

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Sebastien Garrasi

Case No. D2022-4445

1. The Parties

The Complainant is Caffè Borbone S.r.l., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Sebastien Garrasi, Switzerland.

2. The Domain Name and Registrar

The disputed domain name <caffèborbone.net> [xn--caffborbone-19a.net] (the “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 November 21, 2022. On November 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 23, 2022, 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 November 24, 2022 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 28, 2022.

The Center verified that the Complaint together with the amendment 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 November 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 21, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on December 27, 2022. 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, Caffè Borbone S.r.l., is an Italian company founded in 1997. The Complainant manufactures and sells coffee and coffee-related products.

The Complainant holds various trademarks including the signs BORBONE or CAFFÈ BORBONE, such as the following:

- United Kingdom figurative mark depicted below, registered under No. UK00915670532 on November 23, 2016, in classes 7, 11, 21, 30, 35, 37, 40 and 43:

BORBONE

- European Union figurative mark depicted below, registered under No. 15670541 on November 23, 2016, in classes 7, 11, 21, 30, 35, 37, 40 and 43:



- United States figurative mark depicted below, registered under No. 4356426 on June 25, 2013, in classes 7, 30, and 43:



The Disputed Domain Name was registered on March 28, 2022. According to evidence provided by the Complainant, the Disputed Domain Name resolved to a parking page including a search function of a third-party website, as well as a “Log in” and a “Sign up” clickable button. The Disputed Domain Name currently resolves to a blocked web page.

5. Parties’ Contentions

A. Complainant

The Complainant considers the Disputed Domain Name to be essentially identical to a trademark in which it claims to have rights. The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the Respondent is not known and cannot be known by the Disputed Domain Name. The Complainant claims it never authorized the Respondent to register and use the Disputed Domain Name. In the Complainant’s view, the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the Respondent knew or should have known of the Complainant’s mark when it registered the Disputed Domain Name and the Disputed Domain Name being identical to the Complainant’s mark cannot amount to mere coincidence. Moreover, the Complainant claims that the

Disputed Domain Name is used to disrupt the Complainant's business, and to mislead online users in order to prevent the Complainant from using its reputed trademarks on the Internet and from reflecting them in corresponding domain names.

B. Respondent

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

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. The standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The Disputed Domain Name is identical or confusingly similar to a 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.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there is a trademark in which it has rights. The Complainant's BORBONE and CAFFÈ BORBONE trademarks have been registered and used in connection to its coffee business.

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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Moreover, the use of punycode to create a domain name indistinguishable from a trademark manifestly does not prevent a finding of identity or confusing similarity between the two (see *Inter Ikea Systems B.V. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2017-2211](#); and *Dogan Internet Yayinciliği Ve Yatırım Anonim Sirketi v. Moniker Privacy Services/H A Lempka-Alpha Domains*, WIPO Case No. [D2013-2244](#)).

The unicode version of (the second-level portion of) the Disputed Domain Name includes the textual component of the Complainant's BORBONE trademark in its entirety and is identical to the textual Component of the Complainant's CAFFÈ BORBONE trademark.

It is well established that the generic Top-Level Domain (“gTLD”), here “.net”, may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights (see section 1.11 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant’s BORBONE and CAFFÈ BORBONE trademarks.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights (there being no Response or evidence of any such rights). According to the information provided by the Registrar, the Respondent is named “Sebastien Garrasi”. There are no indications that a connection between the Complainant and the Respondent exists.

Fundamentally, a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry. Where a domain name is identical to a complainant’s trademark, UDRP panels have largely held that it carries a high risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name is identical to the textual components of the Complainant’s CAFFÈ BORBONE mark, including the accented letter “è” and without any addition but the gTLD “.net”. In the Panel’s view, the Disputed Domain Name therefore carries a high risk of implied affiliation with the Complainant.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Complainant provides evidence showing that the Disputed Domain Name resolved to a parking page including a search function of a third-party website, as well as a “Log in” and a “Sign up” clickable button.

The Panel is not absolutely convinced by the Complainant’s argument that redirecting online users to a third-party website through a search function disrupts the business of the Complainant.

However, in view of the Disputed Domain Name being identical to the textual components of the Complainant’s CAFFÈ BORBONE mark, the Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. In the Panel’s view, the “Log in” and a “Sign up” clickable buttons may capitalize on the reputation and goodwill of the Complainant’s mark or mislead Internet users, which cannot be considered as a fair use of the Disputed Domain Name (see section 2.9 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 the website or location or of a product or service on the website or location.

In the present case, the Panel finds it likely that the Respondent was aware of the Complainant and its rights in the BORBONE and CAFFÈ BORBONE marks when it registered the Disputed Domain Name:

- the Complainant's marks predate the registration of the Disputed Domain Name by more than five years;
- the Complainant shows that its marks have acquired at least some level of reputation in the coffee business; and
- the Disputed Domain Name is identical to the textual components of the Complainant's CAFFÈ BORBONE mark, even including the accented letter "è".

As a result, the Respondent must have had knowledge of the Complainant's rights at the time of registering the Disputed Domain Name. The Panel finds that the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trade marks in question, the inclusion of the entire trade mark in the domain name, and the similarity of products implied by addition of a telecommunications services suffix suggested knowledge of the complainant's rights in the trade marks).

In the Panel's view, the above circumstances (including the Respondent very likely having knowledge of the Complainant's mark) indicate that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain or other such purposes inhering to the Respondent's benefit, by creating a likelihood of confusion with the Complainant and its trademarks.

In any event, the Panel finds that the Disputed Domain Name being identical to the textual components of the Complainant's CAFFÈ BORBONE mark makes it difficult to conceive any plausible legitimate future use of it by the Respondent.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is shown that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 <caffèborbone.net> [xn--caffborbone-19a.net] be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: January 10, 2023