



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-18010127
Complainant:	Educational Testing Service
Respondent:	junqiang zhu
Disputed Domain Name(s):	<etsscm.club>

1. The Parties and Contested Domain Name

The Complainant is Educational Testing Service, of Rosedale Road, Princeton, New Jersey 08541, U.S.A..

The Respondent is junqiang zhu, of xianzhujiatingxiangjiangxiacuneyazhu3haoHunan, Hunan 491119 CN. The contact email is zhujunqiang111@gmail.com.

The domain name at issue is <etsscm.club>, registered by the Respondent with GoDaddy.com, Inc. (“the Registrar”), of abuse@godaddy.com.

2. Procedural History

On 29 June 2018, the Complainant submitted a complaint in English to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“the ADNDRC-HK”) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (“the Policy”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“the ADNDRC Supplemental Rules”).

Upon receipt of the complaint, the ADNDRC-HK sent to the Complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. On 30 June 2018, upon request by the ADNDRC-HK, the Registrar transmitted by email to the ADNDRC-HK its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 4 July 2018, the ADNDRC-HK notified the Respondent about the commencement of the proceedings. On the same day, the ADNDRC-HK notified the Complainant that the

complaint had been confirmed and transmitted to the Respondent, and also notified the Registrar of the commencement of the proceedings.

The Respondent had not filed a response within the stipulated time. On 26 July 2018, the ADNDRC-HK sent out notice noting that no response had been received and the complaint was to be proceeded to a decision by the Panel to be appointed.

On 26 July 2018, the ADNDRC-HK sent to the Complainant and the Respondent notification for the selection of a one-person panel to proceed to render the decision. Having received a declaration of impartiality and independence and a statement of acceptance, the ADNDRC-HK notified the parties, on 26 July 2018, that the Panel in this case had been appointed, with Mr. Gary Soo acting as the sole panelist.

On 26 July 2018, the Panel received the file by email from the ADNDRC-HK and was requested to render the Decision on or before 9 August 2018.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative proceedings 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 proceedings. The language of the current Disputed Domain Name registration agreement is English, thus the Panel determines English as the language of the proceedings.

3. Factual background

The Complainant

The Complainant in this case is Educational Testing Service. The registration address is Rosedale Road, Princeton, New Jersey 08541, U.S.A.. The Complainant appointed Vivien Chan & Co., the address of which being at 32/F, Harbour Centre, 25 Harbour Road, Hong Kong, as its authorized representative in this matter.

The Respondent

The Respondent, junqiang zhu, is the current registrant of the Disputed Domain Names <etsscm.club> according to the GoDaddy.com, Inc.. The address of the Respondent from the registration information is “xianzhujiatingxiangjiangxiacunyeyazhu3haoHunan, Hunan 491119 CN”. The Respondent’s email is zhujunqiang111@gmail.com.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be set out below.

The Complainant was founded in 1947 and is one of the world’s largest private nonprofit educational testing and assessment organisations 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, 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 “ETS” – inclusive trademarks around the world. The first 100 search results from the WIPO Global Brand online database are enclosed in Appendix 2, using “Educational Testing Service” and “ETS” as the keywords for the owner name and the mark respectively. Amongst which the mark “ETS” has been registered in the United States for “Testing service-namely, developing constructing, and administering tests and testing programs for specialized educational purposes; conducting research for the purpose of advancing test theory and practice; and providing advisory testing services to schools, colleges, and other educational institutions” in Class 42 since 1952 (registration no. 0558879). The printout of the USPTO online register of the mark no. 0558879 registered in the US is appended to the complaint.

The Complainant has also registered many trademarks containing “ETS” in China as listed. It can be seen that the “ETS”-inclusive marks are registered in classes 9, 16 and 41 in China. The printout of the records retrieved from the online database of the China Trademarks Office showing that the Complainant has obtained registration for its “ETS” mark in Class 41 in China as early as 1994 is appended. According to the Complainant, the Complainant enjoys the exclusive right to use the following registered trademarks in China:

- (1) The mark of No. 176267 for “ETS” in Class 16;
- (2) The mark of No. 771628 for “ETS” in Class 41;
- (3) The mark of No. 3024962 for “ETS” in Class 16;
- (4) The mark of No. 3024963 for “ETS” in Class 9;
- (5) The mark of No. 3024964 for “ETS” in Class 42;
- (6) The mark of No. 3024965 for “ETS” in Class 41;
- (7) The mark of No. 3162516 for “ETS” in Class 41;
- (8) The mark of No. G1069280 for “ETS” in Class 9;
- (9) The mark of No. G1069809 for “ETS” in Class 9;

From the information, the dates of the registration start from 1983 and are valid till 2024.

