

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Liu Fen

Case No. DCO2023-0007

### **1. The Parties**

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

The Respondent is Liu Fen, China.

### **2. The Domain Name and Registrar**

The disputed domain name <caffeborbone.co> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 20, 2023. On January 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 23, 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 January 27, 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 January 30, 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 February 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 22, 2023.

The Center appointed Selma Ünlü as the sole panelist in this matter on March 2, 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

Given that no Response was filed, the following facts are based on the submissions in the Complaint and the Annexes to the Complaint.

The Complainant, Caffè Borbone S.r.l., is one of the leading Italian coffee maker companies founded in 1996 in Naples, Italy, devoted to coffee and operates worldwide. The Complainant has been recognized as a primary Italian player in the portioned coffee sector by winning prizes.

The Complainant is the owner of several trademarks for CAFFÈ BORBONE device marks and BORBONE marks including in Italy, the European Union and the United States of America, for goods and services related to coffee, such as coffee products, coffee roasters, bar services, and cafés. The Complainant's trademarks including the term BORBONE are, *inter alia*, the following:

- Italian trademark CAFFÈ BORBONE Registration No. NA2000C000037, registered on June 6, 2003
- International trademark CAFFÈ BORBONE Registration No. 902614, registered on January 11, 2006
- European Union trademark BORBONE Registration No. 15670532, registered on November 23, 2016

The Complainant is also the owner of several domain names incorporating its CAFFE BORBONE trademark, such as <caffeborbone.com> and <caffeborbone.it>.

The disputed domain name was registered on November 23, 2022. The disputed domain name resolves to a parking page, where it is on sale for USD 1,450.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant states that it is the owner of the CAFFÈ BORBONE trademarks, and the business with these trademarks was well established at the time of the registration of the disputed domain name. The disputed domain name is identical and confusingly similar to the Complainant's trademarks, because it incorporates the CAFFÈ BORBONE trademark in its entirety. It is also noted that the addition of the country-code Top Level Domain ("ccTLD") ".co" is not significant in determining whether the disputed domain name is identical or confusingly similar to the trademarks of the Complainant.

The Complainant contends that the Respondent has no legitimate rights or interests in the disputed domain name, since it has no trademark or any right over the CAFFÈ BORBONE signs and that the Complainant did not authorize the Respondent to use its trademarks, or give any license to the Respondent.

Regarding bad faith, the Complainant submits that the Complainant and its trademarks are well reputed and predate the registration of the disputed domain name, that it is clear the Respondent knew or should have known about the existence of the earlier CAFFÈ BORBONE trademarks. Therefore, the Complainant asserts that the disputed domain name exploits the reputation of the Complainant's CAFFÈ BORBONE trademarks.

In addition, the Complainant claims that there is no connection between the owner of the disputed domain name and the relevant distinctive sign reproducing the Complaint's trademark and company name and principal domain name <caffeborbone.com>; that "CAFFÈ BORBONE" is not a common or descriptive term; and that because of the intensive use made by the Complainant, the Complainant's trademarks CAFFE BORBONE are reputed in Italy and abroad since before the registration of the disputed domain name.

Moreover, the Complainant contends that the disputed domain name <caffeborbone.co> resolves to a page owned by <Dan.com>, where the disputed domain name is for sale for USD 1,450 which is a very high amount compared to the normal cost of a domain names. Therefore, the disputed domain name containing

the Complainant's distinctive mark has been offered for sale for profit for a sum in excess of out of pocket costs relating to the disputed domain name, which is not a *bona fide* offering of goods or services or a legitimate non-commercial or fair use.

The Complainant also states that the Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the Complainant's trademarks BORBONE/CAFFÈ BORBONE to attract Internet users to the websites related to the disputed domain name at issue creating a likelihood of confusion with the Complainant's trademarks CAFFÈ BORBONE/BORBONE and company name Caffè Borbone as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites depriving the Complainant of the possibility to register the contested domains in which it might have a legitimate interest.

The Complainant lastly referenced some former UDRP decisions showing that the Respondent registered domain names that correspond to third party's trademarks including well-known ones to prove that this is not an isolated event.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Complainant must prove that the three elements of paragraph 4(a) of the Policy have been met for the disputed domain name, namely:

- (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.

