

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Beats, Beats / KAI  
Case No. D2022-0824

### **1. The Parties**

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

The Respondent is Beats, Beats, Republic of Korea / KAI, Republic of Korea.

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

The disputed domain name <borbone.com> is registered with Megazone Corp., dba HOSTING.KR (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2022. On March 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 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 amended Complaint on March 18, 2022.

On March 15, 2022, the Center notified the Parties in both English and Korean that the language of the registration agreement for the disputed domain name is Korean. On March 18, 2022, the Complainant requested for English to be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 April 1, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was April 21, 2022. The Response was filed with the Center on April 22, 2022.

The Center appointed Andrew J. Park as the sole panelist in this matter on May 4, 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 coffee manufacturing company. It was founded in 1996 in Naples, Italy, and is now one of the leading Italian coffee makers. The Complainant produces Caffè Borbone products, namely, capsule, coffee beans, and ground coffee with high quality and careful choice of raw materials which are distributed and appreciated all over the world. The Complainant has been recognized as a primary Italian player in the portioned coffee sector by winning prizes in the Absolute Winner category and in the “Growth and Sustainability” category. The Complainant has achieved unparalleled progression in performance in recent years, establishing itself as an important brand and positioning itself for further growth in the future.

The Complainant is the owner of the trademarks CAFFÈ BORBONE and BORBONE, which are used in Italy and in many other countries throughout the world, for goods and services related to coffee, such as coffee products, coffee roasters, bar services, and cafés. Also, the Complainant owns many domain names reflecting the trademark CAFFÈ BORBONE.

Countries/ Jurisdictions	Trademark	Registration No.	Application Date	Registration Date	Classes
Italy	CAFFÈ BORBONE	0000895990	January 19, 2000	June 9, 2003	9, 30, 42
European Union	BORBONE	15670532	July 18, 2016	November 23, 2016	7, 11, 21, 30, 35, 37, 40, 43
United States of America	CAFFÈ BORBONE	4356426	April 12, 2012	June 25, 2013	7, 30, 43
International	CAFFÈ BORBONE	1359499		May 30, 2017	11, 30, 43

The disputed domain name <borbone.com> was registered on August 19, 2013.

The Complaint was filed in English on March 9, 2022 and on March 18, 2022, the Complainant requested for English to be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Respondent acquired the disputed domain name from the previous owner on March 1, 2022. The Response was filed with the Center on April 22, 2022.

## 5. Parties' Contentions

### A. Complainant

1. The Complainant, following the filing of the Complaint with the Center, requested that the language of proceedings be English, providing the following reasons:

- (a) The disputed domain name includes Latin letters rather than Korean script.
- (b) The website to which the disputed domain name resolves contained links and content that were in Italian and English, and now it contains content in English and Korean. The Respondent has shown to be perfectly able to communicate and defend himself in English.
- (c) The fact that the Respondent used services rendered by Sedo.com LLC, a domain name marketplace and domain parking provider which was founded in Germany in 2001, and which is headquartered in Cologne, Germany with an office in Cambridge, Massachusetts, demonstrates that the Respondent is familiar with English and uses this language to conduct its commercial affairs.
- (d) The choice of English as the language of the present proceeding is fair to both parties and is not prejudicial to either one of the parties in its ability to articulate the arguments for this case.

2. The Complainant contends that the disputed domain name should be transferred to the Complainant for the following reasons.

(a) the disputed domain name is identical and confusingly similar to the Complainant's trademark CAFFÈ BORBONE in which the Complainant has rights. The disputed domain name incorporates the distinctive component of the Complainant's trademark CAFFÈ BORBONE in its entirety, considering that CAFFÈ is a dictionary term for the goods and services that the trademarks distinguish and is also universally known for such goods as well as a word which is similar to the terms 'coffee,' 'café,' and 'kaffee.'

Thus, when confronted with the disputed domain name, Internet users or consumers will inevitably focus their attention on the term BORBONE and immediately associate the disputed domain name with the Complainant's trademark CAFFÈ BORBONE. The ".com", a Top-Level extension in the disputed domain name, does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name.

