



DISPUTE RESOLUTION SERVICE

D00014654

Decision of Independent Expert

Bloomberg L.P.

and

Mustaqbal Trading Limited

1. The Parties:

Lead Complainant: Bloomberg L.P.
Legal Department
731 Lexington Avenue
New York City
NY 10022
United States

Complainant: Bloomberg Finance L.P.
Legal Department
731 Lexington Avenue
New York City
NY 10022
United States

Complainant: Bloomberg Finance Three L.P.
Legal Department
731 Lexington Avenue
New York City
NY 10022
United States

Respondent: Mustaqbal Trading Limited
 4 Goldsmiths Close
 Woking
 Surrey
 GU21 3HF
 United Kingdom

2. The Domain Name:

bloombergplace.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

14 August 2014 15:06	Dispute received
15 August 2014 08:53	Complaint validated
15 August 2014 13:53	Notification of complaint sent to parties
27 August 2014 16:21	Response received
27 August 2014 16:21	Notification of response sent to parties
01 September 2014 02:30	Reply reminder sent
04 September 2014 08:55	Reply received
04 September 2014 09:00	Notification of reply sent to parties
04 September 2014 09:01	Mediator appointed
09 September 2014 10:36	Mediation started
15 September 2014 15:47	Mediation failed
15 September 2014 15:51	Close of mediation documents sent
22 September 2014 11:39	Expert decision payment received

4. Factual Background

The Complainants are part of a group of companies which are a major provider of financial news and data services under the BLOOMBERG name. They have Community and UK registered marks for BLOOMBERG for business information services and publications registered in the UK since at least 1997, although there is no evidence when this use in this regard actually started, there is evidence that BLOOMBERG is currently a well-known mark for financial news and data services in the UK. Since 2012 the Complainants have engaged in a

large scale construction project in London which will be the Complainant's European headquarters with office space and retail outlets known as 'Bloomberg Place'. The Complainants also own reputation and goodwill in the mark BLOOMBERG PLACE in relation to its business of operating a major development in London of this name.

The Domain Name was registered on 25 October 2012. The Domain Name currently directs users to a holding page featuring the words 'Bloomberg Place: Our site is currently under construction.' Since the dispute arose, a disclaimer in small type has been added to the web page indicating that the site is not associated with the Complainants and stating that common words cannot be monopolised. The Respondent maintains that it intends to use the Domain Name as a site about the facilities available at 'Bloomberg Place' as a place or address. However, it has not provided any actual evidence of any preparations to run such a web site or business and puts emphasis, rather, on its freedom to do so.

5. Parties' Contentions

Relevant submissions of the Complainant in the Complaint can be summarised as follows:

The Complainants are the largest and best known providers of financial news and data services in the world online, in print and on television and radio. The BLOOMBERG name has been used since 1987 and is the subject of Community Trade mark and UK registered trade marks. The Complainants own many domain names containing the BLOOMBERG mark including bloomberg.com. The BLOOMBERG trading name has substantial goodwill.

Since 2012 the Complainants have engaged in a large scale construction project in London to be the Complainant's European headquarters which are already well known by the name 'BLOOMBERG PLACE'.

The Domain Name is similar to the BLOOMBERG trading name and identical to the name of its European headquarters.

The Domain Name was registered on 25 October 2012. The Complainants found out about the registration on 11 April 2014. The Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to

confuse people or businesses into believing that the Domain Name is associated with the Complainants.

The Respondent has no legitimate legal or commercial interest in the Domain Name. It has not professed to have underlying rights in the Domain Name. The Respondent is neither commonly known by the name nor connected with any mark identical or similar to the Domain Name. Neither is there evidence that the Respondent intends to use or has used the Domain Name in connection with a genuine offering of goods and services or for any other genuine or legitimate reason.

