

## **ADMINISTRATIVE PANEL DECISION**

**Caffè Borbone S.r.l. v. Oscar Broghammer, Mobiletrade AG**  
**Case No. D2023-2798**

### **1. The Parties**

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

The Respondent is Oscar Broghammer, Mobiletrade AG, Switzerland.

### **2. The Domain Name and Registrar**

The disputed domain name <borbonemarketing.agency> 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 June 30, 2023. On June 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 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, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 2023, 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 July 7, 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 the Respondent of the Complaint, and the proceedings commenced on July 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on August 24, 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

The Complainant is an Italian coffee company founded in 1996. It produces and distributes coffee – as capsules, coffee beans and ground coffee – and related goods and services under the CAFFÈ BORBONE brand.

The Complainant is the owner of trademark registrations worldwide consisting of or including the designation BORBONE and CAFFÈ BORBONE, *inter alia* the following:

- International (“IR”) trademark registration No. 902614 CAFFÈ BORBONE (with crown and coffee bean device) designating the European Union (“EU”) and Russia, filed and registered on January 11, 2006, for goods and services in Classes 9, 30, and 43;
- EU trademark registration No. 015670532 BORBONE (with crown device), filed on and registered on November 23, 2016, for goods and services in Classes 7, 11, 21, 30, 35, 37, 40, and 43;
- EU trademark registration No. 015670541 CAFFÈ BORBONE (with crown and coffee bean device), filed on and registered on November 23, 2016, for goods and services in Classes 7, 11, 21, 30, 35, 37, 40, and 43;
- United States of America (“US”) trademark registration No. 1359499 CAFFÈ BORBONE (with Crown and coffee bean device), filed on and registered on May 30, 2017, for goods and services in Classes 11, 30, and 43.

In addition, the Complainant owns domain names including the designations BORBONE, CAFFÈ BORBONE or CAFFÈ BORBONE, including the domain name <caffeborbone.com>, which resolves to the Complainant’s official website.

The disputed domain name was registered on March 31, 2022. It is currently inactive resolving to a Tumblr page without content. Previously, it had been redirected to websites displaying pay-per-click (“PPC”) links to competing products.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant holds that the disputed domain name is confusingly similar to the CAFFÈ BORBONE and BORBONE trademarks, in which it claims rights. The disputed domain name fully reproduces the Complainant’s trademark BORBONE and the distinctive component of its company name and trademarks CAFFÈ BORBONE. The presence of the word “marketing”, according to the Complainant, merely emphasizes the word “BORBONE” as the only distinctive element, whereas the generic Top-Level Domain (“gTLD”) “.agency” – being a necessary part of a domain name – must be disregarded in the comparison.

The Complainant argues that the Respondent is not known by the disputed domain name. It has not authorized or otherwise permitted the Respondent to register or use the disputed domain name. The Complainant points to a search result according to which – except for one-third party – no one except the Complainant owns trademarks in CAFFÈ BORBONE, CAFFÈ BORBONE, BORBONE MARKETING or BORBONEMARKETING. The Complainant also notes that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name: Besides having been passively held, the disputed domain name had been used in the past to resolve to a landing page for PPC links and to redirect to websites advertising competing products. This, so the Complainant claims, is a commercial misappropriation that is not accidental, as its trademarks are well known due to the fact that, according to the Complainant, it is one of the most important Italian companies in the coffee industry and a leader in the Italian coffee market due to substantial turnover, having won numerous prizes and awards for its products. The Complainant

concludes that these circumstances do not confer any rights or legitimate interests to the Respondent in respect of the disputed domain name.

Finally, on registration in bad faith, the Complainant holds that at the time of registration of the disputed domain name its business had been well established through many years of use. Also, in addition to being neither common nor descriptive terms, the trademarks BORBONE and CAFFÈ BORBONE had achieved a reputation before that. Thus, the Complainant considers it clear that the Respondent knew or should have known of the Complainant's trademarks before registration of the disputed domain name. By merely adding the word "marketing" to the trademark BORBONE, the Respondent even emphasized the likelihood of confusion, as this is a general term for promoting or selling products. On use in bad faith, even when looking at the presently inactive use this constitutes use in bad faith according to the prevailing UDRP panel's view, as the trademarks of the Complainant were reputed, the Respondent did not submit a response and concealed its identity, and it was inconceivable that the disputed domain name could be put to any legitimate use. In addition, the Complainant claims that the Respondent, through past active use of the disputed domain name for landing pages with PPC links that redirected to competitive products, had been unfairly and intentionally taking advantage of and exploiting the reputation of the Complainant's trademarks to attract Internet users to those websites.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the UDRP, the Complainant must cumulatively establish and prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

On the first element, pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must demonstrate that the disputed domain names are (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

On the basis of the evidence presented, it is established that the Complainant owns several trademarks for CAFFÈ BORBONE or BORBONE, respectively, being the only word element.

It is well-accepted that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7). Where the trademark is recognizable within the disputed domain name, the addition of other terms – whether descriptive, geographical, pejorative, meaningless, or otherwise – would not prevent a finding of confusing similarity under the first element ([WIPO Overview 3.0](#), section 1.8; and *LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com*, WIPO Case No. [D2011-1290](#)).

