



(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.:</b>	<b>HK-1901313</b>
<b>Complainant:</b>	<b>Educational Testing Service</b>
<b>Respondent:</b>	<b>Qing Lin</b>
<b>Disputed Domain Name:</b>	<b>&lt;yhtoefl.net&gt;</b>

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### 1. The Parties and Contested Domain Name

The Complainant is Educational Testing Service, of Rosedale Road, Princeton, New Jersey 08541, United States of America, represented by VIVIEN CHAN & CO.

The Respondent is Qing Lin of rm 302, Wu Yu Da Sha, Xu Hui Qu, Shanghai, Shanghai, 00000, China.

The domain name at issue is <yhtoefl.net>, registered by Respondent with GoDaddy.com of <http://www.godaddy.com>.

### 2. Procedural History

The Centre has verified that the Complaint to which this proceeding relates satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy (“**the Policy**”), the Rules of Procedure under the Policy (“**the Rules**”) and the Centre’s Supplemental Rules.

The Complaint was filed pursuant to the Policy, the Rules and the Centre’s Supplemental Rules, with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“**the Centre**”) on December 27, 2019 and the Centre has received payment of the applicable fee. The Centre is a domain name dispute resolution provider accredited by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”).

The Centre acknowledged receipt of the Complaint on December 29, 2019. Also on December 29, 2019, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name and in particular to confirm the identity, including the contact details of the registrant or domain name holder, together with a request that the domain name should remain locked.

On December 30, 2019, the Registrar transmitted by email to the Centre its verification response confirming that the Respondent as listed above as the Respondent in this proceeding is the registrant of the disputed domain name and providing the contact details of the registrant, including the email address being lichangliangttt@163.com. By the same communication, the registrar confirmed that the Uniform Domain Name Dispute Resolution Policy applies to the domain name which would remain locked during the pending administrative proceeding.

On January 8, 2020, the Centre advised the Complainant of an administrative deficiency relating to the Respondent, which the Complainant rectified on January 9, 2020 by filing a revised form of the Complaint. On January 10, 2020, the Centre advised the Complainant that the Complaint was now in administrative compliance with the Policy and its Rules and that the Centre would forward the Complaint to the Respondent and formally commence the proceeding in accordance with the Policy and the Rules.

On January 14, 2020 and pursuant to the Rules, the Centre notified the Respondent of this administrative proceeding, by email sent to lichangliangttt@163.com, and by way of the Written Notice of Complaint. The said notice informed the Respondent that the Respondent was required to submit a Response to the proceeding within 20 days from January 14, 2020 and thus by February 3, 2020. The Respondent did not file a Response to the proceeding by February 3, 2020 or at all.

On February 7, the Centre informed both parties that it had not received the Response by the due date.

On March 16, 2020, the Centre appointed The Honourable Neil Anthony Brown, QC, as a single-member Panel in the above-referenced matter and he has completed and returned to the Centre the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Rules. The Centre on the same day advised the parties of that appointment.

### **3. Factual background**

#### **Complainant**

The following facts have been taken from the Complaint.

The Complainant, Educational Testing Service, was founded in 1947 and is one of the world's largest private nonprofit educational testing and assessment organizations which is 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, i.e. trademarks including the Complainant's principal trademark, TOEFL. The Complainant

tenders as evidence a printout of the search results from the WIPO Global Brand online database, using Educational Testing Service and TOEFL as the keywords for the owner name and the mark respectively. 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). Further evidence tendered by the Complainant is a printout of the USPTO online register of the mark no. 73155230 registered in the United States.

The Complainant has also registered many trademarks containing TOEFL in China details of which are also tendered as evidence. The Complainant submits that it can be seen from that evidence that the TOEFL-inclusive marks are registered in classes 9, 16 and 41 in China. The Complainant also tenders as evidence a printout of the records retrieved from the online database of the China Trademarks Office showing that the Complainant obtained registration for its TOEFL mark in Class 41 in China as early as 1983. The Complainant then lists its TOEFL-inclusive registrations (including its Chinese equivalent “托福”) owned by the Complainant in China, to which reference will be made later in this decision if necessary.

