

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Ismael Perez
Case No. D2024-2638

1. The Parties

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

The Respondent is Ismael Perez, Ecuador.

2. The Domain Name and Registrar

The disputed domain name <caffeborboneecuador.com> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 27, 2024. On June 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 2024, 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 (Redacted for Privacy, Privacy Service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 1, 2024, 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 July 3, 2024.

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 July 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 26, 2024.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on August 5, 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 factual findings pertinent to the decision in this case are that:

(1) the Complainant is an Italian company doing business under the trademarks CAFFÈ BORBONE and BORBONE which it uses in respect of coffee products, coffee machines, coffee roasters, bar services and cafés;

(2) the Complainant is the owner of, inter alia, Italian trademark Reg. No. 0000895990, filed January 19, 2000 and registered June 9, 2003, for the trademark, CAFFÈ BORBONE (figurative);

(3) the disputed domain name was registered on April 29, 2024, and resolves to a webpage with pay-per-click (“PPC”) links to coffee products put on the market by the Complainant’s competitors in business; and

(4) there is no relationship between the Parties and the Complainant has not authorized the Respondent to use any of its trademarks or to register any domain name incorporating any of those marks.

5. Parties’ Contentions

A. Complainant

The Complainant asserts trademark rights in CAFFÈ BORBONE and BORBONE. It holds national and pan-national registrations for those trademarks and submits that the disputed domain name is confusingly similar to the trademarks.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name because it has no trademark rights; it is not known by the disputed domain name; and the use of the disputed domain name is not bona fide since it redirects Internet users to the goods of the Complainant’s competitors.

The Complainant alleges that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant accordingly requests the Panel to order transfer of the disputed domain name.

B. Respondent

The Respondent did not submit a Response.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

(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.

It is the responsibility of the Panel to consider whether the requirements of the Policy have been met, regardless of the fact that the Respondent failed to submit a response. Having considered the Complaint and the available evidence, the Panel finds the following:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to the trademark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trademark rights. It is accepted that a trademark registered with a national authority is evidence of trademark rights for the purposes of the Policy.¹ For the purposes of this Decision, the Panel need only consider the Complainant's assertion of trademark rights in CAFFÈ BORBONE which it finds proven by reason of registration of that trademark² with the Italian Patent and Trademark Office, a national authority.

For the purposes of comparing the disputed domain name with the trademark, the generic Top-Level Domain (“gTLD”) “.com” can be disregarded.³ The standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name. The entirety of the mark is reproduced and remains recognizable within the disputed domain name despite addition of the term “ecuador”. The Panel finds that the disputed domain name is confusingly similar to the trademark.⁴

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the disputed domain name. Nevertheless, it is well settled that the Complainant may first make out a prima facie case, after which the burden of production shifts to the Respondent to rebut such prima facie case by providing evidence demonstrating rights or legitimate interests in the disputed domain name.⁵

Notwithstanding the lack of a response to the Complaint, paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

¹See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

²The Panel observes that all the registrations for CAFFÈ BORBONE referred to in the Complaint are for figurative versions of those words. However, for the purposes of paragraph 4(a)(i) of the Policy they can be treated by the Panel as registrations for the word mark. See section 1.10 of the [WIPO Overview 3.0](#).

³See section 1.11.1 of the [WIPO Overview 3.0](#).

⁴See section 1.7 and 1.8 of the [WIPO Overview 3.0](#).

⁵See section 2.1 of the [WIPO Overview 3.0](#); see also *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

The Respondent's name does not suggest that the Respondent might be commonly known by the disputed domain name, and the Panel finds no other evidence that the Respondent might be known by the disputed domain name.

Further, the Complainant states that there is no association between the Parties and the Panel finds that there is nothing to contradict that claim. There is no evidence that the Respondent has any trademark rights. The disputed domain name resolves to a website as described with various PPC links to coffee products or coffee machines competitive with products made and sold by the Complainant under the trademark. Countless decisions under the Policy have held that such use does not give rise to either rights or a legitimate interest in a domain name corresponding with another's trademark.⁶

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the Respondent in failing to reply to the Complainant's contentions has not rebutted such prima facie case.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and so the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out circumstances, which shall be evidence of the registration and use of a domain name in bad faith. They are:

"(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

(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 Panel finds that use of the disputed domain name is caught by subparagraph 4(b)(iv) above. The Panel has already found the disputed domain name to be confusingly similar to the trademark for the purposes of the Policy.

Further, the Panel finds that the use of the domain name is for commercial gain, most likely by way of PPC revenue as alleged by the Complainant. In terms of subparagraph 4(b)(iv), the Panel finds that the Respondent has used the disputed domain name intending to attract Internet users to its webpage by causing a likelihood of confusion as to the source or endorsement of that webpage.

⁶See section 2.9 of the [WIPO Overview 3.0](#).

Even if the PPC links are “automatically” generated, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).⁷

The Panel finds that the Complainant has satisfied the third and final element 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 <caffeborboneecuador.com> be transferred to the Complainant.

/Debrett G. Lyons/

Debrett G. Lyons

Sole Panelist

Date: August 19, 2024

⁷See section 3.5 of the [WIPO Overview 3.0](#).