

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Firat Taskara, D Management Group GmbH  
Case No. D2023-0557

### **1. The Parties**

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

Respondent is Firat Taskara, D Management Group GmbH, Switzerland.

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

The disputed domain name <kafiborbone.com> is registered with Ascio Technologies Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on February 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 13, 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 Respondent of the Complaint, and the proceedings commenced on February 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 7, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on March 13, 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

Complainant is a company organized under the laws of Italy that is active in the coffee industry.

Complainant has provided evidence that it is the registered owner of numerous trademarks relating to its company name and brand CAFFÈ BORBONE, *inter alia*, but not limited to the following:

- Word/design mark CAFFÈ BORBONE, International trademark registration, registration number: 902614, registration date: January 11, 2006, status: active;
- word/design mark CAFFÈ BORBONE, European Union trademark registration, registration number: 015670541, registration date: November 23, 2016, status: active;
- word/design mark BORBONE, European Union trademark registration, registration number: 015670532, registration date: November 23, 2016, status: active.

Moreover, Complainant has demonstrated to own numerous domain names relating to its CAFFÈ BORBONE and BORBONE trademarks, *inter alia*, the domain name <caffeborbone.com>, which resolves to Complainant's main website at "www.caffeborbone.com", promoting Complainant's coffee products, coffee machines and related services.

Respondent, according to the disclosed Whois information for the disputed domain name, is located in Switzerland and registered the disputed domain name on June 4, 2022. By the time of rendering this decision, the disputed domain name resolves to a website at "www.kafiborbone.com" with the content of a typical parking website set up by a hosting provider, indicating that the disputed domain name has just been acquired.

Complainant requests that the disputed domain name be transferred to Complainant.

#### 5. Parties' Contentions

##### A. Complainant

Complainant contends to be one of the most important companies and a market leader in the Italian coffee industry, with roots going back to 1996 and owing its name to the famous Royal family and to Charles III of Bourbon. Due to intensive use of the CAFFÈ BORBONE and BORBONE trademarks ever since, they have meanwhile received reputation in Italy and abroad.

Complainant submits that the disputed domain name is identical to Complainant's CAFFÈ BORBONE and BORBONE trademarks as it reproduces the latter almost entirely, differing only in the first word element "Kafi", being the term for "coffee" (English) and "caffè" (Italian) in a Chadic language spoken by Hausa people in various African countries. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Complainant has neither ever authorized nor somehow given its consent to Respondent to register and/or use the disputed domain name, and (2) respective trademark database searches show no trademark results registered in the name of Respondent, who apparently is not known and could not be known by the disputed domain name which clearly refers to Complainant's CAFFÈ BORBONE and BORBONE trademarks. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) the disputed domain name reproduces, without authorization or approval, Complainant's well reputed CAFFÈ BORBONE and BORBONE trademarks, and (2) given that Complainant's trademarks are distinctive and well-established and in the absence of any conceivable good faith use to which the disputed domain name could be put, the passive holding of the disputed domain name must be considered bad faith use.

## B. Respondent

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

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

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

### A. Identical or Confusingly Similar

The Panel concludes that the disputed domain name <kafiborbone.com> is at least confusingly similar to the CAFFÈ BORBONE and BORBONE trademarks in which Complainant has rights.

The disputed domain name incorporates the entirety of Complainant's BORBONE trademark and a distinctive part of Complainant's CAFFÈ BORBONE trademark. Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, 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 trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7). Moreover, it has been held in many UDRP decisions and has become a consensus view among panelists (see [WIPO Overview 3.0](#), section 1.8), that the addition of other terms (whether e.g. descriptive or otherwise) would not prevent the finding of confusing similarity under the first element of the UDRP. Accordingly, the addition of the descriptive term "kafi" (being the term for "coffee" (English) and "caffè" (Italian) in a Chadic language spoken by Hausa people in various African countries) does not prevent to find confusing similarity arising from the incorporation of Complainant's entire BORBONE trademark and a distinctive part of Complainant's CAFFÈ BORBONE trademark in the disputed domain name.

Therefore, Complainant has established the first element under the Policy set forth by paragraph 4(a)(i).

### B. Rights or Legitimate Interests

The Panel is further convinced on the basis of Complainant's undisputed contentions that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain name nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent obviously has not been authorized to use Complainant's CAFFÈ BORBONE and/or BORBONE trademarks, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the terms "caffè" and "borbone" on its own. Finally, Respondent so far obviously has neither used the disputed domain name for a *bona fide* offering of goods or

services nor for a legitimate noncommercial or fair purpose, but rather passively held it instead. UDRP panels, however, have found that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, does not by itself automatically confer rights or legitimate interests therein (see [WIPO Overview 3.0](#), section 2.10.1).

Accordingly, Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in respect of the disputed domain name. Having done so, the burden of production shifts to Respondent to come forward with appropriate evidence demonstrating such rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.1). Given that Respondent has defaulted, it has not met that burden.

Therefore, the Panel finds that Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

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

The Panel finally holds that the disputed domain name was registered and is being used by Respondent in bad faith.

As a general rule, UDRP panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding (see [WIPO Overview 3.0](#), section 3.3). While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include *e.g.*: the degree of distinctiveness or reputation of Complainant’s mark, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, or the implausibility of any good faith use to which the domain name may be put.

Complainant contends, and Respondent has not challenged this contention, that its CAFFÈ BORBONE and BORBONE trademarks are well reputed in Italy and abroad. Moreover, the disputed domain name contains a direct translation of the Italian term “caffè” which is reflected in Complainant’s CAFFÈ BORBONE trademark together with the term “borbone” which is a distinctive part of both of Complainant’s trademarks. Against this background, it is unlikely that Respondent was not aware of Complainant’s CAFFÈ BORBONE and BORBONE trademarks by the time of the registration of the disputed domain name. Finally, Respondent has failed to submit any explanation as to why it needed to rely exactly on the terms “kafi” and “borbone” when it registered the disputed domain name. Accordingly, there is no room for any plausible use of the disputed domain name which would not take unfair advantage by profiting from the undisputed reputation which Complainant’s CAFFÈ BORBONE and BORBONE trademarks enjoy in Italy and abroad. Therefore, the passive holding of the disputed domain name by Respondent is not in contrast to hold that Respondent has registered and is using the disputed domain name in bad faith within the larger meaning of paragraph 4(b) of the Policy.

Accordingly, the Panel concludes that Complainant has also satisfied the third element under the Policy as set forth by 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 <kafiborbone.com> be transferred to Complainant.

*/Stephanie G. Hartung/*

**Stephanie G. Hartung**

Sole Panelist

Date: March 27, 2023