The above shows, the Complainant says, that the Complainant owns the “ETS” and “ETS”-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 <etsscm.club> (the Disputed Domain Name), which is identical or confusingly similar to the “ETS” trademarks of the Complainant.

The Complainant asserts that the following:-

- 1) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

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 includes the trademark, *regardless of the other terms in the domain name* [emphasis added]. The Disputed Domain Name incorporates the trademarks and trade name of the Complainant “ETS” in its entirety, which is readily identifiable as it is placed at the front of the Disputed Domain Name, but it is 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 trademarks or trade name “ETS”.

As seen from the information provided by the Complainant, the Complainant has registered the trademark “ETS” in the US since 1952. Also, the Complainant has registered the trademark “ETS” in China in Class 16 in 1983 (Registration No. 176267). The stylization of the Complainant’s “ETS” marks is minimal and the most distinctive element of the marks is “ETS”. The Disputed Domain Name, however, was only created on 10 May 2018, which is substantially later than the registration date of the “ETS” trademarks.

The Disputed Domain Name comprises of “etsscm.club”. It wholly incorporates the element “ets” as its first three characters. Generally more attention will be placed on the frontal part of the domain name. Further, the term “etsscm” does not carry any specific meaning. Hence, the most distinctive element of the Disputed Domain Name is the letters “ets” at the front which is identical to the Complainant’s “ETS” marks. It is therefore submitted that the Disputed Domain Name should be considered as highly similar to the Complainant’s “ETS” trademarks in which the Complainant has rights in and it is likely that confusion will be caused on the part of the public pursuant to paragraph 4(a)(i) of the Policy.

- 2) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name:

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

The Respondent’s name, ‘junqiang zhu’ has no connection with the term “ets” and/or “etsscm”. Hence, the Respondent does not own any legitimate interest in “ets”, “scm” or in using any part(s) or combination of “etsscm” as its trade name. No trademark registration in relation to “ETS” 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 “ETS” 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 “ets” included in the Disputed Domain Name has also increased through the extensive use and fame of the Complainant worldwide, including in China. A copy of the printout of the brochure in Chinese prepared by the Complainant is enclosed and a copy of the press release of the Complainant targeting the Chinese audience announcing all Australian universities are accepting scores of ETS’s TOEFL test is appended. It can be seen from these that the mark “ETS” 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 “ETS” with respect to education services in China. As such, a unique connection has been established between the mark “ETS” and the Complainant. Thus, not only that the Respondent has no rights or legitimate interests in the Disputed Domain Name, the Respondent should have knowledge about the Complainant and the mark “ETS”. The Complainant submits that the Respondent has no reasonable grounds for adopting “etsscm” 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 interests in respect of the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy

3) The Disputed Domain Name has been registered and is being used in bad faith:

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, if found to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) By using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s web site, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s web site or location or of a product or service on the Respondent’s web site or location

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 that the Respondent has knowledge of the Complainant and yet intentionally attempted to register a domain name that incorporates the trademarks 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 mark. The website hosted under the Disputed Domain Name is a pornographic website called “538porn online videos” (<http://www.1188porn.com:6767>), where erotic pictures and videos can be viewed. A copy of the printout of the website hosted under the Disputed Domain Name is enclosed.

The domain name begins with the element “ets”. When the general public perform an internet search for key words such as “ets” or directly key in “ets” at the address bar, it is possible that the website hosted under the Disputed Domain Name may pop up. The Complainant is engaged in the business of education where reputation is of prime importance. The reputation of the Complainant will be severely damaged if the general public is misled into believing that there is some sort of relationship between the Complainant and the Disputed Domain Name.

There is no reason for the Respondent to adopt a domain name which is highly similar to the Complainant’s marks as an introductory website to “538porn online videos” 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)(ii) 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

As said, the Respondent, junqiang zhu, is the current registrant of the Disputed Domain Name <etsscm.club> according to the GoDaddy.com, Inc.. The Respondent registered the Disputed Domain Name on 10 May 2018.

The Respondent has not submitted a response.

5. Findings

Paragraph 14 of the Rules provides that, in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by the Rules or the Panel, the Panel shall proceed to a decision on the complaint; and that, if a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Paragraph 15(a) of the Rules instructs the Panel as to the principles that the Panel is to use in determining the dispute, stating that the Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4 (a) of the Policy requires that the Complainant shall prove all of the following three elements in order to obtain an order that a domain name should be cancelled or transferred:-

- (i) the domain name registered by the Respondent 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The Complainant submits that the Disputed Domain Name incorporates the trademarks and trade name of the Complainant, i.e. “ETS”, in its entirety, which is readily identifiable as it is placed at the front of the Disputed Domain Name, but it is 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 trademarks or trade name “ETS”. In support, the Complainant attaches various documents as per the above to the complaint. To these, there is no contrary submission or evidence from the Respondent.

