

ADMINISTRATIVE PANEL DECISION

FN Funding Inc. v. Nick Mofford, 80 Eighty
Case No. D2023-3537

1. The Parties

Complainant is FN Funding Inc., United States of America (“United States” or “U.S.”), represented by Reinhart Boerner Van Deuren s.c., United States.

Respondent is Nick Mofford, 80 Eighty, United States, represented by Parsons Behle & Latimer, United States.

2. The Domain Name and Registrar

The disputed domain name <dreamcargiveaway.com> (hereinafter “Disputed Domain Name”) 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 August 22, 2023. On August 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 23, 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 (Registration Private) and contact information in the Complaint. The Center sent an email communication to Complainant on August 24, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 30, 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 Respondent of the Complaint, and the proceedings commenced on August 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 24, 2023. The Response was filed with the Center on September 24, 2023.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on October 3, 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

Complainant is a United States corporation based in Florida that conducts fundraising sweepstake contests. Since 2008, Complainant has used the trademark DREAM GIVEAWAY (hereinafter the “Mark”) in connection with its contests, which often “give away” a car as the sweepstake prize. Complainant owns United States Trademark Registration No. 3,695,208 for DREAM GIVEAWAY (registered on October 13, 2009).

Respondent registered the Disputed Domain Name <dreamcargiveaway.com> on July 13, 2015, and subsequently secured United States Trademark Registration No. 5259319 (registered on August 8, 2017) for the trademark DREAM CAR GIVEAWAY for “entertainment services, namely, conducting contests”. Respondent does not engage in charitable fundraising. Instead, Respondent uses the Disputed Domain Name in connection with sweepstake contests designed to promote Respondent’s own business of selling merchandise, such as hats, shirts, *etc.* When customers buy a product from Respondent’s merchandise website, which operates under the domain name <80eighty.com>, Respondent enters the customer in a contest to win a car. Respondent uses DREAM CAR GIVEAWAY as the trademark for its sweepstake contest. The Disputed Domain Name does not resolve to a unique webpage, but instead redirects to Respondent’s merchandise website at the domain name <80eighty.com>, where Respondent displays the DREAM CAR GIVEAWAY mark and explains the contest.

In March 2020, Complainant filed in the United States Trademark Trial and Appeal Board (“TTAB”) a petition to cancel Respondent’s DREAM CAR GIVEAWAY trademark. Complainant alleged prior use and confusing similarity. Complainant prevailed. On November 28, 2022, the TTAB found that Complainant was the senior user and that the marks were confusingly similar and cancelled the registration for Respondent’s DREAM CAR GIVEAWAY trademark.

5. Parties’ Contentions

A. Complainant

Complainant contends that the Disputed Domain Name incorporates the trademark DREAM GIVEAWAY in its entirety and that the addition of the descriptive term “car” does not prevent the finding of confusing similarity.

Complainant further contends that Respondent has no rights or legitimate interests in the Disputed Domain Name. Complainant has not authorized Respondent’s use of Complainant’s DREAM GIVEAWAY, and Respondent is not known by the name DREAM GIVEAWAY because, Complainant contends, the Whois information for the Disputed Domain Name does not identify the registrant as DREAM GIVEAWAY.

Complainant contends that Respondent’s use is not legitimate because Respondent redirects Internet visitors to Respondent’s website at the domain name <80eighty.com>, where Respondent displays the DREAM CAR GIVEAWAY mark and encourages visitors to purchase merchandise for entries into promotional events that feature cars or other vehicles as prizes. Complainant contends this redirection is illegitimate because it competes with Complainant’s charitable fund-raising services.

Complainant contends there is a high risk that Internet visitors will mistakenly perceive that Respondent is affiliated with Complainant.

Complainant contends that Respondent's use of the Disputed Domain Name is not legitimate because it represents a deliberate infringement of Complainant's DREAM GIVEAWAY trademark. Complainant further contends that the TTAB's order cancelling Respondent's trademark registration demonstrates that Respondent does not have legitimate rights in the Disputed Domain Name.

Complainant contends that Respondent has "constructive, if not actual," notice of Complainant's DREAM GIVEAWAY trademark rights. Complainant contends that, because both Parties are United States residents, they are subject to United States trademark law, which provides that registration of a trademark "shall be constructive notice of the registrant's claim of ownership thereof". 15 U.S.C. 1072. Complainant contends that Respondent registered the Disputed Domain Name in bad faith because Respondent only began using the Disputed Domain Name after Complainant established common law rights and acquired a U.S. federal trademark registration for DREAM GIVEAWAY.

