

## **ADMINISTRATIVE PANEL DECISION**

**Caffè Borbone S.r.l. v. Premium Domain Seller**  
**Case No. D2023-0492**

### **1. The Parties**

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

The Respondent is Premium Domain Seller, China.

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

The disputed domain name <caffeborbone.xyz> (the “Domain Name”) is registered with Sav.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2023. On February 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name differed from the named Respondent (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 6, 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 February 6, 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 February 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Jonas Gulliksson as the sole panelist in this matter on March 15, 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 company engaged in the coffee industry. The company was founded in 1996 in Naples, Italy.

The Complainant is the proprietor *i.a.* of the following trademark and service mark registrations for CAFFÈ BORBONE:

- European Union trademark registration No. 015670541 (figurative), registered November 23, 2016;
- International Trademark registration No. 902614 (figurative), designating the European Union and Russian Federation, registered January 11, 2006;
- Italian trademark registration No. 0000895990 (figurative), registered June 9, 2003;
- Italian trademark registration No. 362019000144424 (figurative), registered February 28, 2020; and
- United States of America trademark and service mark registration No. 4356426 (figurative), registered June 25, 2013.

The Domain Name was registered March 29, 2022, and resolves to a domain name for sale parking page.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts, substantially, the following:

The Domain Name is identical to a trademark or service mark in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent was not known and could not be known by the Domain Name. Further, the Respondent has no trademark rights to a sign that corresponds to the Domain Name and the Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the Domain Name.

The Domain Name was registered and is being used in bad faith. At the time of registration by the Respondent of the Domain Name, the Complainant's business and its CAFFÈ BORBONE mark was well established. Therefore, considering the reputation of the Complainant's CAFFÈ BORBONE mark before the registration of the Domain Name, it is clear that the Respondent knew or should have known about the existence of the Complainant's earlier CAFFÈ BORBONE mark. The Domain Name exploits the reputation of the Complainant's CAFFÈ BORBONE mark.

The Domain Name is on sale for USD 1,450 which is a very high amount compared to the normal cost for a domain name. Therefore, the Domain Name, containing the Complainant's distinctive mark, has been offered to a price in excess of out-of-pocket costs relating to the Domain Name, which is an indication of bad faith.

Further, the Respondent also appears to be the owner of other domain name registrations related to well-known names such as Carbon Capital, NetWolf and Stepn. The Respondent also seems to be the losing

party in the domain name dispute *Elecnor, S.A. v. Privacy Protection / Premium Domain Seller*, WIPO Case No. [D2022-1534](#).

## **B. Respondent**

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

## **6. Discussion and Findings**

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

- (i) that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

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

The Complainant has established that it holds trademark and service mark rights in relation to CAFFÈ BORBONE.

The Domain Name is close to identical to the Complainant's CAFFÈ BORBONE mark, with the difference of the apostrophe over the first "e" in the Complainant's mark, the spacing between "CAFFÈ" and "BORBONE" and the addition of the generic Top-Level Domain ("gTLD") ".xyz" in the Domain Name. It is well established that gTLDs, typically are disregarded in the assessment of confusing similarity, see the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1.

Accordingly, the Panel finds that that the Domain Name is confusingly similar to a trademark and service mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

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

Under paragraph 4(a)(ii) of the Policy, a complainant must first make out a *prima facie* case showing that the respondent lacks rights or legitimate interests in respect of a disputed domain name and then the burden, in effect, shifts to the respondent to come forward with evidence of its rights or legitimate interests, if the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see [WIPO Overview 3.0](#), section 2.1).

Considering the evidence presented in the case, and the Complainant's un rebutted contentions that the Respondent has no rights or legitimate interests in the Domain Name, the Panel finds that the Complainant has made out an undisputed *prima facie* case. In addition, the Panel finds that the Domain Name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Considering the above, the Panel finds that the Complainant has established that the Respondent lacks rights or legitimate interests in the Domain Name, in accordance with paragraph 4(a)(ii) of the Policy.

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

Of the evidence presented in the case and the confusing similarity between the Domain Name and Complainant's CAFFÈ BORBONE mark, it is clear that the Respondent had the Complainant's mark in mind when registering the Domain Name. Evidence has also been presented regarding offering of the Domain

Name for a price that seems likely to be in excess of the out-of-pocket costs for the Domain Name. The Respondent has not provided any evidence of good faith use.

Considering the above, the Panel finds that the Domain Name was registered and is being used in bad faith.

## **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 Domain Name <caffeborbone.xyz> be transferred to the Complainant.

*/Jonas Gulliksson/*

**Jonas Gulliksson**

Sole Panelist

Date: March 29, 2023