

KLAGENÆVNET FOR DOMÆNENAVNE

J.nr.: 2021-0156

Klager:

B&B Hotels Denmark ApS
Gammel Kongevej 1
1610 København V
Danmark

v/advokat Annemette Ellermann Holmbom

Indklagede:

Charlotte Mølsted Andersen
Vardevej 474
7100 Vejle
Danmark

v/advokat Nicolaj Horn

Parternes påstande:

Klagerens påstande

Principalt: Registreringen af domænenavnene ”hostelbb.dk” og ”bbhostel.dk” skal overføres til klageren.

Subsidiært: Indklagede tilpligtes at afregistrere domænenavnene ”hostelbb.dk” og ”bbhostel.dk”.

Indklagedes påstand

Frifindelse.

Dokumenter:

Der er for klagenævnet fremkommet klageskrift af 9. juni 2021 med ti bilag (bilag 1-10), svarskrift af 9. juli 2021 med ét bilag (bilag A) samt replik af 13. juli 2021 med to bilag (bilag 11-12).

Registreringsdato:

Domænenavnene ”hostelbb.dk” og ”bbhostel.dk” er registreret den 30. januar 2021, jf. bilag 7.

Sagsfremstilling:

I klageskriftet er bl.a. anført følgende:

”This case concerns the question of whether the Defendant has infringed B&B Hotels’ rights and acted contrary to good domain name practices (god domænenavnskik) by registering the domain name hostelbb.dk and bbhostel.dk.

The Defendant:

1.2. The Defendant conducts commercial business in Denmark that involves services which are identical and/or similar to the services of the Complainant and within the same business field.

*1.3 The Defendant is registered as the owner of the sole proprietorship under the name Charlotte Andersen (CVR no. 28200374) which was established in 2005. As can be seen in the attached company transcript from the Central Business Register (**Appendix 1a**), this company was historically named “Danhostel Vejle Vandrerhjem” and is linked to the production unit no. 1011026938 that operates under the same name and the same business field involving “accommodation services in the form of hostels”.*

*1.4 Danhostel Vejle Vandrerhjem is a hostel located in Vejle, Denmark. The hostel is a branch of the large franchisor DANHOSTEL which includes 64 hostels in Denmark that provide budget accommodation in Denmark. See the attached screen prints from the websites vejledanhostel.dk and danhostel.dk (**Appendix 1b**).*

The Complainant:

*1.5 The Complainant’s company in Denmark, B&B Hotels Denmark ApS, CVR no. 40380388, was established on 4 March 2019. The company is fully owned by the French company Financiere B&B Hotels, 271 rue du Général Paulet, 29200 Brest, France. A complete company transcript from the Danish Central Business Register and the French Main Registration in the Trade and Companies Register is attached as **Appendix 2**.*

*1.6 B&B Hotels was first established in France in 1990 and is one of the leading independent budget hotel chains in Europe. It is the third largest economy hotel chain in France with a network of more than 500 hotels and it has regularly won awards like the Hospitality Awards in 2006 and again in 2019. Today, B&B Hotels is the owner of more than 500 hotels and more than 40,000 rooms across Europe: Spain, Portugal, France, Germany, Italy, Poland, Czech Republic, Austria, Switzerland, Slovenia and Belgium. See attached **Appendix 3** which contains a list overview over number of B&B Hotels.*

*1.7 Over the twenty years since B&B HOTELS has been used, the Complainant has invested substantially in the development of its services, marketing and advertising of its brand. In order to proactively protect and market the B&B HOTELS trademark (depicted in section 1.9. below) on the Internet, the Complainant registered many domain names, as early as 1998, consisting of the elements “BB” and ”HOTEL” combined (with or without hyphens), either under the format “HOTEL(S)BB” or ”BBHOTEL(S)”. A list of the Complainant's domain names portfolio alongside transcripts from Whois.com is attached as **Appendix 4**. The Complainant also owns several trademarks composed of the elements “BB” and “HOTEL” in*

various order, such as the French trademark *bb-hotel* n°023182313, the French trademark *hotelbb* n°023182312 and many others. A list of these trademarks is listed in **Appendix 5**.

The actual circumstances of the case:

1.8 In 1998 the Complainant, *B&B Hotels*, created and registered the domain name *hotel-bb.com* and has since then continually used the domain name to provide hotel services under the name *B&B Hotels*. Today the domain name is registered under the name of *Casper BidCo*, a sister company to *B&B Hotels* (see transcript from *Whois.com* attached as **Appendix 6**).

1.9 In 2006 *B&B Hotels* registered the EU-trademark no. 004767323,



for “Hotels, restaurants, cafeterias, bars, reservation of hotels and temporary accommodation” services in class 43 (the Registered Trademark)

1.10 On 30 January 2021 the Defendant created and registered the domain names *hostelbb.dk* and *bbhostel.dk* (see transcript from *DK Hostmaster* attached as **Appendix 7**). The registration was discovered on 10 May 2021 following which investigations were conducted by *B&B Hotels*’ attorneys to determine the registrant and the intentions for the domain names *hostelbb.dk* and *bbhostel.dk*.

2. GROUNDS

2.1 In support of the claims of the Complainant, here are the Complainant’s grounds for the complaint.

Infringement of B&B Hotels trademark rights

Reputed trademark

2.2 *B&B Hotels* is the registered proprietor of the prior EU-trademark no. 004767323,



which is a trademark that has a reputation and has been established by use within the meaning of Section 4(2)(3) of the Danish Trademark Act (*Lovbekendtgørelse 2019-01-29 nr. 88*) (TMA) and Article 9(2)(c) of Regulation (EU) 2017/1001 of the European Parliament and

of the Council of 14 June 2017 on the European Union trade mark (EUTMR) throughout the European Union.

2.3 It follows from Section 4(2)(3) TMA and Article 9(2)(c) EUTMR that a proprietor of an EU trademark is entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where the sign is identical with, or similar to, the EU trademark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trademark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trademark.

2.4 According to principle set out in the Judgement of the Court of Justice of the European Union (CJEU) in case C-125/14, *IRON & SMITH*, para. 34, if a trademark has already proved to have a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State where reputation is claimed, the trademark may be regarded as a reputed trademark if “it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

2.5 The Complainant submits **Appendices 8a-e** as proof of the reputation of the trademark within a substantial part of the territory of the European Union. B&B Hotels is established in Denmark with a Danish CVR number. With the large number of hotels located in various popular travel destinations such as Hamburg very close to Denmark, Rome and Madrid, the relevant public in Denmark has been and will be exposed to the trademark when searching for budget accommodation for travels in Europe. A commercially significant part of the Danish relevant public is therefore familiar with the trademark B&B Hotels, as this mark will appear when searching for budget temporary accommodation located in the EU.

