

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Aldo Vincenzo Pecora  
Case No. D2023-3351

### **1. The Parties**

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

The Respondent is Aldo Vincenzo Pecora, Italy.

### **2. The Domain Names and Registrars**

The disputed domain name <espressoborbone.com> is registered with Register SPA.

The disputed domain name <espressoborbone.shop> is registered with eNom, LLC (the “Registrars”).

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 3, 2023. On August 4, 2023, the Center transmitted by email to the Registrars requests for registrar verification in connection with the disputed domain names. On August 4, and August 7, 2023, the Registrars transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 15, 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 in English on August 17, 2023.

On August 15, 2023, the Center sent an email communication regarding the language of the proceeding in English and Italian. The Complainant submitted a request to proceed in English on August 17, 2023. The Respondent did not submit any response to the Center’s communication.

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 both in English and Italian, and the proceedings commenced on August 24, 2023. In accordance

with the Rules, paragraph 5, the due date for Response was September 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 14, 2023.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on September 15, 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 was founded in 1996 in Naples, Italy and is one of the leading companies in the market for Italian coffee, producing every day around 96 tonnes of processed coffee in its Italian factories. The reputation of the Complainant's CAFFE' BORBONE brand has already been acknowledged in previous UDRP decision *Caffè Borbone S.r.l. v. Beats, Beats /KAI*, WIPO Case No. [D2022-0824](#); and in the Italian procedure against the same Respondent, *Caffè Borbone Srl v. Aldo Vincenzo Pecora*, No. 7/2023 (issued by the Italian Dispute Resolution Service Provider MFSD).

The Complainant has several registrations for the BORBONE and CAFFE' BORBONE trademarks around the world. The Complainant is, *inter alia*, the owner of:

- European Union Trade Mark BORBONE (device), registration number 015670532, registered on November 23, 2016;
- European Union Trade Mark CAFFE' BORBONE (device), registration number 015670541, registered on November 23, 2016;
- Italian trademark CAFFE BORBONE (device), registration number 0000895990, registered on June 9, 2003;
- International trademark CAFFÈ BORBONE (device), registration number 902614, registered on January 11, 2006.

In addition, the Complainant holds numerous domain names reflecting the trademarks CAFFÈ BORBONE/BORBONE, including <caffeborbone.it> and <caffeborbone.com>.

The disputed domain names, at the time the Complaint was filed, presented a blank page.

The disputed domain names were registered on May 18, 2023.

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

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

The Complainant claims that:

(a) the disputed domain names are confusingly similar to the Complainant's trademarks; (b) the Respondent lacks any rights or legitimate interests in the disputed domain names; and (c) the Respondent has registered and is using the disputed domain names in bad faith.

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

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

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

Paragraph 11(a) of the Rules provides that “Unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative 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 administrative proceeding”.

In this case, the registration agreement for the disputed domain name <espressoborbone.shop> is in English, whereas the language of the registration agreement for the disputed domain name <espressoborbone.com> is Italian. The Respondent appears to be Italian.

The Complainant has requested that the language of the proceedings in this case should be English, arguing that the Respondent has a sufficient understanding of the English language, as is shown by the Respondent’s own assertion, on his LinkedIn profile, that he is proficient in English.

Paragraph 10(b) of the Rules provides that: “In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case”, and paragraph 11(a) of the Rules allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel finds that the affirmation of the Respondent on his LinkedIn profile that he is proficient in English provides sufficient evidence to suggest that the Respondent is able to conduct the proceeding in English. The Respondent has not responded to the Complainant’s assertion that the Respondent is able to read and understand English, and has not requested that the proceeding be conducted in Italian. In addition, the language of the Registration Agreement for one of the disputed domain names is English.

Therefore, in the circumstances of this case the Panel finds that the Respondent will not be prejudiced by the language of the proceeding being English.

The Panel, accordingly, accepts the Complainant’s argument that the language of the proceedings should be English, and so finds.

