

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Paulo Ricaurte
Case No. D2023-5035

1. The Parties

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

The Respondent is Paulo Ricaurte, Colombia.

2. The Domain Name and Registrar

The disputed domain name <borboncoffee.com> is registered with Hello Internet Corp (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 4, 2023. On December 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 December 15, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Also on December 15, 2023, the Center informed the parties in Spanish and English, that the language of the registration agreement for the disputed domain name is Spanish. The Complainant filed an amended Complaint on December 18, 2023, confirming its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's request on the language of the proceeding.

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 December 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2024. The Respondent did not submit any formal

response in due time. Accordingly, the Center notified the Respondent's default on January 10, 2024. The Respondent submitted a late Response on January 12, 2024.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on January 16, 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 since 1996 in the coffee industry. It produces every day around 96 tons of processed coffee in its Italian factories. The Complainant's products, namely capsules, coffee beans and ground coffee are distributed internationally. The Complainant maintains its main website at "www.caffeborbone.com".

Apart from its company name, Caffè Borbone S.r.l., the Complainant owns several trademark registrations including:

- Italian Trademark Registration no. 0000895990, CAFFÈ BORBONE (fig.), filed on January 19, 2000 and registered on June 9, 2003, for goods and services in International classes 9, 30, and 42;
- European Union Trademark Registration no. 15670532, BORBONE (fig.), filed on July 18, 2016, and registered on November 23, 2016, for goods and services in International classes 7, 11, 21, 30, 35, 37, 40, and 43; and
- International Trademark Registration no. 1359499, CAFFÈ BORBONE (fig.), registered on May 30, 2017 for goods and services in International classes 11, 30, and 43.
- Colombian Registration No. 618478, CAFFÈ BORBONE (fig.), registered on June 17, 2019.

The Complainant owns domain name registrations containing its trademarks, including <caffeborbone.it> and <caffeborbone.com>.

Previous UDRP panels have recognized the reputation of the Complainant's trademarks (See, *Caffè Borbone S.r.l. v. Beats, Beats / KAI*, WIPO Case No. [D2022-0824](#); *Caffè Borbone S.r.l. v. Firat Taskara, D Management Group GmbH*, WIPO Case No. [D2023-0557](#); *Caffè Borbone S.r.l. v. Sebastien Garrasi*, WIPO Case No. [D2023-2902](#), *Caffè Borbone S.r.l. v. Fabio Salcina, Italissimi LLC*, WIPO Case No. [D2023-2624](#)).

The disputed domain name was registered on August 16, 2022. At the time the Complaint was filed, it resolved to an inactive site. It currently resolves to a website that displays the brand BORBON COFFEE, and contains references in English to the Respondent's coffee products, with sections "About us", "Services" and "Market Plan" and images related to coffee production. The footer of the website contains a reference to phone number in Orlando, United State of America ("USA") and another one in Bogota, Colombia and a contact email.

The Respondent is Paulo Ricarte. The respondent is reportedly a resident of Colombia. The Respondent has applied on November 20, 2023, to register the trademark BORBON COFFEE (and design) at the trademark office of Colombia (application no. SD2023/0105037). The trademark has not yet been granted.

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 confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions in the given deadline.

The Respondent sent an email in Spanish to the Center on December 20, 2023, stating the following: "Good morning, Please I need more information regarding this email, since our company has the respective web domain, and our coffee brand of the same name is approved by the National Federation of Coffee Growers of Colombia. Thank you. Paulo Ricaurte - RGB&I".

On January 12, 2023 the Respondent sent a late Response to the Center stating mainly the following:

- BORBON COFFEE is a registered trademark at the trademark office of Colombia.
- the trademark BORBON COFFEE is approved by the National Federation of Coffee Growers of Colombia, and is authorized for sales in the U.S.A. under that name.
- the name BORBON COFFEE is derived from a type or variety of coffee known as "bourbon coffee".
- the Complainant's domain name is "caffeborbone" and Respondent uses "borboncoffee"; both domain names are different and the Complainant's domain is in Italian, while the Respondent's disputed domain name is in English.
- the disputed domain name does not reproduce the Complainant's trademark because the names are different.
- the Respondent owns the disputed domain name since it was available for registration.

There were no annexes or documentation attached to this response.