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant contends that the Complainant has neither authorized, nor somehow given its consent to the Respondent to register and/or use the disputed domain name. The Complainant also insists that the Respondent is not a *bona fide* provider of goods or services under the disputed domain name and is not making any legitimate noncommercial or fair use of the Complainant's trademark. Also, the Respondent is not commonly known by the disputed domain name and does not currently utilize the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith by the Respondent.

i) The Complainant contends that the Respondent was well-acquainted with the Complainant's trademark CAFFÈ BORBONE when the Respondent registered the disputed domain name on August 19, 2013. At the time of registration of the disputed domain name by the Respondent, the Complainant's business with the trademarks CAFFÈ BORBONE was well established and therefore, considering the reputation of the Complainant's trademarks CAFFÈ BORBONE, it is clear that the Respondent "knew or should have known" about the existence of the complainant's existing trademark CAFFÈ BORBONE. Moreover, the disputed domain name was registered long after the trademark CAFFÈ BORBONE had been used in commerce and registered in different jurisdictions.

ii) The disputed domain name resolved to a parking page on which various pay-per-click links were displayed. These links were all related to coffee products competitive with the Complainant's products and therefore a clear indication of bad faith. The purpose of the Respondent in registering the disputed domain name was to mislead, confuse and divert consumers or to tarnish the well-known CAFFÈ BORBONE trademark. However, immediately after the Complaint was filed by the Complainant and, specifically, on March 10, 2022, the page to which the disputed domain name resolves was updated and now leads to a page on which, in addition to the English words "Coming Soon," a paragraph in Korean about the history of the royal family Bourbon. The sudden change in the content of the page is indicative of the Respondent's desire to conceal its responsibility in having actually operated in violation of the prior rights of the Complainant.

iii) The disputed domain name was also on sale with a bid of USD 900 (according to a screen print dated March 17, 2022).

(d) The Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the Complainant's trademark, CAFFÈ BORBONE to attract Internet users to the websites related to the disputed domain name creating a likelihood of confusion with the Complainant's trademarks CAFFÈ BORBONE and company name as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites.

## **B. Respondent**

(a) The Respondent has legitimately acquired the disputed domain name from the previous owner. The Complainant is making a claim that has nothing to do with the current owner, the Respondent, without distinguishing between the existing owner and the current owner. The current Respondent is in contact with Sedo company to not post domain sales.

(b) The Respondent is a student studying French. The etymology of Bourbon originated from the Celtic word, Borvo, and from Robert de France, Count of Clermont who was the son of Louis IX. A new website will soon be created with the content of the history of the royal family Bourbon. The disputed domain name will be introducing the history of Bourbon family.

(c) Currently, the Complainant cannot assert that the Respondent's right to use is unfair. The Respondent signed a legitimate contract with the previous owner of the disputed domain name on March 1, 2022, and received the transfer of the ownership of the disputed domain name in mid-March.

## **6. Discussion and Findings**

### **A. Language of Proceeding**

The registration agreement for the disputed domain name is in Korean. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the parties, or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, *i.e.*, Korean.

Having considered the circumstances of the case, the Panel decides that English be adopted as the language of the proceeding under paragraphs 10 and 11(a) of the Rules. In coming to this decision, the Panel has taken the following into account:

1) The Complaint has been submitted in English and it would cause undue delay and expense if the Complainant was required to translate the Complaint and other documents into Korean;

2) The Panel is proficient in both English and Korean, capable of reviewing all the documents and materials in both languages and giving full consideration to the Parties' respective arguments;

3) The Respondent submitted the response in Korean. However, from the content of the response, it was clear that the Respondent was able to understand the Complaint fully and to defend himself in English. Therefore, English would be a fair language for both Parties.

In light of these circumstances, the Panel concludes that it will (1) accept the Complaint in English; (2) consider any relevant materials in English and Korean; and (3) issue a decision in English.

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

This element consists of two parts; first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the trademark, and that the disputed domain name is confusingly similar to the Complainant's CAFFÈ BORBONE trademark. The disputed domain name incorporates the Complainant's trademark in its entirety. The omission of the word "CAFFÈ" does not prevent a finding of confusing similarity as the main component, BORBONE remains clearly recognizable. Further, the addition of the generic Top-Level Domain ("gTLD") extension ".com" may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#)).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

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

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1.

Here, the Panel finds that the Complainant has made out a *prima facie* case.

