

## **ADMINISTRATIVE PANEL DECISION**

B&B Hotels v. B. Schalk, benschalk.com

Case No. D2022-2293

### **1. The Parties**

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

Respondent is B. Schalk, benschalk.com, Germany.

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

The disputed domain name <bb-hostel.com> (the “Domain Name”) is registered with PSI-USA, Inc. dba Domain Robot (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 24, 2022. On June 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 6, 2022, 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 July 8, 2022.

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 July 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2022. The Center received email communications from the Respondent on July 14, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on August 19, 2022. 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**

Complainant is a French company incorporated on May 28, 1990, which maintains a hotel chain under the name B&B HOTELS, with more than 500 hotels worldwide in France, Germany, Italy, Spain, Portugal, Belgium, Switzerland, Poland, Austria, Slovenia, Czech Republic and Brazil and more than 280 hotels in France. Complainant has been using the B&B HOTELS brand since as early as 1990. It employs more than 1,000 employees and had a turnover of more than 280 million euros in 2019.

Complainant owns trademark registrations for B&B HOTELS including:

- the French trademark registration No. 3 182 313, BB-HOTEL (word), filed on August 29, 2002, for services in international class 43;
- the French trademark registration No. 3 182 311, BBHOTEL (word), filed on August 29, 2002, for services in international class 43 and;
- the European Union trademark registration No. 004767323, B&B HOTELS (figurative), filed on November 29, 2005, and registered on December 12, 2006, for services in international class 43.

Complainant also owns the following *inter alia* domain names: <bb-hotel.fr> registered on August 6, 2002, <bb-hotels.fr> registered on October 30, 2009, and <bb-hotel.eu> registered on August 26, 2006. The Domain Name was registered on February 19, 2022, and leads to a Webgo parking page.

#### **5. Parties' Contentions**

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

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

##### **B. Respondent**

Respondent did not formally reply to the Complainant's contentions. On July 14, 2022 it sent several email communications to the Center asking it to write in German or Thai, to which the Center informed the Parties of paragraph 11 of the Rules, that the Complaint was submitted in English, and that the language of the registration agreement for the Domain Name is English (as confirmed by the Registrar). The Panel has decided to proceed in the language of the registration agreement (*i.e.*: in English).

#### **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements that Complainant must satisfy with respect to the Domain Name:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

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

The Domain Name incorporates Complainant's B&B HOTELS trademark in its entirety. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)).

The reversal of the order of placement of the letter "s" in HO(S)TEL rather than HOTEL(S), does not prevent a finding of confusing similarity as the B&B HOTELS trademark remains clearly recognizable (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8). Except for the addition of the letter "s", the Second-Level of the Domain Name corresponds in its entirety with Complainant's BB-HOTEL trademark.

The Panel notes that the term "hostel" from the Domain Name and the term "hotel" from Complainant's trademark are different words in the English language. In the Panel's opinion, this does not prevent a finding of confusing similarity under the threshold test for the first element (see *Match Group, LLC v. Merl Matrix GmbH*, WIPO Case No. [D2018-0511](#)).

The generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is confusingly similar to Complainant's B&B HOTELS trademark.

Complainant has established Policy, paragraph 4(a)(i).

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

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any formal response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complainant, Respondent was not authorized to register the Domain Name.

Respondent has not demonstrated any preparations to use, or has not used the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolved to a parking page.

Per Complainant, Respondent is not an affiliated entity or an authorised distributor or partner of Complainant and no agreement, express or otherwise, existed allowing the use of Complainant's trademarks on the website of Respondent.

In addition, while the Panel notes that the words "hostel" and "hotel" are different words in the English language, the Panel notes that both words are related to the "travel industry", and is conscious of the fact that except for the addition of the letter "s", the Second-Level of the Domain Name corresponds in its entirety with Complainant's BB-HOTEL trademark. The Domain Name has not been used except for a parking page, and Respondent has not provided any relevant arguments or evidence that may give rise to rights or legitimate interests in the Domain Name.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name, and that Complainant's *prima facie* case remains unrebutted.

Complainant has established Policy, paragraph 4(a)(ii).

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

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that on the balance of probabilities Respondent has registered and used the Domain Name in bad faith.

Because the B&B HOTELS mark had been used and registered by Complainant before the Domain Name registration, and noting that the Domain Name is almost identical to Complainant's BB-HOTEL trademark, the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

The Domain Name currently resolves to a hosting parked page, which essentially equates to passive holding. It is generally recognised that the passive holding of a domain name does not prevent a finding of bad faith (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent registered and used the Domain Name in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

## **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, <bb-hostel.com>, be transferred to the Complainant.

*/Marina Perraki/*

**Marina Perraki**

Sole Panelist

Date: September 2, 2022