

ADMINISTRATIVE PANEL DECISION

80 Eighty LLC v. Mohammad Lutfi
Case No. D2023-5104

1. The Parties

Complainant is 80 Eighty LLC, United States of America (“United States”), represented by Parsons Behle & Latimer, United States.

Respondent is Mohammad Lutfi, United States.

2. The Domain Name and Registrar

The Domain Name <eighty80.com> (the “Domain Name”) is registered with TurnCommerce, Inc. DBA NameBright.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 7, 2023. On December 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 8, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (unknown registrant) and contact information in the Complaint. The Center sent an email communication to Complainant on December 11, 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 December 11, 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 January 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. Respondent did not submit any response but sent an informal email on December 12, 2023. The Center notified the Parties that it would proceed to Panel Appointment on January 25, 2024.


The Center appointed Christopher S. Gibson as the sole panelist in this matter on February 12, 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.

The Respondent sent another informal email on March 6, 2024.

4. Factual Background

Complainant, a Utah-based company, is an online retailer of apparel, automotive accessories, and other gear and products for motorsports enthusiasts. In February 2015, Complainant began using the 80 EIGHTY mark in association with Complainant’s goods and with sweepstakes contests that promote Complainant’s goods. The contests involve the chance to win a car and, in many cases, cash. Detailed information on Complainant and its products and services may be found at its website at <80eighty.com>. Complainant is also the owner of the following United States trademarks and incontestable registrations:

Trademark:	80 EIGHTY
Country:	United States
Registration No.:	5,259,317
Registration Date:	August 8, 2017
Date of First Use:	February 1, 2015
Goods/Services	Stickers; Bumper stickers (in International Class 16); Headwear; Hoodies; T-shirts; Caps; Graphic T-shirts; Short-sleeved or long-sleeved t-shirts (in International Class 25); Entertainment services, namely, conducting contests (in International Class 41)

Trademark:	
Country:	United States
Registration No.:	5,259,321
Registration Date:	August 8, 2017
Date of First Use:	February 1, 2015
Goods/Services	Stickers; Bumper stickers (in International Class 16); Headwear; Hoodies; Long-sleeved shirts; T-shirts; Caps; Graphic T-shirts; Short-sleeved or long-sleeved t-shirts (in International Class 25); Entertainment services, namely, conducting contests (in International Class 41)

The Domain Name was originally registered on January 23, 2011, with the registration last updated on July 27, 2023. Complainant has provided evidence that at least as of December 1, 2023, the Domain Name has been used to redirect to the website of Complainant’s competitor, who like Complainant offers automotive themed apparel and accessories and related sweepstakes giveaways.

5. Parties' Contentions

A. Complainant

Complainant states it recently learned that a competitor registered and is using the Domain Name for the improper purpose of diverting Internet users from Complainant's website to the competitor's site at <tunercult.com>. Complainant respectfully requests that the Panel transfer the Domain Name to Complainant.

(i) Identical or confusingly similar

Complainant states the Domain Name incorporates the entirety of its 80 EIGHTY wordmark, in which Complainant has superior rights. The Domain Name is also a reproduction of Complainant's trade name. Complainant contends that while the Domain Name displays the alpha and numeric portions of the 80 EIGHTY mark in reverse order, this is a distinction without a difference. The Domain Name is phonetically identical to Complainant's 80 EIGHTY mark. Further, "80 and "eighty" have identical meanings. Their reversal does not change their meaning or commercial impression. Complainant's mark remains recognizable in the Domain Name despite the reversal of the alpha and numeric formatting. The marks are legally identical, and the reversed order does not prevent a finding of confusing similarity. Complainant also submits that, and as previous UDRP decisions have repeatedly found, the addition of a generic Top-Level Domain ("gTLD"), in this case ".com," to the end of the Domain Name does not diminish the likelihood of confusion between Complainant's 80 EIGHTY marks and the Domain Name.

(ii) Rights or legitimate interests

Complainant contends that under the UDRP, a respondent is generally considered to have no right or legitimate interest in a domain name if (a) the respondent does not use, or undertake demonstrable preparations to use, the domain name in connection with a bona fide offering of goods and services, (b) the respondent is not commonly known by the domain name, and (c) the respondent is not making a legitimate noncommercial or fair use of the domain name.

Complainant claims that it is clear Respondent has no rights or legitimate interests in the Domain Name. Complainant contends, upon information and belief, that Respondent recently acquired and began using the Domain Name long after Complainant registered and began using its 80 EIGHTY marks. Respondent is not a licensee of Complainant, nor is Respondent otherwise authorized to use the 80 EIGHTY marks for any purpose. Complainant has no affiliation or connection with Respondent. Respondent's use of the Domain Name is not bona fide or in good faith because it infringes Complainant's 80 EIGHTY marks.

Furthermore, upon information and belief, Respondent is not commonly known as "Eighty 80." Instead, Respondent is identified as an individual, Mohammad Lufti. Complainant is not aware of any evidence to indicate that Respondent is or was ever commonly known as "Eighty 80". Upon information and belief, Respondent is the owner and operator of Tuner Cult and its associated website at <tunercult.com>, which offers goods and services that compete with Complainant's goods and services. The Domain Name redirects to <tunercult.com>, offering automotive themed apparel and accessories and related sweepstakes giveaways. Upon information and belief, Respondent has never used or been known by the terms "Eighty 80." Complainant was unable to find any references to the term "Eighty 80" on Tuner Cult's website. Respondent's use of the terms "Eighty 80" only in the Domain Name does not provide any rights or legitimate interests. Because Respondent is not commonly known by the name "Eighty 80", Respondent has not established rights or legitimate interests in the Domain Name pursuant to the Policy.

