

**DISPUTE RESOLUTION SERVICE**

**D00009790**

**Decision of Independent Expert**

Viacloud WLL

and

Inshallah Ltd

**1. The Parties:**

Complainant: Viacloud WLL  
Manama Centre Building  
2nd Floor, Part 3, Suite 201  
Government Avenue  
P.O. Box 2724  
Manama  
Bahrain

Respondent: Inshallah Ltd  
4 Goldsmiths Close  
Woking  
Surrey  
GU21 3HF  
United Kingdom

**2. The Domain Name:**

viacloud.co.uk

### **3. Procedural History:**

08 April 2011 18:23 Dispute received  
11 April 2011 09:22 Complaint validated  
11 April 2011 09:34 Notification of complaint sent to parties  
04 May 2011 02:30 Response reminder sent  
05 May 2011 14:29 Response received  
05 May 2011 14:30 Notification of response sent to parties  
10 May 2011 02:30 Reply reminder sent  
16 May 2011 10:17 Reply received  
16 May 2011 10:37 Notification of reply sent to parties  
16 May 2011 10:38 Mediator appointed  
19 May 2011 12:05 Mediation started  
09 August 2011 17:42 Mediation failed  
09 August 2011 17:42 Close of mediation documents sent  
15 August 2011 11:13 Expert decision payment received  
22 August 2011 Notification of appointment of K Gymer as Expert (wef 25 August 2011)  
06 September 2011 Request from Respondent for extension of time for Respondent's newly appointed representative to submit and for subsequent consideration of non-standard further submissions on the Respondent's behalf. The Expert declined to consider any non-standard further submissions.  
15 September 2011 Draft decision provided for review  
19 September 2011 Expert extended period for finalising decision under DRS Procedure Rule 12a to 23 September 2011  
21 September 2011 Respondent's representative submitted a second request for consideration of non-standard further submissions on the Respondent's behalf. The Expert again declined.  
22 September 2011 Respondent's representative submitted a third request for consideration of non-standard further submissions on the Respondent's behalf, based on allegations of a "serious failure to make a material disclosure" by the Complainant in relation to One of the Complainant's associated UK companies, and "questions raised by the close proximity of the Complainant's UK office and the expert's office". The Expert again declined to consider any further submissions and noted that he had signed Nominet's Declaration of impartiality and independence when appointed to handle this case and is happy to reconfirm that status regardless of where the Complainant's UK office may apparently be located.

### **4. Factual Background**

The Complainant, Viacloud WLL, is an international telecommunications company providing international calling services under the trade mark VIACLOUD. It has been operating in Bahrain since 2004 and has traded under the VIACLOUD trade mark since 2004. It expanded its services to Jordan in 2005, the USA in 2007 and Oman in 2008. The Complainant operates a website at [www.viacloud.com](http://www.viacloud.com).

The Complainant holds itself or through a related company the following VIACLOUD trade mark registrations and application:

- (a) Bahraini registration no. 48690 dated 22 June 2006;
- (b) Jordanian registration no. 87487 dated 6 July 2006;
- (c) Community trade mark ("CTM") registration no. 9506932 VIACLOUD and device dated 9 November 2010; and
- (d) CTM application no. 9507062 VIACLOUD filed on 9 November 2010. This has matured into a registration since the Complaint was filed.

The Complainant announced the launch of its UK service under the VIACLOUD name in the press and online on 17 January 2010.

On the same day, Mr John Pepin, the sole director of the Respondent, Inshallah Limited, registered the Domain Name in his own name.

Mr Pepin himself then personally filed a UK trade mark application 2537379 in Class 35 for the mark VIACLOUD on 27 January 2010, which was granted registration on 30 April 2010. An assignment of this registration from Pepin to the Respondent, Inshallah Limited, was recorded on 29 June 2010.

The Complainant's solicitors wrote to Mr Pepin on 16 December 2010 claiming that the registration of the Domain Name infringed the Complainant's rights.

Mr Pepin transferred the Domain Name to Inshallah Limited on 21 December 2010.

At the date of the Complaint, the web address [www.viacloud.co.uk](http://www.viacloud.co.uk) resolved to a domain parking page at [www.ndparking.com/viacloud.co.uk](http://www.ndparking.com/viacloud.co.uk) with click through advertising links to a number of other websites relating to electronic component and equipment suppliers.