### **6.2 Substantive Elements of the Policy**

In order for the Complainant to obtain a transfer of the disputed domain names, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

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

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

The Complainant has established rights in the BORBONE trademark.

The disputed domain names contain the Complainant's BORBONE trademark with the addition of the term "espresso" and the Top-Level Domains, ".com" and ".shop" respectively. The addition in the disputed domain names of the term "espresso" does not prevent the BORBONE trademark from being recognizable in the disputed domain names.

Pursuant to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") which states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

Therefore, the Panel finds the disputed domain names to be confusingly similar to the BORBONE trademark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain names, and the burden of production of evidence shifts to the Respondent. The composition of the disputed domain names, which combine the Complainant's BORBONE trademark with the term "espresso" (*i.e.* "caffè espresso" in Italian) which clearly refers to the Complainant's field of activity, carries a risk of implied affiliation with the Complainant. The Respondent has no connection or affiliation with the Complainant and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademarks. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain names, nor any use in connection with a *bona fide* offering of goods or services. Indeed, it appears that the Respondent is passively holding the disputed domain names. In addition, the Respondent does not appear to be commonly known by the disputed domain names or by a similar name. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant's trademark registrations and rights to the BORBONE and CAFFÈ BORBONE marks when it registered the disputed domain names.

The Complainant's BORBONE trademark is a distinctive and renowned trademark and has been registered and used for about 20 years. The renown of the Complainant's trademark has already been acknowledged in previous UDRP decision *Caffè Borbone S.r.l. v. Beats, Beats / KAI*, WIPO Case No. [D2022-0824](#), in which it was held that "...since the Complainant registered its trademark CAFFÈ BORBONE, the Complainant has achieved significant growth in the coffee business industry for more than 20 years. The Complainant's trademark has become a relevant trademark in the coffee industry worldwide".

The Respondent has registered three domain names containing the Complainant's trademark. These domain names combine the Complainant's trademark with the term "espresso" which refers to the Complainant's field of activity. In addition, the Respondent appears to be an Italian residing in Italy where the Complainant and its trademark are renowned.

Clear evidence that the Respondent was aware of the Complainant's trademark and activity is also given by the fact that the disputed domain names were registered on May 18, 2023, namely after this same Complainant filed an opposition before the Italian Registry of the ccTLD.it on December 22, 2022, against the registration of the domain name <espressoborbone.it> by this same Respondent, and also after the Complainant filed (on March 30, 2023) a reassignment procedure in order to recover the domain name <espressoborbone.it>, at that time assigned to the Respondent.

Consequently, it appears that the Respondent registered the disputed domain names while aware of the Complainant's trademark and activity, and did so with the intention of creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of either the Respondent and/or the disputed domain names.

This constitutes bad faith registration and use as well as a disruption of the Complainant's business under the Policy.

Inference of bad faith can also be found in the Respondent's failure to respond to the Complainant's contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain names.

As regards the use in bad faith of the disputed domain names, which at the time the Complaint was filed, were inactive (namely, a blank page), the Panel considers that in the circumstances of this case, the passive holding of the disputed domain names does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3. The Panel here considers as relevant the renown of the Complainant's trademark, the incorporation of said distinctive trademark, the inherently misleading nature of the disputed domain names, and the Respondent's failure to participate in the proceeding.

Finally, this same Respondent was already found to have registered and used in bad faith the domain name <espressoborbone.it>. See the Italian procedure *Caffè Borbone Srl v. Aldo Vincenzo Pecora*, MFSD Case No. 7/2023.

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and used the disputed domain names in bad faith.

Therefore, the Complainant has satisfied 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 names, <espressoborbone.com> and <espressoborbone.shop>, be transferred to the Complainant.

*/Fabrizio Bedarida/*

**Fabrizio Bedarida**

Sole Panelist

Date: September 29, 2023