



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Tillamook County Creamery Association v. Dorene Kirkingburg

Case No. D20051175

1. The Parties

The Complainant is Tillamook County Creamery Association, of Oregon, United States of America, represented by Ben C. Fetherston, United States of America. (hereinafter referred to as “Complainant” or “TCCA”)

The Respondent is Dorene Kirkingburg, of Oregon, United States of America.

2. The Domain Names and Registrar

The disputed domain names:

<tillamookcandy.com> <tillamookcandyfactory.com> <tillamookchocolate.com>
<tillamookchocolatefactory.com> <tillamookfudgefactory.com> are all registered with Tucows.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2005. On November 11, 2005, the Center transmitted by email to Tucows a request for registrar verification in connection with the domain names at issue. On November 15, 2005, Tucows transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 24, 2005. In accordance with the Rules, paragraph 5(a), the due date for Response was December 14, 2005. No Response was filed. Accordingly, the Center notified the Respondent’s default on December 15, 2005.

The Center appointed Prof. Justin Hughes as the Sole Panelist in this matter on December 20, 2005. 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 holds a family of federally registered trademarks for TILLAMOOK in relation to cheese, butter, milk, whey, yogurt, sour cream, ice cream, and for retail services selling these products as well as fudge and “novelty items” (Complaint, Annex 4, Exhibit A). These trademark registrations date back as early as 1948 and establish the trademark’s use in commerce by the Complainant as early as 1918.

On March 2, 2004, the Respondent registered the domain name <tillamookcandy.com>, <tillamookchocolate.com>, <tillamookfudgefactory.com>, <tillamookcandyfactory.com>, and <tillamookchocolatefactory.com> (Complaint, Annex 1). The domain names have resolved or presently resolve to a blank or virtually blank page with a “web designworks.com” logo (Complaint, Annex 3, Exhibits D F and verified by the Panel, January 2, 2006).

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions, as they bear on resolution of this dispute, are discussed individually under section 6. AC below.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. Therefore, for purposes of this decision, the Panel accepts the Complainant’s contentions when supported by evidence, as shown above and below.

6. Discussion and Findings

To prevail in a UDRP action, Paragraph 4(a) of the Policy requires that the complainant must prove each of the following:

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

Because this dispute is between two parties who are United States citizens and would otherwise be subject to jurisdiction before American courts to resolve any disagreement regarding the trademark(s) and domain names in question, the Panel concludes that pursuant to UDRP Rules, paragraph 15(a), it is appropriate to apply rules and principles of American trademark law between the parties.

A. Identical or Confusingly Similar

As described above, the Complainant holds a family of federally registered trademarks for TILLAMOOK in relation to dairy products. The Complainant produces various kinds of cheese as well as “Butter, Ice Cream, Sour Cream, Yogurt, Fluid Milk and Dried Whey”, all of which appears to be marketed under the TILLAMOOK trademarks. [“<http://www.tillamookcheese.com/about/facility.html>” lists the TCCA product; *see also* products list at “<http://www.tillamookcheese.com/products/productshome.html>”.] Nonetheless, Complainant apparently does not produce fudge, milk chocolate, or other dairybased candies. *Id.*

Although the Complainant does not produce fudge or milk chocolate, given its range of dairybased products as well as the categories of federal registrations for which it owns the TILLAMOOK trademark, the Panel concludes that <tillamookchocolate.com>, <tillamookchocolatefactory.com>, and <tillamookfudgefactory.com> are confusingly similar to the Complainant’s trademarks.

[Pursuant to a letter of November 22, 2005 sent to the WIPO Arbitration and Mediation Center, the Complainant withdrew those elements of the Complaint concerning <tillamookmilkchocolate.com>, but the same reasoning would apply more forcefully to any domain name using “TILLAMOOK” in combination with the word “milk”.]

At the same time, from Complainant’s registration of a family of trademarks for dairy products and fudge, it does not follow that all combinations of TILLAMOOK with a food word are confusingly similar. Candy products are not automatically associated with dairy foods. In the United States, “candy” is usually defined as food based on sugar, honey, or other sweeteners. [See, e.g. definitions at “<http://www.answers.com/topic/candy>”, “<http://www.wordreference.com/definition/candy>”, “<http://www.thefreedictionary.com/candy>” and “<http://en.wikipedia.org/wiki/Candy>”.]

For this reason and because the Panel concludes that the Complainant has failed to establish the third element of a successful UDRP action, the Panel does not reach a final determination as to whether <tillamookcandy.com> and <tillamookcandyfactory.com> are confusingly similar to the Complainant’s trademark.

B. Rights or Legitimate Interests

In this particular case, however, the second and third requirements of the Policy overlap to some degree because the Respondent clearly has or had some kind of relationship to Complainant.

The Complaint states that the Respondent was, during some undesignated period, married to “one of the Complainant’s ownermilk producers” (Complaint, Paragraph 11.B at 6), but does not provide any additional details. The June 8, 2005 email from Respondent to Complainant’s employee Mike Franklin asserts that the Respondent “registered these names while a member of TCCA” (Complaint, Annex 4, Exhibit D). The Complaint and its attendant documentation raises additional questions concerning the relationship of the parties. For example, the June 7, 2005 email from Mike Franklin to the Respondent indicates that the domain names at issue are “unfinished business” between the parties, indicating some type of relationship not shown in the documentation. (Complaint, Annex 4, Exhibit D)

Nonetheless, without any submission from the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the domain names.

