

## ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Hayat  
Case No. D2025-0798

### 1. The Parties

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

The Respondent is Hayat, Morocco.

### 2. The Domain Name and Registrar

The disputed domain name <borbonemaroc.net> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 26, 2025. On February 26, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 27, 2025, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 March 5, 2025. In accordance with the Rules, paragraph 5, the due date for Response was March 25, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 27, 2025.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on April 3, 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 has submitted evidence that it is the owner of a number of BORBONE trademark registrations including:

BORBONE (figurative), European Union Trademark (“EUTM”) registration number 15670532 and registration date November 23, 2016, for class 7, 11, 21, 30, 35, 37, 40 and 43.

BORBONE, United Kingdom trademark registration number UK00915670532 and registration date November 23, 2016, for class 7, 11, 21, 30, 35, 37, 40 and 43.

BORBONE (word), EUTM registration number 18719148 and registration date October 25, 2022, for class 9, 35 and 42.

BORBONE, Chinese trademark registration number 77976901 and registration date October 6, 2024, for class 30.

The disputed domain name <borbonemaroc.net> was registered by the Respondent on January 14, 2025. The disputed domain name resolves to a website that displays commercial pay-per-click (PPC) links, some of which compete with the Complainant.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant, Caffè Borbone S.r.l., contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Founded in 1996 in Naples, the Complainant owes its name to the famous royal family and to Charles III of Bourbon. The Complainant is considered one of the Italian coffee market leaders and produces around 96 tonnes of processed coffee every day.

The Complaint is based on the Complainant’s prior rights in and to the trademarks CAFFÈ BORBONE and BORBONE as well as its company name Caffè Borbone S.r.l., which are used not only in Italy but also in many other countries of the world for goods and services related to coffee, such as coffee products, coffee machines, coffee roasters, bar services and cafés. For these trademarks, the Complainant owns numerous registrations in several jurisdictions.

The disputed domain name <borbonemaroc.net> is composed of the exact reproduction of the BORBONE trademark to which has been added the term “maroc”, the geographical descriptive French term for Morocco. The presence of the term “maroc” does not add anything in terms of distinctiveness to the disputed domain name. The mere addition of a geographical indication to a trademark is not sufficient to eliminate the confusing similarity with the mentioned trademark. Internet users seek the trademark and not an indication of a country. Thus, when confronted with the disputed domain name, Internet users and consumers will inevitably focus on the term BORBONE and associate it with the Complainant’s identical trademark. Considering the above, the disputed domain name is almost identical or at least confusingly similar to the Complainant’s trademark.

Moreover, the disputed domain name was registered long after the trademarks CAFFÈ BORBONE and BORBONE have been used in commerce and registered in different jurisdictions. The Respondent is not known by the disputed domain name, which clearly refers to the trademark BORBONE and to which the Complainant has rights. The Complainant has neither authorized, nor given its consent to the Respondent to register or use the disputed domain name. The website, to which the disputed domain name resolves, displays various sponsored PPC links leading to commercial coffee websites where competing products are sold. Such use capitalizes on the reputation and goodwill of the Complainant’s trademark or otherwise misleads Internet users, not being considered a bona fide offering of goods or services under the Policy.

Given the extensive geographical spread of the Complainant's business, many Internet users will perceive the disputed domain name as referring to the Complainant's commercial operations in Morocco. The coupling of the Complainant's trademark with a geographic term clearly suggests sponsorship or endorsement of the disputed domain name by the Complainant and does not comprise legitimate and non-commercial or fair use of the disputed domain name.

Considering the reputation of the Complainant's trademarks BORBONE and CAFFÈ BORBONE before the registration of the disputed domain, it is clear that the Respondent knew or should have known about the existence of the Complainant's trademarks. The term "BORBONE" is not a common or descriptive term, but it is obviously a trademark in and to which the Complainant has rights. The addition of the geographical term "Maroc" to the trademark is insufficient for avoiding Internet user confusion.

The disputed domain name is not used in good faith for the offer of goods and services to the public, nor it is used for legitimate commercial or non-commercial use without the intention of misleading the Complainant's customers or infringing the registered trademarks. The disputed domain name was registered with the aim of taking advantage of this reputation for a commercial purpose, in order to mislead and divert the Complainant's consumers into a parking page displaying PPC links, for which the Respondent purportedly earns money. The use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with complainant's trademark.

The circumstances of the case allow to conclude that in registering the domain name, the Respondent had knowledge or at any rate exercised a willful blindness of the Complainant's earlier rights in and to the trademark BORBONE and trade name CAFFÈ BORBONE. The Respondent is depriving the Complainant of the possibility to register the contested domain name in which it has a legitimate interest. The Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the Complainant's trademark to attract Internet users to the website related to the domain name at issue creating a likelihood of confusion with the Complainant's trademarks and company name.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

- (i) that the disputed domain name is 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 the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

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

The Complainant is, according to the submitted evidence, the owner of the registered trademark BORBONE. The disputed domain name <borbonemaroc.net> incorporates the trademark in its entirety with the addition of the geographical location "Maroc", the French term for Morocco. In the present case, the Complainant's trademark is readily recognizable in the disputed domain name.

Having the above in mind, the Panel concludes that the disputed domain name <borbonemaroc.net> is confusingly similar to the Complainant's trademark BORBONE and that the Complainant has proven the requirement under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services prior to the dispute; or
- (ii) that the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

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. See [WIPO Overview 3.0](#), section 2.1.

The Complainant's trademark registrations for BORBONE predate the Respondent's registration of the disputed domain name <borbonemaroc.net>. The Complainant has not licensed, approved or in any way consented to the Respondent's registration and use of the trademark in the disputed domain name.

From the evidence in the case, it is clear that the Respondent's website, to which the disputed domain name resolves, displays links to commercial coffee websites where products that compete with the Complainant's products are marketed and sold. Given the above, the Respondent is not making a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not rebutted the Complainant's prima facie case. The Respondent has not submitted any evidence in this case to demonstrate that the Respondent is the owner of any trademark rights similar to the disputed domain name or that the Respondent is or has been commonly known by the disputed domain name.

By not submitting a response, the Respondent has failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the disputed domain name. Thus, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a

trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or

(ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or

(iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainant has submitted evidence demonstrating that the Respondent is using the Complainant's trademark in order to create an impression that the disputed domain name <borbonemaroc.net> is associated with or endorsed by the Complainant. By using the disputed domain name, which is confusingly similar to the Complainant's trademark, to display links to commercial websites where products that compete with the Complainant's products are marketed and sold, there is a risk of confusion as Internet users may be confused or misled into believing that the disputed domain name and website belong to, or are in some way associated with the Complainant.

In the absence of any evidence to the contrary, the Panel is persuaded on the balance of probabilities that the Respondent has registered and is using the disputed domain name with the Complainant's trademark and business in mind. Thus, the evidence in the case before the Panel indicates that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the websites or of a product or service on the website. Another factor to weigh in the balance is the Respondent's failure to respond to the Complainant's contentions. Hence, there is no evidence in the case that refutes the Complainant's submissions.

The Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name <borbonemaroc.net> has been registered and is being used in bad faith.

## **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 <borbonemaroc.net> shall be transferred to the Complainant.

*/Johan Sjöbeck/*

**Johan Sjöbeck**

Sole Panelist

Date: April 17, 2025