

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Host Master, Transure Enterprise Ltd  
Case No. DCO2024-0067

### **1. The Parties**

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

Respondent is Host Master, Transure Enterprise Ltd, United States of America.

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

The disputed domain name <caffeborboneamerica.co> (the “Domain Name”) is registered with Above.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 16, 2024. On September 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 23, 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, Transure Enterprise Ltd) and contact information in the Complaint. The Center sent an email communication to Complainant on September 23, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. 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 Respondent of the Complaint, and the proceedings commenced on September 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 18, 2024.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on October 24, 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**

Complainant is an important Italian company in the coffee industry. Founded in 1996 in Naples, it produces every day around 96 tons of processed coffee in its Italian factories. Complainant's products (namely, capsule, coffee beans, ground coffee) are distributed all over the world.

Complainant owns multiple trademarks for BORBONE and CAFFÈ BORBONE, including:

- European Union wordmark BORBONE, registration number 018719148 and registration date October 25, 2022, and
- International Trademark (figurative) CAFFÈ BORBONE with registration number 902614 and registration date January 11, 2006.

In addition, Complainant runs its main website using the domain name <caffeborbone.com>.

The Domain Name was registered on July 17, 2024.

The Domain Name resolves to a pay-per-click ("PPC") website.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Notably, Complainant contends that the Domain Name is confusingly similar to its CAFFÈ BORBONE trademark because the Domain Name combines Complainant's trademark in its entirety to which the geographical term "america" has been added.

According to Complainant, Respondent has no rights or legitimate interests in the Domain Name.

Complainant has neither authorized, nor somehow given its consent to Respondent to register or use the Domain Name. Complainant submits that Domain Name has been registered around Complainant's well-known trademark to attract current and potential customers of Complainant. Also, the website under the Domain Name displays various PPC links in Complainant's field. Such use capitalizes on the reputation and goodwill of the CAFFÈ BORBONE trademark or otherwise misleads Internet users, not being considered a bona fide offering of goods or services.

Complainant submits that Respondent registered and is using the Domain Name in bad faith. According to Complainant at the time of registration of the Domain Name by Respondent Complainant's business with the trademarks CAFFÈ BORBONE and BORBONE was well established. Therefore, considering the reputation of Complainant's trademarks before the registration of the Domain Name, it is clear that Respondent knew or should have known about the existence of Complainant's trademarks.

The Domain Name is not used in good faith for the offer of goods and services to the public, nor it is used for legitimate commercial or noncommercial use without the intention of misleading Complainant's customers or infringing the registered BORBONE and CAFFÈ BORBONE trademarks. The Domain Name resolves to a parking page showing PPC links in the coffee field including products competitive with Complainant's ones. Complainant submits that this is a clear indication of bad faith use of the Domain Name. Complainant adds that Respondent registered in the past domain names identical to well-known trademarks or their typos resulting in being the losing party in several domain name dispute procedures.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires that a complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (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.

### **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 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.

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 CAFFÈ BORBONE mark is recognizable within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the addition of the geographical term "America" in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The country code Top-Level Domain ".co" is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted 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.

Complainant has not licensed or otherwise permitted Respondent to use its CAFFÈ BORBONE trademark or to register the Domain Name incorporating its mark. Respondent is not making a legitimate noncommercial or fair use of the Domain Names without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of Complainant. Based on the undisputed submission and evidence provided by Complainant, the Panel notes that the Domain Name is used to resolve to a PPC parking website with different coffee categories which contain links to competitors of Complainant. Such use cannot be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name, nor has it acquired any trademark rights.

The Panel finds the second element of the Policy has been established.

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

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of a domain name in bad faith in the event Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service offered on Respondent’s website or location.

The Panel finds that the Domain Name has been registered and is being used in bad faith. Noting the status of the CAFFÈ BORBONE mark and the overall circumstances of this case, the Panel finds it more likely than not that Respondent knew or should have known Complainant’s CAFFÈ BORBONE mark. The registration of the Domain Name in awareness of the CAFFÈ BORBONE trademark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Panel notes that the Domain Name resolves to a website which incorporates Complainant’s trademark in its entirety, and which resolves to PPC pages with different coffee categories which contain links to competitors of Complainant, which indicates, in the circumstances of this case, that Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy. As noted by previous UDRP panels, the fact that such links may be generated automatically does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.5.

The Panel finally notes that Respondent has been cited as a respondent in a very substantial number of UDRP cases and appears to be a serial cyber squatter, which suggests a pattern of such conduct on the part of Respondent.

The Panel finds that 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, <caffeborboneamerica.co>, be transferred to Complainant.

*/Dinant T. L. Oosterbaan/*

**Dinant T. L. Oosterbaan**

Sole Panelist

Date: November 4, 2024