The Respondent has said that Bloomberg Place is a well-known geographical place in London, but there is no other Bloomberg Place in London, whether building or street other than the Complainant's development. The Respondent also said that Bloomberg was a common surname, but that is not the context of the use in the Domain Name. In a WhoIs search undertaken in June 2014 the Respondent described itself as 'trading as Bloomberg Place'. The Domain Name currently directs users to a holding page featuring the words 'Bloomberg Place: Our site is currently under construction.' Visitors will be confused into thinking the site is associated with the Complainants. Since the dispute arose an abusive disclaimer in small type has been added to the bottom of the page indicating that the site is not associated with the financial company Bloomberg and stating that common words cannot be monopolised. However, this cannot turn back the clock and adds to the impression that the Respondent has no legitimate purpose in mind.

The Respondent is involved in a pattern of registrations relating to well-known names or trade marks in which it does not have rights and the Domain Name is part of that pattern. In four previous Nominet Complaints there is a clear connection between John Pepin and the other Respondents. The Respondent's sole director John Pepin has been involved in a number of WIPO disputes where the Respondent has lost. These cases follow a pattern of registration after announcement of a major building project or product launch. Historically an approach has been made to sell the Domain Name to a rights holder, but lately the approach has become more sophisticated and passive in nature. The Complainant's Bloomberg Place development was in the news around the time of the registration. In fact, the Domain Name was registered on the same day that a press report was published on line announcing details of the plans for the development. The Respondent has registered the Domain Name to make a profit. While the Respondent has not directly approached the

Respondent, its sole director is engaged in the purchase and sale of Domain Names at a profit. The Respondent refused an offer by the Complainant to pay its reasonable and verifiable costs incurred in registering the Domain Name and transfer to the Complainant.

The Domain Name is operating as a blocking registration against a name and a mark in which the Complainants have rights.

Relevant submissions of the Respondent in the Response can be summarised as follows:

The only evidence relevant to these proceedings should be evidence strictly about the Respondent and the Complainant should not be allowed to adduce evidence that relates to other persons or parties. In certain cases information is misleading e.g. in one UDRP case mentioned, the Respondent subsequently began proceedings and the German Courts held that the Respondent should keep the name. Another similar case is also pending before the German Courts.

The Complainant has sought to far exceed the extent of their rights in other cases, such as in one case where it failed to get the name 'bloombergreality.com" where the panellist held that 'Bloomberg' was not similar to 'Bloomberg Realty.' This is very similar to what the Complainant is attempting here since 'Bloomberg Place' should not be confused with 'Bloomberg'. Also in another case the Complainant failed to recover 'Michaelbloombergsucks.com.'

To say that each and every domain name or trade name containing 'Bloomberg' was violating the Complainant's rights would be to wrongly grant the Complainant a worldwide total monopoly, which would be grossly extortionate and unfair and not what is intended by a trade mark system of different classes of goods and services.

The disclaimer posted on the web site attached to the Domain Name arose because the Respondent is unhappy with the undue, unfair contentions of a large company thinking they can take what they want. The Domain Name was purchased for wholly legitimate business purpose, that of developing the domain name into a web site about the facilities at and location of Bloomberg Place, not at all related to the Complainant.

The respondents mentioned by the Complainant in other domain name

proceedings are not the Respondent, nor are they pseudonyms and their actions are not those of the Respondent. There is no reason to include them except to throw mud and hope it sticks. The Panellist in the viacloud.co.uk case and the German Courts have considered these contentions and disregarded them.

The Respondent was not seeking to suggest it would not abide by a domain name dispute resolution ruling in correspondence, subject to appeal, but was simply pointing out the error of the Complainant's solicitors in saying their client would bring UDRP proceedings in respect of a .co.uk name. The Respondent merely said he would bring Court action if a UDRP procedure was brought as threatened, as the UDRP procedure is not relevant to a .co.uk claim.

At no time has the Respondent used the name to pass off as the Complainant or to make any financial gain. It was purchased in or around April 2014 to develop into a web site about the area known as 'Bloomberg Place' as a generic location and as a list of all the facilities and companies that are going to be based there. Bloomberg Place is not scheduled for completion until 2016 and the web site will not be completed till then. The name 'Bloomberg' is much more common than the Complainant would have the Expert believe and, in fact, there is even a book with the name 'Bloomberg Place' as a location. Far from being associated with the Complainant, the name 'Bloomberg Place' is a separate and distinct generic name and place name.