Since the Respondent did not object to any of the contentions from the Complainant by not submitting a Response, the Panel will decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint and supporting Annexes.

### **A. Identical or Confusingly Similar**

In light of the explanations and evidence provided by the Complainant, the Panel is satisfied that the Complainant has valid trademark rights in the CAFFÈ BORBONE trademark, which is reproduced in its entirety in the disputed domain name.

Furthermore, the addition of the ccTLD ".co" does not prevent a finding of confusing similarity, since it is merely a technical registration requirement to be disregarded typically.

Consequently, the Panel finds that the disputed domain name is identical to the Complainant's trademark and the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists non-exhaustively the relevant circumstances that could show the Respondent's rights or legitimate interests in a domain name, as follows:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent’s] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or

(iii) [the respondent] is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel notes that the Respondent has not filed a Response, and therefore, neither denied the Complainant’s claims, nor brought any information or evidence to prove any rights or legitimate interests.

The Complainant has made a *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. In particular, the Complainant asserted that the Respondent has no trademarks with the words “borbone” or “caffè borbone” and that it did not provide any license or authorization for the Respondent to use its trademark as part of the disputed domain name.

Additionally, the Complainant’s registration and use of the CAFFÈ BORBONE trademark predates the registration of the disputed domain name. Since the Complainant made out a *prima facie* case, the burden of production shifts to the Respondent to establish its rights or interests in the disputed domain name. The Respondent, however, has not sought to rebut that *prima facie* case.

Moreover, the Panel finds that the composition of the disputed domain name, consisting of the Complainant’s trademark entirely, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

In light of the Complainant’s assertions and evidence, the Panel finds that the Complainant has met the requirement under the Policy of *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists certain relevant non-exhaustive circumstances, which can be considered as the registration and use of a domain name in bad faith, namely:

“(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location."

Given the explanations in the Complaint and the evidence provided by the Complainant, the Panel finds that the disputed domain name was registered in bad faith.

The disputed domain name incorporates the exact distinctive CAFFÈ BORBONE trademark of the Complainant, which cannot be considered as a coincidence. The Complainant has provided that the CAFFÈ BORBONE trademark is well established and predated, therefore, the fact that the Respondent decided to register the disputed domain name including this term in its entirety strongly suggests that the Respondent has taken the Complainant's reputed CAFFÈ BORBONE trademark into account and targeted it specifically in order to gain unfair advantage. This is even more likely given the fact that the disputed domain name is on sale.

As follows, the disputed domain name resolves to a <Dan.com> page displaying a general offer to sell the disputed domain name. The Complainant contends that the Respondent has registered the disputed domain name only to sell it back for out-of-pocket costs, which shows bad faith registration and use.

The Panel finds that the dispute in question is a typical case of bad faith provided in the Policy under UDRP paragraph 4(b) as one of the scenarios constituting evidence of the Respondent's bad faith, namely, the case that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration probably in excess of the Respondent's out-of-pocket costs directly related to the domain name, considering that the disputed domain name reproduces entirely the distinctive well-known CAFFÈ BORBONE trademark. See section 3.1.1 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#).

The Panel must decide by examining all relevant circumstances of each case in question. It is possible that cumulative conditions lead to the finding of bad faith, such as the Complainant's trademark being well-known, as well as no response to the Complaint. Additionally, the fact that Respondent tried to register other third party trademarks as domain names systematically, including well-known trademarks, shows bad faith.

Accordingly, the evidence shows that the Respondent likely knew of and had sought to take unfair advantage of the similarity between the disputed domain name and the Complainant's trademarks and to prevent the Complainant from reflecting the mark in a corresponding domain name probably in order to resell the disputed domain name to the Complainant or to its competitors for commercial gain.

Consequently, the Panel decides that the third requirement is also met and both the registration and the use of the disputed domain name are 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, <caffeborbone.co> be transferred to the Complainant.

*/Selma Ünlü/*

**Selma Ünlü**

Sole Panelist

Date: March 16, 2023