

CEPANI
THE BELGIAN CENTER FOR ARBITRATION AND MEDIATION
ARBITRATION N°44471 – BLABLABUS.BE

COMUTO
vs.
FLIXBUS

DECISION OF THE THIRD-PARTY DECIDER

30 JULY 2019

1. The parties

Complainant : COMUTO s.a.

with registered offices at Avenue de la République 84, 75011 Paris, France

hereinafter referred to as “*the complainant*”

Represented by

Axel DOUCERAIN, trademark attorney at ATLANTIP, Rue Edith Piaf 4, Immeuble Asturia Bât C, 44800 Saint-Herblain, France

Domain name holder, Respondent :

FLIXMOBILITY GmbH (formerly FLIXBUS GmbH)

with registered offices at Birketweg 33, 80369 München, Germany

hereinafter referred to as “*the domain name holder*”

Represented by

Dr. Hannah ECKERMANN, attorney at law at Kroher Strobel Rechts- und Patentanwälte PartmbB, Bavariaring 20, 80336 Munich, Germany

2. Domain name

Domain name: **BLABLABUS.BE**

Registered on: 13 May 2015

hereinafter referred to as “the domain name”.

3. Background of the case

The complainant filed a complaint with CEPANI on 7th June 2019 in view of a decision of a Third-Party Decider, according to the CEPANI Rules for domain name dispute resolution (“the Rules”) and the dispute resolution policy of DNS.be, incorporated in its general conditions (“the Policy”).

The complainant requests that the domain name be transferred in his favour.

The complaint was notified to the domain name holder who was invited to reply.

The domain name holder submitted on 4th July 2019 a response form to answer to the affirmations and accusations of the complainant.

4. Factual information : summary

4.1. The complainant sets out it operates worldwide and since 2006 an online marketplace for carpooling under the trademark BLABLACAR while its website and mobile apps connect drivers and passengers willing to travel together between cities and to share the cost of the journey.

The complainant decided to expand its activities and acquired from SNCF, late 2018, the bus network "Ouibus". The idea is to operate bus lines in various countries such as Germany, Belgium and the Netherlands under the denomination BLABLABUS.

4.2. The domain name holder does not deny that it is active in the same market (transportation of persons) as the complainant, at least in Germany, and therefore a competitor of the latter. This is confirmed by the extract from the *Handelsregister B des Amtsgerichts München* (annex R1) where the latest description of the company's activities reads: "Planung, Konzessionsbeantragung, Vermarktung, Vertrieb und der Betrieb bzw. die Organisation des Betriebs von Fernverkehren im nationalen und internationalen Personenverkehr sowie der Einkauf, Vermarktung und Vertrieb von damit direkt und indirekt im Zusammenhang stehenden Produkten und Dienstleistungen" (registered on 13 January 2015). The previous descriptions (14 March 2012 and 6 September 2012) mention "Marketing und Vertrieb von Tickets für Fernbuslinien (und angrenzende Geschäftsfelder)". In summary, the activities as registered with the German authorities relate to the transportation of persons and the related services.

5. Position of the parties

5.1. Position of the complainant

The complainant argues in its complaint that the conditions of Art. 10.b.1 of the Policy are met since:

- the domain name is identical or confusingly similar to a trademark, etc. in which the complainant has rights;
- the domain name holder has no rights or legitimate interests in the domain name; and
- the domain name was registered or is being used in bad faith.

As a result, the complainant requests that the domain name BLABLABUS.be be transferred to the complainant.

5.2. Position of the domain name holder

The domain name holder argues in its response that the conditions of Art. 10.b.1 of the Policy are not fulfilled since:

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- the domain name is not identical or confusingly similar to any relevant earlier rights in signs of the complainant;
- the complainant failed to demonstrate that there are serious grounds to consider that the contested domain name holder does not have rights or legitimate interests in the domain name; and
- the complainant has failed to prove that the domain name has been registered or is being used in bad faith.

As a result, the domain name holder asks that the request for the transfer of the domain name BLABLABUS.be to the complainant be dismissed.

6. Discussion and findings

6.1 Pursuant to Art. 10.b.1. of the Policy, the complainant has to assert and to prove that:

- i) “the registrant's domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the complainant has rights; and*
- ii) the registrant has no rights or legitimate interests in the domain name; and*
- iii) the registrant's domain name has been registered or is being used in bad faith.”*

(i) “Is identical or confusingly similar to ...”