Complainant contends that Respondent uses the Disputed Domain Name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's DREAM GIVEAWAY Trademark. Respondent is also exploiting confusion for commercial gain by using the Disputed Domain Name to redirect to the domain name <80eighty.com> where Respondent offers competitive goods and services are offered.

Finally, Complainant contends that it is bad faith for Respondent to continue using the Disputed Domain Name after the TTAB found a likelihood of confusion between the Parties' marks as registered and cancelled Respondent's registration.

B. Respondent

Respondent contends that The Disputed Domain is not identical or confusingly similar to Complainant's DREAM GIVEAWAY mark; that the mark is weak, and the term "car" in the Disputed Domain is sufficient to preclude confusion. Given this weakness, the additional term "car" in the Disputed Domain distinguishes the Disputed Domain Name from Complainant's Mark.

Respondent contends that he has a legitimate interest in the Disputed Domain Name.

Respondent has used the Disputed Domain in connection with a *bona fide* offering of goods and services long prior to the initiation of this dispute. In February 2015, Respondent began using the mark DREAM CAR GIVEAWAY in association with sweepstakes contests that promote Respondent's goods.

When Respondent started using the DREAM CAR GIVEAWAY mark and the corresponding Disputed Domain Name, Respondent had no knowledge of Complainant's use of or alleged rights in the DREAM GIVEAWAY mark. Respondent did not become aware of Complainant's registration until Complainant filed a petition to cancel Respondent's mark.

Respondent selected the Disputed Domain Name because it is descriptive of Respondent's sweepstakes contests that feature "dream cars."

Respondent has completed 66 Dream Car Giveaway contests. and, as of July 2023, is currently conducting the 67th contest. Respondent has consistently and prominently used the DREAM CAR GIVEAWAY mark in association with each contest.

Respondent's sweepstakes contests are fundamentally different from Complainant's. Respondent does not conduct any charitable fundraising.

Respondent also contends that his business is commonly known by its trademark DREAM CAR GIVEAWAY and the corresponding Disputed Domain Name. In support, it submits evidence of social media activity, including: approximately 926,000 users currently follow Respondent's Instagram account, which features the DREAM CAR GIVEAWAY mark. Nearly 85,000 users currently subscribe to Respondent's YouTube channel, which has over 23 million cumulative views.

Respondent denies bad faith registration and use.

When he registered the Disputed Domain Name, Respondent was not aware of Complainant or its alleged trademark rights in the DREAM GIVEAWAY mark. Instead, Respondent registered the Disputed Domain Name because it was descriptive of Respondent's services.

The Panel should not apply the doctrine of constructive notice. Because there is no evidence of any effort to target Complainant or exploit its goodwill or reputation for the purpose of profiting from a complainant's trademark rights, there can be no finding of bad faith registration based on constructive knowledge.

Although the TTAB has cancelled Respondent's registration for DREAM CAR GIVEAWAY, it did not adjudicate Respondent's rights to continue using DREAM CAR GIVEAWAY mark or the Disputed Domain Name.

While Complainant successfully petitioned to cancel the registration, the fact that the United States Trademark Office ("USPTO") allowed registration of the mark in the first place supports Respondent's position that the Disputed Domain Name was registered and used in good faith.

Finally, Respondent contends that Complainant has engaged in reverse domain hijacking because it learned in the cancellation proceedings that Respondent has long used the Disputed Domain Name for a legitimate business purpose and that Respondent had no knowledge of Complainant's rights when Respondent registered the Disputed Domain Name.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that Complainant has rights in the Mark, as evidenced by its United States Trademark Registration No. 3,695,208. The Panel also finds that the Disputed Domain Names is confusingly similar to Complainant's trademark. The addition of the term "car" does not prevent the finding of confusing similarity. See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.8.

The Panel finds that Complainant has satisfied Policy paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests and Bad faith

The Panel finds that before Respondent received notice of the dispute, Respondent used the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Given this finding there is no need to address Respondent's contention that it was commonly known by the Disputed Domain Name.

Complainant first notified Respondent of a dispute in March 2020 when it filed a petition to cancel Respondent's DREAM CAR GIVEAWAY trademark registration. Complainant does not deny that it contacted Respondent about the dispute prior to filing the petition to cancel and Respondent's co-founder submitted sworn statements in this case and also in the cancellation proceedings denying knowledge of Complainant's trademark or the dispute prior to the commencement of the cancellation petition.

