

ADMINISTRATIVE PANEL DECISION

Educational Testing Service v. Alonso Lopez Lara
Case No. D2023-4813

1. The Parties

The Complainant is Educational Testing Service, United States of America (“United States”), represented by Cantor Colburn LLP, United States.

The Respondent is Alonso Lopez Lara, Mexico.

2. The Domain Name and Registrar

The disputed domain name <certificadoets.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 20, 2023. On November 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 2023 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 on November 22, 2023.

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 of the Complaint, and the proceedings commenced on November 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2023. The Response was filed with the Center on November 27, 2023. In addition, the Respondent sent email communications to the Center on November 22, 27, 30 and December 4, 2023. The Center sent the Commencement of Panel Appointment Process email on December 19, 2023.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on December 20, 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 was established in 1947, and it operates continuously under the ETS brand since 1948. The Complainant is a large private non-profit educational testing and assessment organization that currently develops, administers and scores more than 50 million tests per year in more than 180 countries, including the TOEFL and TOEIC tests.

The Complainant owns trademark registrations in various jurisdictions for its brands, including the United States and Mexico, where the Respondent is located according to the Registrar verification. These registrations include:

- Unites States Trademark Registration No. 559686, ETS (figurative), registered on June 03, 1952, in class 16;
- Unites States Trademark Registration No. 1166461, ETS (word), registered on August 25, 1981, in classes 16, 41, and 42;
- Mexican Trademark Registration No. 493225, ETS (figurative), registered on May 26, 1995, in class 41; and
- Mexican Trademark Registration No. 495148, ETS (figurative), registered on June 19, 1995, in class 16.

The aforementioned trademark registrations will collectively be referred to as the “ETS mark”.

Prior decisions under the Policy have recognized the international reputation of the ETS mark.¹

The Complainant further owns various domain names related to its ETS mark, including <ets.org> (registered on October 10, 1994), and <etsglobal.org> (registered on July 23, 2001), which resolve to its corporate websites.

The disputed domain name was registered on January 10, 2023, and it currently resolves to a landing page of GoDaddy that announces that it is possible to obtain the disputed domain name, and includes various Pay-Per-Click (“PPC”) links related to security, travels and hotels. According to the evidence provided by the Complainant, the disputed domain name previously resolved to a website in Spanish language that offered the purchase of various options of TOEFL certificates. This site displayed various images of different TOEFL and TOEIC certificates, offered their purchase for a price amounting to USD 70, and indicated, “en menos de una hora recibe tu certificado vía correo electrónico con una validez de dos años”, which can be translated as “in less than an hour receive your certificate per email with a validity of two years”. This website further explained that, after doing the payment, the user should provide the information needed to generate the certificate. For the TOEIC Listening and Reading Complete Score certificate the delivery time indicated in the site was 5 to 6 hours, as, it explained, in this type of certificate the text changes depending of the performance, and “[...] y se le da una descripción por parte de nosotros [...]”, which can be translated as “it is given a description by us”.

¹ See, e.g., *Educational Testing Service v. Ndip Junior Arrey Johnson, Johnson Empire and Jamie Chaviers*, WIPO Case No. [D2022-0495](#); *Educational Testing Service v. Ahmed Hasan Ali, Dr. Haider*, WIPO Case No. [D2017-0689](#); *Educational Testing Service v. Int'l Names Ltd.*, WIPO Case No. [D2007-0449](#); or *Educational Testing Service v. Park Jeong Foreign Language Institute*, WIPO Case No. [D2001-1064](#).

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the well-known trademark ETS, the Respondent has no rights or legitimate interests with respect of the disputed domain name, and has acted in bad faith. The Respondent has no authorization to use the ETS mark, and has used the disputed domain name to intentionally mislead internet users and attract traffic to its website. The Respondent has attempted to increase the traffic to its website generating a false affiliation to the Complainant and the ETS mark, and has used the disputed domain name for an illegal activity fraudulently offering counterfeit TOEFL and TOEIC certificates.

B. Respondent

The Respondent indicated in its Response that it is an English language school that provides didactic material for the preparation of the ETS tests. The Respondent recognizes the Complainant's allegations regarding the infringement of its rights, as well as the use and registration of the disputed domain name to misleadingly attract the attention of potential customers and increase the traffic of its website.

In a separate email communication, the Respondent indicated, "We acknowledge the error committed and the inconveniences we have caused due to lack of knowledge and inadvertence in the use of images and logos of this registered trademark. We want to emphasize that it was never our intention, and we seek to bring an end to this domain dispute in the most respectful and amicable manner possible. We are in full agreement for the domain to be transferred to the complainant, or alternatively, for it to be deleted. We have no willingness or intention to prolong this conflict".

The Respondent further requested to change the language of the proceeding to Spanish.

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Language of Proceeding

Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.

Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

The Panel considers that there is no reason to change the language of the proceeding, in this case English, as it was the language of the registration agreement of the disputed domain name. The Respondent has indicated that "We are a language school specializing in American Language", and has demonstrated its knowledge of this language providing its Response as well as various email communications in English, so the Panel considers appropriate and fair to maintain English as the language of the proceeding.

B. Respondent's Consent for the Transfer of the Disputed Domain Name, and Three Elements of the UDRP Policy

Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the "standard settlement process" articulated in paragraph 17(a) of the Rules, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis). WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.10.

The Panel acknowledges the Respondent's indication of its "full agreement for the domain to be transferred to the complainant, or alternatively, for it to be deleted". The Respondent's consent to the remedy requested by the Complainant allows this Panel to give effect to this consent to the transfer of the disputed domain name to the Complainant without any further analysis of the case.

The Panel, however, wishes to emphasize that the disputed domain name is confusingly similar to the ETS mark, and the registration and use of the disputed domain name for an illegal activity here, claimed sale of counterfeit TOEFL and TOEIC certificates, impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on the Respondent, and constitutes bad faith. ([WIPO Overview 3.0](#), sections 2.13.1, and 3.4).

Furthermore, the current use of the disputed domain name resolving to a landing page that includes PPC links and offers for sale the disputed domain name, is a further evidence of bad faith, and the Respondent cannot disclaim responsibility for content appearing on the website associated with the disputed domain name. ([WIPO Overview 3.0](#), section 3.5).

Therefore, based on the available record, the Panel finds the three elements 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 <certificadoets.com> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: January 3, 2023