

## **ADMINISTRATIVE PANEL DECISION**

Caffè Borbone S.r.l. v. Nitish Ghuse

Case No. DNL2023-0002

### **1. The Parties**

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

The registrant of the disputed domain name is Nitish Ghuse, India, (the “Respondent”).

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

The disputed domain name <caffeborbone.nl> is registered with SIDN through 1API GmbH.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 13, 2023. On January 13, 2023, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name.

On January 16, 2023, SIDN 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 January 20, 2023, providing the information disclosed by SIDN, and inviting the Complainant to amend the Complaint in this light. The Complainant filed an amended Complaint on January 23 and 24, 2023.

The Center verified that the Complaint as amended satisfies the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint and the proceedings commenced on January 25, 2023. In accordance with the Regulations, article 7.1, the due date for Response was February 14, 2023. The Center did not receive any response. Accordingly, the Center notified the Respondent’s default on February 15, 2023.

The Center appointed Thijs van Aerde as the panelist in this matter on March 7, 2023. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

#### 4. Factual Background

The Complainant is an Italian coffee manufacturing company. It is one of the leading Italian coffee makers. The Complainant has been recognized as a primary Italian player in the coffee sector and has won several prizes, demonstrating such position.

The Complainant holds, *inter alia*, the following trademark registrations (the “Trademarks”):

- European Union trademark CAFFÈ BORBONE, registered on January 11, 2006, registration no. 902614; and
- European Union trademark BORBONE, registered on November 23, 2016, registration no. 015670532.

Furthermore, the Complainant owns a number of domain names reflecting the Trademarks.

The disputed domain name was registered on May 29, 2022, and according to the evidence in the Complaint resolved to a pay-per-click page. At the time of this decision the disputed domain name does not resolve to an active website.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant’s contentions may be summarized as follows.

- (a) The Complainant contends that the disputed domain name is identical and confusingly similar to the Complainant’s trademark CAFFÈ BORBONE in which the Complainant has rights. The disputed domain name identically reproduces the Complainant’s trademark CAFFÈ BORBONE and fully reproduces the Complainant’s trademark BORBONE. Thus, when confronted with the disputed domain name, Internet users and consumers will inevitably and immediately associate it with the Trademarks.

The “.nl” Top-Level extension in the disputed domain name does not affect and cannot mitigate the confusion between the Trademarks and the disputed domain name.

- (b) The Respondent has no rights to or legitimate interests in the disputed domain name. The Respondent is not known by the disputed domain name. There are no trademark registrations for CAFFE BORBONE in the name of any parties other than the Complainant, except for one (opposed) application in Argentina, which is not in the name of the Respondent but in the name of a third party.
- (c) The disputed domain name was registered and is being used in bad faith by the Respondent. The Respondent knew or should have known about the Trademarks. At the time of registration of the disputed domain name by the Respondent on May 29, 2022, the Complainant’s business with the Trademarks was well established.

The Respondent was also respondent for three similar WIPO domain name disputes which concerned reputed trademarks (*Medtronic, Inc. v. Nitish Ghuse*, WIPO Case No. [D2018-2387](#); *Zv Holding v. Nitish Ghuse*, WIPO Case No. [DNL2019-0052](#); *Crédit Agricole S.A. v. Nitish Ghuse*, WIPO Case No. [DNL2019-0006](#)) and the Respondent is the owner of several domain names which incorporate well-known trademarks.

Further indications of bad faith are:

- There is no connection between the owner of the disputed domain name and the Complainant’s

- trademark CAFFÈ BORBONE, its company name and its principal domain name <caffeborbone.com>;
- “caffè borbone” is not a common or descriptive term;
- The Trademarks are reputed in Italy and abroad and have been so before the registration of the disputed domain name;
- The disputed domain name incorporates, without any authorization or approval, the Complainant’s trademark CAFFÈ BORBONE;
- The disputed domain name resolves to a page on which various pay-per-clicks for products competitive with the Complainant’s ones are displayed;
- According to a screen print dated January 12, 2023, the disputed domain name was on sale for a bid of EUR 1,999.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to article 2.1 of the Regulations the Complainant must prove each of the following three elements:

- a. the disputed domain name is identical or confusingly similar to:
  - I) a trademark or trade name protected under Dutch law in which the Complainant has rights; or
  - II) a personal name registered in the General Municipal Register (*Gemeentelijke Basisadministratie*) of a municipality in the Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in the Netherlands under which the Complainant undertakes public activities on a permanent basis; and,
- b. the Respondent has no rights or legitimate interests in the disputed domain name; and
- c. the disputed domain name has been registered or is being used in bad faith.

