

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Lorenzo Cortina
Case No. D2023-4378

1. The Parties

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

The Respondent is Lorenzo Cortina, Spain.

2. The Domain Name and Registrar

The disputed domain name <borbones.xyz> (the “Disputed Domain Name”) is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 23, 2023. On October 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 25, 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 (Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 October 27, 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 November 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 22, 2023.

The Center appointed Daniel Kraus as the sole panelist in this matter on November 27, 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 engaged in the coffee industry. The company was founded in 1996 in Naples, Italy. The Complainant is the proprietor *i.a.* of the following trademark and service mark registrations for CAFFÈ BORBONE, respectively BORBONE:

- Italian trademark registration No. 0000895990 (figurative), registered June 9, 2003;
- European Union trademark registration No. 15670541 (figurative), registered November 23, 2016; and
- International Trademark registration No. 902614 (figurative), designating the European Union and the Russian Federation, registered January 11, 2006.

Hereinafter jointly referred to as the BORBONE Trademarks.

The Complainant is also the owner of numerous domain names that include its BORBONE Trademarks.

The Disputed Domain Name was registered on April 13, 2023, and resolves to a page with pay-per-click ("PPC") links.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant contends that, first of all, 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 letter "s" and the generic Top-Level Domain ("gTLD") ".xyz". The Complainant stands that the mere addition of the generic letter "s" only emphasizes 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 the Disputed Domain Name does not include the term "caffè" is indifferent since this term, which means coffee in Italian, is purely descriptive of the Complainant's products.

The Complainant further 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, in attracting consumers on a parking page with PPC links.

B. Respondent

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

6. Discussion and Findings

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that 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 holds trademark and service mark rights in the BORBONE Trademarks.

The Disputed Domain Name is close to identical to the Complainant's BORBONE Trademark, with the difference of the addition of the letter "s" and the gTLD ".xyz". This addition does not prevent a finding of confusing similarity, as the mark is recognizable in the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.9. It is well established that gTLDs, typically are disregarded in the assessment of confusing similarity, see [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that that the Disputed Domain Name is confusingly similar to a trademark and service mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must first make out a *prima facie* case showing that the respondent lacks rights or legitimate interests in respect of a disputed domain name and then the burden, in effect, shifts to the respondent to come forward with evidence of its rights or legitimate interests, 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).

Considering the evidence presented in the case, and the Complainant's unrebutted contentions that the Respondent has no rights or legitimate interests in the Disputed Domain Name, the Panel finds that the Complainant has made out an undisputed *prima facie* case. In addition, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Prior UDRP decisions have consistently held that respondents that monetize domain names using pay-per-click links have not made a *bona fide* offering of goods or services that would give rise to rights or legitimate interests in a disputed domain name. As such, the Respondent is not using the Disputed Domain Name to provide a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use as allowed under the Policy.

Considering the above, the Panel finds that the Complainant has established that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

On the evidence presented in the case and the confusing similarity between the Disputed Domain Name and the Complainant's BORBONE Trademarks, it is clear that the Respondent had the Complainant and its BORBONE Trademarks in mind when registering the Disputed Domain Name.

The Respondent's use of a typographical variant of the Complainant's trademark and the use of PPC advertising links all support a finding of bad faith registration and use. See [WIPO Overview 3.0](#), sections 3.2.1 and 3.5.

Considering the above, the Panel finds 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, <borbones.xyz> be transferred to the Complainant.

/Daniel Kraus/

Daniel Kraus

Sole Panelist

Date: December 11, 2023