

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. hu xue lian
Case No. D2023-0808

1. The Parties

The Complainant is Educational Testing Service, United States of America (“U.S.”), represented by Fross Zelnick Lehrman & Zissu, PC, U.S.

The Respondent is hu xue lian, China.

2. The Domain Name and Registrar

The disputed domain name <toefl-club.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2023. On February 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 28, 2023, 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 to the Complainant on February 28, 2023, in English and Chinese, 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 March 3, 2023.

On February 28, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on March 3, 2023. The Respondent did not comment on 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 the Respondent in English and Chinese of the Complaint, and the proceedings commenced on March 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 4, 2023.

The Center appointed Francine Tan as the sole panelist in this matter on April 14, 2023. 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 provides learning solutions, pioneering research and trusted assessments that help guide learners around the world, which it has been doing for more than 70 years. The Complainant's most trusted assessments include the TOEFL and TOEIC exams. The TOEFL exams are standardized tests, introduced since 1964, to measure the English language ability of non-native speakers wishing to enroll in English-speaking schools and universities. The Complainant states that through long and exclusive use and a significant investment of time, money and effort over many years, and as a result of the quality of its products and services, it has developed enormous goodwill in its TOEFL marks.

The Complainant owns U.S. trade mark registrations for TOEFL including U.S. Registration Nos. 1103427, 3168050, 5059810, and 4595363, the earliest registration date for which is October 3, 1978. It also has trade mark registrations in many jurisdictions around the world including India, Japan, Republic of Korea, and China where the Respondent appears to be located. The Chinese registrations' filing dates are from as early as 1982.

The Complainant manages a number of social media accounts dedicated to the TOEFL exams, including Facebook, Instagram, LinkedIn, WeChat, Weibo, and YouTube.

The disputed domain name was registered on November 10, 2020, which has been used for a parked website with pay-per-click links to pornographic websites.

5. Parties' Contentions

A. Complainant

1. The disputed domain name is confusingly similar to the Complainant's TOEFL trade mark in which it has rights, both from its trade mark registrations and at common law. The disputed domain name incorporates the TOEFL mark in its entirety, merely adding the non-distinctive word "club" and the generic Top-Level Domain ("gTLD") ".com".
2. The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent registered the disputed domain name after the Complainant had adopted and extensively used the TOEFL trade mark. The burden is therefore on the Respondent to establish it has rights or legitimate interests in the disputed domain name. Given the trade mark registrations secured by the Complainant for the TOEFL trade mark in the U.S. and in many jurisdictions around the world, the Respondent would have been on notice of the Complainant's rights before he adopted the disputed domain name incorporating the Complainant's mark. There is no relationship between the Complainant and the Respondent, nor any license or permission given to the Respondent to own or use any domain name incorporating the TOEFL trade mark. The disputed domain name is not, nor could it reasonably be contended to be a nickname of the Respondent.
3. The disputed domain name has been registered and is used in bad faith. The Respondent's registration of the disputed domain name containing the reputable and famous TOEFL mark is

opportunistic in nature and done in bad faith. Most Internet users who see the disputed domain name are likely to recognize the Complainant's TOEFL mark in it and assume that any website associated with it is owned, controlled, or approved by the Complainant. It is evident that the Respondent selected the disputed domain name with the intention to divert Internet traffic from the Complainant's site to his website, which is used for pornographic content.

B. Respondent

The Respondent did not file a formal Response to the Complainant's contentions. However, the Center received apparent automated messages from the Respondent in reply to various communications sent by the Center.

6. Discussion and Findings

6.1 Preliminary Issue - Language of the Proceedings

The Registration Agreement in relation to the disputed domain name is in Chinese. The Complainant requested, notwithstanding, that the language of the proceeding be English on the basis that the disputed domain name incorporates the English word "club" and portions of the Respondent's website are in English. These facts indicate that the Respondent is familiar with the English language.

Paragraph 11 of the Rules provides, *inter alia*, that the language of the proceeding shall be the language of the Registration Agreement, subject to the panel's authority to decide otherwise. The Respondent did not respond on the issue. Having considered the circumstances of the case including the fact that the Panel has the mandate to ensure that the proceeding take place expeditiously, the Panel determines that it would be appropriate for English to be the language of the proceeding. Requiring the Complainant to translate the Complaint and supporting evidence into Chinese would cause undue delay to the proceeding and a financial burden on the Complainant which does not appear to be merited in this case. The Respondent was notified in English and Chinese by the Center of the commencement of the proceeding and related matters concerning the domain name dispute. The Respondent could have communicated in the Chinese language regarding any objections he had, but did not.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Complainant has established that it has trade mark rights in TOEFL. The Panel is of the view that the disputed domain name is confusingly similar to the TOEFL mark as it is incorporated in its entirety and recognizable in the disputed domain name. The addition of the hyphen and word "club" does not prevent a finding of the confusing similarity with the Complainant's trade mark. (See section 1.8 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The gTLD does not have to be considered when considering the issue of the identity or confusing similarity of the disputed domain name with the Complainant's trade mark as it is a technical requirement for domain name registrations.

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's mark.

The first element of paragraph 4(a) of the Policy has been established.

B. Rights or Legitimate Interests

The Panel finds on the evidence submitted that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The use and registration of the disputed domain name was not permitted nor authorized by the Complainant. There is also no evidence that the Respondent is commonly known by the disputed domain name. In fact, one

cannot reasonably envisage any valid rights or legitimate interests on the Respondent's part in the disputed domain name which incorporates the well-known TOEFL trade mark. Moreover, the fact that the Respondent's website to which the disputed domain name resolved was used to display pornographic material indicates that the Respondent's use was illegitimate and for commercial gain by misleadingly diverting Internet traffic and/or to tarnish the Complainant's trade mark (paragraph 4(c)(iii) of the Policy). Such use cannot constitute a *bona fide* or fair use within the meaning of the Policy. The Respondent did not file any Response and did not rebut the *prima facie* case established that he lacked rights or legitimate interests in the disputed domain name.

The second element of paragraph 4(a) of the Policy has been established.

C. Registered and Used in Bad Faith

Following from the above finding that the Respondent lacks rights or legitimate interests, the Panel also concludes that the disputed domain name was registered and is being used by the Respondent in bad faith. There is no doubt that the Respondent knew or should have known of the Complainant's rights in the highly-distinctive TOEFL trade mark when he registered the disputed domain name. The TOEFL trade mark is widely known and has been used extensively worldwide for many years. The Complainant's trade mark registrations in China date from 1983. Section 3.1.4 of the [WIPO Overview 3.0](#) states that the "mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith".

The Panel finds that the Respondent has registered the disputed domain name to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's TOEFL trade mark and to trade on the Complainant's rights and reputation.

The third element of paragraph 4(a) of the Policy has been established.

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 <toefl-club.com> be transferred to the Complainant.

/Francine Tan/

Francine Tan

Sole Panelist

Date: April 20, 2023