

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. mustafa karli

Case No. D2024-0420

1. The Parties

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

The Respondent is mustafa karli, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <borbonelovers.com> (the “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 January 30, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 31, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (REDACTED FOR PRIVACY, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 2024, 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 February 2, 2024.

The Center verified that the Complaint together with 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 February 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 27, 2024.

The Center appointed Ian Lowe as the sole panelist in this matter on March 1, 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 was founded in Naples, Italy in 1996 under the name L'Aromatika S.r.l and is one of the leading manufacturers of coffee products in Italy. It adopted its current name Caffè Borbone in 2000. The Complainant produces around 96 tonnes of processed coffee every day in its Italian factories and its products are distributed all over the world.

The Complainant is the proprietor of a number of registered trademarks comprising BORBONE, including Italy trademark number 895990 CAFFÈ BORBONE device mark registered on June 9, 2003, International trademark number 1359499 CAFFÈ BORBONE device mark registered on May 30, 2017, and European Union trademark number 15670532 BORBONE figurative mark registered on November 23, 2016. On December 13, 2023, the Complainant applied to register the word mark BORBONE LOVERS as a European Union trademark.

The Domain Name was registered on December 13, 2023. It resolves to a web page at "www.dan.com" offering the Domain Name for sale at a price of USD 2,850.

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 Domain Name.

B. Respondent

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

6. Discussion and Findings

For this Complaint to succeed in relation to the Domain Name the Complainant must prove that:

- (i) the Domain Name is 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

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 uncontested rights in the BORBONE and CAFFÈ BORBONE trademarks (the "Marks"), both by virtue of its trademark registrations and as a result of its widespread use of the Marks over a number of years. Ignoring the generic Top-Level Domain ("gTLD") ".com", the Domain Name comprises the entirety of the Complainant's BORBONE trademark together with the word "lovers". In the view of the

Panel, this addition does not prevent a finding of confusing similarity between the Domain Name and the Marks. Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights, and 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. Accordingly, 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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

The Domain Name is not being used for an active website but resolves to a webpage offering the Domain Name for sale. The Domain Name was registered on the same day that the Complainant applied to register BORBONE LOVERS as a European Union trademark. In light of the obvious association between the Domain Name and the Complainant’s BORBONE mark, the inference is that the Respondent registered the Domain Name with a view to selling the Domain Name to the Complainant or a competitor at a price significantly in excess of the Respondent’s out-of-pocket expenses in relation to the Domain Name (absent any evidence from the Respondent to the contrary). Alternatively, it was registered with a view to deceiving Internet users into believing that it had been registered by or operated on behalf of the Complainant.

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.

In light of the nature of the Domain Name (identical to the Complainant’s recent trademark application) and the timing of its registration (the same day as the trademark application), the Panel considers that the Respondent must have had the Complainant and its rights in the marks in mind when it registered the Domain Name. As set out above, the obvious inference is that the Respondent registered the Domain Name for commercial gain with a view to selling the Domain Name to the Complainant or a competitor; alternatively, that it did so with a view to taking unfair advantage of the Complainant’s rights in the Marks and confusing Internet users into believing that the Domain Name was being operated by or authorized by the Complainant.

Accordingly, the Panel finds that the Domain Name has been registered and is being used in bad faith and 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 Domain Name <borbonelovers.com> be transferred to the Complainant.

/Ian Lowe/

Ian Lowe

Sole Panelist

Date: March 12, 2023