion of confusing similarity vis-à-vis the disputed domain name but that is not the case here.

The Complainant alleges that the Respondent infringes its copyright in the ACT practice tests. The Panel recalls that claims of copyright infringement do not fall within the scope of applicable disputes set out in paragraph 4 of the Policy. Such claims can only be resolved by other means, as provided in paragraph 5 of the Policy.

Therefore, the Panel does not find that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant has failed to satisfy the first element of paragraph 4(a) of the Policy. Given that finding, there is no need to consider the second and third elements.

Naturally, should the Complainant believe its rights are being infringed, in a copyright, trademark, or other sense, it would be able to pursue those claims in a court of competent jurisdiction.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: July 27, 2022