

ADMINISTRATIVE PANEL DECISION

Goethe-Institut e.V. v. Chris S Desley

Case No. D2023-4894

1. The Parties

The Complainant is Goethe-Institut e.V., Germany, represented by Lausen Rechtsanwälte, Germany.

The Respondent is Chris S Desley, United States of America.

2. The Domain Name and Registrar

The disputed domain name <buy-telc-goethe-zertifikat.com> is registered with Squarespace Domains II LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 24, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 27, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 28, 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 amendment to the Complaint on November 29, 2023. The Center sent a further email communication to the Complainant on November 30, 2023, regarding the place of mutual jurisdiction. The Complainant filed a second amendment to the Complaint on November 30, 2023, stating that the Complainant will submit to the jurisdiction of the courts at the location of the principal office of the Registrar.

The Center verified that the Complaint together with the amendments to the 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 December 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2024.

The Center appointed Andrea Mondini as the sole panelist in this matter on January 16, 2024. 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, Goethe-Institut e.V., is a registered association founded in 1951 with headquarters in Munich, Germany. The Complainant is the globally active cultural institution of the Federal Republic of Germany. It offers courses and exams for German as a foreign language, corresponding to the levels of the Common European Framework of Reference for Languages ("CEFR"). The certificate awarded for passing an exam, the "Goethe-Zertifikat", is recognized all over the world as evidence of German language skills, also in connection with immigration to Germany.

The Complainant holds the domain name <goethe.de> which hosts its main website.

The Complainant owns the European Union Trademark Registration GOETHE INSTITUT (no. 012235685, figurative) which was registered on April 14, 2014, in International Classes 9, 16 and 41.

Because the Respondent did not file a Response, not much is known about the Respondent.

The disputed domain name was registered on June 10, 2022.

According to the evidence submitted with the Complaint, the disputed domain name resolves to a website offering "Goethe-Zertifikate" for sale "without taking the exam".

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 as follows:

The disputed domain name is confusingly similar to the GOETHE INSTITUT trademark in which the Complainant has rights, because it contains the identical element GOETHE which is the main word element of the Complainant's trademark, whereas the addition of the terms "buy-telc" and "zertifikat" is not sufficient to avoid confusing similarity but rather directly refers to the "Goethe-Zertifikat" and thus to services offered by the Complainant.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not been authorized by the Complainant to use this trademark, is not commonly known by the disputed domain name, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods and services.

The disputed domain name was registered and is being used in bad faith. The Respondent is offering "Goethe Certificates" (and other German language skill certificates) as German language certifications, making several references to the services offered by the Complainant. The Respondent is even offering to "Get A Certificate From Us Without Taking The Exam" or "Buy original GOETHE Certificate (...) without an exam". Thereby, the Respondent is offering for sale counterfeit certificates allegedly issued by the Complainant which not only intentionally creates a likelihood of confusion with the Complainant's mark and name, but is also impairs the authenticity and integrity of the Complainant and its certificates. On the "About

Us” page of the website posted under the disputed domain name, the Respondent states that “our insiders work in the different exam centers around the world” and so they would “create real registered TELC, GOETHE, OSD, TestDaF certificates without you taking an exam”. Thus, the Respondent falsely claims that the certificates it provides would be legitimate. By using the disputed domain name, the Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s mark.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the distinctive element of the mark “goethe” is reproduced within the disputed domain name so that the trademark is recognizable within the disputed domain name.

Although the addition of other terms such as here “buy-telc” and “-zertifikat” may bear on assessment of the second and third elements, the Panel finds that in the present case the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity such as here selling counterfeit language certificates can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the view of the Panel, noting that that the Complainant's trademark predates the registration of the disputed domain name and considering that the Complainant's trademark and language certificates are well known and that the disputed domain name resolves to a website selling language certificates purportedly issued by the Complainant and considering the nature of the added terms "buy-telc" and "zertifikat" relevant to the Complainant's business in the disputed domain name, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant's well-known trademark. In the circumstances of this case, this is evidence of registration in bad faith.

The available record shows that the Respondent is offering "Goethe Certificates" (and other German language skill certificates) as German language certifications, making several references to the "Goethe Certificates" and the services offered by the Complainant. The Respondent is offering to "Get A Certificate From Us Without Taking The Exam" or "Buy original GOETHE Certificate (...) without an exam". On the "About Us" page of the website posted under the disputed domain name, the Respondent even states that "Our insiders work in the different exam centers around the world" and so they would "create real registered TELC, GOETHE, OSD, TestDaF certificates without you taking an exam". Thereby, the Respondent is fraudulently offering for sale counterfeit certificates allegedly issued by the Complainant.

The Panel thus holds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site in the sense of Policy, paragraph 4(b)(iv).

Moreover, panels have held that the use of a domain name for illegal activity such as in the present case selling counterfeit language certificates constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy with regard to the disputed domain name.

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 <buy-telc-goethe-zertifikat.com> be transferred to the Complainant.

/Andrea Mondini/

Andrea Mondini

Sole Panelist

Date: January 30, 2024