

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. 吴清儒 (Wu Qing Ru)
Case No. D2023-3320

1. The Parties

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

The Respondent is 吴清儒 (Wu Qing Ru), China.

2. The Domain Name and Registrar

The disputed domain name <caffeborbone.info> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 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 August 4, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. On August 11, 2023, the Center sent an email in English and Chinese regarding the language of the proceeding. On August 16, 2023, the Complainant sent an email confirming the request for English to be the language of the proceeding.

The Center verified that the 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 in English and Chinese of the Complaint, and the proceedings commenced on August 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 15, 2023.

The Center appointed Andrew Sim as the sole panelist in this matter on October 5, 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 founded in Naples, Italy in 1996. It produces and distributes globally coffee products including capsule, coffee beans and ground coffee. There are a number of industry awards won by the Complainant with respect to its products and corporate performance.

The Complainant is the owner of the trademark CAFFÈ BORBONE (the “Mark”), with registrations in Italy and several other jurisdictions, including the following:

Mark	Jurisdictions	Registration Details
	International Registration designating the European Union, and the Russian Federation	No. 902614, in classes 9, 30 and 43, filed and registered on January 11, 2006.
	United States of America	No. 4356426, in classes 30 and 43, filed on April 12, 2012, and registered on June 25, 2013.
	European Union	No. 15670541, in classes 7, 11, 21, 30, 35, 37, 40 and 43, filed on July 18, 2016, and registered on November 23, 2016.

The Complainant also owns a number of domain names reflecting the Mark, including <caffeborbone.es>, registered on November 9, 2014, <caffè-borbone.eu>, registered on December 6, 2016 and <caffeborbone.shop>, registered on August 11, 2020. It also operates a main corporate website at “www.caffeborbone.com”, to which most of its domain names redirect.

The disputed domain name was registered on May 25, 2023. At the time of the Complaint and this decision, the disputed domain name redirects Internet users to a website where the disputed domain name is offered for sale and it is possible to “buy now” at the price of USD 950.

5. Parties’ Contentions

A. Complainant

The Complainant contends that (i) the disputed domain name is identical or confusingly similar to the 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 was registered and is being used in bad faith.

Firstly, the Complainant contends that the disputed domain name is identical or confusingly similar to the Mark in which the Complainant has rights because the disputed domain name entirely reproduces the Mark. The Complainant further submits that the Top-Level extension “.info” does not mitigate the confusion between the Mark and the disputed domain name created using the common element “caffeborbone”. As a result, when confronted with the disputed domain name, Internet users and consumers will associate it with the Complainant.

Secondly, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, as there is no trademark application or registration in the name of any party except the Complainant in respect of “Caffè Borbone” or “Caffe Borbone”, save for an Argentinian application which is currently under opposition procedure brought by the Complainant. The Complainant has also not been able to locate any such application or registration in the name of the Respondent. Further, the Complainant has not authorized or in any way consented to the Respondent’s registration and/or use of the disputed domain name.

Thirdly, the Complainant submits that the disputed domain name was registered and is being used in bad faith. As contended by the Complainant, because of the Complainant's intensive use of the Mark, the Complainant's business associated with the Mark has already been well established at the time of the registration of the disputed domain name, such that the Respondent "knew or should have known" about the existence of the Mark. There is no connection between the Respondent and the disputed domain name, which is not a common term but a distinctive sign representing the Complainant and the Complainant's business. The disputed domain name was registered without the Complainant's authorization, and was registered for the purpose of offering it for sale. The Complainant further contends the Respondent has registered other domain names encompassing third parties' trademarks. It follows that, as submitted, the disputed domain name was registered and is being used by the Respondent in bad faith, with knowledge of the Complainant's earlier rights, and for the purpose of exploiting the reputation of the Complainant and the Mark.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural Matter – Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administration proceeding. According to the information received from the Registrar, the language of the Registration Agreement of the disputed domain name is Chinese.

