

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Bgeyjbcdv Ngd
Case No. D2023-5038

1. The Parties

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

The Respondent is Bgeyjbcdv Ngd, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <borbonesale.shop> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 4, 2023. On December 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 8, 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 December 12, 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 December 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2024.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on January 5, 2024. 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 coffee industry founded in 1996 that presently processes approximately 96 tonnes of processed coffee, daily in its factories. The Complainant's name and trademark derives from the royal family of Charles III of Bourbon.

In addition to various domain names amongst which the <caffeborbone.com>, where the Complainant's official website is available, the Complainant is the owner, amongst others, of the following trademark registrations:

- Italian Trademark Registration No. 362019000144424 for CAFFE BORBONE and device, filed on January 19, 2000, and registered on June 9, 2003, subsequently renewed, in classes 9, 30, and 42;
- International Trademark Registration No. 902614 for CAFFE BORBONE and device, registered on January 11, 2006, in classes 9, 30, and 43;
- United States Trademark Registration No. 4,356,426 for CAFFE BORBONE and device, filed on April 12, 2012, and registered on June 25, 2013, in classes 30, and 43;
- European Union Trade Mark Registration No. 15670532 for BORBONE and device, filed on July 18, 2016, and registered on November 23, 2016, in classes 7, 11, 21, 30, 35, 37, 40, and 43;
- European Union Trade Mark Registration No. 15670541 for CAFFE BORBONE and device, filed on July 18, 2016, and registered on November 23, 2016, in classes 7, 11, 21, 30, 35, 37, 40, and 43; and
- International Trademark Registration No. 1359499 for CAFFE BORBONE and device, registered on May 30, 2017, in classes 11, 30, and 43.

The disputed domain name was registered on August 30, 2023, and resolved to a parking page. Presently, it does not resolve to an active webpage.

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 asserts to be one of the most important Italian companies in the coffee industry, being its products (coffee capsules, coffee beans, and ground coffee) distributed all over the world. The Complainant further states that its products have received various prestigious awards such as the two stars by the International Taste Institute in 2019 and the Business Excellence Award in 2020, in addition to having been ranked the second top-of-mind brand in the coffee sector, what lead its trademark to become well known and reputed, as recognized by past UDRP panels (*Caffè Borbone S.r.l. v. Beats, Beats / KAI*, WIPO Case No. [D2022-0824](#)).

In the Complainant's view, the disputed domain name incorporates its BORBONE trademark entirely, the addition of the term "sale" being insufficient to add any distinctiveness thereto or to distinguish the disputed domain name to the Complainant's trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name given that the Respondent is not known and cannot be known by the disputed domain name which refers to the Complainant's tradename and well-known trademark and the Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name.

The Complainant contends that the disputed domain name was registered in bad faith given the well-known status of the Complainant's trademark; there being no connection between the Respondent and the disputed domain name. In addition to that, the disputed domain name is being passively held, being it safe to assume that the Respondent registered the disputed domain name to profit or detract from or exploit the Complainant's trademark and the Respondent has chosen a privacy protection service to conceal its true identity, what is a further indicative of its bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the term "sale" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent.

In that sense, the Complainant indeed states that it has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name.

Also, the absence of any indication that the Respondent has rights or legitimate interests in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with the Panel’s finding of the absence of rights or legitimate interests.

Another element to consider is the fact that no active use of the disputed domain name appears to have taken place which makes it even more difficult to conceive which rights or legitimate interests the Respondent would have in a domain name that reproduces in its entirety the Complainant’s trademark.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

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.

Past UDRP panels have already dealt with the question of whether the “passive holding” of a domain name could constitute bad faith. Section 3.3 of the already quoted [WIPO Overview 3.0](#) states that “[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”.

In the present case, the passive holding of the disputed domain name by the Respondent amounts to the Respondent acting in bad faith, given that the Respondent has provided no evidence whatsoever of any actual or contemplated good-faith use of the disputed domain name. In addition to that, in the circumstances of this case, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

The registration and use of the disputed domain name in bad faith are further corroborated in the present case in view of the following circumstances:

(i) the Respondent has provided no evidence whatsoever of any actual or contemplated good-faith use of the disputed domain name;

(ii) the Respondent's choice to retain a privacy protection service so as to conceal its true identity; and

(iii) the use of a false or incomplete contact details in the Whois data and, consequently, the Center not being able to have communications fully delivered to it.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use of the disputed domain name.

The Panel finds that the Complainant has established the third element 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 name <borbonesale.shop> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: January 19, 2024