Use in the course of trade (commercial exploitation)

2.6 The registration itself of a domain name that is confusingly similar to the reputed trademark can be considered as use in the course of trade even when the domain name does not point to the registrant’s website. This follows from the relevant Judgement of the Danish Maritime and Commercial High Court of 22 June 2015 no. SH2005.V-0106-01 regarding the domain name *ups.dk* (published in UfR 2007.1857 H). The following passage from the Judgement can be highlighted:

”Med hensyn til om anvendelsen af *www.ups.dk* sker erhvervsmæssigt, lægger retten vægt på, at der ved søgning på domænet fremkommer en hjemmeside med henvisning til et firma, og at der optræder bannerreklamer. Uanset om disse måtte hidrøre fra indehaveren af domænet eller ej, finder retten, at der derved er tale om erhvervsmæssig brug af domænet *ups.dk*.”

2.7 In this case, the domain name has not yet been exploited by the registrant to point to her website, but as can be seen from the attached **Appendix 5**, when entering the domain names *hostelbb.dk* and *bbhostel.dk*, the websites display advertisements where reference is made to

the webhost of the domain names, “one.com”. According to the principle of the Judgement in SH2005.V-0106-01, even if the advertisement does not originate from the Registrant themselves, the use of the domain name must still be regarded as commercial use.

2.8 Moreover, it must be noted that there is an eminent risk that the Defendant will use the domain names commercially in relation to hostel/temporary lodging services because of her current business field as described above in section 1.2 – 1.4.

2.9 In the Judgement of 8 May 2002 no. SH2002.V-0139-99 regarding the domain name br.dk (published in UfR 2004.1561 H), The Danish Maritime and Commercial High Court has also acknowledged that even when a domain name registered by a third party has not yet been put to use in relation to specific goods/services, the domain name must be considered an exclusive right belonging to the trademark proprietor under the condition that all future use for specific goods of the domain name would be regarded as infringements of a trademark that can be prohibited by the proprietor. In said case, the domain name was transferred to the trademark proprietor. In the present case, any use in relation to temporary lodging services would be considered infringement of B&B Hotels trademark due to the reasons listed below:

Connection and likelihood of confusion

2.10 According to the principle set forth in Judgement of the CJEU in case C-252/07, Intel, para. 42, the following may be relevant factors when assessing whether there exist a connection or link between the domain names and the Registered Trademark:

- The degree of similarity*
- The existence of a likelihood of confusion*

2.11 The domain names in question consist of the words “hostel” and “bb” ending with the country code top-level domain “.dk”. The Complainant’s trademark is a figurative mark consisting of the word “B&B Hotels” in a circular device consisting of two rings, one placed within the other

2.12 When comparing the Complainant’s Registered Trademark with the domain names, it must be taken into consideration that the country code top-level domain “.dk” is generic and descriptive and therefore may be disregarded or at least bears little weight in the overall assessment of the likelihood of confusion.

2.13 The Registered Trademark and the domain names share the same letters “B”, “B” and “H”, “O”, “T”, “E”, “L”, “S” in the almost identical order. The ampersand contained in the Registered Trademark cannot be characterized as a highly distinguishing factor. Moreover, the words “hotels” and “hostel” are highly visually and aurally similar and conceptually similar above average as it is only the placement of the letter “S” that differentiate the two words and the purpose of a hotel and a hostel is the same, just price may vary. Conceptually both words refer to “temporary lodging/accommodation”. Due to the visual and high aural similarity, and the very high conceptual similarity, the domain names and the Complainant’s Registered Trademark are highly similar.

2.14 The above is supported by CJEU case law regarding trademarks parallel to the case at hand. In case T-552/10, the Court found the two marks



and “VITAFIT” to be similar as they are conceptually identical and have an average degree of similarity in the visual and aural aspects. Visually, the marks “vital fit” and “vitafit” have a strong visual similarity just as in the present case regarding the domain names *bbhostel.dk*, *hostelbb.dk* and the trademark containing the words “B&B Hotels”.

2.15 The Court found that on a conceptual level, both marks reflected the message of a healthy life. In the case at hand, the domain names and the Registered Trademark all three refer to the concept of temporary accommodation.

2.16 Moreover, the Court found that the figurative elements in the mark “vital & fit” did not significantly influence the overall visual impression of the mark a.o. because the ampersand (“&”) is in a thinner font than the rest of the text. Direct parallels can be drawn to the present case where the ampersand in the figurative mark B&B Hotels is thinner and therefore appears smaller than the rest of the text.

2.17 As for the aural similarity, the court found that the ampersand, in this case pronounced in German as “und”, in the middle of the mark was not enough to remove the aural similarity of the marks.

2.18 The above decision relates to marks that are built up in a similar way as *hostelbb.dk* and *bbhostel.dk* (word/domain names) as well as B&B Hotels (figurative). Consequently, it will be in accordance with prior EU Court practice to conclude that there is a likelihood of confusion.

2.19 The likelihood of confusion is also emphasized by the fact that when registering a domain name, the ampersand cannot be registered as part of a domain name. Such ampersand appearing in the Complainant's trademark is irrelevant in the assessment of the similarity of the sign. Consequently, the possible domain names that can be used to refer to B&B Hotels are limited to some combination of the letters “BB” and “hotels”. The Complainant itself removed the ampersand in its own domain name registrations associated with the B&B HOTELS mark. This is also the reason why the Complainant's domain name is “*hotelbb.com*”. Internet users are familiar with the fact that ampersands are not used in Internet addresses. They do know and expect that a mark such as “B&B HOTELS” will be used on the Internet without the ampersand in a domain name and web address.

2.20 The services provided by the Defendant would be highly similar and/or identical to the services of B&B Hotels. When a potential customer encounters the Danish domain names, he may be confused that the question is of an undertaking of the Complainant or an economically linked undertaking. As a result, a link between the domain names and the Registered Trademark is and will be established.