C. Procedural Order no. 1

Pursuant to paragraphs 10 and 12 of the UDRP Rules, the Panel issued the following order:

"1. The Panel requests the Respondent the following:

(a) to submit copies of the trademark(s) related to BORBON COFFEE, filed at the Colombian trademark office;

(2) to indicate the date of the filing and the status of said trademarks(s);

(3) to provide evidence (e.g. copy of the certificate) that supports the claim indicated in the response: "our TM has been approved by the Colombian National Federation for Coffee Growers";

(4) to provide evidence of use, or of preparations to use, the BORBON COFFEE trademark in Colombia and/or in the United States of America. Such evidence may include length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition.

The Respondent must submit the required information by February 14, 2024.

The Complainant is afforded the opportunity to comment on the Respondent's submission (if any) by February 19, 2024. The Parties' further submissions should be limited to the above request".

D. Respondent's filing

On February 7, 2024, in response to the Procedural Order No.1, the Respondent sent an email to the Center with several arguments and annexes.

The Respondent stated again several of the statements filed in this original filing and included new information and some documents related to the activities under the disputed domain name and its name. This time the response was signed by Paulo Ricaurte as legal representant ("Representante Legal") of RGB&I and President and CEO of "APS Business & Investment Corp".

E. Complainant's filing

On February 19, 2024, in response to the Procedural Order No.1, the Complainant sent an email to the Center with several arguments and some annexes.

The Complainant stated the following:

- Regarding the existence on the Colombian trademark database of the BORBON COFFEE trademark application, the trademark is still at the application stage and will be subject to the Colombian Trademark Office's novelty examination.
- the Complainant is the owner in Colombia of the earlier registration No. 618478 for the figurative trademark CAFFE' BORBONE. This trademark is registered in the name of "L'Aromatika S.r.l.", which corresponds to the Complainant's previous name as evidenced by the history on its official website.
- the Complainant only received official notice of the filing of the Respondent's trademark application in Colombia on February 14, 2024, and is now taking action to challenge such application.
- the application appears to be filed in the name of RG Business and Investment Group Corporation Filial Colombia SAS, and the Complainant does not have information on the link between such company and the owner of the disputed domain name. Therefore, the owner of the Colombian trademark application for the mark BORBON COFFEE is not the Respondent and they do not have any indication on if and how these subjects are related.
- the Complainant's trademarks BORBONE and CAFFE BORBONE enjoy reputation, so that the filing of a substantially identical (or, at least, highly similar) trademark cannot be a coincidence and is itself evidence of the other party's bad faith.
- with respect to the photos submitted (many of which appear to be designs/renderings and therefore cannot be considered as valid proof of use of the mark) they are all undated and could be referred to a period subsequent to the filing of the complaint. Such images, therefore, cannot be taken into consideration.
- there is no evidence that could indicate that the Respondent started marketing products/services before this complaint has been filed.
- the Respondent states that its trademark revenues are about USD 150,000,000 per year, but there is no evidence to substantiate this statement, which should accordingly not be taken into consideration;
- on the web page "<https://www.cafedecolombia.com/particulares/empresas-y-marcas-autorizadas/>" a no data appears about BORBON COFFEE.
- there is no evidence of a connection between the owner of the disputed domain name and the use of the mark BORBON COFFEE, all the more so considering that the country indicated in the list is the U.S.A., while the Respondent's application for registration has been filed in Colombia;
- the trademark certification of use is dated February 6, 2024 and is therefore subsequent to the filing of the Complaint. In addition, it refers to the company "APS Business & Investment Corp", which has been dissolved.
- moreover, the license appears to relate to the use of the trademark "Café de Colombia" and there is no mention of the BORBON COFFEE trademark.
- Even today, the disputed domain name does not resolve to any active website.

F. Respondent's supplemental filing

In response to the Complainant's submission dated February 19, 2024, the Respondent filed an unrequested supplemental filing, that mostly repeated some of the arguments expressed in earlier submissions. For these reasons, this supplemental filing will not be considered, but in any event, doing so would have no incidence on the outcome of the Decision.