Bloomberg.com appears to be owned by Internic admin and so it is not admitted that this is owned by the Complainant.

The same way the Complainant lists domain names and says that because it owns them it has rights because of the same, the Respondent by the same token has rights from ownership of the Domain Name.

It is not disputed that the Complainant has extensively promoted its name, but it is disputed that the Domain Name infringes in any way on the Complainant's rights.

By stating that its development is already well known as 'Bloomberg Place' the Complainant shows that it knows its trade marks do not cover 'Bloomberg Place' which is a name distinct from its trade marks, such as 'Bloomberg Realty'.

Not only is 'Bloomberg Place' intended as the location of the Complainant, but

it is also planned as the location of many other public facilities, restaurants etc. As such, it can be used not as being connected with the Complainant, but in its generic, locational sense as part of addresses. This is why as a general rule geographical location cannot be trade marked or monopolised and owned by anyone.

The Respondent has never intended to offer and has not offered the Domain Name for sale. It was pointed to a holding page by the registration company and has never ever been offered for sale implicitly or explicitly by any means.

The Respondent has no intention of using the Domain Name in any way that could be confusing.

There are a number of different UK companies named 'Bloomberg' and not related in any way to the Complainant. This shows the generic nature of both 'Bloomberg' and 'Bloomberg Place'.

Relevant submissions of the Complainant in its Reply can be summarised as follows:

Many of the Complainant's domain names are registered to show the generic administrative address at the Complainant 'Internic Admin'. The Complainant does not consider this to be controversial.

The Respondent's contention to have common law rights in the name 'Bloomberg Place' purely by virtue of its registration of the Domain Name is unsustainable. It has never claimed any underlying rights in the name. The DRS exists to allow legitimate rights holders to challenge those who seek to take advantage of the system by registering domain names in which they have no underlying rights.

The Complainant cannot comment on all the examples of third party Bloomberg companies offered by the Respondent without investigation, but in some of the examples given the parties had legitimate rights as they have directors called Bloomberg. By contrast the Respondent has no rights in the name and has gone to great lengths to make clear that its use of the Domain Name (and therefore the BLOOMBERG mark) relates specifically to the Complainant's headquarters and, therefore, the Complainant.

It is inaccurate to characterise the names 'Bloomberg' and 'Bloomberg Place'

as generic or descriptive such as '10greatestmovies.com'. If the Respondent means that the names are not exclusive to the Complainant, the Complainant accepts that there are other individuals with the surname 'Bloomberg' or businesses with other rights in the name. However, the Respondent is not one of those.

The Respondent argues that the evidence should be limited 'strictly' to evidence concerning the Respondent company and that any evidence relating to the activities of its sole director, John Pepin, should be ignored. To fetter the Expert's jurisdiction in this way would make a mockery of the DRS procedure undermining the relevance of paragraph 3(a) (iii) of the Nominet DRS policy relating to patterns of abusive registration as well as paragraph 3 (c) relating to the presumption of Abusive Registration. To accept the Respondent's position would allow those seeking to abuse the system free rein to do so through networks of non-trading, off the shelf companies, to the detriment of legitimate rights holders.

Mr Pepin is the sole director of the Respondent. Under the Companies Act 2006, the activities and management of the company are his responsibility. It would, therefore, be artificial to suggest that the Respondent is operating as anything other than a vehicle for John Pepin. If Mr Pepin considers himself to be independent of the Respondent it is curious that he repeatedly refers to himself in his own individual capacity in the Respondent's evidence.

The Complainant has never suggested that Kevin Reed and SN Pepin are pseudonyms of Mr Pepin, the Complainant's contention is that the Respondent through its connections to these parties (John Pepin) in particular is involved in a pattern of Abusive Registrations and the Domain Name is part of this pattern. The Respondent's only defence has been to claim it has nothing to do with these parties, despite the evidence to the contrary which has been accepted in previous DRS and UDRP decisions, despite the Respondent's submissions to the contrary.