Risk of future injury - Unfair advantage and detriment to the repute of the Registered Trademark

2.21 *The domain names are confusingly similar to the degree where the average customer of the relevant public may think that the website under the domain names belong to the Complainant.*

2.22 *Currently, the domain names are not referring to the Defendant's own website. This means, that any potential customer entering the site will be met with the one.com advertisement as shown in **Appendix 9** and may mistakenly think that the website of B&B Hotels is out of order. This poses a risk of injury for the Complainant and may even be detrimental to their repute.*

2.23 *It is obvious that the Defendant is taking commercial advantage of the Internet traffic coming to its website thanks to the disputed domain names. It is clear that the customers can be attracted to the Defendant's domain name while trying to reach the Complainant's famous domain names and websites, considering the identity or high degree of similarity between the Complainant's trademarks and the Defendant 's domain names. This creates a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Defendant's website.*

2.24 *Moreover, due to the professional background and experience of the Defendant in the field of temporary accommodation services, it is highly likely, that the Defendant will provide similar and/or identical services through the website in the future. Therefore, there is an eminent risk of future injury in the form of free riding (unfair advantage) by the Defendant on the reputation linked to B&B Hotels.*

Sub-conclusion

2.25 *Therefore, as substantiated and illustrated above, the creation, continued registration and any future use by the Defendant of the domain names hostelbb.dk and bbhostel.dk constitute an infringement of B&B Hotels trademark rights*

Marketing Practices

2.26 *Even if the Complaints Board of Domain Names should reach the conclusion that the Registered Trademark was not infringed, it follows from Section 22 of the Danish Marketing Practices Act (Lov 2017-05-03 nr. 426 om markedsføring) that: "Traders may not use business identifiers and similar devices that do not belong to them, nor use their own business identifiers in a manner that is likely to cause confusion with those of others."*

2.27 *In the Judgement no. SH2002.V-0139-99 mentioned above, the Court concluded that the registrant's registration of the contested domain name br.dk violated Section 1 and 5 (now Section 22) of the Danish Marketing Practices Act by registering the domain name containing the business identifier of the well-known toy manufacturer, BR-Legetøj A/S. The Court placed emphasis on the fact that internet users searching for the website of the toy manufacturer*

would encounter the contested domain name website which was not put to use. This would result in injury for the toy manufacturer:

“Det må antages, at en betydelig del af de brugere, som for første gang ønsker at søge BR's hjemmeside på nettet, vil søge på domænenavnet www.br.dk og få oplysning om, at siden ikke er tilgængelig. Med den udbredelse, som anvendelse af internettet har, må meddelelsen herom antages at have markedsføringsmæssig skadevirkning for Top-Toy”.

*2.28 Parallels can be drawn to the case at hand. Any potential customer that wishes to find the website of B&B Hotels attempts to guess their .dk domain name and may then mistakenly think that these domain names belong to the Complainant due to the confusing level of similarity to the existing domain names of the Complainant (e.g. hotel-bb.com, and hotelbb.it, hotelbb.fr, hotelbb.de that redirect the user to hotel-bb.com). All internet users entering the site under the domain names hostelbb.dk and bbhostel.dk will be met with the one.com advertisement as shown in **Appendix 5** and may mistakenly think that the website of B&B Hotels is out of order. This may cause damage and market disorder for B&B Hotels.*

Company name rights and good domain name practices

2.29 Section 6(2) of the Act on Commercial businesses (Lovbekendtgørelse 2021-02-01 nr. 249 om visse erhvervsdrivende virksomheder) states that business names must be clearly distinguishable and that trade names must not contain the trademarks, business identifiers or anything else that may be confused with these.

2.30 Moreover, according to Section 25 of the Internet Domain Name Act (Lov 2014-02-26 nr. 164 om internetdomæner), registrants may not register domain names contrary to good domain name practices.

2.31 According to the preparatory works to Section 25 of the Internet Domain Act (Folketingstidende 2013-14, Appendix A, pp. 30-31), it is assumed, among other things, that the requirement for compliance with good domain name practice applies to various kinds of dispositions regarding the domain name, including: Registration, exploitation, marketing, transfer, use and disclosure of domain names. Consequently, it is thus not intended to add any restriction in what incidents regarding registration and use of domain names may be subject to the duty to follow the good domain name practice. Based on this, the factors included in the assessment of good domain name practice, does not only become relevant at the moment of registration, but must also include relevant factors that arise at a point later in time.

2.32 It is also assumed in the preparatory works opposing considerations, such as the legitimate interest of the parties, the value of the domain name for each party and aspects related to the time of the registration of the domain name must be included in the assessment of whether an act is against Section 25 of the Internet Domain Act.

2.33 As concluded above, the domain names hostelbb.dk and bbhostel.dk are confusingly similar to the client's company name “B&B Hotels” to a degree where visitors may misread the domain names and be misled to believe that the domain names belong to B&B Hotels.

2.34 Internet domain names function as the company's virtual company name and as a virtual "shop sign". Domain names containing a confusingly similar name to B&B Hotels trade name constitute a violation of Section 6(2) of the Act on Commercial Businesses.

2.35 Furthermore, B&B Hotels already have an established by use reputed trademark and, as can be seen from the Danish trademark application (no. VA 2020 01532), and the Danish company name registration (CVR no. 40380388), have interests that are expanding into Denmark. Therefore, B&B Hotels has a legitimate interest in the domain names, whereas the Defendant seemingly has no legitimate interest in acquiring the domain names. The Defendant and the business of the Defendant have no relation to the letters "BB".

2.36 On the contrary, the Defendant has registered the domain names several years after the establishment of B&B Hotels and the registrations of B&B Hotels domain names and trademarks. At this point, B&B Hotels have acquired reputation due to the time, effort and money invested in promoting the brand in the EU. It cannot be excluded that the Defendant recognized the benefit in this well-established name and chose to register the confusingly similar domain names to harvest the goodwill of B&B Hotels.

2.37 As a result, the Defendant's registration of the domain names bbhostel.dk and hostelbb.dk is contrary to good domain name practices, cf. Section 25 of the Internet Domain Act and the Defendant must be ordered to transfer the domain names to the Complainant

*2.38 Lastly, the Complainant refers to previous domain name complaint decisions by the WIPO Arbitration and Mediation Center where B&B Hotels has successfully obtained transfer of the infringing domain names groupebbhotels.com, bbb-hotel.com, bbb-hotels.com and bbhotels.net (**Appendix 10**).*"

Som bilag 1 har klageren fremlagt udskrift fra Det Centrale Virksomhedsregister vedrørende indklagede samt skærmpoint fra hjemmesiden for Danhostel Vejle på domænenavnet "vejle-danhostel.dk".

Bilag 2 er udskrift fra Det Centrale Virksomhedsregister vedrørende klageren, hvoraf bl.a. fremgår, at klageren er registreret med startdato den 14. marts 2019.

Bilag 3 er en oversigt over klagerens hoteller.

Bilag 4 er efter det oplyste en oversigt over de af klageren og klagerens moderselskab registrerede domænenavne, der indeholder en kombination af betegnelserne "bb" og "hotel", under forskellige top level-domæner.

Bilag 5 en oversigt over de af klageren og klagerens moderselskab registrerede varemærker (ord- og figurmærker), der indeholder en kombination af betegnelserne "bb" og "hotel".

