



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.:	HK-1901312
Complainant:	Educational Testing Service
Respondent:	rui chen
Disputed Domain Name:	<yhtoefl.com>

1. The Parties and Contested Domain Name

The Complainant is Educational Testing Service, of Rosedale Road, Princeton, New Jersey 08541, United States of America.

The Respondent is rui chen, of yingshanxian,shuangxixiang, gujiacun2zu, nanchongshi, 637700, China.

The domain name at issue is <yhtoefl.com>, registered by Respondent with Extra Threads Corporation Extra Threads, LLC., of <http://www.networksolutions.com>.

2. Procedural History

On December 27, 2019, the Complainant's representative submitted a Complaint in English language to the Hong Kong Office of Asian Domain Name Dispute Resolution Centre ("ADNDRC").

On December 29, 2019, ADNDRC transmitted by email to the Extra Threads Corporation Extra Threads, LLC., a request for registrar verification in connection with the Disputed Domain Name and to provide information thereof.

On December 29, 2019, ADNDRC transmitted by email the receipt of complaint to the Complainant's representative.

On March 11, 2020, the Registrar, Extra Threads Corporation Extra Threads, LLC. transmitted by email to ADNDRC confirming that the Respondent is the registrant of the Disputed Domain Names.

On March 11, 2020, ADNDRC transmitted the Notification of Deficiency to the Complainant's representative by email.

On March 13, 2020, the Complainant's representative transmitted the revised Complaint to ADNDRC by email.

On March 13, 2020, ADNDRC transmitted the Confirmation of the administrative compliance of the Complaint to the Complainant's representative by email.

On March 16, 2020, ADNDRC transmitted the Complaint to the Respondent by email and informed the Respondent of the 20-day period (on or before April 5 2020) to file a Response. However, no Response has been filed.

On April 9, 2020, ADNDRC informed the parties by email that the Respondent did not file a Response and thus in Default.

On April 14, 2020, ADNDRC informed the parties by email of the appointment of Mr. William Law as the sole panelist and the decision would be rendered on or before April 28, 2020.

3. Factual background

The Complainant submits the below background:

The Complainant, Educational Testing Service (herein referred to as "ETS"), was founded in 1947 and is one of the world's largest private nonprofit educational testing and assessment organizations based in the United States. The Complainant develops various standardized tests primarily in the United States for K-12 and higher education, and it also administers international tests including the TOEFL, TOEIC, GRE Tests, and the Praxis test Series in more than 180 countries, and at over 10,000 locations worldwide. In total, the Complainant annually administers 50 million international tests annually including the TOEFL, TOEIC, GRE Tests in more than 180 countries, and at over 10,000 locations worldwide.

The Complainant is the owner of over 100 "TOEFL"-inclusive trademarks around the world. Amongst which the mark "TOEFL" has been registered in the United States for "educational testing services-namely, administering tests dealing with languages" in Class 41 since 1978 (registration no. 73155230).

The Complainant has also registered many trademarks containing "TOEFL" in China. It can be seen that the "TOEFL"-inclusive marks are registered in classes 9, 16 and 41 in China. The Complainant has obtained registration for its "TOEFL" mark in Classes 16 and 41 in China as early as 1983 and 1984. We hereby list out the "TOEFL"-inclusive registrations (including its Chinese equivalent "托福" owned by the Complainant in China:

Trademark	Class	Registration No.	Registration Date	Valid Until
TOEFL	16	176265	1983-4-30	2023-4-29
TOEFL	41	771160	1994-11-7	2024-11-6
TOEFL	9	746636	1993-9-23	2025-5-20
TOEFL	35	25442730	2018-7-21	2028-7-20
TOEFL _®	35	5941539	2010-5-28	2020-5-27
TOEFL _®	41	5941540	2010-5-28	2020-5-27
TOEFL _®	42	5941541	2010-4-21	2020-4-20

Trademark	Class	Registration No.	Registration Date	Valid Until
NEW TOEFL	35	5941524	2010-4-21	2020-4-20
NEW TOEFL	42	5941522	2010-4-21	2020-4-20
NEW TOEFL <small>IBT</small>	35	5941544	2010-4-21	2020-4-20
NEW TOEFL <small>IBT</small>	42	5941546	2010-4-21	2020-4-20
托福网考	35	5941527	2010-7-28	2020-7-27
托福网考	42	5941531	2010-4-21	2020-4-20
托福	42	1129730	1997-11-21	2027-11-20
托福	41	1129840	1997-11-21	2027-11-20
托福	16	1136266	1997-12-21	2027-12-20
TOEFL Junior	41	9485052	2012-6-14	2022-6-13
TOEFL Junior	35	9485053	2012-6-14	2022-6-13
TOEFL Junior	16	9485054	2012-6-14	2022-6-13
TOEFL Junior	9	9485055	2012-7-14	2022-7-13
初中托福	35	9965019	2013-2-7	2023-2-6
初中托福	16	9965020	2012-12-7	2022-12-6
TOEFL PRACTICE ONLINE TPO	41	14317218	2015-5-14	2025-5-13
TOEFL PRACTICE ONLINE TPO	35	14317219	2015-5-14	2025-5-13
TOEFL PRACTICE ONLINE TPO	9	14317220	2015-5-14	2025-5-13
TOEFL ITP	42	G1208644	2015-1-20	2025-1-20
TOEFL ACCELERATOR	42	G905050	2016-9-7	2026-9-7
TOEFL Primary	16	12723349	2014-10-28	2024-10-27
TOEFL Primary	9	12723350	2014-10-28	2024-10-27
TOEFL Primary	41	12723347	2014-10-28	2024-10-27
TOEFL Primary	35	12723348	2014-12-14	2024-12-13