6. Discussion and Findings

A. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Spanish. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that: (i) the Respondent is familiar with English, as confirmed by the fact that the English language is used in the disputed domain name itself ("coffee") and (ii) in its relevant website contents, which are entirely in English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

At the same time, the Panel also notes that the Respondent submitted a Response, in Spanish, addressing the Complainant's contentions.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1). In the present case the Panel takes into account the fact that Respondent was able to answer all the claims of the Complaint which means that he understands English. The Respondent also states that operates in the U.S.A.. Also, the Respondent's webpage is in English and the footer of the website contains a reference to phone number in U.S.A. where English is the official language.

Having considered all the matters above, and the circumstances of this case, the Panel finds that accepting the Complaint filed in English does not prejudice the Respondent's right of defense, and the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English, accepts the Response filed in Spanish, but will proceed with rendering the decision in English.

B. Identical or Confusingly Similar

The Complainant has shown rights in respect of the CAFFÈ BORBONE and BORBONE marks for the purposes of the Policy. The Panel finds the marks are recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks 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.

C. 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.

The Panel finds that, before notice to the Respondent of the dispute, the Respondent made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods. [WIPO Overview 3.0](#), section 2.2.

As expressed in UDRP decisions, non-exhaustive examples of prior use, or demonstrable preparations to use the domain name, in connection with a bona fide offering of goods or services may include: (i) evidence of business formation-related due diligence/legal advice/correspondence, (ii) evidence of credible investment in website development or promotional materials such as advertising, letterhead, or business cards (iii) proof of a genuine (i.e., not pretextual) business plan utilizing the domain name, and credible signs of pursuit of the business plan, (iv) bona fide registration and use of related domain names, and (v) other evidence generally pointing to a lack of indicia of cybersquatting intent. While such indicia are assessed pragmatically in light of the case circumstances, clear contemporaneous evidence of bona fide pre-complaint preparations is required. [WIPO Overview 3.0](#), section 2.2.

Acknowledging that business plans and operations can take time to develop, panels have not necessarily required evidence of such use or intended use to be available immediately after registration of a domain name, but the passage of time may be relevant in assessing whether purported demonstrable preparations are bona fide or pretextual. [WIPO Overview 3.0](#), section 2.2.

If not independently verifiable by the panel, claimed examples of use or demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services cannot be merely self-serving but should be inherently credible and supported by relevant pre-complaint evidence. [WIPO Overview 3.0](#), section 2.2.

In relation to the existence and activity of the Respondent under BORBON COFFEE the Panel notes that:

- the complaint was filed on December 28, 2023.
- there is no evidence that a cease-and-desist letter or any other kind of communication was sent to Respondent before the filing of the Complaint.
- the disputed domain name was registered on August 16, 2022.
while the disputed domain name was not resolving to an active website at the time of the filing of the Complaint, the website to which the disputed domain name resolves currently is active and has information in English about Respondent products. There is, however, no evidence about when that webpage was activated.
- the Respondent’s trademark application (SD2023/0105037) BORBON COFFEE (& design) corresponding to the disputed domain name was filed on November 20, 2023.
- the Trademark Office of Colombia informs that the Respondent’s trademark application is pending final examination.
- the Panel visited the website of the Trademark Office of Colombia and was able to verify that the trademark was filed by a company named “RG Business and Investment Group Corporation Filial

- Colombia S.A.S.” (it’s representant is Andrei Sebastian Ricaurte, probably a person related to the Respondent since they share their last name).
- the design and trademark of the Respondent’s trademark is identical to the one being used in the disputed domain name.
 - the company “RG Business and Investment Group Corporation Filial Colombia S.A.s.” was apparently incorporated on October 26, 2018.
 - the footer of the disputed domain name contains a telephone number from the U.S.A. and from Colombia.
 - the photos attached to the response to the Procedural Order No.1 contains a mention of “RG Business and Investment Group Corporation Filial Colombia S.A.S”, and an email and the same telephone number from the U.S.A. as indicated in the website.
 - at the Colombian Coffee Growers website¹, there is an official list of companies authorized to export Colombian coffee to the U.S.A. in 2019 and the company named “RG Business and Investment Group” is mentioned in entry number 363 with an email assigned to “pricaurte” and the domain name of the company (probably Paulo Ricaurte). The domain name and the telephone coincide with the phone numbers listed in the banner of one of the photos attached by Respondent.
 - at the same website there is another list of trademarks authorized to be part of the program “Authorized trademarks for the Program 100% Colombian Coffee” (“Marcas Autorizadas Programa 100% Café de Colombia”). The name BORBON COFFE is mentioned there². However, there is no link to the Respondent.
 - The term “Bourbon” is a cultivar of Coffee, or a type of coffee and it is the reason, according to the Respondent, of the name chosen for the domain name.