The Complainant makes the complaint that is the subject of this proceeding as, first, it claims that it owns the TOEFL and TOEFL-inclusive trademarks used in the services of administering and scoring examinations relating to English language proficiency and other education related services. Secondly, it disputes the registration by the Respondent of the domain name <yh~~toefl~~.net> (“**the disputed domain name**”) which it maintains is identical or confusingly similar to its TOEFL trademark.

### **Respondent**

The Panel is unable to describe the factual background from the perspective of the Respondent as it did not file a Response.

## **4. Parties’ Contentions**

### **A. Complainant**

The Complainant’s contentions may be summarized as follows:

#### **i) The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights.**

The Complainant submits that the disputed domain name incorporates the TOEFL trademark in its entirety and that the trademark is preceded in the domain name by the letters “yh”, but that this term carries minimal distinctiveness. Accordingly, it is submitted that the domain name is confusingly similar to the trademark in which the Complainant has rights. Moreover, as will be argued, the result of this construction of the domain name is that confusion is likely to be caused to the public.

#### **ii) The Respondent has no rights or legitimate interests in the disputed domain name.**

In support of the Complainant's submission that there is a *prima facie* case that the Respondent has no rights or legitimate interest in the disputed domain name, the Complainant says:

(a) The Respondent's name, Qing Lin has no connection with the term "toefl" and/or "yh-toefl", the former being the same spelling as the trademark and the latter being the same spelling as the domain name.

(b) No trademark registration in relation to "yh-toefl" is owned by the Respondent.

(c) 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.

(d) The Respondent has used the Complainant's mark to register the disputed domain name without authorization from the Complainant.

(e) The distinctiveness of the TOEFL mark that has been included in the disputed domain name has increased through its extensive use by the Complainant worldwide, including in China and the fame that has resulted from that use. As a result, a unique connection has been established between the TOEFL mark and the Complainant which shows that the Respondent must have had knowledge of the Complainant and the mark when the domain name was registered on April 23, 2017.

(f) The Complainant submits that there can be no explanation for Respondent adopting "toefl" in its domain name, except for the purpose of passing off and creating the appearance of a connection with the Complainant.

**iii) The disputed domain name has been registered and is being used in bad faith.**

That is so because the facts of the matter bring it squarely within the provisions of paragraph 4(b) of the Policy.

The disputed domain name does not resolve to an active website. But the fact that the Complainant is so well-known means that the Respondent must have had actual knowledge of the TOEFL trademark and chose it as the basis for the domain name to benefit from an alleged association with it.

The domain name consists substantially of the element "toefl". 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 disputed domain name may pop up. Moreover, the use of the trademark in the domain name shows an attempt to attract commercial gain by creating a likelihood of confusion with the Complainant. In the Complainant's industry its reputation is very important. There is therefore a very real danger that internet users seeking Toefl may come across the domain name and infer an association between the Complainant and the domain name that would damage the Complainant's reputation.

There is also no reason for the Respondent to adopt a domain name which is highly similar to the Complainant's marks other than to try to have a free ride on the fame and reputation of the Complainant and to attract, for commercial gain, internet users to the Respondent's web site.

All of these matters show bad faith registration and use. Accordingly, 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 did not file a Response in this proceeding.

**5. Findings**

The ICANN Uniform Domain Name Dispute Resolution 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.

The Panel will now deal with each of these three elements in turn.

**A) Identical / Confusingly Similar**

The first question that arises is whether Complainant has rights in a trademark or service mark on which it may rely. Complainant claims to have registered trademark rights arising from a series of registrations for TEOFL internationally. The Complainant draws attention to one registered trademark in particular, registered in the United States and a group of trademarks registered in China which are significant because the Respondent is apparently domiciled in China.

The first of the trademarks is the trademark serial number 733155230 and registered number 1103427 in the United States Patent and Trademark Office ("**USPTO**") for TEOFL, registered in the name of the Complainant. This trademark was registered on October 3, 1978.

