

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Sebastien Garrasi  
Case No. D2023-2902

### **1. The Parties**

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

The Respondent is Sebastien Garrasi, Switzerland.

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

The disputed domain name <miscelaborbone.info> (the “Disputed Domain Name”) 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 July 6, 2023. On July 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 10, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 July 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Mariia Koval as the sole panelist in this matter on August 22, 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, founded in 1996, is one of the major producers specializing in coffee in compostable pods and compatible capsules, with a widespread sales network throughout Italy. The Complainant is considered one of the Italian coffee market leaders, produces every day around 96 tons of processed coffee in its Italian factories, which are distributed and appreciated all over the world. The Complainant's product "Caffè Borbone" received two stars in 2019 from the International Taste Institute. Also, in 2019 the Complainant won the 2019 Quality Award, the prize given to food products; in 2020, the Complainant was the winner of the Business Excellence Award 2020. The Complainant has seen an unparalleled 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 is the owner of numerous BORBONE and CAFFE BORBONE trademark registrations (the "BORBONE Trademark") around the world, among which are:

- Italian Trademark Registration for CAFFE BORBONE No. 0000895990, registered on June 9, 2003, in respect of good and services in classes 9, 30 and 42;
- European Union Trademark for BORBONE, Registration No. 15670532, registered on November 23, 2016, in respect of goods and services in classes 7, 11, 21, 30, 35, 37, 40 and 43;
- International Trademark Registration for CAFFE BORBONE, No. 1359499, registered on May 3, 2017, in respect of goods and services in classes 11, 30, 43;
- United States of America Trademark Registration for CAFFE BORBONE, No. 4356426, registered on June 25, 2013, in respect of goods and services in class 7, 30, 43.

The Complainant operates many domain names reflecting the BORBONE Trademark: <caffeborbone.com>, <borbone.com>, <caffe-borbone.eu>, <borbone-kaffeepads.ch> and many others, for sale and promoting its products under the BORBONE Trademark. The Complainant is also active on social media platforms such as Facebook, LinkedIn, Instagram and YouTube.

The Disputed Domain Name was registered on March 29, 2022. As of the date of this Decision the Disputed Domain Name resolves to a webpage containing the message "There's nothing here" and automatically redirects to the microblogging and social networking website "www.tumblr.com".

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

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

The Complainant contends that it has been acknowledged as one of the main Italian players in the portioned coffee sector (compatible capsules and pods), triumphs by winning both the prize as Absolute Winner and the one for the "Growth and Sustainability" category. The Complainant owns numerous BORBONE Trademark registrations in several jurisdictions.

The Complainant claims that the Disputed Domain Name is confusingly similar to the Complainant's BORBONE Trademark. The Disputed Domain Name is composed by the exact reproduction of the BORBONE Trademark to which has been added the term "miscela", which means "blend" in Italian. The presence of the term "miscela", which is descriptive in the coffee sector, merely emphasizes the link with BORBONE Trademark that is the only distinctive component of the Disputed Domain Name.

The Complainant also notes that when confronted with the Disputed Domain Name, Internet users and consumers will inevitably focus their attention on the term "BORBONE" and immediately associate it with the Complainant's almost identical BORBONE Trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Respondent is not known and cannot be known by the Disputed Domain Name, which clearly refers to the BORBONE Trademark and to which, as demonstrated above, the Complainant has rights. The Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the Disputed Domain Name. The Disputed Domain Name has been registered with use of the Complainant's well-known BORBONE Trademark to attract current and potential customers of the Complainant.

The Complainant also asserts that the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain in view of the Disputed Domain Name resolves to an empty Tumblr page displaying the following message: "There is nothing here" and this can be considered as a passive holding. Moreover, the content of the website under the Disputed Domain Name frequently changes and it also used to redirect to a website with pay-per-click ("PPC") links of competing products. The Complainant's BORBONE Trademark is distinctive and well-established; the Respondent has taken steps to conceal its identity through use of a privacy service; there is no conceivable good faith use to which the Disputed Domain Name could be put by the Respondent.

Additionally, the Respondent's misappropriation of the BORBONE Trademark by its inclusion in the Disputed Domain Name is no accident. Clearly, the Respondent chose to use the well-known BORBONE Trademark to divert Internet users from the Complainant's website by capitalizing on the association of term "BORBONE" with the Complainant's coffee products.

The Complainant further claims that the Respondent has registered and is using the Disputed Domain Name in bad faith. At the time of registration of the Disputed Domain Name by the Respondent, the Complainant's business with the BORBONE Trademark was well established. Therefore, considering the reputation of the Complainant's BORBONE Trademark 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 BORBONE Trademark. Therefore, it is obvious that the Respondent registered the Disputed Domain Name with the Complainant's BORBONE Trademark in mind. Moreover, the Disputed Domain Name exploits the reputation of the Complainant's BORBONE Trademark.