It is thus conceivable on the record, and further supported by the Panel’s research ([WIPO Overview 3.0](#), section 4.8) that before notice of these proceedings over the disputed domain name, the Respondent apparently had made preparations to use the disputed domain name in connection with an offering of goods or services , as the Panel will discuss below.

On the record the Panel is not able to conclude whether or not the Respondent has a right or legitimate interest in respect of the disputed domain Name but on the balance of probabilities it is not possible to ignore that the Respondent apparently registered the disputed domain name and applied for a trademark before having notice of this dispute, without sufficient evidence to reach a conclusion as to the Respondent’s intention with the registration of the disputed domain name.

In view of the Panel’s finding under the third element, the Panel does not consider it necessary to reach a determination under the second element of the Policy.

D. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances shall be evidence of registration and use in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

¹ See <https://www.cafedecolombia.com/static/integrador/TOSTADO.pdf>

² See <https://www.cafedecolombia.com/particulares/wp-content/uploads/2023/11/2023-11-16-Listado-licenciatarios-y-marcas-autorizadas-Programa-1005-Cafei-de-Colombia.pdf>

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location."

Each of those circumstances requires, or implies, that a respondent must have known, or ought to have known, of a Complainant's rights. The Panel finds on the balance of probabilities that the Respondent did not have such knowledge.

The Complainant mentions but fails to offer evidence that the Respondent intentionally attempted to attract Internet users based on the trademark value of the Complainant's mark thereby indicating bad faith registration. On the record in this case, the Panel sees no evidence that the disputed domain name was registered nor used for such purpose. Rather it looks as if the Respondent has a business in Colombia and the U.S.A., which raises a reasonable question as to the reasons for the registration of the disputed domain name being unrelated to the Complainant. In addition, the Panel notes that while there are similarities between the disputed domain name and the Complainant's trademark, the Panel also considers plausible that the Respondent may have registered this disputed domain name due to the name of a type of coffee. On the other hand, when the disputed domain name is compared to the name designating the type of "bourbon coffee", the Panel also notes that a letter "u" is missing. The Panel further notes that the Respondent's logo for "BORBON COFFEE" when compared to the one of the Complainant's trademarks shows some differences, and the Parties' business while related or connected are not exactly the same.

The consensus view is that the general standard of proof under the UDRP is "on balance" - often expressed as the "balance of probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true. Conclusory statements unsupported by evidence which merely repeat or paraphrase the criteria or scenarios under paragraphs 4(b) of the UDRP would typically be insufficient ([WIPO Overview 3.0](#), section 4.7).

There is no material evidence before the Panel to indicate that the Respondent has attempted to profit from confusion between the Complainant's mark and the disputed domain name. There appears to be no advertising, nor pay per click uses of the disputed domain name, beyond reference to the Respondent's own products.

In this case, while there appear to be some gaps concerning the preparations for the apparent Respondent's business, and the use of the disputed domain name, the evidence is not sufficient as to conclude that the Respondent was targeting the Complainant's trademark. In these circumstances, the Complainant has not proved registration and use in bad faith. Therefore, the third requirement of the UDRP has not been satisfied and the Complaint must therefore be rejected.

Additionally, while the disputed domain name does not appear to involve a clear case of cybersquatting that the Policy was designed to address. The Panel considers that the nature of the present proceeding entails a broader dispute between what appears to be potentially two businesses established in different jurisdictions operating in connected business fields in a broad sense. The written submissions procedure provided under the Policy is not best suited to resolving such a case, where the issues are substantial, complex, and nuanced. Naturally this decision is wholly without prejudice of any recourse to trademark law and the jurisdictions where the Complainant may choose to pursue legal actions. For example, court proceedings may provide the Parties with an opportunity to conduct a fuller inquiry into the facts and circumstances of this matter with the benefit of discovery procedures, oral testimony, and cross-examination (see *PetSmart, Inc. v. Pet Mart*, WIPO Case No. [D2020-2065](#)).

7. Decision

For the foregoing reasons, the Complaint is denied.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: March 4, 2024.