The above shows that the Complainant owns the “TOEFL” and “TOEFL”-inclusive trademarks in the services of administering and scoring examinations relating to English language proficiency and other education related services. The Complainant disputes the registration by the Respondent of the domain name “yhtoefl.com” (the disputed domain name), which is identical or confusingly similar to the “TOEFL” trademark of the Complainant.

The disputed domain name was registered by the Respondent on February 2, 2019.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant submits that in *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662, the panel held that a domain name is "identical or confusingly similar" to a trademark for purpose of the Policy when the domain name include the trademark, regardless of the other terms in the domain name. The disputed domain name incorporates the trademark and trade name of the Complainant "TOEFL" in its entirety, which is readily identifiable as it is placed at the front of the disputed domain name, but not included amidst a long list of letters nor buried in the middle of the disputed domain name. As such, the disputed domain name is "identical or confusingly similar" to the Complainant's trademark or trade name "TOEFL".

The Complainant has registered the trademark "TOEFL" in the US since 1978. Also, the Complaint has registered the trademark "TOEFL" in China in Class 41 in 1983 (Registration No. 176265). The disputed domain name, however, was only created on 7 March 2019, which is substantially later than registration date of the "TOEFL" trademarks.

The disputed domain name comprises of "yhtoefl.com". It wholly incorporates the element "toefl" as its last five characters. Further, the term "toefl" itself does not carry any specific meaning. The letter "yh" which precedes "toefl" in the disputed domain name carries minimal distinctiveness. It is therefore submitted that the disputed domain name should be considered as highly similar to the Complainant's "TOEFL" trademarks in which the Complainant has rights in and it is likely confusion will be caused on the part of the public pursuant to paragraph 4(a)(i) of the Policy.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name(s)

The Complainant submits that according to *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. D2008-1393, once the complainant makes such a prima facie showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have established the second element of the UDRP.

The Respondent's name, Rui Chen has no connection with the term "toefl" and/or "yhtoefl". Hence, the Respondent does not own any legitimate interest in "toefl", "yhtoefl" or used any parts or combination of "toefl" as its trade name. No trademark registration in relation to "yhtoefl" owned by the Respondent, including in China is revealed.

The Complainant has no relationship with the Respondent. The Complainant has never authorized the Respondent to use "TOEFL" or to register a domain

name or part of a domain name on the Complainant's behalf. The Respondent is not in any way related to the Complainant. The Respondent has used the Complainant's mark to register the disputed domain name without authorization from the Complainant.

In addition, the distinctiveness of "toefl" included in the disputed domain name has also increased through extensive use and fame of the Complainant worldwide, including in China. The Complainant encloses a copy of the printout of the brochure in Chinese prepared by the Complainant and a copy of the press release of the Complaint targeting the Chinese audience announcing all Australian universities are accepting scores of ETS's TOEFL test. It can be seen from the Appendices that the mark "TOEFL" is widely known in China. In view of the above, it is submitted that the Complainant has enjoyed a high degree of fame and reputation in the use of "TOEFL" with respect of education services in China. As such, a unique connection has been established between the mark "TOEFL" and the Complaint, and not only that the Respondent has no rights or legitimate interests in, the Respondent should have knowledge about the Complainant and the mark "TOEFL". The Complainant submits that Respondent has no reasonable grounds for adopting "toefl" as a domain name, except for passing off and creating a connection with the Complainant.

Based on the above, the Complainant submits that the Respondent has no rights or legitimate interest in respect of the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy

- iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith:

The Complainant submits that the website hosted under the disputed domain name is in Chinese and it would be logical to infer that the target audience is Chinese. As mentioned above, the Complainant has acquired worldwide fame in the education industry, particularly in China. According to the pinyin name of the Respondent, s/he appears to be a Chinese and the registered address is in China. The Complainant has established that it has invested substantially in China and has attained a high degree of fame and reputation in respect of education services in China. As such, it is highly likely the Respondent has knowledge of the Complainant and yet intentionally attempted to register a domain name that incorporates the trademark of the Complainant.