The group of trademarks registered in China are for TEOFL and for TEOFL-inclusive trademarks. In addition, the Complainant has a series of other TEOFL and TEOFL-inclusive trademarks.

All of the foregoing trademarks have been meticulously proven by the Complainant by evidence of registrations which the Panel accepts. Registration of a mark with the USPTO or with other internationally recognised domestic and international authorities sufficiently confers a complainant's rights in a mark for the purposes of paragraph 4(a)(i) of the Policy *See DIRECTV, LLC v. The Pearline Group*, FA 1818749 (Forum Dec. 30, 2018) ("*Complainant's ownership of a USPTO registration for DIRECTV demonstrate its rights in such mark for the purposes of Policy 4(a)(i).*").

The Complainant has thus established the registered trademarks referred to (“**the TOEFL mark**”). Accordingly, the Panel finds that the Complainant has established rights in the TOEFL mark for the purposes of paragraph 4(a)(i) of the Policy.

It is also clear that the Complainant has established that the TOEFL mark is extensive and well-known internationally including in China.

The next question that arises is whether the disputed domain name is identical or confusingly similar to Complainant’s TOEFL mark. Complainant argues that the <**yhtoefl.net**> domain name is confusingly similar to Complainant’s TOEFL mark as it contains the TOEFL mark in its entirety, merely adding the letters “yh” before the TOEFL trademark, along with adding a gTLD. Misspelling of a complainant’s mark, either by adding or removing letters, as the Respondent has done by adding the letters “yh” and adding a gTLD will not negate any confusing similarity between a disputed domain name and a mark under paragraph 4(a)(i) of the Policy. *See Twitch Interactive, Inc. v. zhang qin*, FA 1626511 (Forum Aug. 4, 2015) (“*The relevant comparison then resolves to the trademark, TWITCH, with the term, ‘titch’, which, as can be readily seen, merely removes the letter ‘w’ from the trademark. In spite of that omission the compared integers remain visually and aurally very similar and so Panel finds them to be confusingly similar for the purposes of the Policy.*”); *see also Trip Network Inc. v. Alviera*, FA 914943 (Forum Mar. 27, 2007) (concluding that the affixation of a gTLD to a domain name is irrelevant to a paragraph 4(a)(i) Policy analysis). The same can clearly be said of the present case where the Respondent has merely added two letters before the trademark.

The Complainant also makes a strong point by submitting that the letters “yh” create a term that “carries minimal distinctiveness”. In any event, the internet user would probably recognize the TOEFL trademark, as it is the dominant portion of the domain name. The internet user would then think that the domain name was an official domain name associated with the Complainant and that it would lead to an official website of the Complainant, none of which, of course, is true. The domain name is therefore similar to the trademark and confusingly so.

Therefore, for all of these reasons the Panel finds that the disputed domain name is confusingly similar to Complainant’s TOEFL mark within the meaning of paragraph 4(a)(i) of the Policy.

Complainant has thus made out the first of the three elements that it must establish.

## **B) Rights and Legitimate Interests**

It is now well established that Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy, then the burden shifts to the Respondent to show it does have rights or legitimate interests. *See Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (Forum Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy 4(a)(ii)); *see also Neal & Massey Holdings Limited v. Gregory Ricks*, FA 1549327 (Forum Apr. 12, 2014) (“*Under Policy 4(a)(ii), Complainant must first make out a prima facie case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests*”).