6.2.1. According to Article 10.b.1., i) of the Policy, the complainant has to prove that the contested domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the complainant has rights.

6.2.2. The complainant alleges to be the owner of a portfolio of very similar or identical trademarks to the domain name BLABLABUS.be, and alleges that the same is also the trade name of its bus activities. It alleges to be the owner of numerous trademarks worldwide within the framework of its activity related to transport.

The Complainant further alleges to be the owner of numerous domain names corresponding exactly to BLABLABUS or similar to this denomination and that have been used for years to identify its websites which provide valuable information to the public about the services it offers, mainly in the field of transport.

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6.2.3. The domain name holder alleges that the complainant has failed to show that it is the owner of any relevant earlier rights in signs identical or confusingly similar to the domain name.

6.2.4. The complainant submits various European Union trademark registrations for **BLABLACAR** (registration No. EM 10812485 for word trademark, dated 31 Aug. 2012; registration No. EM 10813236 for figurative trademark, dated 3 September 2012) as well as an international registration designating the European Union for the word mark **BLABLACAR** (registration No. WO 1305968, dated 22 April 2016).

It also submits various European Union trademark registrations for **BLABLA** (registration No. EM 13431895 for word trademark, dated 27 February 2015; registration No. EM 13434378 for figurative trademark, dated 10 March 2015).

It also submits an international trademark application for the word trademark **BLABLA** originating from France (filed 25 February 2019) and designating the European Union.

The complainant further submits a European Union trademark registration for the word mark **BLABLALINES** (registration No. EM 17311622, dated 7 February 2018) and an international trademark registration designating the European Union for the word mark **BLABLASURE** (registration No. EM 1398437, dated 4 December 2017).

The complainant also submits an international trademark application for the word trademark **BLABLABUS**, originating from France (filed 25 February 2019) and designating the European Union

All trademarks submitted are *i.a.* in class 39 (travel and transportation services).

The complainant also submits numerous domain names of which it is the owner, namely **BLABLABUS.com**, **BLABLABUS.fr**, **BLABLA.com**, **BLABLACAR.com**, **BLABLACAR.fr**, **BLABLACAR.co.uk**, **BLABLACAR.be**, **BLABLACAR.lu**, **BLABLACAR.nl**.

6.2.5. The trademarks **BLABLALINES** (EM 17311622) and **BLABLASURE** (EM 1398437) will not be taken into consideration as they were registered after the domain name. The same applies to the international trademark applications for **BLABLA** and **BLABLABUS** as well as to the international registration of **BLABLACAR**.

6.2.6. The complainant does not submit a relevant registration of any trademark **BLABLABUS** identical to the domain name. It only submits an international trademark *application* designating the European Union. However, trademark applications cannot be considered as valid earlier signs (see C.E.P.A.N.I., 44065, “*marinador.be*”). Furthermore, the application is posterior to the registration of the contested domain name.

The complainant alleges that it is the owner of various domain names **BLABLABUS** that are identical to the domain name at stake, except for the ccTLD. While domain names cannot as such be considered as earlier rights within the wording of Article 10.b.1., i) of the Policy, some decisions have considered that the existence of several similar registered

domain names makes it possible to consider that the complainant is known under this name and that it therefore has a right to a trade name (see C.E.P.A.N.I., 44062, “mobyilines.be”).

However, the complainant has failed to prove a relevant use of the domain names BLABLABUS for considering a possible application of that case law. The domain name BLABLABUS.com cannot in itself be considered as proving that the complainant has a right to a trade name BLABLABUS.

6.2.7. Therefore, the Third-party Decider will consider as relevant only the following earlier trademark registrations: BLABLA (Nos. EM 013434378 and 10813236) and BLABLACAR (No. EM 10812485).

6.2.8. The domain name is confusingly similar to these complainant’s relevant earlier rights.

The domain name “BLABLABUS” is auditorily and conceptually composed of two elements, the first element being “BLABLA” and the second element being “BUS”.

The first element “BLABLA” is distinctive and not descriptive in the sector of activities relating to transport which form the market in which both the complainant and the domain name holder are active. The same observation applies to the trademarks BLABLA and BLABLACAR for travel and transportation services.

The second element “BUS” is however purely descriptive in the travel and transport field, and even more so as regards activities relating to such specific services.

With regards to the above, “BLABLA” is therefore the dominant element in the domain name BLABLABUS.be.