Despite the constructive or even actual knowledge of the existence of the Complainant, the Respondent has registered the disputed domain name which incorporates an element similar to the Complainant's marks. The website hosted under the disputed domain name is a gambling website called "500 Lottery" (500 彩票) (<http://https://www.565600.com:8760/register?key=1000608710>). The Complainant encloses a copy of the printout of the website hosted under the disputed domain name.

The domain name incorporates the word element "toefl" in its entirety. When the general public perform an internet search for key words such as "toefl" or directly key in "toefl" at the address bar, it is possible that the website hosted under the dispute domain name may pop up. The Complainant engages in the business of education where reputation is of prime importance and the

Complainant represents an international standard for English proficiency. The reputation of the Complainant will be severely damaged and the general public's interest will be compromised if they are misled into believing that there is some sort of relationship between the Complainant and the disputed domain name (which hosts a gambling website) or that the Respondent is an affiliate or is endorsed by the Complainant.

There is no reason for the Respondent to adopt a domain name which is highly similar to the Complainant's marks other than to free ride on the fame and reputation of the Complainant and to attract, for commercial gain, Internet users to the Respondent's web site. The situation stipulated in paragraph 4(b)(iv) of the Policy has been satisfied.

Based on the above, the Complainant submits that the disputed domain name has been registered and is being used in bad faith by the Respondent.

B. Respondent

The Respondent has not filed any submission within the prescribed time.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy ("ICANN Policy") provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

A) Identical / Confusingly Similar

The Complainant has obtained registration of the trademark "TOEFL" in numerous jurisdictions including in the United States since 1978 and China since 1983. The "TOFEL" exam has also been recognized by over 9000 universities in over 130 countries as submitted by the Complainant. In view of this the Panel finds that the Complainant has obtained rights to the trademark "TOEFL" through substantive registration and actual use.

The distinctive part of the Disputed Domain Name is "yhtoefl", which is almost identical, and in fact only adding the letters 'yh' as the 'prefix' to the Complainant's registered trademark. The addition of the "yh" to "toefl" does not generate a distinctive meaning and do not dispel the overall impression of similarity, as "toefl" is a non-dictionary word. The generic Top-Level Domain ("gTLD") ".com" is typically disregarded when considering the similarity, since it is a technical registration requirement.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's proven trademarks.

B) Rights and Legitimate Interests

The Complainant, as the registrant of the “TOEFL” trademark registrations, submitted that it has no relationship with the Respondent and had never authorized the Respondent to use “TOEFL” or to register a domain name or part of a domain name of the Complainant’s behalf.

Under the ICANN Policy Paragraph 4c, the Respondent should demonstrate his rights or legitimate interest by showing circumstances such as:

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

However, since the Respondent defaulted in contesting the Complainant’s allegations, with no evidence to the contrary, the Panel accepts the Complainant’s submissions that:

(1) the Respondent’s name has no connection with the term “toefl” or “yhtoefl”;

(2) the Respondent should have knowledge about the Complainant and the mark “TOEFL” given the extensive use and fame of the Complainant worldwide, including China. Thus the Respondent adopted “toefl” in the domain name for the purpose of passing off and creating a connection with the Complainant;

The Panel is therefore satisfied that the Respondent has no rights or legitimate interest to register and use the Dispute Domain Names.

C) Bad Faith

Under the ICANN Policy Paragraph 4b, the Panel may find evidence of the registration and use of a domain name in bad faith if the following circumstances are present:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Name, the Respondent was or should have been aware of Complainant's "TOEFL" marks. As the Respondent has not provided reasons to show the contrary, the Panel is deemed to draw the conclusion that the Respondent was aware of the Complainant and its "TOEFL" trademark at the time that he/she registered the disputed domain name and deliberately chose to register it as part of the disputed domain name in bad faith.

The disputed domain name redirects the website to an account registration page of a gambling website (<https://www.101055.com:8452/register?id=10700779>).

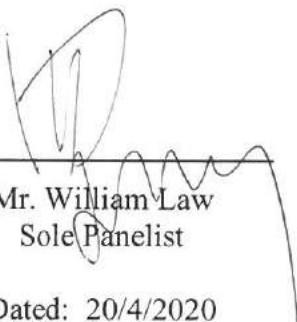


On the redirected page, the 邀请码(invitation code) for account registration has been pre-filled. Without evidence to the contrary, the Panel is of the view that the Respondent is very likely to generate commercial gain through internet users registering an account in the gambling website through the redirected domain name.

Therefore the Panel is satisfied that by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, it is the Panel's view that the disputed domain name has been registered and is being used in bad faith.

6. Decision

In conclusion, the Complainant has satisfied all the 3 grounds laid down in Article 4(b) of the ICANN Policy. I therefore order that the Dispute Domain Name <yhtoefl.com> be transferred to the Complainant.



Mr. William Law
Sole Panelist

Dated: 20/4/2020

