

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l., v. Daniela Pascazio, borbonecialde  
Case No. D2023-1385

### **1. The Parties**

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

The Respondent is Daniela Pascazio, borbonecialde, Italy.

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

The disputed domain name <borbonecialde.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 30, 2023. On March 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 30, 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 (Contact Privacy Inc. Customer 0166787261) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 18, 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 the same date.

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 April 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on May 25, 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**

The Complainant is the registered owner of several trademarks consisting and/or containing the term BORBONE, e.g. European Union Trade Mark registration no. 15670532 BORBONE (figurative), registered on November 23, 2016 for goods and services in the classes 07, 11, 21, 30, 35, 37, 40 and 43.

The disputed domain name was registered on March 18, 2023. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a website displaying the Complainant's trademark (figurative) and purportedly offering for sale products under the Complainant's trademarks and whose general terms and conditions are a copy of those showed on the Complainant's official website and therefore referring to the Complainant and its address.

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

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

It results from the Complainant's allegations that the Complainant is one of the Italian companies in the coffee industry. Founded in 1996 in Naples, it owes its name to the famous royal family and to Charles III of Bourbon. It produces every day around 96 tonnes of processed coffee in its Italian factories. Thanks to the quality and the careful choice of raw materials, Caffè Borbone's products (namely, capsule, coffee beans, and ground coffee) are distributed and appreciated all over the world.

The Complainant contends that its trademark BORBONE is distinctive and well known.

The Complainant uses the domain name <caffeborbone.com> in order to promote its products.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademark, since it is composed of the exact reproduction of the BORBONE trademark to which has been added the term "cialde", the Italian term for "pods", and the generic Top-Level Domain ("gTLD") ".com". The presence of the term "cialde", which is descriptive in the coffee sector, merely emphasizes the link with BORBONE that is the only distinctive component of the disputed domain name.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent is not known and cannot be known by 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. Clearly, the Respondent chose to use the well-known trademark BORBONE to divert Internet users from the Complainant's website by capitalizing on the association of BORBONE with the Complainant's coffee products. Consumers could easily be led, because of the slavish copying of the terms and conditions of the Complainant's official website, to believe that it is an official website belonging to the Complainant. The website to which the disputed domain name resolves, does not contain any information that would allow the user to identify the relationship between the Complainant and the Respondent and no information about the Respondent, whose general terms and conditions on the website merely copied those showed on the Complainant's official website. The intent to subrogate itself to the Complainant and deceive the consumer is evident, all the more so since the general conditions have not been modified and refer to the addresses and website of the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, considering the reputation of the Complainant's trademarks BORBONE before the registration of the disputed domain name, it is clear that the Respondent knew or should have known about the existence of the earlier Complainant's trademarks at the time of the registration of the disputed domain name. The addition of the word "cialde" to the BORBONE trademark is insufficient for avoiding Internet user confusion. On the contrary, the use of the term "cialde" emphasizes the likelihood of confusion, given that this is the Italian term for "pods", which is directly linked to the Complainant's activities.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this 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 a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name 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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

Panel 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.

It results from the evidence provided, that the Complainant is the registered owner of trademark registrations for BORBONE as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) at section 1.7.

This Panel shares this view and notes that the Complainant's registered trademark BORBONE is fully included in the disputed domain name, followed by the term “cialde” – the Italian term for “pods”. Furthermore, it is the view of this Panel that the addition of the term “cialde” in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the gTLD “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1). In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

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

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name.

In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the Complainant's trademark BORBONE, e.g., by registering the disputed domain name comprising said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name contains the Complainant's registered trademark BORBONE and that trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain name with the intention to take advantage of the Complainant's reputation by registering a domain name containing the Complainant's trademark with the intent to attract Internet users for commercial gain (e.g., *Marks & Spencer PLC v. Hongxia Li*, WIPO Case No. [D2022-2613](#)).

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation, since the disputed domain name contains the Complainant's trademark followed by the term "cialde" (i.e. the Italian term for "pods"), which is related to the Complainant's business activity, see [WIPO Overview 3.0](#), section 2.5.1. This is also confirmed by the content of the website to which the disputed domain name resolves, displaying without authorization the Complainant's trademark (figurative) and purportedly offering for sale products under the Complainant's trademarks and whose general terms and conditions are a copy of those showed on the Complainant's official website and therefore referring to the Complainant and its address.

It is acknowledged that once the panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain name resolves to a website displaying the Complainant's trademark (figurative) and purportedly offering for sale products under the Complainant's trademarks and whose general terms and conditions are a copy of those showed on the Complainant's official website and therefore referring to the Complainant and its address.

For the Panel, it is therefore evident that the Respondent positively knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant's trademark followed by the term "cialde". Registration of a disputed domain name which contains a third party's mark, in awareness of said mark and in the absence of rights or legitimate interests amounts to registration in bad faith (see *e.g.*, *Marks & Spencer PLC v. Hongxia Li*, WIPO Case No. [D2022-2613](#)). In the circumstances of this case, the Panel finds that the registration of the disputed domain name was in bad faith.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant's mark plus the addition of the term "cialde");
- (ii) the content of the website to which the disputed domain name directs, displaying the Complainant's trademark (figurative), and purportedly offering for sale products under the Complainant's trademark and whose general terms and conditions are a copy of those showed on the Complainant's official website and therefore referring to the Complainant and its address
- (iii) a clear absence of rights or legitimate interests coupled with no response for the Respondent's choice of the disputed domain name.

In light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) 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 <borbonecialde.com> be transferred to the Complainant.

/Federica Togo/

**Federica Togo**

Sole Panelist

Date: June 8, 2023