

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Tam Tuong
Case No. D2025-1963

1. The Parties

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

The Respondent is Tam Tuong, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <caffeborbonemerch.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 16, 2025. On May 16, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 16, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 19, 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 May 20, 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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 23, 2025. In accordance with paragraph 5 of the Rules, the due date for Response was June 12, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 13, 2025.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on June 24, 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant is an Italian company which was founded in 1996 in Naples and now produces around 96 tons of processed coffee every day in its Italian factories. The Complainant's products (namely, capsule, coffee beans, ground coffee) are distributed all over the world.

The Complainant is the owner of the globally registered CAFFÈ BORBONE trademarks (the "CAFFÈ BORBONE Trademarks") including International Trademark Registrations No. 902614 for CAFFÈ BORBONE (figurative) (registered on January 11, 2006) and No. 1359499 for CAFFÈ BORBONE (figurative) (registered on May 30, 2017), United States of America Trademark Registration No. 4356426 for CAFFÈ BORBONE (figurative) (registered on June 25, 2013), and European Union Trade Mark Registration No. 015670541 for CAFFE' BORBONE (figurative) (registered on November 23, 2016).

Moreover, the Complainant owns many domain names reflecting the CAFFÈ BORBONE Trademarks, most of which redirect to the main corporate website at the domain name <caffeborbone.com>.

The disputed domain name was registered on February 15, 2025. The disputed domain name has resolved to a website in the Italian language, which is used for allegedly offering "official" merchandising products of the Complainant and provides the impression as if it is operated by the Complainant, particularly by prominently using the Complainant's CAFFÈ BORBONE Trademarks without any visible disclaimer describing the lack of relationship with the Complainant, and currently resolves to an inactive website.

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's contentions may be summarized as follows:

The disputed domain name is composed of the exact reproduction of the CAFFÈ BORBONE Trademark, to which the term "merch", a descriptive abbreviation for "merchandising", has been added. Therefore, the disputed domain name is substantially identical to the Complainant's CAFFÈ BORBONE Trademark.

The Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name. The database search shows that there are no "CAFFEBORBONEMERCH" or "CAFFE BORBONE MERCH" trademark applications or registrations and no trademark applications or registrations in the name of the Respondent containing "BORBONE". As a variety of food or beverage products are offered for sale, including coffee from the Complainant's competitors, on the website to which the disputed domain name has resolved, the Respondent is evidently not 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 CAFFÈ BORBONE Trademarks.

In registering the disputed domain name, the Respondent had knowledge or at any rate exercised a willful blindness of the Complainant's earlier rights in and to the CAFFÈ BORBONE Trademarks. The Respondent is depriving the Complainant of the possibility to register the disputed domain name in which it might have a legitimate interest. The fact that the disputed domain name corresponds to the Complainant's well-known

CAFFÈ BORBONE Trademark constitutes an indication of the bad faith of the Respondent. The Respondent is unfairly and intentionally taking advantage of, and exploiting without authorization, the reputation and distinctiveness of the Complainant's CAFFÈ BORBONE Trademarks to attract Internet users to the website related to the disputed domain name creating a likelihood of confusion with the Complainant's CAFFÈ BORBONE Trademarks.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) 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 in paragraph 4(a) of the Policy 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 (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#))).

The disputed domain name incorporates the verbal element of the Complainant's CAFFÈ BORBONE Trademark in its entirety (without accent on "e" and without space between "caffe" and "borbone") with the addition of the term "merch" and a generic Top-Level Domain ("gTLD") ".com".

The omission of the accent on the "e" in the disputed domain name does not prevent a finding of confusing similarity (see *Illycaffè S.p.A. v. Mauro Sergio*, WIPO Case No. [D2009-1453](#); and *Caffè Borbone S.r.l. v. 吳清儒 (Wu Qing Ru)*, WIPO Case No. [D2023-3320](#)).

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element in paragraph 4(a) of the Policy (see section 1.8 of the [WIPO Overview 3.0](#)).

The applicable gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether the disputed domain name is identical or confusingly similar to the Complainant's trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Complainant's CAFFÈ BORBONE Trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's CAFFÈ BORBONE Trademark and the first element in paragraph 4(a) 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.

As the Complainant asserts, the Complainant has neither authorized, nor somehow given its consent to the Respondent to register or use the disputed domain name. There is no evidence to show that the Respondent is commonly known by the disputed domain name pursuant to paragraph 4(c)(ii) of the Policy.

As regards the composition of the disputed domain name, the term “merch” is commonly known as an abbreviation for “merchandise” (see *Discord Inc. v. Domain Administrator, See PrivacyGuardian.org / Maven Pos Service LLP, Tilek Suierkulov*, WIPO Case No. [D2021-0893](#) (<discord-merch.com>); and *Morgan Wallen v. Domains By Proxy, LLC / xu zengyi, SOUFEEL JEWELRY LIMITED*, WIPO Case No. [D2022-2444](#) (<morganwallenmerch.com>)). The use of a domain name for illegal activity (e.g., impersonation/passing off) can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)). Considering the offer for sale of unauthorized merchandising products bearing the Complainant’s CAFFÈ BORBONE Trademark on the website to which the disputed domain name has resolved, the website tab indicating that it is an “official” shop for the Complainant’s merchandise, the Respondent has not been 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 CAFFÈ BORBONE Trademarks pursuant to paragraph 4(c)(iii) of the Policy.

Although the overall burden of proof in the proceedings is on the complainant, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on the second element in paragraph 4(a) of the Policy 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 in paragraph 4(a) of the Policy (see section 2.1 of the [WIPO Overview 3.0](#)).

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.

Consequently, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the second element in paragraph 4(a) of the Policy has been established.

C. Registered and Used in Bad Faith

At the time of registration by the Respondent of the disputed domain name, the Complainant’s business with the CAFFÈ BORBONE Trademarks was well established. Thus, considering the reputation of the Complainant’s CAFFÈ BORBONE Trademarks before the registration of the disputed domain name as well as the contents of the website to which the disputed domain name has resolved, it is clear that the Respondent knew or should have known about the existence of the Complainant’s CAFFÈ BORBONE Trademarks.

Although there is no connection between the Respondent and the Complainant, the Respondent has used the website to which the disputed domain name has resolved to sell the goods presenting itself as “Caffè Borbone Official Merch T-Shirt” and mislead the consumers by indicating a connection with the Complainant which is not real. This fact clearly indicates that the Respondent’s use in targeting and freeriding on the Complainant’s CAFFÈ BORBONE Trademarks and underlying reputation to attract Internet users for the Respondent’s illegitimate commercial gain is in bad faith. The Respondent intentionally tries to misrepresent itself as the Complainant or a Complainant’s official distributor and to attract, for commercial gain and

possibly even fraudulent purposes, Internet users to its website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation or endorsement of its website pursuant to paragraph 4(b)(iv) of the Policy.

Although the disputed domain name currently resolves to an inactive site and is not being used, it does not prevent a finding of bad faith under the doctrine of passive holding in this case, in consideration of (i) the reputation of the Complainant's CAFFÈ BORBONE Trademarks, (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 by using a privacy service, and (iv) the previous impersonating use to which the disputed domain name had been put (see section 3.3 of the [WIPO Overview 3.0](#)).

All the above considered, it is to be concluded that the disputed domain name was registered and is being used by the Respondent in bad faith and the third element in paragraph 4(a) 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 <caffeborbonemerch.com> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: July 8, 2025