From the evidence produced, the Panel finds that the Complainant has registered the trademark “ETS” in the US since 1952 and has also registered various trademarks of “ETS” in China since 1983 (Registration No. 176267). The Panel also finds that the Complainant has put to extensive use the “ETS” mark worldwide, including in China, such that the “ETS” mark can be regarded as a famous mark well-known in Chinese communities, particularly for those who are students or in education related industries.

In the circumstances, the Panel finds that the Complainant has succeeded in establishing the necessary rights over the “ETS” mark, as required under Paragraph 4(a)(i) of the Policy.

The Disputed Domain Name in full is <etsscm.club>. The Panel accepts that it wholly incorporates the element “ets” as its first three characters and agrees that, generally more attention may be placed on the frontal part of a domain name by a number of internet users. Further, the Panel takes the view that, while the gTLD of ‘club’ is by itself generic, looking at the Disputed Domain Name, it does give an impression of reading it as “ets scm club”, which can in a way signify to mean the ‘ETS Club of SCM’ or the ETS SCM Club’, i.e. giving the ‘ets’ part an ‘umbrella’ meaning. This is particularly so when the term “etsscm” does not by itself carry any specific meaning. Reading in this way, the most distinctive element of the Disputed Domain Name is the letters “ets” at the front which is identical to the Complainant’s “ETS” marks. Also, with the fame of the “ETS” mark, the Panel does not see the addition of ‘scm’ has made the Disputed Domain Name dissimilar enough from the “ETS” mark, but rather as under the ‘umbrella’ meaning as aforesaid.

On the basis of no contrary submission and/or evidence from the Respondent, in the premises, the Panel finds that the Complainant has successfully established that the Disputed Domain Name <etsscm.club> is identical or confusingly similar to the mark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(i) of the Policy as regards <etsscm.club>.

B) Rights and Legitimate Interests

The Complainant submits that the Respondent has no such rights or legitimate interests necessary under the Policy as regards the Disputed Domain Name. The Complainant makes it clear that the Respondent has never been authorized by the Complainant to use the mark or any mark such as ‘etsscm’. To this, the Respondent does not deny or provide evidence to the contrary.

From the name or email address of the Respondent, the Panel does not see any rights of the Respondent over the Disputed Domain Name <etsscm.club>, the “ETS” mark, the terms “ets” and/or “etsscm”. Also, the Complainant has no relationship with the Respondent and the Complainant has never authorized the Respondent to use “ETS” or to register a domain name or part of a domain name on the Complainant’s behalf.

Also, taking into account that neither “ets” or “etsscm” is in the daily use of language, that the Respondent has not offered any valid explanation as to why it has rights to register and/or use this Disputed Domain Name, and that the Complainant has trademark rights over the “ETS” mark as said, the Panel finds that the Complainant has succeeded in proving the element in Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

Under Paragraph 4(b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that the Respondent has registered or 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 the Respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) The Respondent has 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 the Respondent has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) 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.

The Panel agrees that, as the Complainant submits, the website hosted under the Disputed Domain Name is in Chinese and it is logical to infer that the target audience is Chinese readers. Indeed, the Panel notices that the Respondent’s stated address is in Hunan, i.e. within China and the name of the Respondent also suggests that the Respondent is a Chinese reader and/or Chinese. Given the fame and reputation of the “ETS” mark of the Complainant via the extensive use worldwide, including in China, the Panel accepts and finds that the Respondent has knowledge of the Complainant’s rights over the “ETS” mark when the Disputed Domain Name is registered and used.

The Complainant submits that the Disputed Domain Name begins with “ets” and when the general public perform an internet search for key words such as “ets” or directly key in “ets” at the address bar, it is possible that the website hosted under the Disputed Domain Name may pop up and that, as the Complainant is engaged in the business of education where reputation is of prime importance, the reputation of the Complainant will be severely damaged if the general public is misled into believing that there is some sort of relationship between the Complainant and the Disputed Domain Name. To these, the Respondent does not deny or provide evidence to the contrary.

From all these, it seems clear to the Panel that the Respondent was well aware of the Complainant’s rights in this regard when registering and/or using this Disputed Domain Name. By doing this, the Panel finds that the registration and use of the Disputed Domain Name were and are with bad faith and believes that the purpose is for using the domain name to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the Complainant’s “ETS” mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website.

Therefore, the Panel also finds that the Complainant has succeeded in proving the elements in Paragraph 4(a)(iii) of the Policy as regards <etsscm.club>.

6. Decision

Having established all three elements required under the Policy in respect of the Disputed Domain Name <etsscm.club>, the Panel concludes that relief should be granted in favour of the Complainant. Accordingly, the Panel decides and orders that the Disputed Domain Name <etsscm.club> shall be transferred from the Respondent to the Complainant.

Gary Soo
Sole Panelist

5 August 2018