The Respondent raises two previous UDRP decisions which did not result in transfers to the Complainant, but did not draw to the Expert's attention to more than 70 UDRP complaints made by the Complainant that have resulted in transfers. In relation to the Bloomberg Realty case the Respondent's principal was found to have genuine rights in the Bloomberg name as, at one stage, her name was Nancy Bloomberg and the bloombergrealty content of the domain name was found not similar to BLOOMBERG as realty was not associated with

and, therefore, did not suggest a connection with the Complainant's business, not simply because there was another word added. In addition, the registrant was able to provide evidence that it had made real and demonstrable preparations for use of the Domain Name in relation to a bona fide offering of goods and services. In the michaelbloombergsucks case the panel denied the claim because the Respondent was actively using the Domain Name for a legitimate purpose as part of a wider campaign related to free speech. By contrast the Respondent has no rights in the Bloomberg name and has demonstrated no legitimate use or preparation for use of the Domain Name.

The name BLOOMBERG PLACE is derived from the Complainant's trading name and registered trade marks, which in turn are derived from the name of the Complainant's majority owner Michael Bloomberg . Accordingly despite its statements that it has no intention of using the Complainant's trade marks in a confusing way because the Bloomberg name is famous for its services, by using the name BLOOMBERG in its name in relation to BLOOMBERG PLACE the Respondent is making use of the Complainant's registered mark in a way that is likely to confuse.

The Respondent gives the impression that BLOOMBERG PLACE is to be some sort of multi occupancy office-cum-shopping centre. However, while there will be publicly accessible spaces within the building and a small retail arcade, the office buildings comprising the bulk of the development will be occupied exclusively by the Complainant. In light of this it is difficult to see the value associated with a web site such as that proposed by the Respondent. It would be akin for a web site for the mall. Such websites are almost exclusively owned and managed by or, at least connected in some way with the operator of the shopping centre. As such any visitor to it would assume it is connected to or sanctioned by the Complainant or that any products offered on the site are being offered by the Complainant. The Respondent states it has registered the name for commercial activity, presumably to monetise it through advertising links or offering web hosting activities and, in either case, the Respondent would be taking further advantage of the Complainant's trade mark and goodwill and further exposing its reputation to potential harm.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert

pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy). Rights is defined as 'rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

Complainant's Rights

The Complainant is the proprietor of, inter alia, Community and UK registered trade marks for BLOOMBERG for business information services.

There has also been considerable publicity for the name of the proposed headquarters of the Complainant 'BLOOMBERG PLACE'. UK law has traditionally provided protection for names announced for use in business, particularly where such names have been afforded great amounts of publicity, so that the name in a business context has come to be associated with the services or goods of the business or person that owns the reputation in the name, even if significant goodwill through trade has yet to be established, except as would arise in the course of setting up that business. Here it appears there are and will be services associated with operating a large development with office space and retail outlets, which is a business in itself, apart from the Complainant's main business of providing business information services.

Accordingly, the Expert is satisfied that the Complainant owns registered rights in the name BLOOMBERG for business information services and unregistered rights in the name BLOOMBERG PLACE in relation to its services involved in running a large development of offices and retail outlets. As such the Expert is satisfied that the Complainant has Rights under the Policy as set out above.

The Domain Name is identical to the Complainant's unregistered mark BLOOMBERG PLACE and similar to the Complainant's registered mark BLOOMBERG. 'Place', in itself, is a generic word and in the combination 'Bloomberg Place' BLOOMBERG is, by far the most distinctive element.

The addition of the word 'place', which does not suggest any particular type of business, is not sufficient in itself to distinguish the Domain Name from the Complainant's registered BLOOMBERG mark (As an aside, and as an aid to understanding, as more use is made of the combination mark 'BLOOMBERG PLACE' by the Complainant this combination of the words 'Bloomberg' and 'Place' as a mark when used together will attain more reputation and goodwill as an integral mark indicating the Complainant's services associated with its development.)