The only difference between the trademarks BLABLA and BLABLACAR, on the one hand, and the domain name BLABLABUS.be, on the other hand, is therefore their eventual respective suffix and the suffix “BUS”.

Given the fact that “BLABLA” has been in itself registered as a trademark by the complainant, and given the fact that the Third-Party Decider is not to assess the validity of the submitted trademarks nor to verify the genuine use thereof, while the domain name holder does not evidence that there is an ongoing opposition against these two trademarks, they must be considered as valid and therefore as meeting the E.U. law requirements of distinctiveness and non-descriptiveness.

With regards to these two earlier trademarks BLABLA (EM 013434378 and EM 10813236), it is considered that where a domain name incorporates the entirety of a trademark, it is usually confusingly similar to that trademark (W.I.P.O., D2009-0227, “unofficialblackberrystore.com”). Therefore, slightly distinctive or purely descriptive elements of differentiation do not exclude the risk of confusion (W.I.P.O., D2000-0404, “straumann-clone.com”; D2000-0664, “priceclub.com *et al*”; D2000-1493, “4microsoft200.com”; D2005-0580, “cialisclones.com”). In this matter, there is no doubt

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that the addition of the suffix “BUS” which is descriptive (while the first element “BLABLA” is distinctive), cannot eliminate the risk of confusion.

With regards to the trademark BLABLACAR (EM 10812485) where the dominant feature of the relevant trademark is recognizable in the domain name, the latter is determined as confusingly similar because, as mentioned above, slightly distinctive or purely descriptive elements of differentiation do not exclude the risk of confusion (W.I.P.O., D2000-0404, “straumann-clone.com”; D2000-0664, “priceclub.com *et al*”; D2000-1493, “4microsoft200.com”; D2005-0580, “cialisclones.com”). This confusing similarity is reinforced by the fact that the only other feature of the domain name, namely the suffix “BUS” is purely descriptive (W.I.P.O., D2003-0251, “artlecorbusier.com *et al*”; D2004-0206, “covancecampaign.com”).

Moreover, in the French language, which is relevant for the examination of a domain name .be, the suffixes “BUS” and “CAR” both describe transportation means even if “CAR” is translated into “voiture” rather than evoking an “autocar”. They can even be considered as synonyms when “CAR” is understood in the French language as meaning a large transportation means for persons (abridged form of “autocar” as used in the day-to-day language).

These elements are highly similar on a conceptual basis irrespective of the languages and therefore, the risk of confusion cannot be denied.

6.2.9. As a result, the domain name is confusingly similar to earlier rights in which the complainant has rights, namely, the trademarks BLABLA and BLABLACAR.

(ii) *Rights and legitimate interests of the domain name holder*

6.3.1. According to Article 10.b.1., ii) of the Policy, the complainant has to prove that the contested domain name holder has no rights or legitimate interests in the domain name.

6.3.2. The complainant states that the domain name holder has no rights or legitimate interests in the domain name and that the choice of the latter is only motivated by the will to create an illegitimate association with the complainant and its activities or to deprive the complainant from the domain name.

6.3.3. The domain name holder states that the complainant has failed to demonstrate that there are serious grounds to consider the domain name holder has no rights or legitimate interests in the domain name.

6.3.4. Considering the difficulty of proving such a negative fact (“*negativa non sunt probanda*”), the burden of proof that the domain name holder has no rights or legitimate interests to the domain name is considered to be satisfied when, taking into account all the facts of the case, the complainant can credibly state that he is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (W.I.P.O.,

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D2001-1020, “pokemonplanet.com”; C.E.P.A.N.I., 44071, “hrs.be”; 44059, “brabant-wallon.be”; 44013, “smirnoff.be”).

It is credible to consider that there are no reasons or circumstances that are indicative of such right or legitimate interest. This is corroborated by the fact that the domain name holder does not deny that it has never used the domain name in connection with any *bona fide* offering of goods and services and that it has made no preparations to do so.

Therefore, the burden to prove that there is a right or legitimate interest in the domain name shifts to the domain name holder. The domain name holder cannot merely state that this analysis is superfluous. Therefore, the statement of the complainant is deemed to be sufficient to determine the lack of rights and legitimate interests (C.E.P.A.N.I., 44068, “vueling.be”; 44056, “idealstandard.be”; W.I.P.O., D2000-0270, “htmllease”; D2002-0503, “arroyocraftsman.com”).

