

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Manlidy, GNN
Case No. D2023-1095

1. The Parties

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

The Respondent is Manlidy, GNN, Singapore.

2. The Domain Name and Registrar

The disputed domain name <cialdeborbone.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 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 the Complainant on March 14, 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 also on March 14, 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 March 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 5, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on April 17, 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

It results from the Complainant's undisputed allegations that the Complainant is one of the most important Italian companies in the coffee industry, producing every day around 96 tons of processed coffee in its Italian factories. Founded in 1996 in Naples, it owes its name to the famous royal family and to Charles III of Bourbon.

The Complainant is the owner of an international trademark portfolio consisting of or containing the term BORBONE. In particular, the Complaint is based on *inter alia*, figurative European Union Trade Mark no. 15670532 registered on November 23, 2016 for goods and services in classes 7, 11, 21, 30, 35, 37, 40 and 43.

The disputed domain name was registered on October 21, 2022. No content is displayed on the website to which the disputed domain name resolves ("This side can't be reached").

5. Parties' Contentions

A. Complainant

Firstly, the Complainant points out that the disputed domain name is confusingly similar to the registered mark BORBONE, since it includes the BORBONE trademark to which has been added the term "cialde", that means "pods" in Italian language, and the generic Top-Level-Domain ("gTLD") ".com".

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainant submits that the disputed domain name is passively held and has not been used in connection with a *bona fide* offering of goods and services. Moreover, the Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name. In addition, the Respondent is not commonly known as "Cialdeborbone". Finally, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert the public or to tarnish the Complainant's BORBONE trademark.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. This passive holding of the disputed domain name constitutes bad faith. In addition, the Respondent has registered the disputed domain name to fully incorporate the Complainant's BORBONE trademark. Such misappropriation of the Complainant's BORBONE trademark creates a likelihood of confusion by suggesting to the public that the disputed domain name relates to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to said mark.

The Complainant is the registered owner of an international trademark portfolio consisting of or containing the term BORBONE, including, figurative European Union Trade Mark no. 15670532 registered on November 23, 2016.

The fact that the trademark is a figurative trademark, showing a stylized crown on the second letter “o”, is to be disregarded for purposes of assessing identity or confusing similarity under the first element. It is acknowledged amongst UDRP Panels that where design elements comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements (*i.e.*, the scope of protection afforded to the mark is effectively limited to its stylized elements), panels may find that the complainant’s trademark registration is insufficient by itself to support standing under the UDRP (*cf.* section 1.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). In the Panel’s view, this is not the case here for the above mentioned trademark.

Many UDRP panels have found that a domain name is confusingly similar to a complainant’s trademark for purposes of the first element where the relevant trademark is recognizable within the domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* [WIPO Overview 3.0](#), section 1.8). This Panel shares the same view and notes that the disputed domain name contains the Complainant’s registered trademark BORBONE in its entirety. The addition of the term “cialde” does not prevent a finding of confusing similarity between the Complainant’s trademark and the disputed domain name. The Panel is of the opinion that the trademark BORBONE remains recognizable within the disputed domain name.

Finally, the gTLD “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1).

Hence, this Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark BORBONE pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name. In the Panel's view, based on the unrebutted allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

No content is displayed on the website to which the disputed domain name resolves. Such use can neither be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name in the sense of paragraph 4(c)(i) and (iii) of the Policy (see, e.g. *CCA and B, LLC v. Domain Administrator, Fundación Privacy Services LTD*, WIPO Case No. [D2021-1531](#)). In addition, the Respondent's concealment of its identity behind a privacy service is also taken in consideration, and this Panel finds it most likely that the Respondent selected the disputed domain name with the intention to take advantage of the Complainant's registered trademark BORBONE and its reputation.

Finally, the Panel does not dispose of any elements that could lead the Panel to the conclusion that the Respondent is commonly known by the disputed domain name or that it has acquired trademark rights pursuant to paragraph 4(c)(ii) of the Policy.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence in this regard, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

According to the Complainant's undisputed allegations, the Respondent does not actively use the disputed domain name. With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, prior UDRP panels have found that the apparent lack of active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith under the doctrine of passive holding (see, e.g. *CCA and B, LLC v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-1531](#)). The Panel must therefore examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- (iv) the implausibility of any good faith use to which the domain name may be put (see [WIPO Overview 3.0](#), section 3.3).

In the case at hand, the Panel considers the following circumstances surrounding the registration as suggesting that the Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith:

(i) the distinctiveness of the trademark BORBONE which has existed since many years and which has no generic or descriptive meaning for the relevant goods and services;

(ii) the wording of the disputed domain name, combining the trademark BORBONE with the Italian term "cialde" referring to the coffee pods which indicate the Complainant's core business, *i.e.* coffee including coffee pods;

(iii) the Respondent concealing its identity and the use of false contact details and, subsequently, the fact that the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications; and

iv) the Respondent's failure to respond to the Complaint.

In addition, due to these circumstances this Panel concludes that the Respondent knew or should have known the trademark BORBONE when it registered the disputed domain name, and that there is no plausible legitimate active use that the Respondent could make of the disputed domain name.

In the light of the above, the Panel finds that the disputed domain name has been registered and used in bad faith. The Complainant is therefore deemed to also have satisfied the third element, paragraph 4(a)(iii) 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 <cialdeborbone.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: May 1, 2023