Additionally, there is no evidence that Respondent's has used or is preparing to use the Domain Name in connection with a bona fide offering of goods or services. There is no actual connection between the Domain Name and the corresponding website content at <tunercult.com>, to which the Domain Name redirects. Respondent's improper use of Complainant's 80 EIGHTY marks to redirect consumers to a website that competes with Complainant's goods and services does not confer upon Respondent any rights

or legitimate interests. Complainant submits the evidence shows that Respondent uses the Domain Name solely to divert traffic to a competing site, which is sufficient to establish a prima facie case that Respondent has no legitimate rights or interests in the Domain Name.

(iii) Registered and used in bad faith

Complainant contends that Respondent registered and is using the Domain Name in bad faith. Complainant refers to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 3.1, stating “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark.” Panels have found bad faith when the respondent has registered a domain name that is identical or confusingly similar to a competitor’s trademark for the purposes of diverting traffic from the competitor to another website used by the respondent for the purposes of commercial gain. Upon information and belief, Respondent was aware or Complainant when Respondent acquired the Domain Name. Respondent acquired the Domain Name for the sole purpose of confusing customers and diverting traffic from Complainant’s website to Respondent’s competing site at <tunercult.com>, which offers competing goods and services. Respondent’s use of the Domain Name is a textbook case of bad faith and the Panel should transfer the Domain Name to Complainant.

B. Respondent

Respondent did not formally reply to Complainant’s contentions, but sent two informal emails on December 12, 2023 and March 6, 2024.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element of the Policy functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant’s trademark and the Domain Name. [WIPO Overview 3.0](#), section 1.7. Here, Complainant has demonstrated rights in respect of a trademark for purposes of the Policy through its United States trademark registrations and use of the 80 EIGHTY mark in commerce. Moreover, the entirety of the mark is reproduced within the Domain Name, although the terms “80” and “eighty” are reversed in their order of placement. The Panel finds that this reversal of the terms does not avoid confusing similarity. As Complainant has indicated, these changes in the Domain Name do not change the pronunciation, meaning or commercial impression when comparing it to Complainant’s trademark.

Accordingly, the Domain Name is confusingly similar to Complainant’s mark for the purposes of the Policy, and the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

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. See [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds that Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent is not a licensee of Complainant, nor is Respondent otherwise authorized to use Complainant’s 80 EIGHTY mark for any purpose. Further, there is no evidence that Respondent is not commonly known as “Eighty 80;” instead, Complainant has provided evidence that the Domain Name redirects to a website at <tunercult.com>, which is operated by a competitor of Complainant. This redirection does not serve to establish that Respondent has any rights or legitimate interests in respect of the Domain Name.

Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

Accordingly, 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 third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith.

In the present case, the unrebutted evidence establishes clearly that the Domain Name is being used in bad faith by Respondent to intentionally attempt to attract, for commercial gain, Internet users to Respondent’s website by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement. The evidence shows that the Domain Name was being used to redirect to the website at <tunercult.com>, which is operated by a competitor of Complainant to offer goods and services very similar to those offered by Complainant.

The issue that requires more thorough analysis in this case is whether the Domain Name was registered in bad faith. The Whois registration record for the Domain Name shows that it was first registered in January 2011, before Complainant acquired its 80 EIGHTY trademark registrations, both of which have February 1, 2015 listed as the date of first use for the marks. However, the Domain Name’s registration was last updated on July 27, 2023, which is more than eight years after Complainant began using its marks. Complainant in its Complaint has alleged that, upon information and belief, Respondent recently acquired and began using the Domain Name long after Complainant had registered and began using its 80 EIGHTY marks, and that Respondent was aware of Complainant when Respondent acquired the Domain Name for the sole purpose of confusing customers and diverting traffic from Complainant’s website to Respondent’s competing site at <tunercult.com>, which offers competing goods and services. Further, Complainant has provided evidence that at least as of December 1, 2023, the Domain Name was used to redirect to Respondent’s competing website.

In the face of these allegations, Respondent did not respond to the Complaint. The Panel observes, however, that [WIPO Overview 3.0](#), section 4.8, provides guidance that “a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.” Further, [WIPO Overview 3.0](#), section 4.8 states, in particular, that this research may include, among other things, “consulting historical resources such as the Internet Archive (www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past....” The Panel has reviewed the Internet Archive Wayback Machine records for the Domain Name to research its historical use. The Panel found that the Wayback Machine records contained 52 captures of the webpages to which the Domain Name has resolved over time. Between 2011 when the Whois records indicate the Domain Name was registered and January 21, 2022, which is the last record logged by the Wayback Machine, the numerous webpages captured contain content that is completely and solely in the Japanese language. Yet as noted above, the Whois registration record for the Domain Name indicates that the Domain Name’s registration status was recently updated on July 27, 2023. Further, Complainant has provided evidence that at least as of December 1, 2023, the Domain Name was used to redirect to Respondent’s competing website.

[WIPO Overview 3.0](#), section 4.2 provides in relevant part that “[w]hile conclusory statements unsupported by evidence will normally be insufficient to prove a party’s case, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case e.g., where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent.” In view of the evidence submitted in this case, and the lack of any response from Respondent, the Panel determines that it is reasonable to infer that when the Domain Name’s registration record was last updated in July 2023, this update more likely than not was due to the transfer of the Domain Name from a previous owner to Respondent. In particular, it was only after this time that the Domain Name was no longer used to post content in the Japanese language, but instead used to redirect to Respondent’s competing website. Based on a consideration of all the facts and circumstances, the Panel finds not only has the Domain Name been used in bad faith, but it was also registered in bad faith when it recently acquired by Respondent.

Accordingly, based on the balance of the probabilities and for all of the above reasons, the Panel finds that Complainant has established the third element of the Policy.

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 Domain Name, <eighty80.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: March 11, 2024