Bilag 6 er skærmpoint fra hjemmesiden på domænenavnet "namebay.com" med registrantoplysninger om domænenavnet "hotel-bb.com".

Bilag 8 fremstår navnlig som skærmpoint og kopier af nyhedsartikler og –notitser om B&B Hotels i især Frankrig, Tyskland og Italien samt skærmpoint fra B&B Hotels' nationale hjemmesider og kopier af B&B Hotels' markedsføringsmateriale.

Bilag 10 er kopi af panelafgørelser af 14. december 2020 og 8. april 2021 fra WIPO Arbitration and Mediation Center vedrørende domænenavnene "bbhotels.net", "bbb-hotels.com" og "bbb-hotel.com".

I svarskriftet er bl.a. anført følgende:

"Domænenavnene er erhvervet i forbindelse med, at indklagede - som følge af Corona og i forbindelse med genåbningen af Danmark - har været nødsaget til at ændre sit forretningskoncept.

Indklages forretningskoncept er herefter Bed & Breakfast kombineret med hostel.

Der vil således være mulighed for, at man hos indklagede dels kan indlogere sig ved Bed & Breakfast og dels på ren hostel-vis.

Det bemærkes i den forbindelse, at indklagede ikke driver hotelvirksomhed men hostel med dertil hørende fællesarealer og fællesskab.

Som bilag A vedlægges udskrift fra Zleep Hotels der er en kæde af økonomihoteller.

Zleep Hotels har i bilag A redegjort for forskellen mellem hotel, motel og vandrerhjem.

Det fremgår side 1, 3. afsnit under Vandrerhjem, at vandrerhjem er en budget venlig og ofte meget social overnatningsmulighed.

Derudover fremgår det af 3. linje at den engelske betegnelse for hotelkategorien hostel, er ved at vinde frem i Danmark som et mere populært udtryk.

Det må herefter kunne lægges til grund, at hostel er en almindelig kendt betegnelse i Danmark for vandrehjem, ligesom vandrerhjem er en særskilt overnatningskategori.

Der henvises endvidere til side 4, hvor der er redegjort for forskellen mellem vandrerhjem og hoteller.

For så vidt angår indklagedes forretning, kan der svares ja til alle de tydelige forskelle, der er oplyst i bilag A side 4.

Det er herefter i det hele opfattelsen, at hostel er et selvstændigt produkt, der tiltrækker et andet segment end det klassiske hotelsegment, der ønsker at benytte økonomihoteller som dem klageren repræsenterer.

Det gøres herefter gældende, at der ikke er nogen muligheder for forveksling, idet det segment der vil søge på hotel, ikke ved en fejl vil skrive hostel.

Ligesom det segment der vil søge efter hostel, vil søge på hostel og ikke hotel.

For så vidt angår muligheden for forveksling, gøres det gældende, at den reelt ikke er tilstede, idet der dels er tale om to almindeligt kendte ord:

Hotel og hostel

ligesom bogstavforskellen i form af S i hostel ikke umiddelbart giver mulighed for forveksling eller fejl i forbindelse med søgning, da de færrest vil søge på hotel med et S i midten.

Det bemærkes således også, at de afgørelser der er fremlagt, vedrører tilfælde, hvor S er sat bag på hotel, således det bliver til hotels.

For så vidt angår BB i Bbhostels.dk og Bbhostel.dk, er det opfattelsen, at det heller ikke giver nogen anledning til forvikling, idet der henvises til Bed & Breakfast.

*Det bemærkes endeligt at indklagede alene har erhvervet Domænenavnene **Bbhostel.dk** og **Bbhostel.dk***

Indklagede har således ikke søgt nogen former for internationale domænenavne som @com, @net. eller andet.

Det må også derfor kunne lægges til grund, at Indklagedes erhvervelse af domænenavnene Bbhostel.dk og Bbhostel.dk er helt konkret og forretningsmæssigt betinget ligesom den alene er regionalt betinget i forhold til virksomhedens behov.

For så vidt angår anvendelsen af Hostel i øvrigt bemærkes det, at de af klager i appendiks 7 oplyste domænenavne ikke for nogens vedkommende indeholder ordet hostel.

Det er herefter opfattelsen, at klager er vidende om og accepterer, at der er tale om to forskellige produkter og to forskellige kundesegmenter, hvorfor reel forveksling ikke er tilstede.”

Bilag A er skærmprent fra hjemmesiden på domænenavnet ”zleep.com” med en forklaring på forskellene mellem ordene ”hotel”, ”motel”, ”hostel” og ”vandrerhjem”.

I replikken er bl.a. anført følgende:

”The claims and statements made in the Complaint are maintained in their entirety with the minor modification that in the Reply the Defendant has confirmed the commercial purpose of acquiring the disputed domain names, and that accordingly paragraphs 2.6-2.9 of the Statement of Claim (Klageskriftet) should be regarded as supplementary argumentation.

1. ADDITIONAL FACTS AND EVIDENCE

1.1. *Contrary to the claims made by the Defendant, a likelihood of confusion between the Complainant's Registered Trademark Rights and the domain names remains.*

1.2 *According to the Response filed by the Defendant dated 9. July 2021, the Defendant the domain names bbhostel.dk and hostelbb.dk are intended for commercial use for the Defendant's "bed & breakfast and hostel services".*

1.3 *The submitted Appendix A does not change the fact that the services provided by the Defendant are highly similar to and clearly overlapping with the services provided by the Complainant under the earlier trademark and domain names. This is supported by EU trademark practice. In the Decision by the EUIPO Opposition Division of 10 October 2018 on Opposition No B 2 940 073, it was concluded that "The contested hostels and boarding houses are highly similar to the opponent's hotels, as they have the same nature and purpose (temporary accommodation), they may be offered through the same channels and they have the same consumers. Furthermore, they may be in competition." The Decision was upheld in the Appeal case before the EUIPO Boards of Appeal, case No R 2073/2018-4.*

1.4 *Similarly, in Opposition No B 2 567 595, the EUIPO Opposition Division concluded that hotel services and hostel services are similar, which was later confirmed in the Appeal case No R 406/2018-4. The decisions are attached as **Appendix 11**. That fact that the hotel services offered by B&B Hotels are in a similar price range to the services offered as hostel services further supports that the services are in competition and therefore must be deemed as similar.*

1.5 *The term "BB" used in both the Complainant's various domain names as shown in Appendix 4 and the disputed domain names bbhostel.dk and hostelbb.dk is not a generic or normal abbreviation for "bed & breakfast". This is in accordance with the assessment of the Danish Trademark Office. An extract from one of the Danish Trademark Office's letters in opposition proceedings where B&B Hotels have been involved is attached as **Appendix 12**. As it can be seen, the Danish Trademark Office concludes that "BB" is not equivalent of "bed & breakfast" and will not be perceived as an abbreviation thereof by the Danish consumers.*

