

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Z X
Case No. DRO2025-0001

1. The Parties

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

The Respondent is Zhu Xumei, China.

2. The Domain Name and Registrar

The disputed domain name <caffeborbone.ro> is registered with ROTLD (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 20, 2025. On January 20, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 21, 2025, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 23, 2025, 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 January 27, 2025.

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 January 28, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 17, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 20, 2025.

The Center appointed Charles Gielen as the sole panelist in this matter on February 25, 2025. 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 an Italian company active in the coffee industry. Founded in 1996 in Naples, it owes its name to the famous royal family and to Charles III of Bourbon. The Complainant produces every day around 96 tons of processed coffee in its Italian factories. The Complainant's products (namely, capsule, coffee beans, ground coffee) are distributed all over the world. The Complainant received two stars in 2019 from the International Taste Institute. In the same year, the Complainant also won the 2019 Quality Award, the prize given to food products (Food & Beverage) through sensory tests conducted by independent laboratories specializing in sensory analysis. In 2020, the Complainant was the winner in the ceremony for the awarding of the Business Excellence Award 2020 which took place at the Teatro Manzoni in Milan.

The Complainant owns registrations for its CAFFÈ BORBONE trade mark (figurative mark, consisting of the words CAFFÈ BORBONE and device), including for instance European Union Trade Mark No. 15670541, registered on November 23, 2016, as well as International Registration No. 902614, designating the European Union and Russian Federation, registered on January 11, 2006. The Complainant owns a number of domain names featuring the Complainant's trade mark, redirecting to its official website at "www.caffeborbone.com".

The disputed domain name was registered on November 29, 2024, and resolves to a website featuring pay-per-click links to websites in the area of the Complainant's business.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's trade mark. In particular, the disputed domain name is composed of the exact reproduction of the Complainant's trade mark CAFFÈ BORBONE to which has been added the country-code Top-Level Domain ("ccTLD") ".ro". The applicable ccTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trade mark.

Furthermore, the Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant gives several reasons for this. First, the Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name. Second, the Respondent is not commonly known by the disputed domain name and does not offer any genuine goods or services. Research in national and international trade mark databases shows that the Respondent does not own any registrations for the trade mark CAFFÈ BORBONE. Third, the website to which the disputed domain name redirects shows pay-per-click links which bring the Internet user to websites of companies offering products in the same field as the Complainant. This can never be considered as a bona fide offering of goods or services.

Finally, the Complainant argues that the Respondent registered and is using the disputed domain name in bad faith. The following reasons for this are given by the Complainant. At the time of registration of the disputed domain name, the Complainant's business with its trade mark was well established. Considering the reputation of the Complainant's trade mark before the registration of the disputed domain name, the Respondent "knew or should have known" about the existence of the earlier Complainant's trade mark. The disputed domain name exploits the reputation of the Complainant's trade mark. There is no connection between the owner of the disputed domain name and the relevant distinctive sign reproducing the Complainant's trade mark, company name, and Complainant's principal domain name. The Complainant's trade mark is not a common or descriptive term. Because of the intensive use made by the Complainant, the

Complainant's trade mark is reputed all over the world and was so also before the registration of the disputed domain name. The Complainant's trade mark was used and registered long before the registration of the disputed domain name and the Respondent could not have been unaware of it 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 Complainant's trade mark.

Furthermore, the Complainant contends that the disputed domain name was registered with the aim of taking advantage of the reputation of the Complainant's trade mark for a commercial purpose, in order to mislead and divert the Complainant's consumers into a parking page displaying pay-per-click links, for which the Respondent purportedly earns money. These links bring the Internet user to websites of companies offering products in the same field as the Complainant. This is a clear indication of bad faith. In fact, the purpose of the Respondent in registering the disputed domain name was to mislead, confuse and divert consumers or to tarnish the well-known CAFFÈ BORBONE mark. The bad faith of the Respondent also follows from the fact that the Respondent has indicated false address data when registering the disputed domain name and employed a privacy service to hide its identity, which past panels have held serves as further evidence of bad faith registration and use. Moreover, two days after submission of the Complaint, Respondent sent Complainant an offer to sell the disputed domain name to Complainant for 1,995 USD.

B. Respondent

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

6. Discussion and Findings

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 trade mark 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 trade mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.2.1). Assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. Thus, the Panel disregards the design element of the Complainant's trade mark for the purposes of the confusing similarity check ([WIPO Overview 3.0](#), section 1.10). The entirety of textual portion of the mark CAFFÈ BORBONE is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.7).

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 name. 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 name such as those enumerated in the Policy or otherwise.

First, the Respondent did not show that it owns any rights to the name "caffè borbone", nor that it has any license from the Complainant to use its trade mark. Second, the Respondent did not argue that it is commonly known, or that it has ever been known under the name "caffè borbone". Furthermore, the Panel did not find any evidence that the Respondent has used, or prepared to use, the disputed domain name in connection with a bona fide offering of goods or services. On the contrary, the disputed domain name redirects to a parking page displaying pay-per-click links, for which the Respondent purportedly earns money. These links bring the Internet user to websites of companies offering products in the same field as the Complainant. This is not a bona fide offering of goods and services.

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.

Noting the reputation and notoriety of the CAFFÈ BORBONE trade mark and the composition of the disputed domain name, the Panel finds that the Respondent should have been aware of the existence of the Complainant and its trade mark at the time the Respondent obtained the registration of the disputed domain name, and as such registered the disputed domain name in bad faith. Further, the Respondent has demonstrated, by registering the disputed domain name to resolve to a parking page displaying pay-per-click links where such links redirect to websites with content competitive to the Complainant's business, an intent to capitalize on the goodwill of the Complainant's trade mark. Moreover, in these circumstances, Respondent's purported offer to sell the disputed domain name to Complainant shortly after submission of the Complaint is indicative of bad faith.

The Panel therefore notes that the disputed domain name is being used in bad faith since the Respondent is trying to attract Internet users to its website by creating likelihood of confusion with the Complainant's trade mark as to the disputed domain name's source, sponsorship, affiliation or endorsement, an activity clearly detrimental to the Complainant's business in accordance with paragraph 4(b)(iv) of the Policy.

The Panel finds that the third element of the Policy has been established.

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 <caffeborbone.ro> be transferred to the Complainant.

/Charles Gielen/

Charles Gielen

Sole Panelist

Date: March 10, 2025