

## **ADMINISTRATIVE PANEL DECISION**

**B&B Hotels v. Jose Garcia Saez**

**Case No. D2023-4094**

### **1. The Parties**

The Complainant is B&B Hotels, France, represented by Fiducial Legal By Lamy, France.

The Respondent is Jose Garcia Saez, Spain.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 2, 2023. On October 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 3, 2023, 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 (To the owner of the domain name: hotelbyb.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 2023, 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 October 5, 2023.

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 October 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2023. The Respondent submit an informal communication on October 4, 2023. The Center notified the Parties of the Commencement of Panel Appointment Process on November 10, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on November 21, 2023. 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 a French company incorporated in 1990. It provides hotel, restaurant, temporary accommodation, and related booking services, and operates more than 700 hotels worldwide and has approximately 1,000 employees.

The Complainant owns various trademark registrations for the term “BBHOTEL” – for example French trademark registration No. 3182311, registered on August 29, 2002. These trademarks are referred to as the “BBHOTEL trademark” in this decision. The Complainant is also the owner of various device trademarks which incorporate the term “B&B HOTELS” – see for example European Union trademark B&B HOTELS with registration No. 004767323, registered on December 12, 2006. These trademarks are referred to the “B&B HOTELS trademark” in this decision.

The Complainant is also the owner of the domain names <bbhotels.com>, registered on September 13, 2004, which resolves to the Complainant’s principal website. It also owns many other domain names incorporating the term “bbhotel” such as <bbhotel.eu>, <bbhotels.fr> and <bbhotels.net>. These domain names redirect to the Complainant’s official website.

The Respondent previously registered the domain name <byb-hotel.com> on March 3, 2023 (the “Previous Disputed Domain Name”). On May 10, 2023, the Complainant sent a letter of complaint to the registrar of the Previous Disputed Domain Name. On May 18, 2023, that registrar informed the Complainant that it had notified the Respondent of the Complainant’s communication. The Disputed Domain Name was registered on May 24, 2023. In June 2023 the Complainant brought a UDRP complaint against the Respondent in relation to the Previous Disputed Domain Name. The Respondent then offered to sell the Previous Disputed Domain Name to the Complainant for €120,000. Negotiations took place which resulted in an agreement where the Complainant paid the Respondent €1500 in return for a transfer of the Previous Disputed Domain Name and the Previous Disputed Domain Name was transferred to the Complainant and the previous Complaint was closed.

The Complainant subsequently discovered the existence of the Disputed Domain Name.

#### **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 Respondent registered the Disputed Domain Name after the Respondent was aware that the Complainant objected to the Previous Disputed Domain Name and considered that the Respondent infringed its rights, and the Respondent in those circumstances must have registered the Disputed Domain Name with a view of further targeting the Complainant.

##### **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 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 rights in the BBHOTEL trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable within the disputed domain name, the disputed domain name is considered to be confusingly similar to the mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) at section 1.7). The Panel considers "hotelbyb" is a confusingly similar approximation to the BBHOTEL trademark involving simply the rearrangement of the elements present within the trademark and the addition of a single letter "y".

So far as the B&B HOTELS trademark is concerned, the same principles apply. It does not matter that this trademark is a device mark. Similarity between a domain name and a device mark which includes words or letters is a readily accepted principle where the words or letters comprise a prominent part of the trademark in question – see for example *EFG Bank European Financial Group SA v. Jacob Foundation* WIPO Case No. [D2000-0036](#) and *Sweeps Vacuum & Repair Centre, Inc. v. Nett Corp* WIPO Case No. [D2001-0031](#)

It is also well established that the Top-Level Domain ("TLD"), in this case ".com", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#) at section 1.11.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and hence, based on the available record, 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.

Accordingly, based on the available record, 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. Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

In the present case, the Panel notes that the Respondent registered the Disputed Domain Name after it had received notice that the Complainant objected to the Respondent's earlier registration of the Previous Disputed Domain Name. The Respondent must have registered the Disputed Domain Name with the Complainant in mind and most likely did so primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant for valuable consideration in excess of his documented out-of-pocket costs directly related to the Disputed Domain Name. Such conduct falls squarely within paragraph 4(b) of the Policy and establishes that the registration and use of the Disputed Domain Name was in bad faith.

Accordingly, based on the available record, 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 <hotelbyb.com> be transferred to the Complainant.

*/Nick J. Gardner/*

**Nick J. Gardner**

Sole Panelist

Date: December 5, 2023