

ADMINISTRATIVE PANEL DECISION

ORNUA Co-operative Limited v. orla o shea, Glengarriff camping
Case No. D2024-0838

1. The Parties

The Complainant is ORNUA Co-operative Limited, Ireland, represented by Tomkins & Co., Ireland.

The Respondent is orla o shea, Glengarriff camping, Ireland.

2. The Domain Name and Registrar

The disputed domain name <kerry-gold.com> (“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 February 26, 2024. On February 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, 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, Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 27, 2024, 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 March 1, 2024.

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 March 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2024. The Respondent sent an email communication to the Complainant, copying the Center on March 5, 2024 (the “Response”). On the same day, the Complainant issued a holding reply to the Respondent.

Upon the confirmation from the Complainant, the Center suspended the case on March 8, 2024. On April 4, 2024, the Complainant informed the Center that the parties were engaging in good faith discussions; the Center therefore extended the suspension until April 30, 2024. On April 24, 2024, the Complainant indicated that the Respondent has yet to provide the settlement undertaking as proposed by the Complainant. The Center did not hear further from the parties and re-instituted the proceedings on May 1, 2024.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on May 27, 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 is an Irish dairy co-operative founded in 1961 with, inter alia, an international consumer brand called KERRYGOLD (the "Complainant's Trademark"). The Complainant operates 19 subsidiaries worldwide and has a global team of over 3,300 employees.

The Complainant owns several trademark registrations for the Complainant's Trademark in various jurisdictions, including, inter alia, a United Kingdom Trademark Registration No. 1044326 for KERRYGOLD registered on April 1, 1975 in Class 29; European Union ("EU") Trademark Registration No. 000099739 for KERRYGOLD registered on October 26, 1998 in Classes 1, 5, 29, 30, and 33; and Irish Trademark Registration No. 116558 for KERRYGOLD LIGHT registered on June 28, 1985 in Class 29.

The Complainant's Trademark is fully incorporated in the Complainant's own domain name <kerrygold.com>, which resolves to the Complainant's website.

The Disputed Domain Name was registered on February 15, 2024. At the time of the Complaint and this decision, the Disputed Domain Name resolved to a parked GoDaddy page. The Respondent appears to be an individual residing in Ireland based on the information provided by the Registrar.

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 the following:

- (a) The Disputed Domain Name is identical or confusingly similar to the Complainant's Trademark as the Complainant's Trademark is instantly recognisable in the Disputed Domain Name from a side-by-side comparison. Including a hyphen between the words "kerry" and "gold" does not make a sufficient difference between the Disputed Domain Name and the Complainant's Trademark;
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent is not affiliated with the Complainant and has not obtained any licence or authorisation from the Complainant to use the Complainant's Trademark as part of a domain name or otherwise. Resolving to a parked GoDaddy page shows no evidence of the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods and services; and
- (c) The internationally well-known and famous status of the Complainant's Trademark indicates that the Respondent was or should have been aware of the Complainant's Trademark prior to registering the Disputed Domain Name, especially when the Respondent resides in Ireland where the Complainant is from. The non-use of the Disputed Domain Name does not prevent a finding of bad faith under the doctrine of

passive holding. The Respondent has deprived the Complainant from registering the Disputed Domain Name, and the Respondent's concealment of her contact details adds to her bad faith.

B. Respondent

In the Respondent's email dated March 5, 2024, she stated "I am happy to transfer the domain or I can delete from my account? Was going to be used for campsite didn't realise. Let me know how you would like me to proceed".

On April 4, 2024, the Complainant informed the Center that the Parties were engaging in good faith discussions. However, it appears from the Complainant's email dated April 24, 2024 that the Parties did not reach a settlement.

The Center is not aware if other or further communication took place between the Respondent and the Complainant.

6. Discussion and Findings

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.

The Complainant has shown rights in respect of the Complainant's Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's Trademark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the Complainant's Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of a punctuation mark, namely a hyphen, may bear on assessment of the second and third elements, the Panel finds the addition of such punctuation mark does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although the Respondent contended that she was going to use the Disputed Domain Name for a campsite, the Panel considers that the Response does not satisfactorily address the Complainant's arguments under this element of the Policy. The Respondent did not give any information about her alleged business or explain what she "did not realise". The Respondent also failed to explain the reasons for adopting the Disputed Domain Name, if not for the purpose of creating an impression that the Disputed Domain Name originates from, or is associated with, the Complainant.

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.

There is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name. There is also no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name, is in connection with a bona fide offering of goods or services or be regarded as legitimate noncommercial or fair use.

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.

The Respondent did not explain what she "didn't realise", nor did she state whether she was aware of the Complainant and its rights in the Complainant's Trademark when registering and using the Disputed Domain Name. A quick Internet search conducted by the Panel shows that the top few search results returned for the Complainant's Trademark relate to the Complainant's business and/or third-party websites providing information relating to the Complainant's goods. According to the Complainant's website at "www.ornua.com/history", it started operating in Ireland since 1961 (where the Respondent is based) and has gradually expanded internationally.

In the present case, the Panel notes that it is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that it has incorporated the Complainant's Trademark in its entirety. As discussed above, the Respondent lacks any rights or legitimate interests in the Disputed Domain Name (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)). Further, the Respondent failed to satisfactorily respond to any of the Complainant's contentions and has provided no evidence of her actual or contemplated good faith use of the Disputed Domain Name.

Panels have found that the non-use of a domain name, in this case a parked GoDaddy page, would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the Disputed Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's Trademark, the composition of the Disputed Domain Name, the inadequacy of the Respondent's Response, and the Respondent's use of a privacy registration service, and finds that in the circumstances of this case the passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

The Panel finds that the 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 Disputed Domain Name, <kerry-gold.com>, be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: June 7, 2024