The Complainant submits that the proceeding should be conducted in English. The Complainant mainly contends that the Respondent is familiar with English as witnessed by the fact that the Respondent offers the disputed domain name for sale using the services rendered by Dan.com, an Internet domain registrar and web hosting company headquartered in Tempe, Arizona, United States of America. The Complainant believes that it would be unusual for one to entrust the sale of a domain to a foreign company operating in a language which it does not speak or know.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

The Panel accepts the Complainant's submissions regarding the language of the proceeding. The Complainant may be unduly disadvantaged by having to conduct the proceeding in Chinese. The Panel further notes that the Center has notified the Respondent in both Chinese and English of the language of the proceeding and commencement of the proceeding. The Respondent chose not to comment on the language of the proceeding nor respond to the Complaint in either English or Chinese. Having considered all relevant circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2 Substantive Matter – Three Elements

Under the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which it 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.

A. Identical or Confusingly Similar

The Complainant has established that it has registered trademark rights in the Mark.

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademarks and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the Mark to assess whether the Mark is recognizable within the disputed domain name. As the Complainant correctly points out, it is well known and established that generic Top-Level Domain ("gTLD"), such as ".com", ".info" and ".net", may be disregarded when assessing the confusing similarity between the disputed domain name and the Mark. Only the second-level portion of the disputed domain name is taken into consideration.

The Panel agrees with the Complainant's submissions. The disputed domain name almost entirely incorporates the Mark, and the Mark is clearly recognizable in the disputed domain name. The omission of the accent on the first letter "e" in the disputed domain name does not prevent a finding of confusing similarity. Further, the gTLD ".info" in the disputed domain name may be disregarded under the first element confusing similarity test as it is viewed as a standard registration requirement.

Having considered the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has confirmed that it has not licensed nor allowed the Respondent to use the Mark. The Respondent is also not known to be associated with the Mark, the Complainant or the Complainant's business. Moreover, there is no evidence showing that the Respondent has been commonly known by the disputed domain name in any manner.

Further, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. As submitted by the Complainant, and the Panel also observes, the disputed domain name directs Internet users to a platform where it is offered for sale and it is possible for a user to "buy now" at the price of USD 950. A number of cases before previous panels, e.g., *Hertz System, Inc. v. Super Privacy Service LTD c/o Dynadot / domain admin*, WIPO Case No. [D2021-3419](#), have established that such use cannot be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use, particularly where the disputed domain name in this case almost fully incorporates the Mark, and is being offered for sale for a price as high as USD 950.

The Panel considers that the Complainant has established a *prima facie* case in this regard, and accordingly, the burden of production on this element shifts to the Respondent. Since the Respondent failed to submit a response, the Panel concludes that the Respondent has no answer to the Complainant's allegations.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant that the Respondent was most likely aware of the Complainant's right in the Mark before or when the Respondent registered the disputed domain name.

The Complainant has had registered rights in the Mark since 2006, whereas the Respondent registered the disputed domain name in 2023. As submitted by the Complainant and also noted by the Panel above, the disputed domain name almost entirely incorporates the Mark. Since the Mark is not a generic or descriptive term, the Panel finds it more likely than not that the Respondent was aware of the Mark at the time the disputed domain name was registered. The Panel considers that the Respondent's likely awareness of the Complainant's rights in the Mark at the time of registration suggests bad faith. See e.g., *Accor, So Luxury HMC v. Youness Itsmail*, WIPO Case No. [D2015-0287](#).

In addition, as noted above, the disputed domain name directs Internet users to a platform where the disputed domain name is offered for sale for USD 950 and it is possible for a user to buy now at this price. The Panel agrees with the Complainant's submission that it is a considerably high price compared to the normal cost of registering a domain name. The Panel thus finds that it is more likely than not that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration 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 its out-of-pocket costs directly related to the disputed domain name, which indicates bad faith according to paragraph 4(b)(i) of the Policy.

Further, the Panel notes that the Respondent has been involved in other proceedings under the UDRP, in which the panels found the Respondent's bad faith in registering the domain names. See *Ostrum Asset Management v. 吴清儒 (wu qing ru)*, WIPO Case No. [D2023-1387](#), and *VIOOH Limited v. 吴清儒 (wu qing ru)*, WPO Case No. [D2023-2155](#). Therefore, the Panel finds that the Respondent has engaged in a pattern of bad faith conduct according to paragraph 4(b)(ii) of the Policy.

Having considered the circumstances above, the Panel believes that the Complainant has made out its case that the disputed 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 disputed domain name <caffeborbone.info> be transferred to the Complainant.

/Andrew Sim/

Andrew Sim

Sole Panelist

Date: October 19, 2023