

ADMINISTRATIVE PANEL DECISION

B&B Hotels v. Simone Paratore

Case No. D2023-0327

1. The Parties

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

The Respondent is Simone Paratore, Italy.

2. The Domain Name and Registrar

The disputed domain name <hotelbbcatania.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2023. On January 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 2023, the Registrar transmitted by email to the Center its verification response registrant and contact information for the disputed domain name which differed from the named Respondent (Contact Privacy Inc. Customer 0165388382) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 26, 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 January 30, 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”).

On January 31, 2023, the Respondent sent an informal communication.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 23, 2023. The Respondent did not submit any formal response. Accordingly, on February 27, 2023, the Center notified the Parties that it would proceed to Panel Appointment.

The Center appointed Adam Taylor as the sole panelist in this matter on March 6, 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

Since 1990, the Complainant has operated a hotel business under the mark B&B HOTELS. According to the Complainant's website, there are currently some 700 hotels bearing this brand, including 378 in France and 61 in Italy, one of which is located in Palermo, Sicily.

The Complainant's turnover in 2019 was over EUR 280 million.

The Complainant owns a number of trade marks for different variations of its trading name including French trade mark No. 3182312 for HOTELBB, filed on August 29, 2002, registered on February 14, 2003, in class 43.

The Complainant operates its main website at "www.hotel-bb.com".

The disputed domain name was registered on October 5, 2022.

The disputed domain name has not been used to resolved to an active website.

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The Complainant's trade mark is well-known.

The disputed domain name is confusingly similar to the Complainant's HOTELBB trade mark, which it incorporates in its entirety, merely adding the geographical indication "catania".

The Respondent lacks rights or legitimate interests in the disputed domain name.

There is no evidence that the Respondent has ever been known by the disputed domain name or that the Respondent has ever offered any goods or services under that name.

The Complainant has not authorised the Respondent to register the disputed domain name or to use its trade mark.

There is no evidence that the Respondent is legitimately using, or has made demonstrable preparations to use, the disputed domain name for a *bona fide* offering of goods or services.

The disputed domain name was registered and is being used in bad faith.

The fact that the Complainant's B&B HOTELS is a famous hotel chain in Europe, and that its marks long predate the disputed domain name, shows that the Respondent was aware of the Complainant's marks when registering the disputed domain name.

The Respondent's sole intention was to create a likelihood of confusion with the Complainant's mark for commercial gain by attracting customers seeking the Complainant's famous mark.

It is impossible to conceive of any legitimate use by the Respondent of the disputed domain name.

The disputed domain name constitutes a passive holding in bad faith.

The non-use of the disputed domain name, which is associated with a term that is almost identical to the Complainant's prior trade mark, together with the addition of the descriptive word "catania", shows that the Respondent is using the disputed domain name in bad faith to take advantage of the Complainant.

B. Respondent

The following is a summary of the contentions in the Respondent's informal Response of January 31, 2023.

The Complainant has wrongly argued that possession and use of the disputed domain name is illegitimate.

The Respondent obviously undertook prior research to verify that the disputed domain name "did not belong to anyone".

The Respondent did not act in bad faith or buy the disputed domain name for profit.

The Respondent did not know that buying the disputed domain name could have interfered with the Complainant's brand, of which the Respondent was unaware. The Complainant's hotel chain is not present in the Respondent's city and the Respondent has never seen it advertised.

The Respondent is the manager of a small family holiday home business in the city of Catania that has operated for over 10 years and owns only four flats in the centre of Catania.

The Respondent intended to use the disputed domain name as the main site, or as a redirect to the website of, the Respondent's business.

The use of keywords relating to the hotel sector, such as "hotel", "bed and breakfast", "holiday homes" and the like are very useful for indexing in search engines.

These are commonly used words in this sector and do not refer to a specific brand. For example, the Respondent did not buy domain names containing well-known brand names such as <hiltonhotelcatania.com> or <nhotelcatania.com>.

Amongst other things, the inclusion of "catania" shows that the Respondent intended to use the disputed domain name in a localised manner.

The Respondent's only purpose was to improve the Respondent's search engine ranking, without infringing any rights or trade marks.

The Respondent's website already exists but at another domain name.

The Respondent invites the Complainant to propose an amicable resolution to this dispute, which results from a misunderstanding.

The Respondent wishes to retain the disputed domain name for the above purposes and undertakes not to interfere with the Complainant's customers, on the basis of disclaimers to be provided by the Complainant.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established rights in the mark HOTELBB.

Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive, geographical or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the disputed domain name consists of the Complainant's trade mark, which remains readily recognisable within the disputed domain name, plus the additional term "catania", which does not prevent a finding of confusing similarity as explained above.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, the disputed domain name is inactive and is therefore not being used for a *bona fide* offering of goods or services.

The Panel notes that the Respondent alleges that it intended to use the disputed domain name as the main site, or as a redirect to, the website of the Respondent's business, but does not provide any evidence to support its allegations.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy are relevant in the circumstances of this case.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Panel will first consider the likelihood that the Respondent registered the disputed domain name to unfairly target the Complainant rather than, as the Respondent claims, for its descriptive qualities and without the Respondent being aware of the Complainant.

The Panel notes the following:

1. the Complainant has established that its mark, B&B HOTELS, is well-known in Europe, with 61 hotels in Italy - one of which is in Sicily, albeit not in Catania where the Respondent resides;
2. the Respondent claims to provide holiday flats – an industry that is at least broadly related to hotels – and is therefore reasonably likely to be aware of a hotel chain with a significant presence in its own country;
3. the formulation consisting of the word “hotel” followed by “bb” used in the disputed domain name is similar to that of the domain name at which the Complainant’s main website is located;
4. the Respondent has not claimed, let alone provided evidence, that the disputed domain name is part of a pattern of descriptive hotel-related domain names;
5. the Respondent implies that “bb” in the disputed domain name was meant as an acronym for “bed and breakfast” and claims that the Respondent intended to use the disputed domain name either as the main site for, or else as a redirect to, the Respondent’s business, but the former at least seems unlikely given that the Respondent does not claim to operate either a hotel or bed and breakfast accommodation but, rather, a holiday home business; and
6. the Respondent claims that the Respondent’s website “already exists” but the Respondent does not provide details, nor explain why the Respondent might have wished to replace the existing domain name with the disputed domain name.

Taking all of the above matters together, and on the balance of probabilities, the Panel does not find the Respondent’s denial that the Respondent knew of, and targeted, the Complainant to be credible. The Panel considers that, more likely than not, the Respondent registered the disputed domain name with a view to taking unfair advantage of Internet users looking for a Complainant hotel in Catania.

While the Respondent has not actively used the disputed domain name, section 3.3 of [WIPO Overview 3.0](#) explains that panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. The Panel considers that the disputed domain name constitutes a passive holding in bad faith for the reasons given above.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) 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 <hotelbbcatania.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: March 20, 2023