

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Elena Altaravichene
Case No. DNL2023-0014

1. The Parties

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

The registrant of the disputed domain names is Elena Altaravichene, Belgium (the “Respondent”).

2. The Domain Names and Registrar

The disputed domain names <borbonecoffee.nl> and <caffeborboneonline.nl> are registered with SIDN through Realtime Register.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 21, 2023. On April 24, 2023, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain names.

On April 25, 2023, SIDN transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 28, 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 May 2, 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 May 8, 2023. In accordance with the Regulations, article 7.1, the due date for Response was May 28, 2023. The Response was filed with the Center on May 27, 2023.

On June 1, 2023, SIDN commenced the mediation process. On June 6, 2023, SIDN informed parties that the dispute had not been solved in the mediation process.

The Center appointed Alfred Meijboom as the panelist in this matter on June 19, 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 producer which was established in 1996. The Complainant is owner of the stylized International trademark CAFFÈ BORBONE with registration number 902614, registered on January 11, 2006 for goods and service in classes 9, 30, 43, designating, *inter alia*, the European Union, as well as stylized European Union trademark BORBONE with registration number 015670532, registered on November 23, 2016 for goods and services in classes 7, 11, 21, 30, 35, 37, 40 and 43.

The Respondent registered the disputed domain name <caffeborboneonline.nl> on October 16, 2021 and the disputed domain name <borbonecoffee.nl> on October 17, 2021. The disputed domain names do not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain names are confusingly similar to the Complainant's trademarks as the disputed domain names incorporates the BARBONE trademark in its entirety, the disputed domain name <caffeborboneonline.nl> incorporates the Complainant's trademark CAFFÈ BORBONE in its entirety, and the disputed domain name <borbonecoffee.nl> is also almost identical to the Complainant's trademark CAFFÈ BORBONE, with the Italian word "caffè" replaced by the English equivalent "coffee".

The Complainant further alleges that it has neither authorized, nor otherwise given its consent to the Respondent to register and / or use the disputed domain names, and has never filed a trademark registration for the terms incorporated in the disputed domain names. According to the Complainant, the Respondent had registered domain names in generic Top-Level Domains ("TLDs") incorporating the Complainant's trademarks which she voluntarily transferred to the Complainant. The Respondent did, however, never replied to the Complainant's request to also transfer the disputed domain names, and promised to transfer two other domain names with country-code TLDs which contains the Complainant's trademarks, but has not yet done so.

The Complainant alleges that at the time of registration of the disputed domain names the Complainant's business was well established, so that the Respondent knew or should have known about the existence of the Complainant's earlier trademarks. The Complainant also alleges that the Respondent has used the disputed domain names in bad faith, *inter alia*, in absence of a connection between the Complainant and the Respondent, and because the disputed domain names do not resolve to an active website and are therefore neither used to offer goods or services to the public, nor for legitimate commercial or noncommercial use without the intention of misleading Internet users.

B. Respondent

In her Response, the Respondent alleges that the disputed domain names were registered because she wanted to collaborate with the Complainant, which never occurred despite several request through the Complainant's website. The Respondent states that she does not want to keep the disputed domain names, and actually asked the registrar to cancel the registrations. The Respondent concludes "I agree voluntary to provide this registration to the Complainant as fast as this possible," adding that she "would like to protest the formulating the registering of this domain names as bad faith".

6. Discussion and Findings

As a threshold matter, the Panel must decide whether to address the conditions for transfer under article 2.1. of the Regulations, or rather to grant a transfer as requested in the Response, without assessment of these conditions. Prior decisions under the Uniform Domain Name Dispute Resolution Policy (“UDRP”¹) (that served as a basis for the Regulations) illustrate that it is within the Panel’s discretion to choose either approach (e.g., *United Pet Group Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1039](#) finding that a detailed merits discussion is not necessary when both parties have consented to a transfer order, and finding that a full discussion of the merits was appropriate despite Respondent’s alleged willingness to unilaterally transfer).

Section 4.10 of the [WIPO Overview 3.0](#) states that a panel, at its discretion may find it appropriate to provide a substantive decision on the merits, regardless of the Respondent having given its consent to transfer of the disputed domain name: “[s]cenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent’s consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights”.

In this case, the Panel considers that the Complainant has alleged that the Respondent owns two other domain names containing the Complainant’s trademarks, while the Respondent expressly protested the Complainant’s assertion that she registered the disputed domain names in bad faith. As in *Alibaba Group Holding Limited. v. De Chinese Handelsplaats B.V.*, WIPO Case No. [DNL2019-0027](#), a substantive decision may therefore be of assistance to the Complainant and other panels under the Regulations. Under these circumstances, the Panel shall provide a substantive decision on the merits.

Based on article 2.1 of the Regulations, a request to transfer the disputed domain name must meet three cumulative conditions:

- 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 to or legitimate interests in the disputed domain name; and
- c. the disputed domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

With regard to the assessment of identity or confusing similarity, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain names (see section 1.7 of [WIPO Overview 3.0](#)). It is also well established precedent that the ccTLD “.nl” may be disregarded in assessing confusing similarity between the trademark on the one

¹ While the Complaint is brought under the Regulations, and not the UDRP, given the similarities between the two, where applicable, the Panel considers UDRP precedent and the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) relevant to the current proceeding, and will refer to it where appropriate.

hand and the disputed domain names on the other hand (see, e.g., *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. [DNL2008-0008](#)).

The Complainant showed that it has rights in trademarks protected under Dutch law. The disputed domain name <caffeborboneonline.nl> incorporates the Complainant's CAFFÈ BORBONE trademark in its entirety, just adding "online" which does not prevent a finding of similarity. And the disputed domain name <borbonecoffee.nl> includes the BORBONE trademark in its entirety, with the addition of "coffee" which also does not prevent a finding of confusing similarity under the Regulations.

Consequently, the Panel finds that the Complainant has satisfied the requirement of article 2.1 sub a. of the Regulations.

B. Rights or Legitimate Interests

Article 2.1 sub b. of the Regulations requires the Complainant to establish that the Respondent has no rights to or legitimate interests in the disputed domain names. This condition is met if the Complainant makes out a *prima facie* case that the Respondent has no such rights or legitimate interests and if the Respondent fails to rebut this (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd.*, WIPO Case No. [DNL2008-0002](#)).

The Complainant's allegations that the Respondent is not known under the disputed domain names or that the Respondent was never authorized or otherwise licensed to register and use the disputed domain names remains undisputed.

In her response, the Respondent does not claim any rights or legitimate interests in the disputed domain names.

Therefore, the Panel finds that the Complainant has satisfied the requirement of article 2.1 sub b. of the Regulations.

C. Registered or Used in Bad Faith

Article 2.1 sub c. of the Regulations requires the Complainant to show that the disputed domain names were registered or is being used in bad faith.

According to the Response, following registration of the disputed domain names, the Respondent has asked the Complainant several times to collaborate, more partially to sell the Complainant's products online. This confirms that the Respondent must have been aware of the Complainant's trademarks when she registered the disputed domain names, and had those trademarks in mind at the moment of registration. The registration of the disputed domain names was therefore made in bad faith.

As it has been established that the disputed domain names were registered in bad faith, the Panel finds that the requirements of article 2.1(c) of the Regulations have also been met.

7. Decision

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

/Alfred Meijboom/

Alfred Meijboom

Panelist

Date: June 19, 2023