

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Baris Kara
Case No. D2024-5026

1. The Parties

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

The Respondent is Baris Kara, Germany.

2. The Domain Name and Registrar

The disputed domain name <caffeborboneturkey.com> is registered with Ascio Technologies Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 5, 2024. On December 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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 December 9, 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 December 11, 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 December 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 5, 2025. The Response was received by the Center on January 5, 2025.

The Center appointed Clive N.A. Trotman as the sole panelist in this matter on January 17, 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 manufactures coffee products. The “Borbone” part of the name is derived from that of King Charles III of Bourbon. The Complainant has won a number of industry awards and recognition, including two stars in 2019 from the International Taste Institute; the 2019 Quality Award, the prize given to food products after rigorous sensory tests conducted by independent laboratories; and the Business Excellence Award 2020 at the Teatro Manzoni in Milan, sponsored by the Italian Stock Exchange.

The Complainant owns about 80 trademarks for BORBONE or CAFFE BORBONE (or its Chinese equivalent) alone or in combination with other words, including:

BORBONE, figurative (the word “BORBONE” has a crown surmounting the second letter “O”), European Union trademark, registered November 23, 2016, registration number 015670532, in classes 7, 11, 21, 30, 35, 37, 40, and 43;

CAFFE’ BORBONE, figurative (logo), European Union trademark, registered November 23, 2016, registration number 015670541, in classes 7, 11, 21, 30, 35, 37, 40, and 43;

CAFFÈ BORBONE, figurative (logo), United States Patent and Trademark Office, registered June 25, 2013, registration number 4356426, in classes 30 and 43.

The Complainant also owns an extensive portfolio of domain names comprising variously the words “borbone” or “caffe borbone” alone or in combination with other words, most of which redirect to the Complainant’s main website “www.caffeborbone.com”.

The Respondent has not provided any background information, except for the contact details provided to the Registrar for the purpose of registration of the disputed domain name on September 16, 2024. On January 5, 2025, the Respondent stated that the disputed domain name had been deleted or cancelled. The disputed domain name resolves to a parked page indicating that the website is under construction.

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 identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name comprises the Complainant’s trademark CAFFE BORBONE followed by the geographical term “turkey” which is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark, followed by the generic Top-Level Domain (“gTLD”) “.com”. The disputed domain name also comprises the Complainant’s trademark BORBONE followed by the word “caffe” which is descriptive of the Complainant’s goods and services, and the word “turkey”, and the gTLD “.com”.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant states that it has not authorized the Respondent to use the disputed domain name. According to the Complainant's enquiries, there has been no registration or application for registration by the Respondent of any trademark similar to "Borbone" or "Caffe Borbone Turkey".

The Complainant further contends that the disputed domain name was registered and is being used in bad faith. The Complainant says the disputed domain name is not in use in good faith for an offer of goods and services, or for any legitimate commercial or noncommercial purpose without the intention to mislead the Complainant's customers by confusion with the Complainant's trademarks. There is no connection between the Respondent and the Complainant or the Complainant's trademarks.

The Complainant says the coupling of the Complainant's trademark with a geographic term in the disputed domain name clearly suggests sponsorship or endorsement by the Complainant and does not comprise legitimate noncommercial or fair use of the disputed domain name. The Respondent is blocking the Complainant from the opportunity to register the disputed domain name for itself.

The Complainant also says the disputed domain name is passively held, without there being any evidence of its use or demonstrable preparations for use in connection with a bona fide offering of goods and services. Since, among other considerations, the disputed domain name incorporates a well-known trademark of distinctiveness and reputation, cannot plausibly be put to any use without conflict with the Complainant's rights, was registered later than the Complainant's trademarks, and the Respondent has attempted to conceal its identity, for these reasons the disputed domain name should be found to have been registered and used in bad faith under the applicable doctrine of passive holding.

The Complainant has cited previous decisions under the Policy that it considers to be relevant to this case.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent provided a brief Response by email that said, "Hello, i have already deleted/cancelled the domain and will not enter into any legal dispute". Attached was a communication from the Respondent's service provider confirming that the hosting of the disputed domain name would be cancelled on September 15, 2025.

6. Discussion and Findings

Although the Respondent has effectively conceded that the disputed domain name is in the process of being "deleted/cancelled", the disputed domain name has not been actually transferred to the Complainant. The onus of proof remains upon the Complainant.

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 entirety of the CAFFÈ BORBONE and CAFFE' BORBONE marks is reproduced within the disputed domain name, without an accent over the final "e". Accordingly, the disputed domain name is confusingly similar to these marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the suffix “turkey”, or the prefix “caffe” and the suffix “turkey”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name 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 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.

In particular, the Complainant has not found, and the Respondent has not produced, any evidence that the Respondent has been known by any name similar to the disputed domain name.

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.

The structure of the disputed domain name, comprising essentially the Complainant’s registered trademark CAFFE’ BORBONE (necessarily without the accent) followed by the geographical identifier “turkey”, or alternatively as the Complainant’s trademark BORBONE preceded by “caffe” and followed by “turkey”, can only reasonably be interpreted, on the balance of probabilities, as having been created intentionally with prior knowledge of the Complainant’s trademark. The Panel finds it implausible that the Respondent had any other intention in registering the disputed domain name than for it to be confusing with the Complainant’s trademark, likely for a remunerative purpose, irrespective of whether the Respondent’s immediate intention was to conduct business through a corresponding website, to open a corresponding email address, to sell the disputed domain name, or otherwise. On the evidence, it is clear that the Respondent has targeted specifically the Complainant’s trademark.

The disputed domain name is not in use for a website or email address. Since the early case of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (“Telstra”), much discussion in subsequent cases has gone into the concept that passive holding, without positive use, may nevertheless qualify as “using”. Non-use, in and of itself, is not necessarily an indicator of bad faith, but may be so provided certain other criteria are fulfilled ([WIPO Overview 3.0](#), section 3.3).

The full panoply of criteria discussed in Telstra do not necessarily apply in individual cases, depending on the circumstances. Taking into account the Respondent's concession that the Respondent has "already deleted/cancelled the domain and will not enter into any legal dispute", together with the Panel's finding that the Respondent has targeted specifically the Complainant, the Panel finds sufficient evidence that on the balance of probabilities, the Respondent's registering and passively holding the disputed domain name amounted to bad faith within the meaning of the Policy.

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 name <caffeborboneturkey.com> be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: January 27, 2025