

ADMINISTRATIVE PANEL DECISION

BH Vigny, BH Hotels, BH Balzac v. Paulo Ferreira, MBI Holdings
Case No. D2022-0770

1. The Parties

Complainant is BH Vigny, BH Hotels, BH Balzac, France, represented by BBLM Avocats, France.

Respondent is Paulo Ferreira, MBI Holdings, United Kingdom, represented by SQUADRA AVOCATS, France.

2. The Domain Names and Registrar

The disputed domain names <amarantebeaumanoir.com>, <amarantecannes.com>, <amarantechampselysees.com>, <hotelbalzac.com>, <hoteldevigny.com> (the “Domain Names”) are registered with Lexsynergy Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 4, 2022. On March 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On March 4, 2022, the Registrar transmitted by email to the Center its response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on March 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint March 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 Respondent of the Complaint, and the proceedings commenced on March 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 21, 2022. The Response was filed with the Center on April 21, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on April 29, 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

The Parties have raised a number of points which are not strictly essential to the disposition of this dispute under the Policy. The Panel will endeavor to limit its discussion to those allegations, arguments, and annexes which are necessary to resolve this dispute.

This dispute involves five Domain Names, each associated with a luxury French hotel (four in Paris and one in Cannes). The Domain Names were registered by Respondent MBI Holdings, whose principal, Paulo Ferreira, apparently was the principal of two entities, JJW Luxury Hotels and Amarante. The Domain Names were registered while JJW Luxury Hotels and Amarante still owned and operated these hotels. Specifically, JJW Luxury Hotels owned and operated Hôtel Balzac and Hôtel de Vigny, and Amarante owned and operated Hôtel Amarante Champs-Élysées, Hôtel Amarante Beau Manoir, and Hôtel Amarante Cannes.

Three active French trademark registrations are potentially relevant to this dispute: HOTEL DE VIGNY (number 1576109, registered by JJW Luxury Hotels on February 19, 1990), HOTEL BALZAC (number 4769041, registered by JJW Luxury Hotels on May 21, 2021), and AMARANTE (number 92423669, registered by Amarante on June 22, 1992).

According to Complainant:

“As a preliminary point, it should be noted that the Complaint takes place in the global context of a takeover of the businesses of the companies JJW LUXURY HOTELS and AMARANTE by the Complainants. Indeed, a final takeover offer was filed on May 25, 2021 regarding the businesses of JJW LUXURY HOTELS and AMARANTE, luxury hotels operators, placed in judicial liquidation. As a result, several hotels, located in France, among which HÔTEL DE VIGNY, HÔTEL AMARANTE CANNES, HÔTEL AMARANTE CHAMPS-ÉLYSÉES, HÔTEL AMARANTE BEAU MANOIR and HÔTEL BALZAC have been acquired [pursuant to] Business Transfer Agreements dated January 21st, 2022.”

The three Complainants, which all appear to be part of the conglomerate Groupe Bertrand, entered into Business Transfer Agreements dated January 21, 2022, with JJW Luxury Hotels and Amarante. The three Complainants also entered simultaneously into Trademarks Assignment Agreements with JJW Luxury Hotels and Amarante. According to Complainant, these agreements had the effect of vesting Complainants with the legal ownership of the trademarks and Domain Names (detailed below) associated with the five hotels in question.

Respondent asserts that, contrary to Complainants' allegation, the transfer of the businesses and the attendant trademarks to Complainants is not a *fait accompli*, as these transactions are currently being challenged in court proceedings in France. Neither party has provided any of the court pleadings. In the “Other Legal Proceedings” section of the Complaint, Complainant left the section entirely blank.

In any event, it does appear that there are various provisions in the Business Transfer Agreements and the Trademarks Assignment Agreements which suggest that there are funds being held in escrow, the disposition of which funds depends on the outcome of certain court proceedings alluded to in the escrow clauses. These provisions, among others, tend to suggest that the assignments of the hotel assets and businesses, as well as the trademarks and Domain Names, are not complete, final, and irreversible.

The Domain Names <hoteldevigny.com> and <hotelbalzac.com> were registered on December 6, 2012. The other three Domain Names were registered at different points over the next seven years: <amarantechampselysees.com> on December 16, 2003; <amarantecannes.com> on December 5, 2008; and <amarantebeauanoir.com> on June 4, 2009. Respondent MBI Holdings is listed as the registrant of the Domain Names.

Each of the Domain Names resolves to a website advertising the hotel which corresponds to the Domain Name.

5. Parties' Contentions

A. Complainant

Complainants contend that they have established all three elements required under the Policy for a transfer of each of the Domain Names.

B. Respondent

Respondent's chief arguments are either reflected above in the "Factual Background" section, or will be taken up below in the discussion of the elements required for a transfer under the UDRP.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainants must satisfy with respect to each of the Domain Names:

- (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.

The Panel need not walk through each of the three elements of the Policy. The Complaint fails for the reasons set forth below. Above all, this appears to be a business dispute, not a classic cybersquatting case.

Respondent's chief argument on the merits of this case is that Complainants do not yet have definitive trademark rights in HOTEL DE VIGNY, HOTEL BALZAC, and AMARANTE, because the validity of the assignment of those marks to Complainants is still the subject of adversarial judicial proceedings. Based on the Panel's review of the transactional documents contained in the record, Respondent's plausible assertion that there are ongoing court proceedings to determine the ultimate ownership of the marks, and Complainants' failure to discuss the ongoing judicial proceedings, the Panel on this record cannot definitively conclude that the subject trademark rights belong to Complainants.

The Panel likewise would have a difficult time deciding the "bad faith" element in this case, given the fact that Respondent's affiliates were legitimately using the subject trademarks and the five Domain Names before the purported transfer of same to Complainants. Given the uncertainty in this record about the nature and current status of the legal proceedings, the Panel is in no position to determine whether Respondent is somehow acting in bad faith by not transferring the Domain Names to Complainants.

Again, Complainants made no mention of the litigation, and, indeed, couched their allegations in such a manner as to suggest that Complainants' rights in the trademarks and Domain Names were fully and finally established. The hole in the story caused by Complainants' silence about the litigation leaves the Panel unable to view Respondent as a "bad faith" actor in this case.

The upshot here is that this case does not present a classic case of cybersquatting. It is, rather, a dispute arising from the purported sale of several hotels (with trademarks and Domain Names legitimately owned for some period of time by the seller), which sale apparently remains the subject of judicial proceedings.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: May 11, 2022