Moreover, the lack of a reasoned or documented response of the domain name holder regarding that condition usually allows to consider that the lack of rights and legitimate interests is proven (C.E.P.A.N.I., 44067, “rembostyling.be”; W.I.P.O., D2002-0001, “volvovehicles.com”; D2002-0169, “vegasicilia.info”; D2005-1068, “chungmongku.com”).

6.3.5. It results from the above that the contested domain name holder had no rights or legitimate interests in the contested domain name.

(iii) Registered or used in bad faith

6.4.1. According to Article 10.b.1., iii) of the Policy, the complainant has to prove that the domain name has been registered or is being used in bad faith.

6.4.2. The complainant states that the contested domain name holder should have reasonably known the existence of its prior rights because both parties are direct competitors. Moreover, the complainant states that the domain name registration prevents it from using its main trademark for its bus activities in the most needed and valuable ccTLD in Belgium, that the domain name has never been used by the domain name holder and was reserved by the domain name holder only to prevent the complainant from using it, and that it is therefore clear that the domain name was registered and acquired primarily for the purpose of disrupting the complainant business related to bus activities in which both parties are direct competitors.

6.4.3. The domain name holder denies that the domain name was registered or is being used in bad faith. It first states that its conduct with regards to the domain name does not qualify as passive holding of a domain name and that even if it did, the mere passive holding of a domain name is not in itself sufficient to fulfill the bad faith requirement but that there should also be additional factors that are inexistent in the present case.

Moreover, the domain name holder states that there are no indications that the registration or the refusal to transfer the domain name is aimed at blocking the complainant in its activities because the domain name was registered before the complainant announced that it was considering to use the term "BLABLABUS" and/or that it was considering offering bus services. Moreover, the domain name holder states that the complainant had no trademark "BLABLABUS" at the time of registration of the domain name. Therefore, the domain name holder states that at the time of registration of the domain name, it had no knowledge of the complainant's intention to enter into the bus service market and/or to use the term "BLABLABUS".

6.4.4. It should first be noted that the notion of bad faith is a broad notion and that in CEPANI case law, it is sufficient that the domain name has been registered in bad faith or is being used in bad faith, these two criteria being non-cumulative (C.E.P.A.N.I., 44046, "zodiac.be").

6.4.5. Bad faith can be determined by any legal means (C.E.P.A.N.I., 44068, "vueling.be") and the list of circumstances demonstrating bad faith registration or use of a domain name of Art. 10.b.2., of the Policy is merely illustrative and should therefore not be regarded as exclusive (C.E.P.A.N.I., 44010, "redbulls.be").

6.4.6. Bad faith is to be construed as the knowledge (proven as having been actual or having taken place with a reasonable certainty of evidence in the circumstances) by the domain name holder that a third party (the complainant) enjoyed a factual or legal situation previous to, and conflicting with, the litigious registration or use (C.E.P.A.N.I., 44436, "bollore-logistics.be").

6.4.7. The contested domain name holder does not deny that the parties are competitors and that it did know the existence of the activities of the complainant and its use of the trademarks BLABLA and BLABLACAR, all of this prior to the registration of the domain name. This is sufficient to determine that the registration was made in bad faith..

6.4.8. Furthermore, while the complainant states that the domain name had never been used, the domain name holder does not establish or show that the domain name was used, but merely says that the domain name does not qualify as passive holding and that even if it did, it is not sufficient to establish bad faith. It has however previously been decided that the mere passive holding of a domain name can be sufficient to establish bad faith (C.E.P.A.N.I., 44233).

Considering also that bad faith can be established on the basis of simple presumptions (C.E.P.A.N.I., 44067, "rembostyling.be"), it makes little doubt that the domain name holder registered the domain name in bad faith, not only with the knowledge as defined hereinbefore, but also in order to disturb the complainant, who is active in the same sector (that is, the sector of transportation) and certainly known to the domain holder at the time of registration.

6.4.9. It results from the above that the domain name has been registered in bad faith.

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7. Decision

Consequently, the Third-Party Decider hereby:

- rules that the complaint is founded;
- orders the domain name "BLABLABUS.be" to be transferred from the contested domain name holder to the complainant pursuant to Art. 10.e of the Policy.

Brussels, 30 July 2019.



Fernand DE VISSCHER
Third-Party Decider
(signature)