

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Philip Isberg, IsbergMedia AB  
Case No. D2023-2568

### **1. The Parties**

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

The Respondent is Philip Isberg, IsbergMedia AB, Sweden.

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

The disputed domain name <respresso.shop> (the “Domain Name”) 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 14, 2023. On June 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 16, 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 June 19, 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 June 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 12, 2023. The Respondent sent an email communication to the Center on July 10, 2023. Accordingly, the Center informed the Parties of its commencement of Panel appointment process on July 14, 2023.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on July 20, 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 to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant was founded in 1996, and it is considered one of the Italian coffee market leaders. It produces around 96 tons of processed coffee per day in its Italian factories, distributed all over the world. The Complainant has received different prizes for its products.

The Complainant owns trademark registrations in RESPRESSO in Italy and in other countries, for example Italian trademark registration number 0001577354 (registered on February 5, 2014) and International registration number 1637836 (registered on October 29, 2021), designating among others the European Union.

The Respondent registered the Domain Name on June 5, 2023. The Domain Name has resolved a website that purports to look for resellers of the Complainant's coffee capsules. The website has as only contact information an inactive email address. The website has a defunct section for tracking orders. At the time of drafting the Decision, the website purported to sell coffee capsules named "Ecocaps".

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

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

The Complainant provides evidence of trademark registrations and argues that the Domain Name wholly incorporates the Complainant's trademark, and this may be sufficient to establish confusing similarity.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent has not been commonly known by the Domain Name. The Complainant has neither authorized, nor given its consent to the Respondent to register or use the Domain Name. The Respondent's use of the Domain Name is not *bona fide*. It falsely suggests an affiliation with the Complainant.

The Complainant argues that the Respondent knew or should have known about the existence of the Complainant's trademark. The Respondent's use of the Domain Name cannot be considered a good faith use. There is no connection between the Respondent and the Complainant. The Complainant's trademark is not a common or descriptive term and it is reputed in Italy and abroad. On the balance of probabilities, the Domain Name was registered in bad faith in order to take advantage of the Complainant's reputation. The only contact information on the Respondent's website is an invalid e-mail address.

##### **B. Respondent**

The Respondent did not reply to the Complainant's contentions. In its email communication on July 10, 2023, the Respondent states "[w]e have never heard about your brand before. Our store Respresso.shop is not active as we have disabled the option to make payments on our site. But out of respect and as we have not officially launched yet, we can change our brand name even though our products are not similar."

#### **6. Discussion and Findings**

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

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Domain Name. See WIPO Overview of WIPO Panel Views on Selected

UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

The Complainant has established that it has rights in the trademark RESPRESSO. The Domain Name is identical to the Complainant’s trademark.

For the purpose of assessing the confusing similarity under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain (“gTLD”); see [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. 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.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name.

Based on the record, the Respondent is not affiliated or related to the Complainant. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired trademark rights. There is no evidence of the Respondent’s use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services. The use of the Domain Name is not *bona fide*, the Domain Name reproduces the Complainant’s trademark identically, and the Respondent was using it to sell coffee capsules (a product that the Complainant also commercializes under its RESPRESSO trademark). Even if considering that the Complainant’s products and the Respondent’s products are not similar (as the Respondent claims), both products are related to coffee, and noting the identity between the Complainant’s trademark and the Domain Name, the Domain Name could be easily confused by an Internet user as being connected to the Complainant. The Panel finds that such use of the Domain Name, noting its composition, cannot give rise to rights or legitimate interests for the Respondent.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Despite the Respondent’s contention that they never heard about the Complainant’s brand, the composition and use of the Domain Name makes it probable that the Respondent was aware of the Complainant and its prior rights when the Respondent registered the Domain Name. While the Respondent claimed to “have never heard about [the Complainant’s] brand before”, the Panel notes that the Respondent did not provide any reasonable explanation for its selection of the Domain Name. The Panel notes that both Parties operate within the same business sector, the broad presence of the Complainant’s brand, and the near

instantaneous and global reach of the Internet and search engines. In the circumstances of the case, the Panel is prepared to infer that the Respondent knew, or should have known, that its registration would be identical to the Complainant's trademark. See [WIPO Overview 3.0](#), section 3.2.2.

The use of the Domain Name is further evidence of bad faith in the circumstances of the case.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

The third element of the Policy has been established.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders the Domain Name, <respresso.shop>, be transferred to the Complainant.

*/Mathias Lilleengen/*

**Mathias Lilleengen**

Sole Panelist

Date: July 31, 2023