The Panel finds that Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) Respondent has chosen to take Complainant's well-known and respected TOEFL trademark and to use it in its domain name, adding only the letters "yh" which, as the Complainant has rightly argued is a term that "carries minimal distinctiveness" and hence encourages the internet user to think that it is even more likely that the domain name is an official TOEFL domain name;
- (b) Respondent registered the domain name on April 23, 2017;
- (c) Respondent is using the disputed domain name to resolve to an inactive website that carries no legitimate information. The Panel has tested the domain name and finds that this produces the following message as a result: "*Destination Unknown Everything's working on our side, so the link you clicked is either wrong or has been retired.*" The danger in that message is that actual and potential customers of the Complainant who arrive at that point by following the deceptive domain name may conclude that this message is associated with or approved by the Complainant or that the Complainant has gone out of business. There is no way that such a use of the domain name can be regarded as legitimate;
- (d) There is no evidence to suggest that the Respondent is commonly known by the domain name or any other name linked to Toefl and, indeed, the WHOIS result, which is in evidence, makes it plain that the Respondent is more likely than not to be known by its actual name and not by the domain name;
- (e) There is no evidence to suggest that the Respondent is in any way connected with or is an associate of the Complainant;
- (f) There is no evidence to suggest that the Respondent is using the domain name for a legitimate purpose;
- (g) The Respondent has clearly registered the domain name to use it for an improper purpose, to pretend that it is associated with the Complainant and there could be no other reason why it would register a domain name the most prominent portion of which is the Complainant's trademark;
- (h) All of the evidence suggests that the Respondent must have had actual knowledge of the trademark at the time it registered the domain name;
- (i) The Respondent has been engaged in these activities without the consent or approval of Complainant.

All of these matters go to make out the *prima facie* case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has thus made out the second of the three elements that it must establish.

### **C) Bad Faith**

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith. It is

also clear that the criteria set out in paragraph 4(b) of the Policy for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

First, the practical result of the Respondent's conduct in registering the domain name is that it disrupts Complainant's business and intentionally creates a false association with Complainant. Using a confusingly similar domain name to create a false association with a complainant can evince bad faith under paragraph 4(b)(iii) & (iv) of the Policy. *see Dell Inc. v. Prashant Chhibber*, FA 1785651 (Forum June 1, 2018) ("*The Panel finds that Respondent used the domain names to create confusion with Complainant's DELL mark for commercial gain and that Respondent registered the domain names in bad faith under Policy 4(b)(iv).*"). The purpose of the domain name is clearly to align the Respondent with the Complainant and its services and to suggest some affiliation with it. Such conduct is deceptive and amounts to bad faith. Accordingly, the Panel finds that the Respondent registered and used the domain name in bad faith within the meaning of paragraphs 4(b)(iii) & (iv) of the Policy.

Secondly, the same analysis shows that the Respondent had actual knowledge of Complainant's rights in the TOEFL mark at the time of registering the domain name. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name can evince bad faith under Policy 4(a)(iii). *See iFinex Inc. v. xu shuaiwei*, FA 1760249 (Forum January 1, 2018) ("*Respondent's prior knowledge is evident from the notoriety of Complainant's BITFINEX trademark as well as from Respondent's use of its trademark laden domain name to direct internet traffic to a website which is a direct competitor of Complainant*"). The Panel therefore agrees with the Complainant that to use and trade on the Complainant's well-known and respected trademark as the Respondent has done, it must have had actual knowledge of the trademark when it registered the domain name incorporating the trademark. Thus, registering and using the domain name, even by passively allowing it to remain in place and to resolve to an inactive website has been for an improper purpose and hence in bad faith both with respect to its registration and also its use. The Panel therefore finds that the Respondent had actual knowledge of Complainant's mark when it registered and used the domain name which constitutes bad faith registration and use.

The Complainant has advanced several other persuasive arguments summarized above. There is no need to refer to them in any detail here, other than to say that the Panel agrees with those submissions and that they show the Respondent's bad faith registration and use.

Thirdly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the TOEFL mark and in view of the conduct that Respondent has engaged in when using the disputed domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.


Complainant has thus made out the third of the three elements that it must establish.



## 6. Decision

As the Complainant has established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

It is therefore Ordered that the <yhtoefl.net> domain name be **TRANSFERRED** from the Respondent to the Complainant.

A handwritten signature in black ink, appearing to read 'N.A. Brown', is written over a horizontal line.

The Honourable Neil Anthony Brown QC  
Panelist  
Dated March 23, 2020