## **5. Parties' Contentions**

### **Complainant:**

The Complainant's case was supported by a number of Exhibits. The following is an edited version of the main parts of the Complaint:

### **What rights are you asserting?**

The Domain Name is identical to the Complainant's company name, trading name, trade mark rights and prior domain name registration. The Complainant has Rights in the Domain Name because:

- The Complainant, Viacloud WLL, is an international telecommunications company providing international calling services under the trade mark VIACLOUD. It has been operating in Bahrain since 2004 and has traded under the VIACLOUD trade mark since 2004. It expanded its services to

Jordan in 2005, the USA in 2007 and Oman in 2008, at all times trading under VIACLOUD.

- The Complainant was formed on 15 December 2004. Its UK subsidiary, Viacloud UK Limited, was formed on 9 June 2009 and adopted the name 'Viacloud UK Limited' on 10 September 2009.
- The Complainant's domain name "viacloud.com" was registered on 5 August 2004 [Expert's note: i.e. before the Complainant was formed].
- The Complainant has invested substantially, in excess of £5 million, in its mobile virtual network operator model to become a leading carrier of voice traffic. It has featured in the press since 2004 (see exhibited news extracts from www.viacloud.com). It has been registered with Reseaux IP Europeens Network Coordination Centre since February 2005. As a result of its activities, the Complainant has built up a considerable reputation and goodwill worldwide in and to the name VIACLOUD. It is therefore the owner of unregistered trade mark rights in the mark VIACLOUD.
- The Complainant owns the following VIACLOUD trade mark registrations and application:
  - (a) Bahraini registration no. 48690 dated 22 June 2006;
  - (b) Jordanian registration no. 87487 dated 6 July 2006;
  - (c) Community trade mark ("CTM") registration no. 9506932 VIACLOUD dated 9 November 2010; and
  - (d) CTM application no. 9507062 VIACLOUD & device filed on 9 November 2010.

### **Why is the domain name an Abusive Registration?**

The Domain Name is an Abusive Registration because, on the balance of probabilities, it was registered 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.

Mr John Pepin ("Pepin") registered the Domain Name on 17 January 2010. The Complainant's solicitors wrote to him on 16 December 2010. He transferred the Domain Name to Inshallah Limited ("Inshallah") on 21 December 2010. Pepin is the director and sole shareholder of Inshallah. Therefore references in this Complaint to "the Respondent" are to Pepin and Inshallah.

The Policy provides a non-exhaustive list of factors that may be evidence of an Abusive Registration. The relevant factors in this Complaint are:

- (a) Pattern of registrations: The Respondent is engaged in a pattern of registering domain names (".uk" or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent legitimate rights. This Domain Name is part of this pattern. The Respondent is a serial cybersquatter who has become more sophisticated

in his cybersquatting approach in an attempt to circumvent the Abusive Registration criteria (the "Criteria"). His current focus appears to be the Middle East. He purports to trade under abusive registrations by including links through to other websites. This is standard practice for a holding webpage. He relies on such purported trading as a smokescreen to show he has a legitimate interest. He has developed a practice of filing trade mark applications corresponding to his domain names. These are attempts to circumvent the Criteria. In this Complaint, the Respondent registered the Domain Name on the same day as the Complainant's Announcement (as defined below) and later filed a UK trade mark application for VIACLOUD in an attempt to circumvent the Criteria. The Complainant's solicitors wrote to Pepin on 16 December 2010 about the Domain Name. On 21 December 2010, he transferred the Domain Name to Inshallah, the company in which he is the director and sole shareholder.

(b) Previous disputes and connected disputes: The Respondent is a serial cybersquatter. He has registered over one thousand well-known domain names. He has unsuccessfully attempted to get trade mark protection for well-known names. The Respondent has been through the DRS before and also the UDRP process. The Respondent appears to be at least connected to Kevin Reed and SN Pepin, who have also been through domain name disputes before.

(c) Blocking registration: The Respondent registered the Domain Name primarily as a blocking registration against a name and mark in which the Complainant has Rights. The pattern of registrations and conduct illustrate this. In addition, a vexatious litigant Court order was made against Pepin.

(d) Other factors: The Domain Name may also be an Abusive Registration because, on the balance of probabilities, of the other factors set out below.

### **Pattern of registrations**

Pepin is the registrant of over one thousand ".uk" domain names, which include well-known brands or names such as "american-idol.co.uk", "currys-digital.co.uk", "hmtreasury.org.uk", "law-society.co.uk", "mercedes-world.co.uk" and "newscotlandyard.co.uk".

Pepin has also made UK trade mark applications for well known marks. For example, he applied for "Britain's Got Talent" and "Pirates of the Caribbean" but these were refused.