1.6 *Therefore, the term "BB" is distinctive a term for hotel, hostel, bed & breakfast and similar services, which has been subject to longstanding use by B&B Hotels through, inter alia, their domain names where the term is placed either in front of or after the term "hotel(s)".*

1.7 *When considering whether a likelihood of confusion exist, the signs must be considered in their entirety. When comparing the trademarks and domain names of B&B Hotels with the disputed domain names, it is apparent that the signs only differ by the position of the letter "S" and the usage of the ampersand symbol. Regardless of where the letter "S" is placed within the word or as suffix or prefix, there is still a likelihood of confusion of the disputed domain names with the trademarks and domain names owned by B&B Hotels. A misspelling or mistyping of a word may occur irrespective of the order of the letters when like in this matter the words consist of the identical letters.*

1.8 Taking into account all of the above and the statements and evidence submitted in the Statement of Claim, it must be concluded that the disputed domain names bbhostel.dk and hostelbb.dk are confusingly similar to the trademarks owned by B&B Hotels (Appendix 5) and the domain names registered by B&B Hotels (Appendix 4) and that accordingly, this complaint must be taken into account.

1.9 As the term "BB" is not an abbreviation for "bed & breakfast", the Registrant cannot claim having any legitimate interest in using the letters "BB" as an abbreviation of "bed & breakfast" in their domain names. Considering the high risk of likelihood of confusion as B&B Hotels is establishing a branch on the Danish market, and consumers may mistakenly think that services offered under the disputed domain names are offered by the same undertaking or a economically linked undertaking to B&B Hotels, the legitimate interests of B&B Hotels in obtaining the disputed domain names outweighs the interests of the Defendant.

1.10 The disputed domain names hostelbb.dk and bbhostel.dk must therefore be transferred to B&B Hotels."

Bilag 11 er kopi af en indsigelsesafgørelse af 10. oktober 2018 fra EUIPO, hvori bl.a. er anført følgende:

"hostels and boarding houses are similar to the opponent's hotels, as they have the same nature and purpose (temporary accommodation)".

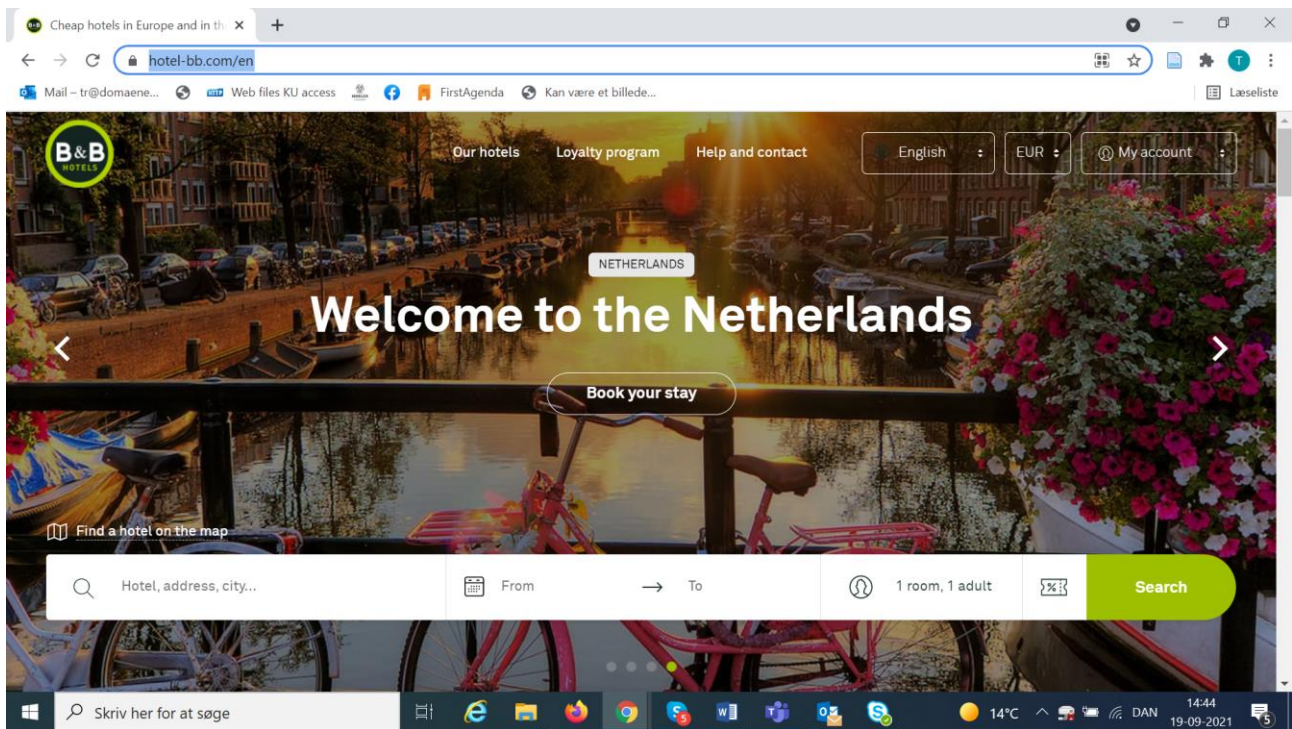
Bilag 12 er kopi af et dokument af 3. september 2019 fra Patent- og Varemærkestyrelsen med titlen "Bemærkninger fra tredjemand vedrørende din ansøgning", hvori bl.a. er anført følgende:

"Det er som følge heraf ikke dokumenteret, at "BB" er en almindelig og kendt forkortelse for "Bed & Breakfast".

Styrelsens egne undersøgelser understøtter ovenstående, idet det ikke kan påvises, at "BB" er en almindelig og kendt forkortelse for "Bed & Breakfast".