Furthermore, it is generally maintained that the addition of a gTLD is a standard registration requirement. Therefore, the gTLD ".agency" may be disregarded when assessing the confusing similarity between the disputed domain name and the Complainant's trademarks ([WIPO Overview 3.0](#), section 1.11.1).

Against this backdrop, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks. It fully reproduces the BORBONE trademark and, respectively, the distinctive component of the Complainant's CAFFÈ BORBONE trademarks.

The addition of the word "marketing" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks (see also *Allianz SE v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Fernando Flores*, WIPO Case No. [D2021-1956](#)). Again, the word "marketing" even links to the commercial activity of the Complainant and thereby reinforces the impression that the disputed domain name is associated with the Complainant. (*Prada S.A. v. Whois Privacy, Private by Design, LLC / Eric Hanson*, WIPO Case No. [D2021-4420](#); and *Notch Up v. Lori Fulbright, Fulbright LTD*, WIPO Case No. [D2021-3220](#)).

For the above reasons, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and hence the first condition of paragraph 4(a) of the UDRP has been fulfilled.

## **B. Rights or Legitimate Interests**

On the second element, pursuant to paragraph 4(c) of the UDRP, evidence of the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) may be established, in particular, by any of the following circumstances:

- (i) prior to becoming aware of the dispute, the Respondent has used the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services, or made serious preparations to do so;
- (ii) the Respondent is known by the disputed domain names in question, even without having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain names without intent to divert consumers for profit by creating confusion or to tarnish the trademark or service mark at issue.

Where the Complainant establishes *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production on this element is on the Respondent and it is up to the Respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent does not provide such relevant evidence, the Complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

The Panel finds that the Complainant has established such *prima facie* case. According to the evidence produced by the Complainant, the Respondent does not hold any trademark rights containing the element "borbone", nor is there any other evidence that the Respondent is commonly known by the disputed domain name. The Complainant has not authorized or otherwise permitted the Respondent to use its trademarks within the disputed domain name.

The Panel also holds that the Respondent has no actual intention to use the disputed domain names for a legitimate noncommercial or fair use. Currently, the disputed domain name merely resolves to an empty Tumblr websites. Before, as the Complainant has demonstrated on record, the disputed domain name resolved to PPC websites advertising links to products of the Complainant's competitors. None of that constitutes a legitimate use.

For the same reasons, the Panel is also unable to find any evidence that the Respondent was or intends to use the disputed domain names in connection with a *bona fide* offering of goods or services. The use of a domain name to host a landing page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users ([WIPO Overview 3.0](#), section 2.9).

For the above reasons, the Panel concludes that the Complainant has provided sufficient evidence to hold that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

On the third element, pursuant to paragraph 4(a)(iii) of the UDRP, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

As to registration in bad faith, the Panel notes that the disputed domain name was registered several years after the Complainant's trademarks, and accepts that it was chosen by reference to them. The Panel holds the BORBONE and CAFFÈ BORBONE trademarks to be sufficiently distinctive to assume that it is inconceivable that the disputed domain name with its specific addition could have been chosen and registered without actual knowledge of the Complainant's trademarks. Whether or not the materials produced by the Complainant suffice to assume that they are in fact well known, as the Complainant puts forth and has been assumed by another UDRP panel (*Caffè Borbone S.r.l. v. Beats, Beats / KAI*, WIPO Case No. [D2022-0824](#)) does not need to be decided here. A quick Internet search conducted by the Panel shows that the top search results returned for the search term "borbone" lead to the Complainant's website or third-party websites providing information about the Complainant's coffee business and products. Accordingly, constructive knowledge by the Respondent of the Complainant's trademarks may be assumed. As the disputed domain name previously also resolved to websites advertising links to coffee-related products similar to those of the Complainant, it is not conceivable that the Respondent has registered the disputed domain name completely unaware of the Complainant's trademarks. As a result, and in the absence of evidence from the Respondent that the similarity of the disputed domain name to the trademarks is coincidental or permitted, the Panel must conclude that the Respondent knew of the Complainant's rights when it registered the disputed domain name.

As to use in bad faith, according to paragraph 4(b) of the Policy, the following circumstance shall be evidence of the registration and use in bad faith: (iv) by using the domain name, to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion the complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website or location of a products or service on his website or location. Given the evidence produced by the Complainant by screenshots of the PPC websites with links to competitive coffee products, the Panel finds this circumstance to be met. The redirection of the disputed domain name to a parking page with PPC commercial links, obviously leading to revenues of the Respondent, is conclusive of the Respondent's use of the disputed domain name in bad faith. By this means, the Respondent attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks ([WIPO Overview 3.0](#), sections 3.1.4 and 3.5).

Against this backdrop, the fact that at present the disputed domain name is inactive does not prevent a finding of confusing similarity. Additional circumstances in support of this finding include (i) the degree of distinctiveness of the Complainant's mark; (ii) the failure of the Respondent to submit a response; (iii) the Respondent's concealing its identity, and – in the absence of plausible reasons put forth by the Respondent; (iv) the implausibility of any good faith use to which the misleading disputed domain name may be put ([WIPO Overview 3.0](#), section 3.3).

For these reasons, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith. Accordingly, the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the UDRP and 15 of the Rules, the Panel orders that the disputed domain name <borbonemarketing.agency> be transferred to the Complainant.

*/Andrea Jaeger-Lenz/*

**Andrea Jaeger-Lenz**

Sole Panelist

Date: September 5, 2023