

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. UniqueSurf Networking, System Admin
Case No. D2025-1631

1. The Parties

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

The Respondent is UniqueSurf Networking, System Admin, United States of America.

2. The Domain Name and Registrar

The disputed domain name <borbonecaffe.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 23, 2025. On April 23, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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 (Handle: 2, UniqueSurf Networking) and contact information in the Complaint. The Center sent an email to the Complainant on April 25, 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 April 29, 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 May 1, 2025. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 22, 2025.

The Center appointed Erica Aoki as the sole panelist in this matter on May 28, 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, Caffè Borbone S.r.l., is an Italian limited liability company founded in 1996 and one of the leading companies in the coffee industry in Italy and internationally. It produces a wide range of coffee products, including capsules, coffee beans, and ground coffee, distributed worldwide under the CAFFÈ BORBONE and BORBONE trademarks.

The Complainant owes its name to the famous royal family and to Charles III of Bourbon. Caffè Borbone, which is considered one of the Italian coffee market leaders, produces every day around 96 tons of processed coffee in its Italian factories.

The Complainant operates a primary website at “www.caffeborbone.com”.

The Complainant holds multiple trademark registrations for CAFFÈ BORBONE and BORBONE, including:

- Italy: Reg. No. 302000900814890, registered on June 9, 2003.
- European Union: Reg. No. 15670532, registered on November 23, 2016.
- United States of America: Reg. No. 4356426, registered on June 25, 2013.
- International Registrations: Reg. Nos. 1359499, registered on May 30, 2017; and 902614 registered on January 11, 2006, designating several countries.

In recent years, CAFFÈ BORBONE has been recognized for its quality and market leadership:

- 2019: Received two stars from the International Taste Institute.
- 2019: Winner of the 2019 Quality Award for food & beverage products.
- 2020: Winner of the Business Excellence Award 2020, including:
 - Absolute Winner.*
 - Growth and Sustainability category.*
 - Sponsored by Italian Stock Exchange and Harvard Business Review Italia.
- Growth: Turnover growing 36% annually, margins strengthening.
- Market: Now the second top-of-mind brand in Italy's portioned coffee sector.

In addition, the Complainant operates a large portfolio of domain names reflecting its trademarks, including historical domains dating back to 2001, with evidence from Wayback Machine.

The disputed domain name <borbonecaffe.com> was registered on November 5, 2020, long after the Complainant's marks had acquired distinctiveness and widespread use.

The disputed domain name currently resolves to an inactive website (“404 Not Found” page), consistent with passive holding. The Respondent has not been authorized by the Complainant to use the trademarks in any manner.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name.

The Complainant contends that Complainant has prior rights in and to the trademarks CAFFÈ BORBONE and BORBONE, which are used in Italy and 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.

Moreover, Caffè Borbone owns many domain names reflecting the trademark CAFFÈ BORBONE/BORBONE among which the main website available at “www.caffeborbone.com” registered in the name of the Complainant, associated to the domain name <caffeborbone.it>.

The Complainant contends that:

- The disputed domain name is confusingly similar to its registered trademarks CAFFÈ BORBONE and BORBONE.
- The Respondent has no rights or legitimate interests in the disputed domain name and is not commonly known by it.
- The disputed domain name was registered and is being used in bad faith, including passive holding and unauthorized appropriation of a well-known brand.

B. Respondent

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

6. Discussion and Findings

The Complainant is required to establish the requirements specified under paragraph 4(a) of the Policy:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of 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

The Panel finds that the Complainant has established its rights to the CAFFÈ BORBONE and BORBONE trademarks through registration and use.

The disputed domain name <borbonecaffe.com> reproduces the distinctive elements of the Complainant’s trademarks, simply inverting the order of terms and omitting the accent on “Caffè.” Such minor differences do not prevent a finding of confusing similarity, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), sections 1.7 and 1.8.

The Panel finds that the first element of paragraph 4(a) of the Policy has been established.

B. Rights or Legitimate Interests

The Respondent is in default and has made no affirmative attempt to show any rights or legitimate interests in the disputed domain name.

There is no evidence that the Respondent is or was commonly known by the disputed domain name as an individual, business, or other organization ([WIPO Overview 3.0](#), section 2.3).

Nor is there any evidence of legitimate noncommercial or fair use of the disputed domain name. The disputed domain name is inactive and does not serve a bona fide offering of goods or services.

The Panel finds that the Complainant has established a prima facie case, which the Respondent has failed to rebut. The second element of paragraph 4(a) of the Policy is therefore established.

C. Registered and Used in Bad Faith

The Panel finds that the disputed domain name was registered and is being used in bad faith.

At the time of registration, the Complainant's trademarks were well known in Italy and internationally. The Respondent's selection of a domain name incorporating these trademarks, combined with passive holding and the use of privacy services, suggests that the domain was registered with knowledge of the Complainant's rights and with an intent to exploit them.

The Panel also notes that the Complainant's reputation has been recognized in prior UDRP decisions involving its trademarks, including:

- *Caffè Borbone S.r.l. v. Beats, Beats / KAI*, WIPO Case No. [D2022-0824](#); and
- *Caffè Borbone S.r.l. v. RONGKAI*, WIPO Case No. [DCO2024-0075](#).

Moreover, the use of a privacy shield to conceal the Respondent's identity, combined with the lack of any legitimate content (passive holding), further supports the finding of bad faith registration and use.

Passive holding does not preclude a finding of bad faith ([WIPO Overview 3.0](#), section 3.3). Given the distinctiveness of the Complainant's trademarks and the lack of any legitimate use, the Panel concludes that the disputed domain name was registered and is being used in bad faith.

The third element of paragraph 4(a) of the Policy is therefore 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 domain name <borbonecaffe.com> be transferred to the Complainant.

/Erica Aoki/

Erica Aoki

Sole Panelist

Date: June 11, 2025