C. Registered and Used in Bad Faith

The third element that must be established under the UDRP is that the Respondent “registered and used” the domain name in “bad faith”. There is insufficient evidence of bad faith before the Panel: concerning this element, the Complainant has not met its burden under Paragraph 4(a)(iii).

There is no evidence that the Respondent “registered or . . . acquired the domain name[s] primarily for the purpose of selling, renting, or otherwise transferring the domain name[s]” beyond the Respondent’s “outf-pocket costs directly related to the domain name[s]” under Paragraph 4(b)(i).

There is no evidence that the Respondent registered “the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name[s]” under Paragraph 4(b)(ii). Nor is there any evidence that the Respondent “registered the domain name primarily for the purpose of disrupting the business of a competitor” under Paragraph 4(b)(iii). In fact, the evidence indicates that the Complainant had consciously chosen a group of domain names for promotion of TCCA and had no interest in these domain names until Respondent registered them (Complaint, Annex 4, Exhibit E). The Complainant’s lack of interest in these domain names is further shown by the Complainant requesting cancellation, not transfer, of the domain names (Complaint, Paragraph 12 at 7).

There is no evidence that the Respondent registered the domain names “to attract, for commercial gain, Internet users to [Respondent’s] website or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [Respondent’s] website or location under Paragraph 4(b)(iv).

The indicia of bad faith provided in Paragraph 4(b) are nonexhaustive. Nonetheless, the Panel does not find any adequate allegation of bad faith in the Complaint.

For example, the Respondent's registration of multiple domain names – at least the five in this dispute – may indicate bad faith under the Policy.

In many circumstances, registration of multiple domain names that are confusingly similar to established trademarks is evidence of bad faith. This is true under both American trademark law, *see* 15 U.S.C. §1125 (d)(B)(i)(VIII) (registration “of multiple domain names which the person knows are identical or confusingly similar to marks of others” is indicia of bad faith), and under the Policy. But the typical pattern in these cases is one individual registering multiple domain names which comprise marks of well known business entities, both unaffiliated with Respondent and unaffiliated with one another. *Stella D'Oro Biscuit Co., Inc. v. The Patron Group, Inc.*, WIPO Case No. D20000012 (February 17, 2000) (respondent held more than 100 domain names confusingly similar to wellknown trademarks); *Toyota Motor Sales, U.S.A., Inc. v. RD Lab*, WIPO Case No. D20051129 (December 13, 2005) (respondent had registered domain names confusingly similar to several separate automobile manufacturers).

In contrast, the Respondent here seems to have had some kind of affiliation with the Complainant. More importantly, her multiple domain name registrations were both small in number and all directed at the Complainant. This is more akin to a disgruntled customer or a disgruntled shareholder who registers a few domain names related to one company in order to criticize the company or press a minority shareholder viewpoint: in such a circumstance, the fact that the case concerns a small number of domain name registrations is in itself not evidence of bad faith as understood under the UDRP.

In his June 9, 2005 email to the Respondent, Mr Franklin wrote:

“Thank you for your email of June 8, 2005. I am very pleased that you are as concerned about the protection of our brands as we are. I am also relieved that your intent in reserving the domain names was to help us protect our brand. We were not aware of your intentions until receiving your email.” (Complaint, Annex 4, Exhibit E).

Even now, the Complainant only characterizes Respondent's intent as a “misguided effort to protect Complainant's rights”. (Complaint, Paragraph 11 at 6)

Complainant does not point the Panel to any UDRP decision that has found that a respondent's effort (without indication of ulterior motives) to help a complainant protect its brand through mere registration of a related domain name, with no use thereof, constitutes bad faith.

Some WIPO Panels have concluded that use of a domain name to express disagreement with the policies or corporate decisions of a trademark holder, either as a dissatisfied customer or a disgruntled shareholder/owner, constitutes bad faith. But those decisions have often been between one or more nonUS parties, *see, e.g. Grupo Picking Pack, S.A. f/k/a Grupo HispanoSuiza, S.A. v. Prospero Moran and Asturnet, S.L.*, WIPO Case No. D20001220 (December 18, 2000); *Compagnie de Saint Gobain v. ComUnion Corp*, WIPO Case No. D20000020 (March 14, 2000).

Those decisions are often incompatible with current views of “nominative fair use” and criticism websites in American trademark law. See *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005); *TMI, Inc. v. Maxwell*, 368 F.3d 433 (5th Cir. 2004); *Lucas Nursery, Inc. v. Grosse*, 359 F.3d 806 (6th Cir. 2004). This point has been acknowledged in the recent *WIPO Overview of WIPO Panel Views on Selected UDRP Questions (2005)* (presenting two views, neither as a majority view, as to whether “a respondent using the domain name for a criticism site generate rights and legitimate interests?”)

Moreover, this is not a case in which the Respondent has used the domain names at all. Respondent appears to have registered them in the belief that the Complainant is not adequately protecting its trademark rights. Whether or not this effort is “misguided”, in the absence of some indication of other ulterior motives, it does not constitute bad faith. “The UDRP is designed to deal with simple cases of cybersquatting” *Summit Industries, Inc. v. Jardine Performance Exhaust Inc.* WIPO Case No. D20011001 (October 15, 2001). There is insufficient evidence to say this is one of those cases. The Panel’s decision does not, of course, give the Respondent free rein to do what it might with these domain names. Any number of subsequent uses by the Respondent might establish the bad faith that the evidence available at this time does not.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Professor Justin Hughes
Sole Panelist

Dated: January 3, 2006