The following circumstances are further indications of bad faith registration and use of the Disputed Domain Name:

- there is no connection between the Respondent and the Complainant's BORBONE Trademark and company name;
- "BORBONE" is not a common or descriptive term, but is the Trademark in and to which the Complainant has demonstrated to have rights;
- because of the intensive use made by the Complainant, the Complainant's BORBONE Trademark, that represent the tradition and quality of the "caffè 15 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 BORBONE Trademark was used and registered long before the registration of the Disputed Domain Name and the Respondent could not have been unaware of the BORBONE Trademark 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 BORBONE Trademark;
- the addition of the word "miscela" to the BORBONE Trademark is insufficient for avoiding Internet user confusion. On the contrary, the use of the term "miscela" emphasizes the likelihood of confusion, given that it is the Italian term for "blend", that is directly linked to the Complainant's activities;
- the Disputed Domain Name now resolves to Tumblr page lacking any contents;
- the Respondent's identity was not known since it has been masked;

- the Disputed Domain Name used to resolve to parking page showing PPC in the coffee field including products competitive with the Complainant's ones;
- the purpose of the Respondent in registering the Disputed Domain Name was to mislead, confuse and divert consumers or to tarnish the well-known BORBONE Trademark.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

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

The Complainant has properly asserted its rights in the BORBONE Trademark due to the long use and numerous registrations worldwide.

The Disputed Domain Name completely reproduces the Complainant's BORBONE Trademark in combination with the term "miscela" and the generic Top-Level Domain ("gTLD") ".info". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. In this case, the addition of the term "miscela" ("blend" in English) to the BORBONE Trademark does not prevent a finding of confusing similarity and does not change the overall impression of the Disputed Domain Name as being confusingly similar to the Complainant's Trademark.

Also, pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

In light of the above, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's BORBONE Trademark, and that the Complainant has established the first condition of paragraph 4(a) of the Policy.

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

The Complainant has used its BORBONE Trademark for more than 20 years, which is long before the Respondent registered the Disputed Domain Name in 2022. The Complainant contends that it has neither authorized, nor somehow given its consent to the Respondent to register or use the Disputed Domain Name.

The Panel considers that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. There is no evidence that the Respondent appears to own any BORBONE Trademark, nor is the Respondent commonly known by the Disputed Domain Name. Furthermore, in this case, the Respondent, having a chance to invoke any circumstances for demonstration of his rights or legitimate interests in the Disputed Domain Name, did not reply to the Complaint, and consequently has not rebutted the Complainant's *prima facie* case.

The Respondent is not using the Disputed Domain Name to offer *bona fide* goods and services or making a legitimate non-commercial or fair use of the Disputed Domain Name. As at the date of this Decision the Disputed Domain Name resolves to a webpage containing the message “There’s nothing here” and automatically redirects to the social networking website “www.tumblr.com”. Moreover, the content of the website under the Disputed Domain Name frequently changes and, according to the evidence presented by the Complainant, it also used to redirect to a website with PPC links of competing products. In accordance with the [WIPO Overview 3.0](#), section 2.9 applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. Therefore, such use of the Disputed Domain Name by the Respondent gives no grounds for considering its use in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Also, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The addition of the term “miscela” (in English “blend”), which is broadly used for describing of special types of coffee, to the Complainant’s BORBONE Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant’s BORBONE Trademark and business at the time of registration of the Disputed Domain Name and has done so for the purpose of creating a clear impression that the Disputed Domain Name is connected with the Complainant’s BORBONE Trademark.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

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

Paragraph 4(b) of the Policy indicates some circumstances, 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:

- (i) circumstances indicating that you [respondent] 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
- (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 online 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.

The Complainant obtained the registration of the BORBONE Trademark almost 20 years earlier than the Respondent registered the Disputed Domain Name in 2022. Having considered that the Complainant has spent huge amount of efforts to promote its BORBONE Trademark, the Panel finds that the Respondent was aware of the reputation of the BORBONE Trademark when registering the confusingly similar Disputed Domain Name that completely incorporates the Complainant’s BORBONE Trademark, as well as the Complainant’s company name, with the addition of the term “miscela” relating to the coffee production

business operated by the Complainant. The Panel considers it is obvious bad faith that the Respondent deliberately chose the Disputed Domain Name to create a likelihood of confusion with the Complainant's BORBONE Trademark so as to create a false association or affiliation with the Complainant.

The Panel finds that, taking into consideration all circumstances of this case, the Disputed Domain Name has been registered and used in bad faith, with the Respondent's awareness of the Complainant and the Complainant's BORBONE Trademark and with the Respondent's intention to benefit from the likelihood of confusion between the Disputed Domain Name and the Complainant's BORBONE Trademark.

The Disputed Domain Name resolves to a webpage containing the message "There's nothing here" and automatically redirects to the social networking website. The Panel finds that the Respondent's attempt to attract Internet users to visit networking website, by registering and using a domain name that is confusingly similar to the Complainant's BORBONE Trademark, constitutes bad faith.

In addition, according to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's famous BORBONE Trademark, intended to disrupt the Complainant's business and confuse Internet users seeking for or expecting the Complainant. In view of the absence of any evidence to the contrary and that the Respondent did not file any response to claim otherwise, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being used 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, <miscelaborbone.info>, be transferred to the Complainant.

*/Mariia Koval/*

**Mariia Koval**

Sole Panelist

Date: September 5, 2023