Respondent had been using the Disputed Domain Name in business for several years prior to the commencement of the cancellation petition. Respondent's application to register the DREAM CAR GIVEAWAY trademark claimed a date of first use in February 2015 and included a specimen of use depicting Respondent's first "giveaway" of a car.

Respondent has conducted 66 giveaway contests as of the commencement of these proceedings since that time. The Panel finds that Respondent has used the Disputed Domain Name in connection with a *bona fide* business that started in 2015, long before Respondent received notice of this dispute.

Complainant makes to attempt to rebut Respondent's declaration that he had no actual knowledge of Complainant's Mark or of the dispute before he registered the Disputed Domain Name. Instead, Complainant argues that, before Respondent registered the Disputed Domain Name in 2015, he had constructive knowledge of Complainant's DREAM GIVEAWAY trademark, which was registered in 2009. Under United States law, the registration of a trademark "shall be constructive notice of the registrant's claim of ownership thereof". 15 U.S.C. 1072. United States law does not control interpretation of the Policy, but:

"In limited circumstances – notably where the parties are both located in the United States and the complainant has obtained a federal trademark registration pre-dating the relevant domain name registration – panels have been prepared to apply the concept of constructive notice. Application of this concept may depend in part on the complainant's reputation and the strength or distinctiveness of its mark, or facts that corroborate an awareness of the complainant's mark."

[WIPO Overview 3.0](#), section 3.2.2.

For three reasons, the Panel rejects Complainant reliance on constructive notice.

First, the Panel is reluctant to rely on constructive knowledge because:

"The Policy makes no mention of constructive notice being enough to satisfy this requirement [of bad faith] [...] and [...] if Complainant's position were adopted, it would essentially establish a per se rule of bad faith any time a domain name is identical or similar to a previously-registered trademark, since constructive notice could be found in every such case. Such a result would be inconsistent with both the letter and the spirit of the policy, which requires actual bad faith".

Educational Testing Service v. Jigsaw Edu Solutions Private Limited, Vivek Raheja, WIPO Case No. [D2012-0244](#), quoting *Advanced Drivers Education Products and Training, Inc v. MDNH, Inc. (Marchex)*, NAF Case Number: NAF Claim No. FA0509000567039 (2009). For these reasons, the Panel is skeptical of relying on constructive knowledge when applying the Policy.

Second, even if the Panel were to charge Respondent with constructive knowledge of Complainant's trademark, this would not put Respondent on notice of the dispute, which Respondent did not receive until April 2020, nearly five years after he began doing business using the Disputed Domain Name. During that period, Respondent had no notice that anyone disputed its right to use its registered DREAM CAR GIVEAWAY trademark. Constructive notice of Complainant's trademark is not equivalent to notice of the dispute. *The Zoological Society of San Diego, Inc. v. Affinity One, LLC*, WIPO Case No. [D2006-1458](#) ("The test for 'rights or legitimate interests' under the Policy, paragraph 4(c)(i) and (ii) is whether the Respondent used the Domain Name in business prior to notice of the dispute, not prior to 'constructive notice' of the Complainant's trademark."); *Jeffrey S. Thompson D/b/a the Wedding Planner, v. Weddingchannel.com, Inc.*, WIPO Case No. [D2002-0086](#) ("Further, knowledge of a trademark registration does not necessarily constitute knowledge of a 'dispute' as that term is used in Section 4(c)(i) of the Policy."). Consequently, even if Respondent had constructive knowledge of Complainant's Mark, Complainant has not denied Respondent's sworn statement that he did not know of the dispute until Complainant filed the petition to cancel in March 2020, which was many years after he began using the Disputed Domain Name in connection with its *bona fide* business.

Third, mere knowledge of the existence of a trademark, whether actual or constructive, is not alone enough to support a finding of bad faith. When UDRP panelists have relied on constructive notice to decide cases under the Policy, that have often required additional evidence corroborating Respondent's deliberate targeting of Complainant. [WIPO Overview 3.0](#) section 3.2.2. This is true under United States law as well. One of the leading cases on point is *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 586 (2d Cir. 1993), where the Second Circuit observed that:

"In determining a defendant's intent, 'actual or constructive knowledge' of the prior user's mark or dress may indicate bad faith. ([citation omitted]). Where such prior knowledge is accompanied by similarities so strong that it seems plain that deliberate copying has occurred, we have upheld findings of bad faith."

