

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. KathleenCarter
Case No. D2024-3840

1. The Parties

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

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

2. The Domain Name and Registrar

The disputed domain name <nespressoborbone.shop> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 20, 2024. On September 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 23, 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 September 25, 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 October 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 23, 2024.

The Center appointed Assen Alexiev as the sole panelist in this matter on October 25, 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 company, founded in 1996, which specializes in coffee in compostable pods and compatible capsules.

The Complainant is the owner of the following trademark registrations for the signs BORBONE and CAFFÈ BORBONE:

- the International trademark  with registration No. 902614, registered on January 11, 2006 for goods and services in International Classes 9, 30 and 43;
- the United States trademark  with registration No. 4356426, registered on June 25, 2013 for goods and services in International Classes 30 and 43;
- the European Union trademark  with registration No. 15670532, registered on November 23, 2016 for goods and services in International Classes 7, 11, 21, 30, 35, 37, 40 and 43; and
- the European Union trademark BORBONE with registration No. 018719148, registered on October 25, 2022.

The Complainant is also the owner of the domain name <caffeborbone.com>, which resolves to its official website.

The disputed domain name was registered on July 30, 2024. It is inactive.

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.

The Complainant states that the disputed domain name is confusingly similar to its BORBONE trademark, because it represents a combination of this trademark and a third party's trademark. The addition of the third party's trademark NESPRESSO to the BORBONE trademark in the disputed domain name does not avoid Internet user confusion, because some of the Complainant's goods are compatible with NESPRESSO coffee machines.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because the Complainant has neither authorized it to register or use the disputed domain name, and the Respondent has no relevant trademark rights. According to the Complainant, the disputed domain name is not being used in good faith for the offering of goods and services to the public and has not been put to legitimate commercial or noncommercial use without the intention of misleading the Complainant's customers or exploiting the BORBONE trademark. Rather, the disputed domain name was registered to divert Internet users away from the Complainant's website by capitalizing on the goodwill of the BORBONE trademark.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that at the time of registration of the disputed domain name, the Complainant's business with the BORBONE trademark was well established, and the Respondent knew or must have known about the existence of this trademark, which is not a common or descriptive term and was used and registered long before the registration of the disputed domain name. The Complainant maintains that the Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the Complainant's BORBONE trademark to attract Internet users to the disputed domain name by creating a likelihood of confusion with the BORBONE trademark and with the Complainant's company name. The Complainant adds that the fact that there is no active website associated with the disputed domain name does not prevent a finding of its registration and use in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural Considerations

The Panel notes that the disputed domain name contains, in addition to the Complainant's BORBONE trademark, a trademark owned by a third party. This fact raises the question of whether, in the event the Complaint is successful, there is any impediment to ordering the remedy sought by the Complainant – i.e., the transfer of the disputed domain name to the Complainant.

This Panel follows the approach taken in *WhatsApp Inc. v. Private Whois whatsappandroid.com, Private Whois whatsappipad.com and Private Whois whatsappiphone.com*, WIPO Case No. [D2012-0674](#), and *Philip Morris USA Inc. v. Whoisguard Protected, Whoisguard, Inc. / MARK JAYSON DAVID*, WIPO Case No. [D2016-2194](#), that there is no basis in principle or in practice for denying a complainant the remedy of transfer merely because the disputed domain name contains, in addition to the Complainant's trademark, a trademark owned by a third party. Neither the Policy nor the Rules contain a provision that precludes the grant of the transfer remedy in this situation. Furthermore, neither the Policy nor the Rules contain a provision that precludes the third party from bringing an action under the Policy, or under any other applicable law, against the Complainant in whose favor an order of transfer is made, in the event that the third party considers the Complainant's holding of the disputed domain name to be in violation of the Policy.

6.2. Substantive Issues

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 the BORBONE trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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

Here, the disputed domain name incorporates also the third-party trademark NESPRESSO. Where the complainant's trademark is recognizable within the disputed domain name, the addition of other third-party marks (i.e., <mark1+mark2.tld>), is insufficient in itself to avoid a finding of confusing similarity to the Complainant's trademark under the first element. [WIPO Overview 3.0](#), section 1.12.

The Panel therefore 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.

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 disputed 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 disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name incorporates the Complainant's BORBONE trademark in combination with the third-party trademark NESPRESSO. Both of these trademarks are used for coffee and coffee-related goods and services, and the Complainant submits that some of its goods are compatible with Nespresso coffee machines. The combination of the two trademarks thus risks giving the appearance that the disputed domain name is an official online location for the Complainant's coffee products that are compatible with Nespresso coffee machines, which may attract to it visitors looking for such products. The Complainant denies having authorized the Respondent to use its BORBONE trademark and there is no evidence that the Respondent has been authorized to use the NESPRESSO trademark either. The disputed domain name is inactive, and the Respondent has not provided any plausible explanation as to why it has registered and how it intends to use it legitimately. In these circumstances, the Panel finds that the Complainant's prima facie case has remained unrebutted and finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Panel therefore finds that 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant’s BORBONE trademark, the composition of the disputed domain name, which combines this trademark with the third-party trademark NESPRESSO and risks appearing as an official online location for the Complainant’s coffee products that are compatible with Nespresso coffee machines, and the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use of the disputed domain name, does not prevent a finding of bad faith under the Policy.

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 <nespressoborbone.shop> be transferred to the Complainant.

The Panel notes that this results in the transfer to the Complainant of a domain name that includes the trademark NESPRESSO which the Panel understands is owned by a third party. In that respect, the Panel consider it appropriate to clarify that the present decision is explicitly without prejudice to any rights which may be asserted by the owner of the NESPRESSO trademark.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: November 1, 2024