

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Hueseyin Ak
Case No. D2024-2639

1. The Parties

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

The Respondent is Hueseyin Ak, Switzerland.

2. The Domain Name and Registrar

The disputed domain names <caffeborboneswitzerland.shop> and <caffeborboneswitzerland.store> are registered with Ascio Technologies 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 July 3, 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 (Not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 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 5, 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 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 29, 2024.

The Center appointed Alissia Shchichka as the sole panelist in this matter on August 2, 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 Caffè Borbone S.r.l., established in 1996 in Naples, Italy and named after the Bourbon royal family, is an Italian coffee company that produces approximately 96 tonnes of coffee daily. The company is active in the production of capsules, coffee beans, and ground coffee, with products distributed internationally. In 2019, Caffè Borbone was recognized by the International Taste Institute and received the 2019 Quality Award. In 2020, the company received the Business Excellence Award for its notable performance, and it is now considered one of Italy's leading brands in the portioned coffee sector.

The Complainant has evidenced to be the registered owner of numerous trademark registrations, containing the term CAFFÈ BORBONE, including, but not limited, to the following:

- International Trademark Registration No. 902614, registered on January 11, 2006, for the figurative mark CAFFÈ BORBONE, in classes 9, 30, and 43;
- European Union Trade Mark No. 15670541, registered on November 23, 2016, for the figurative mark CAFFÈ BORBONE, in classes 7, 11, 21, 30, 35, 37, 40, and 43.

The Complainant is also the owner of the domain name <caffeborbone.com>, registered on May 19, 2012. Additionally, the Complainant owns numerous generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”) domain names comprising its CAFFÈ BORNONE trademark, such as the domain names <caffe-borbone.shop>, registered on December 15, 2022, and <caffeborbone.store>, registered on October 25, 2021, most of which redirect to the main corporate website “www.caffeborbone.com”.

The Complainant's trademarks were registered before the disputed domain names, <caffeborboneswitzerland.shop> and <caffeborboneswitzerland.store>, which were both registered on March 31, 2024. At present, these domain names lead to inactive parking pages of a hosting provider.

The Respondent, according to the disclosed Whois information for the disputed domain names, is located in Switzerland.

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 names.

According to the Complainant, the disputed domain names are confusingly similar to the Complainant's trademark CAFFÈ BORBONE as they incorporate the entire trademark. The addition of the term “switzerland” to the CAFFÈ BORBONE trademark, does not alter the overall impression that the disputed domain names are associated with the Complainant's trademark or prevent the confusing similarity between the disputed domain names and the Complainant's trademark. In respect of the generic Top-Level Domains (“gTLDs”) “.shop” and “.store”, which form part of the disputed domain names, the Complainant requests that the Panel disregard them under the first element as they are a standard registration requirement.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names since (1) the Respondent is not known by the CAFFÈ BORBONE trademark or the disputed domain names, and there are no trademark registrations or applications for CAFFÈ BORBONE in the Respondent's name; (2) the Complainant has not authorized or consented to the Respondent's registration or use of the disputed domain names; (3) the disputed domain names were registered to exploit the Complainant's well-known trademark for commercial gain, misleadingly diverting consumers, without any legitimate noncommercial or fair use by the Respondent.

Finally, the Complainant contends that the domain names were registered and are being used in bad faith since: (1) the domain names identically reproduce the Complainant's trademark with the addition of a geographic term, "switzerland", leading to a heightened likelihood of confusion and suggesting unauthorized sponsorship or endorsement by the Complainant; (2) there is no connection between the Respondent and the Complainant's trademark, which is distinctive and well-known; (3) the Respondent registered the disputed domain names with knowledge or willful blindness of the Complainant's rights, depriving the Complainant of the opportunity to register the disputed domain names and unfairly exploiting the reputation and distinctiveness of the Complainant's trademark; and (4) the disputed domain names resolve to inactive websites, indicating passive holding in bad faith.

The Complainant requests that the disputed domain names be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving:

- (i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The distinctive textual elements of the mark are reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7 and 1.10.

Although the addition of other terms, here, “switzerland”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. 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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names.

Indeed, the Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the CAFFÈ BORBONE trademarks or to seek registration of any domain name incorporating the trademarks. The Respondent is also not known to be associated with the CAFFÈ BORBONE trademarks, and there is no evidence showing that the Respondent has been commonly known by the disputed domain names. [WIPO Overview 3.0](#), section 2.3.

Furthermore, the Panel notes that the disputed domain names are inactive and that no potential legitimate interests are apparent on the record.

Finally, the Panel also notes that the composition of the disputed domain names carries a risk of implied affiliation or suggests sponsorship and/or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Complainant has provided evidence supporting its prima facie claim that Respondent lacks any rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but 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.

On the issue of registration, the Panel finds that, in light of i) the prior registration and use of the Complainant's trademark CAFFÈ BORBONE in connection with the Complainant's products, including online via the Complainant's website at <caffeborbone.com>, ii) the distinctive nature of the CAFFÈ BORBONE trademark, and iii) the confusing similarity of the disputed domain names with the Complainant's trademark, as well as similarity to the Complainant's own registered domain names, the Respondent likely registered the disputed domain names having the Complainant's trademark in mind. [WIPO Overview 3.0](#), section 3.2.2.

As to the use of the disputed domain names, the Panel notes that, as mentioned above, they are pointed to a mere parking page of a hosting provider. As indicated in section 3.3 of the [WIPO Overview 3.0](#), "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

In the case at hand, in view of i) the distinctiveness of the Complainant's prior trademark CAFFÈ BORBONE, ii) the Respondent's failure to submit a Response or to provide any evidence of good-faith use; and iii) the implausibility of any good faith use to which the inherently misleading disputed domain names, incorporating the Complainant's trademark and a geographic term, may be put, the Panel finds that the Respondent's passive holding of the disputed domain names does not prevent a finding of bad faith.

The Panel finds that the Complainant has established the third 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 names <caffeborboneswitzerland.shop> and <caffeborboneswitzerland.store> be transferred to the Complainant.

/Alissia Shchichka/

Alissia Shchichka

Sole Panelist

Date: August 16, 2024