

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Andres Borbon, Borbon Media LLC.
Case No. D2024-2637

1. The Parties

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

The Respondent is Andres Borbon, Borbon Media LLC., United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <borboninternational.com> is registered with Register.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 27, 2024. On June 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 2024, 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 (PERFECT PRIVACY, LLC.) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 4, 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 July 8, 2024.

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 July 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 2, 2024.

The Center appointed Steven A. Maier as the sole panelist in this matter on August 22, 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 a company registered in Italy. It is a coffee producer, offering a range of products including coffee beans, ground coffee, capsules and pods.

The Complainant is the owner of various trademark registrations for the marks CAFFÈ BORBONE and BORBONE, including for example European Union trademark registration number 018719148 for the word mark BORBONE, registered on October 5, 2022, in International Classes 9, 35 and 42.

The disputed domain name was registered on April 14, 2024.

The Complainant exhibits evidence that the disputed domain name has resolved to a registrar's "parking page", including what appear to be pay-per-click ("PPC") links to other locations, one of which was labelled "Borbone Sito Ufficiale". The Complainant also provides evidence that clicking on this link offered the user two further links. One of those links, headed "Borbone Caffè Sito Ufficiale" redirected users to a site named "Sly Today". The second link (not directly labelled with the Complainant's name) redirected users to a website at "www.ilcaffetiereambulante.com", offering links to at least eight coffee producers, including the Complainant and other companies, which the Complainant states to be its competitors.

5. Parties' Contentions

A. Complainant

The Complainant submits that it was founded in 1996 and is one of the most important Italian coffee companies. It states that it owes its name to Charles III of Bourbon. The Complainant submits that it produces around 96 tonnes of processed coffee per days and provides evidence of industry awards it has won in categories including quality, taste and sustainability.

The Complainant submits that the disputed domain name is confusingly similar to its BORBONE trademark, because it almost entirely reproduces that trademark. It contends that neither the absence of the letter "e" in the disputed domain name, nor the addition of the non-distinctive component "international", prevents the disputed domain name from being confusingly similar to the trademark in question.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that it has never authorized the Respondent to use its BORBONE trademark, and that the Respondent is making neither bona fide commercial use nor legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the Respondent's only use of the disputed domain name has been for the purpose of a parking page website which contains PPC links, including one which targets the Complainant's trademark. It contends that the Respondent seeks to capitalize on the association of the trademark BORBONE with the Complainant's coffee products, by diverting Internet users to a website selling its competitors' products.

The Complainant submits that, even though the Respondent's surname may be Borbon, that will not avail the Respondent if there is countervailing evidence that the personal name has been added opportunistically in order to give an air of legitimacy to an otherwise questionable registration. It contends that while such a registration could be used, for example, for a family-related website, it would not be legitimate to use it to

target the Complainant's trademark by way of PPC links (*Riemann Trading ApS v. Riemann, Michael*, WIPO Case No. [D2017-0111](#)).

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. The Complainant contends that, given the pre-existing reputation of the Complainant's trademarks CAFFÈ BORBONE and BORBONE, the Respondent either was, or ought to have been, aware of those trademarks at the time it registered the disputed domain name. The Complainant submits that, such was the reputation of the Complainant's *caffè italiano* all over the world, it should be concluded that the Respondent registered the disputed domain name with the intention of taking unfair advantage of that reputation, by misleading and diverting Internet users to a parking page from which the Respondent earns money. The Complainant contends that such an offering cannot be bona fide in any event where the PPC links in question compete with the Complainant's trademark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service 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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name comprises the two terms "borbon" and "international", together with the generic Top-Level Domain ("gTLD") ".com", which may be disregarded for the purpose of comparison under the first element of the Policy. The Panel finds the term "borbon" to be visually and aurally similar to the Complainant's trademark BORBONE. The Panel finds in these circumstances that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the light of its conclusions in respect of the third element of the Policy, below, the Panel does not consider it necessary to determine whether the Complainant has established that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The third element of the Policy involves the conjunctive requirement that the disputed domain name must both have been registered, and have been used, in bad faith.

To establish registration in bad faith, a complainant must demonstrate that the respondent knew of (or in certain cases should have known of, or was willfully blind to) the Complainant's trademark and registered the disputed domain name with the intention of taking unfair advantage of the commercial goodwill attaching to that trademark.

In this case, the Panel finds no evidence to suggest, or basis upon which to infer, that the Respondent was aware of the Complainant's BORBONE or CAFFÈ BORBONE trademarks when it registered the disputed domain name, or that it did so with the intention of causing confusion with, or otherwise taking unfair advantage of, the Complainant's rights in those trademarks.

While the Complainant has trademark rights in respect of the mark BORBONE, the term used in the disputed domain name is "borbon", which is not the same. Moreover, a basic Google search against the term "borbon" shows that name to have a number of associations unrelated to the Complainant, e.g., the name of a municipality in the Philippines, a pocket ribbon microphone and various personal surnames. Furthermore, a search for the trademark BORBON via the WIPO Global Brand Database suggests that there are approximately 15 entities owning trademark registrations that comprise or include that mark.

The Panel does not find in these circumstances that the disputed domain name is inherently misleading, as inevitably suggesting a connection with the Complainant, or that Internet users would be likely to be misled by the disputed domain name into believing that such a connection existed.

Furthermore, while recognizing that the name "Borbon" represents a personal surname of the Respondent, the Complainant appears to disregard the fact that the Respondent is Andres Borbon, Borbon Media LLC. The Panel finds this fact to give rise to a prima facie inference that the disputed domain name was registered in connection with a corporation of that name. Furthermore, based on a search of publicly available records, namely the Secretary of the Commonwealth of Massachusetts business registrations, a corporation named Borbon Media, LLC was registered in November 2014, with its manager named as Andres Leonardo Borbon. The corporation appears to have filed annual reports from 2015 to 2023 inclusive. The Panel does not therefore find this entity to be a sham, or to have been created as a pretext for targeting the Complainant's trademark.

In all the circumstances, the Panel infers, on balance, that the Respondent is more likely to have registered the disputed domain name with reference to the Respondent corporation, Borbon Media, LLC, than for the purpose of targeting the Complainant's BORBONE or CAFFÈ BORBONE trademarks. The Complainant is therefore unable to establish that the disputed domain name was registered in bad faith and the Complainant must inevitably fail.

Concerning the use of the disputed domain name, the Panel accepts that the disputed domain name has resolved to parking page which, at least indirectly, has included a PPC link to a website promoting coffee producers who may be competitive with the Complainant. The Panel also finds that, while the PPC links appearing on that parking page may be determined by the Registrar, the Respondent is ultimately responsible for those links. However, the Panel does not find this matter to be determinative of any bad faith intent on the Respondent's part (and certainly not to evidence registration in bad faith as discussed above).

The Complainant has therefore failed to establish that the disputed domain name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: September 5, 2024