

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Fabio Salcina, Italissimi LLC
Case No. D2023-2624

1. The Parties

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

The Respondent is Fabio Salcina, Italissimi LLC, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name (the “Disputed Domain Name”) <buyborbone.com> 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 19, 2023. On June 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 20, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 22, 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 22, 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 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 20, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on August 2, 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 one of the most well-known Italian companies in the coffee industry. The Complainant was founded in 1996 in Naples and markets processed coffees and products related to coffee such as capsules, coffee beans and ground coffee in the entire world.

The Complainant is the owner of several registered trademarks (hereinafter the “BORBONE Trademarks”) including:

- the Italian figurative mark  No. 362019000144424, registered on February 28, 2020, and regularly renewed for products and services in classes 9, 30 and 42;
- the European Union figurative  mark No. 15670532, registered on November 23, 2016, for products and services in classes 7, 11, 21, 30, 35, 37, 40 and 43;
- the European Union figurative  mark No. 15670541, registered on November 23, 2016, for products and services in classes 7, 11, 21, 30, 35, 37, 40 and 43;
- the international figurative  mark No. 1359499, registered on May 30, 2017, for products and services in classes 11, 30 and 43;
- the United States figurative  mark No. 4356426, registered on June 25, 2013, for products and services in classes 7, 30 and 43; and
- the international figurative  mark No. 902614, registered on January 11, 2006, for products and services in classes 9, 30 and 43.

The Complainant is also the owner of several domain names incorporating part of the BORBONE Trademarks such as <caffee-borbone.eu> or <borbonepoint.it>.

The Disputed Domain Name was registered on February 17, 2022, and redirects to another website: “www.italissimi.com”. At the time of the decision, this website appears to be an e-commerce website where Internet users can buy the Complainant’s products and other similar products.

5. Parties’ Contentions

A. Complainant

First of all, the Complainant asserts that the Disputed Domain Name is almost identical to its earlier BORBONE Trademarks since it is composed of the BORBONE Trademarks to which has been added the generic term “buy” and the generic Top-Level Domain (“gTLD”) “.com”. The Complainant stands that the mere addition of the generic term “buy” only emphasize the link with the BORBONE Trademarks since they are the only distinctive component in the Disputed Domain Name. The Complainant explains that the fact that several of its BORBONE Trademarks include the term “caffè” is indifferent since this term, which means coffee in Italian, is purely descriptive of the Complainant’s products.

Then, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name since there is no evidence that the Respondent is known under the Disputed Domain Name. The Complainant stands that it has never authorized nor given its consent to the Respondent for registering the Disputed Domain Name. The Complainant considers that the Respondent has registered the Disputed Domain Name which incorporates the well-known BORBONE Trademarks to attract the Complainant’s current and potential customers. The Complainant asserts that the Respondent is using the Disputed Domain Name to derive commercial benefit from its reputation and the BORBONE Trademarks.

Lastly, the Complainant contends that the Disputed Domain Name was registered and is being used in bad faith. The Complainant asserts that when the Disputed Domain Name was registered its BORBONE Trademarks were long registered, and that the Complainant's business was well established. The Complainant considers that the Disputed Domain Name exploits the reputation of the BORBONE Trademarks and that the Complainant has tried to seek profit by registering the Disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has right;
- (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.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the BORBONE Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, 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 mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Regarding the Disputed Domain Name, the Panel finds that it is composed of:

- the BORBONE Trademarks;
- the word "buy"; and
- the gTLD ".com".

The applicable gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of descriptive or geographical terms to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it incorporates the BORBONE Trademarks in their entirety and considers that the insertion of the word “buy” before the BORBONE Trademarks does not prevent a finding of confusing similarity. Therefore, the Panel finds that these elements do not prevent the BORBONE Trademarks to be recognizable in the Disputed Domain Name.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute, 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; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, 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 *prima facie* 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 section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed, the Complainant has not licensed or otherwise authorized the Respondent to use the BORBONE Trademarks or to apply for any domain name incorporating the said trademarks.

Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, at the time of the Complaint, the Disputed Domain Name redirects to another website which appears to be an e-commerce website trying to pass off as someone affiliated to the Complainant by selling the Complainant’s products without any authorization.

In any case, the Respondent did not reply to the Complainant’s contentions, and consequently, did not rebut the Complainant’s *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's 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 to the complainant who is the owner of the trademark or service mark or to a competitor of that 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.

According to prior UDRP decisions, particular circumstances that panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), [...], (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name (see section 3.2.1 of the [WIPO Overview 3.0](#)).

First of all, the Panel finds that it is established that the BORBONE Trademarks were registered and used before the registration of the Disputed Domain Name and enjoy a well-known worldwide reputation. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it reproduces the Complainant's BORBONE Trademarks in their entirety.

Moreover, the Panel points out that the Disputed Domain Name redirects to another website which appears to be an e-commerce website, trying to pass off as someone affiliated to the Complainant and selling the Complainant's products without its authorization.

Accordingly, the Panel finds that the Complainant has provided evidence that the Disputed Domain Name was registered and used by the Respondent in an attempt to pass off as someone affiliated or licensed by the Complainant for commercial gain.

Finally, the Respondent has not provided any formal response to the Complainant's contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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 <buyborbone.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: August 9, 2023