

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. RONGKAI
Case No. DCO2024-0075

1. The Parties

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

The Respondent is RONGKAI, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2024. On October 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 11, 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 October 14, 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 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2024.

The Center appointed Taras Kyslyy as the sole panelist in this matter on November 15, 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 company active in the coffee industry. Founded in 1996 in Naples, it owes its name to the famous royal family and to Charles III of Bourbon. The Complainant produces every day around 96 tons of processed coffee in its Italian factories. The Complainant's products (namely, capsule, coffee beans, ground coffee) are distributed all over the world. The Complainant received two stars in 2019 from the International Taste Institute. In the same year, the Complainant also won the 2019 Quality Award, the prize given to food products (Food & Beverage) through sensory tests conducted by independent laboratories specializing in sensory analysis. In 2020, the Complainant was the winner in the ceremony for the awarding of the Business Excellence Award 2020 which took place at the Teatro Manzoni in Milan. The Complainant had progression in performance in recent years, with turnover growing by 36% annually and a simultaneous strengthening of margins, becoming the second top-of-mind brand in Italy in the sector, establishing itself as an important brand that today shows further growth opportunities for the future.

The Complainant owns registrations for its BORBONE and CAFFE BORBONE marks, including for instance European Union trademark registration No. 15670532 for BORBONE (design mark), and European Union trademark registration No. 15670541 for CAFFE BORBONE (design mark), both registered on November 23, 2016.

The Complainant owns a number of domain names featuring the Complainant's trademarks, redirecting to its official website at "www.caffeborbone.com".

The disputed domain name was registered on July 26, 2024 and redirects to a webpage with an offer for sale of the disputed domain name at USD 1,450.

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.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademarks. In particular, the disputed domain name is composed of the exact reproduction of the Complainant's trademark BORBONE to which has been added the country code Top-Level Domain ".co".

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name. There are no BORBONE trademark applications / registrations in the name of the Respondent. The disputed domain name has been registered around the Complainant's well-known trademark to attract current and potential customers of the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. At the time of registration of the disputed domain name, the Complainant's business with its trademarks was well established. Considering the reputation of the Complainant's trademarks before the registration of the disputed domain name, the Respondent "knew or should have known" about the existence of the earlier Complainant's trademarks. The disputed domain name exploits the reputation of the

Complainant's trademarks. There is no connection between the owner of the disputed domain name and the relevant distinctive sign reproducing the Complainant's trademarks, company name, and Complainant's principal domain name. The Complainant's trademarks are not common or descriptive term. Because of the intensive use made by the Complainant, the Complainant's trademarks represent the tradition and quality of the "caffè italiano" all over the world, are reputed in Italy and abroad and were so also before the registration of the disputed domain name. The Complainant's trademarks were used and registered long before the registration of the disputed domain name and the Respondent could not have been unaware of it at the time of the registration of the disputed domain name, given the reputation of the Complainant and the fact that the disputed domain name wholly incorporates the Complainant's trademark. The Respondent knew of the Complainant's trademarks and intentionally intended to create an association with the Complainant and its business at the time of the registration of the disputed domain name. The Respondent employed a privacy service to hide its identity, which serves as further evidence of bad faith registration and use also in the context of the passive holding doctrine. The disputed domain name resolves to a page owned by GoDaddy.com, a famous marketplace for domain names: the disputed domain name in fact is on sale for USD 1,450 which is a very high amount compared to the normal cost of a domain name. The disputed domain name containing the Complainant's 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 Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the Complainant's trademarks to attract Internet users to the website related to the disputed domain name at issue creating a likelihood of confusion with the Complainant's trademarks and company name as to the source, sponsorship, affiliation, or endorsement of the Respondent's website depriving the Complainant of the possibility to register disputed domain name in which it might have a legitimate interest.

B. Respondent

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

6. Discussion and Findings

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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

Assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. Thus, the Panel disregards design element of the Complainant's trademarks for the purposes of the confusing similarity check. [WIPO Overview 3.0](#), section 1.10.

The entirety of the mark BORBONE is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 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 available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated bona fide or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

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 the present case, the Panel notes that the Respondent registered the disputed domain name identical to the Complainant’s trademark BORBONE that is widely known in their field of services and predates the registration of the disputed domain name, which suggests to the Panel that the Respondent more likely than not knew about the Complainant and its prior trademark rights when registering the disputed domain name, which is bad faith. The Panel’s finding is reinforced given that the Complainant owns the “.com” version of its trademark, which the Respondent would likely have researched or discovered prior to registering the disputed domain name under the “.co” country code Top-Level Domain.

The mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant’s trademark is well established in its field of services through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in Italy and internationally. Thus, the Panel finds that the disputed domain name was registered in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark. To facilitate assessment of whether this has occurred, and bearing

in mind that the burden of proof rests with the complainant, paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating 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 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 its website or other online 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.

In this regard, the Panel finds that at least the first of the above scenarios apply to the present case confirming the Respondent's bad faith. [WIPO Overview 3.0](#), section 3.1.1.

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 <borbone.co> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: November 29, 2024