

ADMINISTRATIVE PANEL DECISION

B&B Hotels v. Jose Ferreiro, FERREIRO SA DE CV
Case No. D2023-2455

1. The Parties

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

The Respondent is Jose Ferreiro, FERREIRO SA DE CV, El Salvador.

2. The Domain Name and Registrar

The disputed domain name <bboutiquehotel.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 9, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 13, 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 June 16, 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 June 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 9, 2023. The Respondent did not submit any response within this time limit. Accordingly, the Center notified the Respondent’s default on July 10, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on July 13, 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.

On July 22, 2023, the Respondent submitted its Response. This was before the date for the Decision in the present proceeding, so the Panel exceptionally decided to accept it as doing so would not delay the proceeding and would allow the Panel to consider the positions of both Parties. At the same time, the Panel reiterates that the time limits under the UDRP are to be observed and each Party should seek in advance an extension from the Panel if it cannot comply with a time limit due to exceptional circumstances.

4. Factual Background

The Complainant is a French company incorporated in 1990. It is offering hotel, restaurant, temporary accommodation and related booking services, operates more than 700 hotels worldwide and has 1,000 employees.

The Complainant is the owner of the following trademark registrations for the sign BB HOTEL (the "BB HOTEL trademark"):

- the French trademark BB-HOTEL with registration No. 3182313, registered on August 29, 2002 for services in International Class 43; and
- the French trademark BBHOTEL with registration No. 3182311, registered on August 29, 2002 for services in International Class 43.

The Complainant is also the owner of the following trademark registrations for the sign B&B HOTELS (the "B&B HOTELS trademark"):

- the European Union trademark B&B HOTELS with registration No. 004767323, registered on December 12, 2006 for services in International Class 43; and
- the International trademark B&B HOTELS with registration No. 944670, registered on November 8, 2007 for services in International Class 43.

The Complainant is also the owner of the domain names <bbhotels.com>, registered on September 13, 2004, <bbhotel.eu>, registered on August 26, 2006, <bbhotels.fr>, registered on June 30, 2010, and <bbhotels.net>, registered on September 30, 2020. These domain names redirect to the Complainant's official website.

The Respondent is a company registered in El Salvador, which operates the B Boutique Hotel located near the capital of the country San Salvador. It is the owner of the following registrations of the sign B BOUTIQUE HOTEL (the "B BOUTIQUE HOTEL trademark"):

- the combined trademark B BOUTIQUE HOTEL with registration No. 225009 01, registered on July 30, 2013 in Panama for services in International Class 43;
- the combined trademark B BOUTIQUE HOTEL with registration No. 0019907, registered in Honduras on April 3, 2014 for services in International Class 43;
- the combined trademark B BOUTIQUE HOTEL with registration No.202423, registered in Guatemala on December 10, 2014 for services in International Class 43; and
- the combined trademark B BOUTIQUE HOTEL with registration No. 63840, registered in El Salvador on August 24, 2015 for services in International Class 43.

The disputed domain name was registered on March 28, 2022. It currently resolves to a hotel website. At the time of the filing of the Complaint, the disputed domain name was inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its BB HOTEL trademark and to the Complainant's domain names <bbhotels.com>, <bbhotels.fr>, and <bb-hotel.eu>. The Complainant points out that the disputed domain name incorporates the elements "bb" and "hotel", which correspond to the Complainant's BB HOTEL trademark. According to it, the addition of the word "boutique" before "hotel" is likely to be seen as a descriptive way to promote a type of hotel and services and it does not change the visual, phonetic and conceptual similarity between the disputed domain name and the Complainant's BB HOTEL trademark. The Complainant maintains that the disputed domain name is a typical cybersquatting behavior and consumers may be misled to believe that the disputed domain name is owned by or linked with the Complainant and is a derivative of the trademarks and domain names owned by the Complainant. According to it, the risk of confusion is increased by the fact that the Complainant owns many domain names with different generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs") made of the elements "bb" and "hotel(s)" in different order and separated or not by hyphens. The Complainant adds that consumers may believe that the Complainant is offering a boutique style hotel.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not authorized the Respondent to use the BB HOTEL and B&B HOTELS trademarks or to register or use the disputed domain name. The Complainant states that the disputed domain name is not currently used and that the Respondent is not known under the name "Bboutique Hotel" and is not offering any goods or services under that name. According to the Complainant, the disputed domain name is only used to benefit from the Complainant's brand reputation to attract Internet traffic and mislead Internet users into thinking that they have reached the Complainant's website.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It maintains that the Respondent was aware of the Complainant's BB HOTEL and B&B HOTELS trademarks at the time of registration of the disputed domain name, and notes that the registration of the disputed domain name took place after the registration of the Complainant's trademarks and the date when the Complainant started using them in 1990. The Complainant maintains that its B&B HOTELS trademark is well-known and that it is a famous hotel chain in France and in Europe.