Accordingly the Expert finds that the Complainant has Rights in respect of the BLOOMBERG PLACE name or mark, which is identical to the Domain Name. The Complainant also has Rights in respect of the BLOOMBERG name which is similar to the Domain Name for the purposes of the Policy. As such the first limb regarding Rights has been satisfied.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" as:-

"a Domain Name which either:

i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR

ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion that the Respondent has given false contact detail or has a relationship with the Complainant, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraph i, ii and iii which read as follows:

i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the

Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out of pocket costs directly associated with acquiring or using the Domain Name;

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;”

ii “Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant

iii The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;”

Since there does not appear to be any place or geographical location other than the Complainant's development 'Bloomberg Place', the Respondent must have been and does not deny that it was aware of this development as a place when it registered the Domain Name. It was, therefore, at the very least, aware of the Complainant and its unregistered mark BLOOMBERG PLACE used in the business of operating a development of offices and shops at the time of registration of the Domain Name. Other than ownership of the Domain Name itself, the Respondent does not allege it owns any underlying rights in the marks BLOOMBERG PLACE or BLOOMBERG.

The contents of the disclaimer do suggest that the Respondent has an agenda against big companies as he feels they believe they can take or own everything.

There is, however, no evidence of the Respondent running web sites as directory services for large developments and the Respondent has not provided any actual evidence of preparations made to run such a business or web site.

The Respondent shows a considerable amount of sophistication and intelligence in the preparation of the arguments in its Response showing a familiarity and great experience with Domain Names and how they are or can be used. The Expert finds it likely on the balance of probabilities, on the facts as disclosed by the evidence, particularly the awareness by the Respondent of the Complainant's development called BLOOMBERG PLACE at the time of registration of the Domain Name, that the Respondent had the Complainant in mind when the Domain Name was registered and should have been aware that selection of the actual name of the Complainant's development as its Domain Name would be a blocking registration or would ride on the Complainant's rights in the unregistered mark and name of its development, taking undue advantage and causing detriment. In so doing, the Respondent's use of the Domain Name is, and, in the opinion of the Expert he must have realised it would be, unfairly disruptive to the Complainant's business. Further, in the opinion of the Expert the Domain Name is likely to confuse and may have confused Internet users into thinking that the site connected to the Domain Name is connected to the Complainant, even if it were used for directory or information services for the Complainant's development, as most such bespoke sites would be associated with the owner and operator of the development. The WhoIs search contained at one time the statement 'trading as Bloomberg Place'. Confusion may be less likely since the addition of the disclaimer, but as the Complainant points out this does not turn back the clock re any confusion caused prior to the posting of the disclaimer and its contents are in small print meaning that many users may fail to go on and read it once they see the site is under construction. Further it is perfectly possible to provide a directory or information services web site about a large development and call it anything. 'Yellow Pages' would be an example of such a directory site. Even for a bespoke site customized for a particular development it would be possible to choose a descriptive domain name for such a site which would indicate its purpose clearly, without acting as a blocking registration, causing confusion as to origin or unfair disruption.

As a result of the above conclusions the Expert has not found it necessary to have to decide if the Respondent is involved in a pattern of registrations containing well known marks in which the Respondent does not have

rights or was really seeking as part of a long term plan to sell the Domain Name as a profit, facts which are hotly contested. It is sufficient that the Respondent was aware of the Complainant's Rights and registered the Domain Name consisting of the actual name of the Complainant's development on the balance of probabilities knowing that it would be a blocking registration, would be unfairly disruptive of the Complainant's business and would be likely to cause confusion on the Internet, even without a statement on its WhoIs that the Respondent was 'trading as Bloomberg Place' or with a disclaimer that many Internet users may not read.

Accordingly, in the view of the Expert in its registration and use of the Domain Names the Respondent took unfair advantage of and caused detriment to the Complainant's Rights.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy. The Expert notes that the Respondent has had some success in overturning decisions in domain name dispute resolution decisions in Court. In fact, a Court will apply the general law in its own jurisdiction which is not the same as the criterion applied under this procedure and, so this is not necessarily, in any way, a criticism of previous decisions of domain name panellists under any domain name dispute resolution procedure.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in respect of an unregistered mark which is identical to and a registered mark which is confusingly similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, bloombergplace.co.uk be transferred to the Complainant.

Signed: Dawn Osborne Dated: 22 October 2014