The Respondent mentioned that it legitimately acquired the disputed domain name from the previous owner and is preparing to create a website with the disputed domain name that contains the history of the French royal Bourbon Family. However, the Respondent's argument is not credible, and it fails, in the Panel's view, to carry the burden of demonstrating its rights or legitimate interest in the disputed domain name.

The Panel finds no evidence of record to show that the Respondent has an actual intention to use the disputed domain name since it acquired the disputed domain name on March 1, 2022. Indeed, there is nothing in the record to show that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name. Also, there is no evidence that the Respondent has an intention to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent's mere assertion, particularly noting the differences between the composition of the disputed domain name <borbone.com> and the "Bourbon" term in the Respondent's explanation, is not sufficient to give rise to rights or legitimate interests in the disputed domain name. Thus, the Panel is unable to find any reasonable basis upon which the Respondent could be said to have any rights or legitimate interests in respect of the disputed domain name.

Accordingly, the Panel holds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent violated the Policy, paragraph 4(b)(i) and (iv).

The Complainant claims that the Respondent registered the disputed a domain name which is confusingly similar to the Complainant's trademark, CAFFÈ BORBONE, with the knowledge of the Complainant, its trademark and its world-wide famous coffee products. The Panel finds that the Complainant created its own trademark CAFFÈ BORBONE which is sufficiently qualified as the identification for the Complainant and its business activities. The Complainant registered its trademark in 2003, approximately 10 years prior to the original registration date of the disputed domain name. Further, this Panel notes that since the registration date of the disputed domain name by the previous owner, and since the Complainant registered its trademark CAFFÈ BORBONE, the Complainant has achieved significant growth in the coffee business industry for more than 20 years. The Complainant's trademark has become a relevant trademark in the coffee industry worldwide. These facts clearly show that the Respondent probably had knowledge of the Complainant's trademark and worldwide business reputation when it acquired the disputed domain name from the previous owner, and that it attempted to take unfair advantage of the similarity between the disputed domain name and the Complainant's trademark. Thus, it is reasonable to conclude that the Respondent acquired the disputed domain name in bad faith with knowledge of the Complainant's trademark and its business.

The Panel notes that according to a dated screen shot provided by the Complainant, on March 8, 2022 the disputed domain name resolved to a webpage that displayed pay-per-click links related to the Complainant's products. The Panel also notes that according to the Response, while the Respondent acquired the disputed domain name on March 1, 2022, its ownership was not transferred until middle March. The website to which the disputed domain name resolved has been inactive apparently after the submission of the Complaint, and there is no evidence whatsoever that the Respondent is currently using or is commonly known by, has used or has been commonly known under, or has a *bona fide* intent to use the disputed domain name. It may be that the Respondent did not have control over the webpage displaying pay-per-click links at the time of the submission of the Complaint, and that the Respondent may have changed its content once the Respondent gained control over the disputed domain name. However, the Complainant's reputation, and/or the fact that the website at the disputed domain name was displaying PPC links connected to the Complainant at the time of the acquisition by the Respondent, leads the Panel to find it more probable than not that the Respondent

was aware of the Complainant's dominant element "BORBONE" in one way or another. The Panel also finds that the Respondent's explanation for the acquisition of the disputed domain name sounds hollow, noting the contraposition between the Respondent's unsupported explanation and the composition of the disputed domain name.

In addition, despite the Respondent's claim that it had not sought to sell the disputed domain name in its response, and that the Respondent is in contact with Sedo to remove the offer for sale, the Panel also notes that the disputed domain name is being offered for sale with a minimum bid of USD 900. The Complainant provided evidence dated March 17, 2022 that the disputed domain name was being offered for sale (that would be after the Respondent's acquisition of the disputed domain name), and the Panel in the exercise of his powers has corroborated at Sedo's website that the disputed domain name is still being offered for sale.

Accordingly, the evidence shows that the Respondent likely knew of and had sought to take unfair advantage of the similarity between the disputed domain name and the Complainant's trademarks and to prevent the Complainant from reflecting the mark in a corresponding domain name probably in order to resell the disputed domain name to the Complainant or to its competitors for commercial gain.

The fact that the disputed domain name is currently leading to a "coming soon" page does not prevent a finding of bad faith.

The Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy, paragraph 4(a)(iii).

## **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 <borbone.com> be transferred to the Complainant.

*/Andrew J. Park/*

**Andrew J. Park**

Sole Panelist

Date: May 18, 2022