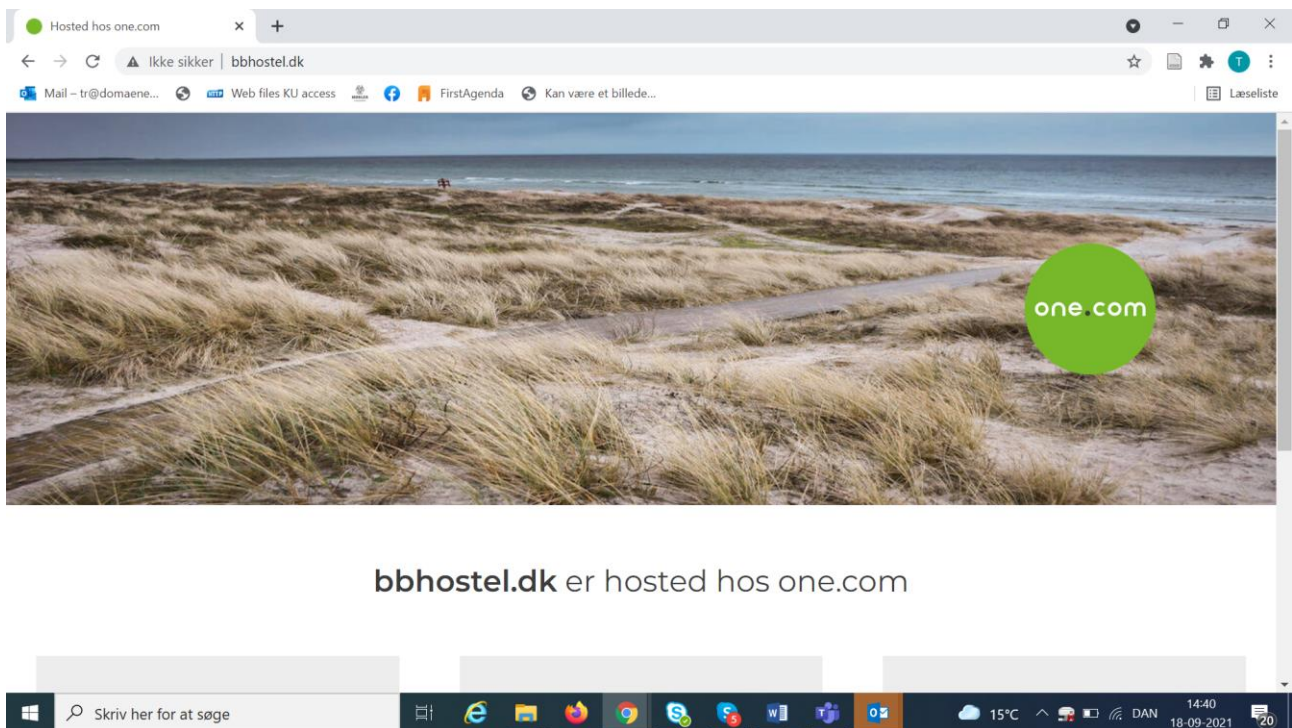
Der er efter styrelsens vurdering endvidere ikke tale om en uvæsentlig udeladelse af "&"-tegnet, tværtimod."

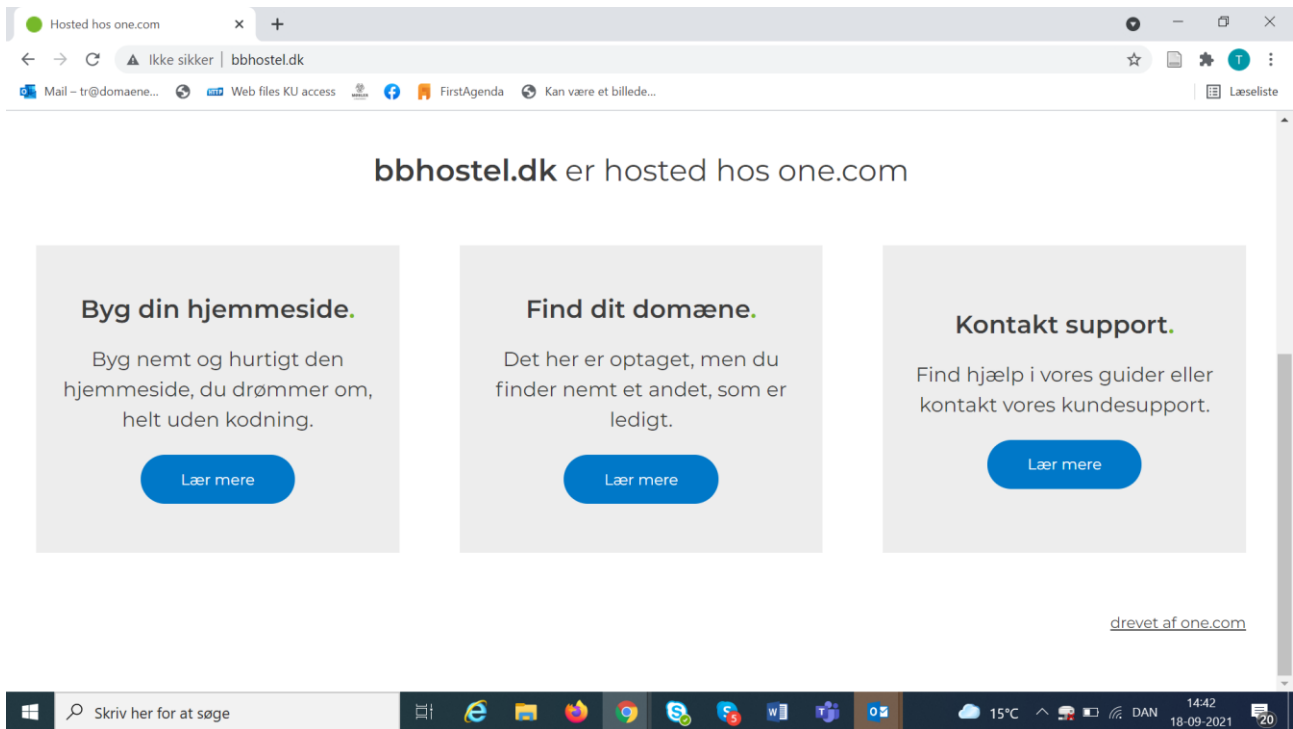
Ved opslag på klagerens moderselskabs hjemmeside på domænenavnet "hotel-bb.com" har sekretariatet den 19. september 2021 taget følgende kopi:



Ved aktivering af linket ved teksten ”Find a hotel on the map” har sekretariatet konstateret, at klageren tilsyneladende ikke driver hotelvirksomhed i Danmark.

Ved opslag på hjemmesiderne på domænenavnene ”hostelbb.dk” og ”bbhostel.dk” har sekretariatet den 11. juni 2021 og igen den 18. september 2021 taget følgende kopier, jf. bilag 9:





Ved opslag på Patent- og Varemærkestyrelsens hjemmeside har sekretariatet konstateret, at virksomheden BB-HOTELS ApS, Store Torv 17, 1., 3700 Rønne, den 27. juni 2007 fik registreret følgende figurmærke i klasse 43 for ”Tilvejebringelse af mad og drikke, midlertidig indkvartering, hoteller og pensionater, nemlig bed and breakfast”:



Det fremgår af Patent- og Varemærkestyrelsens hjemmeside, at der ikke er gjort indsigelser mod denne varemærkeregistrering.