Id. at 586–87; citing *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d Cir.1987).

Here, there is no evidence of deliberate targeting that could elevate mere constructive knowledge into bad faith. Rather than corroborate the imputed knowledge that Complainant proposes, the record overwhelmingly supports the contrary conclusion that when Respondent registered the Disputed Domain Name, he was not aware of Complainant's trademark. Even if such knowledge is imputed, there is no additional evidence of deliberate targeting of Complainant or exploitation of Complainant's good will or reputation.

Instead, it is plausible and more probable that, as Respondent's representative states in his un rebutted declaration, Respondent selected the Disputed Domain Name because of its descriptive connotations. After all, Respondent does in fact "give away dream cars". The phrase straddles the line between descriptive and suggestive, but it is entirely plausible that Respondent chose the Disputed Domain Name for its plain meaning. Certainly, Complainant has not carried its burden to prove that Respondent chose the Disputed Domain Name in order to exploit Complainant's goodwill.

In addition, the Panel has examined the declaration that Respondent submitted with its 2016 application to register its DREAM CAR GIVEAWAY trademark. This declaration corroborates Respondent's current declaration that he lacked knowledge of Complainant's trademark or of the dispute. When Respondent filed its application, Respondent's representative signed a declaration "under penalty of perjury" that "[t]he signatory believes that to the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive." This is further evidence that, when Respondent registered the Disputed Domain Name in 2015, he had the subjective belief that he had the right to use the DREAM CAR GIVEAWAY mark and corresponding domain name.

Furthermore, when the USPTO Examiner reviewed Respondent's application, he conducted a search to identify confusingly similar trademark registrations, but he did not reject Respondent's application based on Complainant's preexisting registration for DREAM GIVEAWAY. Even though the TTAB later found in the cancellation proceedings that the Parties' marks were likely to be confused, the earlier registration of Respondent's DREAM CAR GIVEAWAY mark is evidence that it was objectively reasonable for Respondent to believe its registration and use of the Disputed Domain Name was legitimate.

Complainant contends that Respondent's business is not *bona fide* because Respondent's DREAM CAR GIVAWAY mark infringes its DREAM CAR trademark. Complainant relies on the TTAB's cancellation of Respondent's registration after finding that the two trademarks were confusingly similar. Complainant contends that Respondent's continued use of the Disputed Domain Name after the cancellation constitutes bad faith use.

It is frequently observed that proceedings under the Policy are not appropriate for deciding questions of infringement more appropriate for the courts. The fact that the Parties may someday fight it out in full blown litigation to determine whether Respondent infringes is not the question now. If a party registers a domain name in the good faith and objectively reasonable belief that it is legally entitled to do so, and uses the

domain name to conduct authentic business transactions without any attempt to exploit another's good will, then that business qualifies as "*bona fide*" under the Policy even if a court later determines in litigation that the Disputed Domain Name infringes Complainant's trademark. It may be that a court may decide that Respondent may not continue to use the Disputed Domain Name because it is later found to be infringing under national law, but that is not for the Panel to decide under the Policy.

The central question for the Panel is whether Respondent genuinely adopted DREAM CAR GIVEAWAY as its domain name independently of Complainant's rights, or whether its various explanations are pretextual and designed to cover up an intent to take unfair advantage of Complainant's reputation and goodwill. The balance of probabilities favors Respondent on this central question.

The Panel finds that before receiving notice of the dispute, Respondent began using the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Respondent commenced his use of the Disputed Domain Name without prior actual notice of Complainant's trademark or of the dispute. And constructive notice, if applied, at most imputes awareness of Complainant's trademark. This is necessary evidence, but it is not sufficient to prove notice of the dispute or bad faith deliberate targeting of Complainant or exploitation of its good will and reputation.

Under these circumstances, Respondent prevails under Policy 4(c)(i) and Complainant fails to carry its burden to prove bad faith registration. Given these rulings, there is no need to address Complainant's other arguments.

Reverse Domain Name Hijacking.

The Panel rejects Respondent's request for a finding of reverse domain name hijacking. Complainant's success in the cancellation proceeding is evidence that the current action was not brought primarily to harass but rather a continuation of an ongoing dispute. Furthermore, although the Panel did not accept Complainant's constructive knowledge argument, some prior UDRP decisions have adopted similar arguments when assessing the totality of the circumstances. Accordingly, the Panel denies the request for a finding of reverse domain name hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: October 17, 2023