As the Respondent has not filed a response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or in fact.

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

The Complainant established that it has rights in the Trademarks. The Panel finds the disputed domain name is almost identical and confusingly similar to the Trademarks. It almost entirely incorporates the trademark CAFFÈ BORBONE and fully contains the trademark BORBONE.

The country code Top-Level Domain “.nl” may be disregarded when assessing the confusing similarity between the domain name on the one hand, and the relevant trademark on the other hand, see *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. [DNL2008-0008](#).

The Panel finds that the Complainant has fulfilled the requirements of article 2.1(a) of the Regulations.

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

Under article 2.1(b) of the Regulations, a complainant must make at least a *prima facie* showing that a respondent possesses no rights to or legitimate interests in a disputed domain name. See, *Auto 5 v. E. Shiripour*, WIPO Case No. [DNL2008-0027](#), and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1.<sup>1</sup> Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the Regulations.

The Complainant contends that the Respondent is not known by the disputed domain name. The Panel accepts this. Furthermore, there appear to be no trademark registrations and/or applications for CAFFE BORBONE in the name of the Respondent. Thus, the Panel finds that the Complainant has established a *prima facie* case that the Respondent does not have any rights to or legitimate interests in the disputed domain name, while the Respondent has failed to come forward with any evidence to the contrary and meet its burden of production.

The Respondent has not responded to the Complainant’s contentions. Neither has the Respondent availed itself of demonstrating any rights or legitimate interests on its part through *inter alia* by producing evidence of demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services (see, article 3.1(a) of the Regulations).

The Panel concludes that the Respondent does not have rights to or legitimate interests in the disputed domain name and that the Complainant has satisfied the second limb of article 2.1 of the Regulations.

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

Article 3.2 of the Regulations provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith, see [WIPO Overview 3.0](#), section 3.1:

- (a) 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 registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
- (b) 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
- (c) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (d) 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.

The Complainant claims that the Respondent registered the disputed domain name having knowledge of the Complainant, its Trademarks and its trade name. The Panel finds that the Complainant’s trademark CAFFÈ BORBONE can sufficiently identify the Complainant and its business activities. At the time of registration of

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<sup>1</sup> In view of the fact that the Regulations are substantially similar to the Uniform Domain Name Dispute Resolution Policy (“UDRP”), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore [WIPO Overview 3.0](#), may be relevant to the determination of this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

the disputed domain name on May 29, 2022, the Trademarks were well established. The reputation of the Complainant and its trademarks were confirmed by the panel in *Caffè Borbone S.r.l. v. Beats, Beats*, WIPO Case No. [D2022-0824](#). These facts show that it may be accepted that the Respondent had knowledge of the Complainant's trademark and reputation when it acquired the disputed domain name.

Moreover, the Respondent has engaged, without any authorization or approval, in the registration of the disputed domain name, which incorporates almost entirely the Complainant's registered trademark CAFFÈ BORBONE.

The Panel further notes that according to a dated screen shot provided by the Complainant, on January 12, 2023, the disputed domain name resolved to a webpage that displayed pay-per-click links related to the Complainant's products. The Panel also notes that the disputed domain name is being offered for sale for a minimum bid of EUR 1,999. The Complainant provided evidence dated January 12, 2023, that the disputed domain name was being offered for sale. From these facts, it may be accepted that the Respondent attempted to take unfair advantage of the similarity between the disputed domain name and the Complainant's trademark.

Furthermore, the Respondent has been involved in previous WIPO domain name disputes which were similar to this dispute, and the Respondent is the owner of several domain names which correspond to well-known signs.

The above circumstances evidence registration and use in bad faith in the sense of article 3.2 (a) and (d) of the Regulations. Consequently, the Panel finds that the Respondent registered and used the disputed domain name in bad faith and that the requirement of article 2.1(c) of the Regulations has been met.

## **7. Decision**

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain name <caffeborbone.nl> be transferred to the Complainant.

*/Thijs van Aerde/*

**Thijs van Aerde**

Panelist

Date: March 20, 2023