På BB Hotels' hjemmeside på domænenavnet ”bbhotels.dk” er virksomheden beskrevet på følgende måde:

”BB-Hotels er en bornholmsk ejet hotelkæde der ønsker at tilbyde hotelovernatning til rimelige, gennemskuelige priser.”

Sekretariatet har endvidere konstateret, at BB-HOTELS ApS den 10. april 2019 har søgt om varemærkeregistrering af ordmærket BB-HOTELS i klasse 43. Det fremgår af sagsakterne, at tredjemand har gjort indsigelse, og at Patent- og Varemærkestyrelsen i den forbindelse konkluderede, at ordmærket BB-HOTELS har fornødent særpræg, jf. bilag 12. Denne indsigelsessag er endnu ikke afgjort.

Ved opslag på Patent- og Varemærkestyrelsens hjemmeside har sekretariatet konstateret, at klagerens franske moderselskab den 2. marts 2020 søgte om varemærkeregistrering af følgende figurmærke:



Det fremgår endvidere, at BB-HOTELS ApS gjorde indsigelse over for varemærkeansøgningen, og at denne indsigelsessag endnu ikke er afgjort.

Ved opslag på Den Europæiske Unions Kontor for Intellectuel Ejendomsret (EUIPO) hjemmeside har sekretariatet konstateret, at klagerens franske moderselskab den 12. december 2006 fik registreret følgende figurmærke som EU-varemærke i klasse 43 for *"Hotelvirksomhed, restauranter, cafeterier, barer, hotelreservation og reservation af værelser til udlejning"*:



Parternes anbringender kan sammenfattes således:

Klageren har gjort gældende,

- at klageren er ejet af den franske virksomhed "Financiere B&B Hotels",
- at B&B Hotels blev stiftet i Frankrig i 1990 og er en af de førende uafhængige kæder af discount-hoteller med mere end 500 hoteller i Europa,

- at klageren har foretaget omfattende investeringer i udvikling og markedsføring af sit brand,
- at klageren er registrant af mange domænenavne, der består af en kombination af betegnelserne "bb" og "hotel",
- at klageren i 1998 fik registreret domænenavnet hotel-bb.com og har siden brugt det kontinuerligt til markedsføring af sin virksomhed,
- at klageren er indehaver af adskillige velkendte varemærker, der består af en kombination af betegnelserne "BB" og "hotel", og som er registreret for hoteller, restauranter, cafeterier, barer, hotelreservationer og midlertidig indkvartering i klasse 43,
- at betegnelsen "bb" ikke er generisk eller en normal betegnelse for "bed & breakfast" og derfor har varemærkeretligt særpræg for hotel, hostel, bed & breakfast lignende tjenesteydelser,
- at indklagede er indehaver af enkeltmandsvirksomheden "Danhostel Vejle Vandrerhjem",
- at indklagede driver virksomhed i Danmark med udbud af tjenesteydelser, der er identiske med eller af samme art som de tjenesteydelser, der udbydes af klageren,
- at der på domænenavnene "hostelbb.dk" og "bbhostel.dk" findes en standard-parkeringside for internetvirksomheden "one.com", og at domænenavnene derfor anvendes på en varemærkeretlig relevant måde,
- at det er sandsynligt, at indklagede vil bruge domænenavnene "hostelbb.dk" og "bbhostel.dk" erhvervsmæssigt til markedsføring af indklagedes virksomhed, der ifølge virksomhedens navn er et vandrerhjem,
- at en hvilken som helst brug af domænenavnene "hostelbb.dk" og "bbhostel.dk" i forbindelse med udbud af tjenesteydelser vedrørende indkvartering vil krænke klagerens varemærkeret,
- at der er risiko for forveksling mellem domænenavnene "hostelbb.dk" og "bbhostel.dk" og klagerens varemærke,
- at indklagedes fortsatte registrering og fremtidige brug domænenavnene "hostelbb.dk" og "bbhostel.dk" krænker klagerens varemærkeret,
- at indklagedes brug af domænenavnene "hostelbb.dk" og "bbhostel.dk" er i strid med markedsføringslovens § 22,
- at indklagedes brug af domænenavnene "hostelbb.dk" og "bbhostel.dk" er i strid med § 6, stk. 2, i lov om visse erhvervsdrivende virksomheder,
- at indklagede og indklagedes virksomhed ikke har nogen forbindelse til betegnelsen "BB" og derfor ikke har nogen legitim interesse i domænenavnene "hostelbb.dk" og "bbhostel.dk", og
- at indklagedes registrering af domænenavnene "hostelbb.dk" og "bbhostel.dk" er i strid med god domænenavnsskik, jf. domænelovens § 25, stk. 1.

Indklagede har gjort gældende.

- at indklagede ikke driver hotelvirksomhed men hostel med dertil hørende fællesarealer og fællesskab,
- at indklagede som følge af Corona-situationen har været nødsaget til at ændre sit forretningskoncept til Bed & Breakfast kombineret med hostel,
- at der herefter hos indklagede vil være mulighed for, at man kan indlogere sig ved Bed & Breakfast eller på ren hostel-vis,
- at betegnelsen "bb" i domænenavnene "hostelbb.dk" og "bbhostel.dk" henviser til "Bed & Breakfast",
- at "hostel" er en almindelig kendt betegnelse i Danmark for vandrehjem, ligesom vandrerhjem er en særskilt overnatningskategori, og

- at indklagedes tjenesteydelser henvender sig til et andet kundesegment end klagerens, og at der dermed ikke er nogen risiko forveksling af klageren og indklagede.

Nævnets bemærkninger:

Klageren har bl.a. gjort gældende, at indklagedes anvendelse af domænenavnene "hostelbb.dk" og "bbhostel.dk" krænker klagerens varemærkeret. Klagerens franske moderselskab fik den 12. december 2006 registreret et figurmærke, som indeholder betegnelsen "B&B Hotels" som EU-varemærke i klasse 43 for "Hotelvirksomhed, restauranter, cafeteriaer, barer, hotelreservation og reservation af værelser til udlejning". Klagenævnet finder ikke, at klagerens registrerede figurmærke indebærer, at klageren herved har opnået en eneret til brug af betegnelsen "bb" for tjenesteydelser vedrørende hoteller og anden midlertidig indkvartering.