The Complainant states that the Respondent has no legitimate interests in the disputed domain name as it does not intend to use it for a *bona fide* offering of goods or services. According to it, the Respondent's intention is to attract, for commercial gain, or to defraud Internet users to third party's websites or other on-line locations, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of those websites or locations.

According to the Complainant, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain name, and the Respondent must have registered the disputed domain name without any specific intention to use it. The Complainant adds that the disputed domain name was registered on March 28, 2022 and is not currently used.

In the Complainant's submission, the Respondent must have had the Complainant's trademarks in mind when registering the disputed domain name. In the Complainant's view, the non-use of the disputed domain name shows that it was registered in bad faith to take advantage of the Complainant. According to the Complainant, Internet users may be attracted to the disputed domain name while trying to reach the Complainant's domain names and websites, considering the high degree of similarity between the Complainant's trademarks and the disputed domain name, and this creates a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

B. Respondent

The Respondent states that it is a company registered in El Salvador, which is the owner of the B BOUTIQUE HOTEL trademark. The Respondent maintains that it operates a boutique hotel with four rooms, built on a cliff in the area of La Libertad, El Salvador, and that the official website of this hotel has been located at the disputed domain name since 2014. The Respondent maintains that it has registered its B BOUTIQUE trademark in El Salvador, and has sought its protection in the Central American region, which does not constitute improper use or infringement of the registered trademark or domain name of another.

6. Discussion and Findings

A. Identical or Confusingly Similar

Based on the available record, the Panel finds the Complainant has shown rights in respect of the BB HOTEL trademark for the purposes of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1

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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Issues such as the strength of the complainant's mark or the respondent's intent to provide its own legitimate offering of goods or services without trading off the complainant's reputation, are decided under the second and third elements. Panels view the first element as a threshold test concerning a trademark owner's standing to file a UDRP complaint, *i.e.*, to ascertain whether there is a sufficient nexus to assess the principles captured in the second and third elements. [WIPO Overview 3.0](#), section 1.7.

Applying the principles discussed above, the Panel considers that the BB HOTEL trademark can be regarded as sufficiently recognizable within the disputed domain name. Accordingly, the Panel accepts that the disputed domain name is confusingly similar to the mark for the purposes of standing under the Policy. [WIPO Overview 3.0](#), section 1.7. Nevertheless, the Panel notes that the element "boutique" is well distinguishable within the disputed domain name, and it is identical to the Respondent's B BOUTIQUE HOTEL trademark – a matter the Panel turns to under the other elements.

Based on the available record, the Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

The Respondent has submitted evidence of the registrations of its B BOUTIQUE HOTEL trademark in El Salvador, Guatemala, Honduras and Panama, which registrations were made in 2013 - 2015, and the disputed domain name is identical to this trademark.

As discussed in section 2.12.1 of the [WIPO Overview 3.0](#), panels have recognized that a respondent's prior registration of a trademark which corresponds to a domain name will ordinarily support a finding of rights or legitimate interests in that domain name for purposes of the second element. The existence of a respondent trademark does not however automatically confer rights or legitimate interests on the respondent. For example, panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights (even if only in a particular jurisdiction). Absent evidence of such circumstances indicating pretext however, panels have been reluctant to reject a respondent trademark registration out of hand.

In the present case, there is no indication that the Respondent registered its trademark primarily to circumvent the application of the UDRP or otherwise prevent the Complainant's exercise of its rights. The Respondent's website at the disputed domain name contains a link to a YouTube video advertising the Respondent's B Boutique Hotel, which was published in 2014 and has had about 10,000 views, and a link to its Instagram account, created in 2013, which has about 665 posts and 17,300 followers. This supports a conclusion that the Respondent's hotel under the name B Boutique Hotel must have started operating in 2014 at latest. Having checked the Respondent's social media accounts, the Panel does not consider that the Respondent has intentionally tried to pass it off as the Complainant, nor to create a likelihood of confusion with the Complainant and its mark.

The Complainant has submitted no evidence that would support a conclusion that the Respondent must have known of the Complainant when it registered its B BOUTIQUE HOTEL trademark and started operating its hotel under the same name. There is no evidence that the Complainant has carried out any activities in any part of the American continent at that time or that its trademarks have been registered there. Although the disputed domain name was registered only last year and was not active at the time the Complaint was filed, it appears from the circumstances of the case that the Respondent has registered it to reflect its own trademark and to advertise its own offering of hotel services through an additional channel, without trading off the Complainant's reputation.

On this basis, the Panel finds the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

As discussed in the section on rights and legitimate interests, there is no evidence to support a conclusion that the Respondent may have known of the Complainant when it registered its B BOUTIQUE HOTEL trademark and started operating its hotel with the same name in El Salvador in 2013 – 2015 or that it may have targeted the Complainant with the registration and use of the disputed domain name, which is identical to its trademark and to the name of its hotel.

In view of the above, there is no basis to conclude that the disputed domain name was registered and is being used in bad faith.

Based on the available record, the Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: July 29, 2023