Vil klageren påberåbe sig at have opnået en kendetegnsret til betegnelsen "bb" for hotelvirksomhed og anden midlertidig indkvartering, må klageren derfor godtgøre at have taget betegnelsen "bb" i brug her i landet for varer eller tjenesteydelser, og at betegnelsen vedvarende anvendes for disse varer eller tjenesteydelser, samt at brugen har et omfang, der er af mere end lokalt afgrænset karakter, jf. herved varemærkelovens § 3, stk. 1 nr. 3. Klagenævnet finder ikke, at de oplysninger, som er fremkommet i denne sag, giver grundlag for at antage, at klageren har taget betegnelsen "bb" i brug på en sådan måde, at klageren derved har opnået en kendetegnsretlig beskyttelse, som giver klageren fortrinsret til at benytte denne betegnelse for sin virksomhed efter de kendetegnsretlige regler.

Selvom klagenævnet ikke på baggrund af oplysningerne i sagen kan lægge til grund, at klageren har opnået en kendetegnsretlig beskyttelse af betegnelsen "bb", har indklagede imidlertid som registrant af domænenavnene "hostelbb.dk" og "bbhostel.dk" pligt til at overholde § 25, stk. 1, om god domænenavnsskik, i lov nr. 164 af 26. februar 2014 om internetdomæner (domæneloven). Denne bestemmelse har følgende ordlyd:

"§ 25. Registranter må ikke registrere og anvende domænenavne i strid med god domænenavnsskik".

I forarbejderne til domænelovens § 25, stk. 1, jf. lovforslag L 66 af 13. november 2013 (Folketingstidende 2013-14, Tillæg A, s. 30-31), er det forudsat blandt andet, at kravet om overholdelse af god domænenavnsskik gælder både registrering, ibrugtagning, markedsføring, overdragelse, anvendelse og opgivelse af domænenavne, og at det således ikke er tilsigtet at lægge nogen begrænsning i, hvilke hændelser omkring registrering og brug af domænenavne der kan være underlagt pligt til at følge god domænenavnsskik. De forhold, der indgår i vurderingen af god domænenavnsskik, kan som hidtil ikke alene angå registreringsøjeblikket, men også ethvert senere tidspunkt. Det er endvidere forudsat i forarbejderne, at der fortsat i den praktiske udmøntning af kravet om god domænenavnsskik vil kunne indgå en række modstående hensyn, som må afvejes over for hinanden. I forarbejderne er blandt andet anført følgende om disse hensyn:

"Loven angiver ikke en prioritering af hvilke hensyn, der vejer tungest, men overlader dette skøn til klagenævnet og domstolene. Der er ikke på forhånd foretaget en interesseafvejning mellem private registranter, kommercielle eller samfundsmæssige formål.

I lighed med klagenævnets praksis i dag kan klagenævnet og domstolene i vurderingen af god domænenavnsskik overveje og balancere forskellige hensyn, herunder blandt andet den samfundsmæssige værdi i anvendelsen, hensynet til muligheden for at komme til orde, sammenhængen mellem domænenavnet og den faktiske anvendelse, domænenavnets anvendelse i praksis eller påtænkte anvendelse (teknisk, aktivt eller passivt), værdien af domænenavnet for henholdsvis registranten og tredjeparten, forudgående og efterfølgende forhold, der er relevante for vurderingen, om det er anstødeligt, om det er i strid med anden lovgivning m.v.

Hertil kommer, at hensynet til de tidsmæssige aspekter af sagen ligeledes kan være relevante at inddrage i vurderingen af god domænenavnsskik. Et tidsmæssigt aspekt kunne eksempelvis være forholdet mellem tidspunktet for registreringen af domænenavnet og tidspunktet for etableringen af en tredjeparts rettighed. Et andet tidsmæssigt aspekt kunne være, om en tredjepart har haft mulighed for at registrere det omtvistede domænenavn på et tidligere tidspunkt, eller om tredjeparten burde have kendskab til eksistensen af registreringen af domænenavnet forinden etableringen af en rettighed.”

Det følger af det anførte, at lovgiver har forudsat, at der ved anvendelse af domænelovens § 25, stk. 1, i en situation som den foreliggende skal foretages en interesseafvejning og en afvejning af, om et domænenavn anvendes på loyal måde og til varetagelse af legitime interesser.

Det fremgår af sagens oplysninger, at klageren har fået registreret et antal varemærke, hvoraf visse består af en kombination af betegnelserne ”bb” og ”hotel”. Det fremgår endvidere, at klageren er registrant af et antal domænenavne, der ligeledes består af en kombination af betegnelserne ”bb” og ”hotel”, og at klageren navnlig markedsfører sin virksomhed på hjemmesiden på domænenavnet ”hotel-bb.com”. Klageren har på den anførte baggrund en naturlig interesse i tillige at kunne råde over domænenavnene ”hostelbb.dk” og ”bbhostel.dk”.

Klagerens interesse skal imidlertid afvejes i forhold til de øvrige interesser, som registreringen og anvendelsen af domænenavnene ”hostelbb.dk” og ”bbhostel.dk” involverer, herunder indklagedes interesse.

Domænenavnene ”hostelbb.dk” og ”bbhostel.dk” er registreret af indklagede den 30. januar 2021. Indklagede driver et vandrerhjem, der på engelsk kaldes et ”hostel”. Indklagede har endvidere oplyst, at indklagede som følge af Corona-situationen har været nødsaget til at ændre sit forretningskoncept til Bed & Breakfast kombineret med hostel, og at betegnelsen ”bb” i domænenavnene ”hostelbb.dk” og ”bbhostel.dk” henviser til ”Bed & Breakfast”. Da anvendelse af domænenavnene ”hostelbb.dk” og ”bbhostel.dk” for indklagedes virksomhed er egnet til at afspejle domænenavnets signalværdi, finder klagenævnet, at indklagede har en naturlig interesse i fortsat at kunne disponere over domænenavnene.

Efter en samlet vurdering af parternes modstående interesser, finder klagenævnet det ikke godtgjort, at klagerens interesse i domænenavnene ”hostelbb.dk” og ”bbhostel.dk” væsentligt overstiger indklagedes interesse heri. Klagenævnet finder herefter, at indklagedes fastholdelse af registreringen af domænenavnene ”hostelbb.dk” og ”bbhostel.dk” ikke indebærer en overtrædelse af domænelovens § 25, stk. 1, om god domænenavnsskik.

Da der ikke foreligger oplysninger, som giver klagenævnet anledning til at antage, at indklagedes registrering og fastholdelse af registreringen af domænenavnene ”hostelbb.dk” og ”bbhostel.dk” i øvrigt skulle være illoyal eller på anden måde retsstridig i forhold til klageren, og da indklagede endvidere har været først i tid med hensyn til at lade det pågældende domænenavn registrere, træffer nævnet herefter følgende

A F G Ø R E L S E

Der kan ikke gives klageren, B&B Hotels Denmark ApS, medhold.

Dato: 28. oktober 2021

Jacob Waage
(Formand)

Knud Wallberg

Jens Schovsbo