Pepin has a history of bad faith and abusive domain name registrations going back over a period of at least ten years (the Steven Rattner case below was in 2000). A pattern of registrations can be established. According to the ICANN

UDRP and Nominet DRS decisions over this time, he has developed and refined his approach in an attempt unsuccessfully to circumvent the UDRP bad faith and Nominet Criteria. He has been the respondent in at least the following cases:

- (a) Steven Rattner v BuyThisDomainName (John Pepin) for "stevenrattner.com" ("Stevenrattner");
- (b) Citigroup Inc and Citigroup Global markets, Inc v John Pepin for "citismithbarney.com" ("Citismithbarney");
- (c) By Design (UK) Limited t/a "mydeco" v John Pepin for "mydeco.co.uk" ("Mydeco");
- (d) Abu Dhabi Future Energy Company PJSC v John Pepin for "masdarcity.com" and "masdarcity.net" ("Masdarcity"); and
- (e) Tiara Hotels & Resorts LLC v John Pepin for "essque.com" ("Essque").

Pepin is engaged in a pattern of registrations where he is the registrant of domain names, which correspond to well known names or trade marks in which he has no apparent legitimate rights. The Respondent has developed his knowledge, processes and tactics for his registration practice from his involvement in domain name disputes and a pattern of registrations can be established.

In summary, this pattern is:

- There is an announcement by the owner of a name/mark.
- The Respondent immediately, or shortly after, registers a domain name corresponding to the name/mark referred to in that announcement (see the summaries of Stevenrattner, Mydeco, Masdarcity and Essque below).
- More recently, the Respondent has focussed on the Middle East (see the summaries of Masdarcity and Essque).
- The Respondent files a corresponding UK trade mark application to attempt to unsuccessfully circumvent the Criteria (see the summaries of Masdarcity and Essque).
- He purports to trade under the domain name by including links through to other websites (see the summaries of Masdarcity and Essque). This is standard practice for a holding webpage and is not trade under the mark/name in issue, but a mere smokescreen to attempt to show legitimate use of the domain name.
- The Domain Name is part of this pattern. This Complaint involves an announcement in the Middle East. Pepin registered the Domain Name on the same day as the Announcement. He then applied for the VIACLOUD UK trade mark and set up a smokescreen website with a holding page that links through to other websites. He transferred the Domain Name and Registration to Inshallah, the company in which he is the director and sole shareholder. On the balance of probabilities, these are attempts to circumvent the Criteria by purporting to demonstrate a legitimate interest in the Domain Name but with a primary purpose of at least blocking the Complainant from registering the Domain Name.

Inshallah is a UK company incorporated on 23 April 2010. The registered address for Inshallah is the same as Pepin's. The officers of Inshallah are Pepin (director and sole shareholder) and Kevin Reed (secretary) and they all use the same address.

The Complainant's solicitors wrote to Pepin, the then registrant of the Domain Name, on 16 December 2010. The Respondent responded on 22 December 2010 referencing the Registration. As set out above, Pepin transferred the Domain Name to Inshallah on 21 December 2010 and had also previously assigned the Registration to Inshallah.

The cases cited above that establish the Respondent's pattern of registrations, present in this Complaint, are summarised below:

(a) Stevenrattner: On 1 March 2000, Mr Rattner issued a worldwide press release announcing his resignation from Lazard Frères and intention to form an investment consulting partnership. On 3 March 2000, the Respondent registered "stevenrattner.com" under the designation BuyThisDomainName. The Respondent failed to establish a legitimate right or interest in the domain name. He asserted that he registered the domain for a friend named Steven Rattner with whom he intended to run a hotel. However, the Panel disregarded this and found "on balance that the existence of the Respondent's friend and of the business venture has not been proven to their satisfaction". The complainant contacted the Respondent about acquiring "stevenrattner.com". He initially replied that he would transfer it for an amount "around low 5 figures", eventually settling on £7,500. The Respondent then put "stevenrattner.com" up for auction on "www.names123.com" for £2,000 minimum.

The Panel stated that it is "well aware of a practice which has developed recently of registering names and events in the news, literally moments after they become news" and found that the Respondent's "registration of the Domain Name smacks greatly of this practice as the correlation between the dates of the high profile resignation of the Complainant from Lazard Frères, the Complainant's announcement that he was intending to ground an investment consulting partnership and the registration of the Domain Name by the Respondent are simply too great to be merely coincidental. It is also of note that the Respondent used the designation BuyThisDomainName when registering the Domain Name, which gives further evidence as to the state of the Respondent's mind when he first registered the Domain Name]. The Panel decided the Respondent registered the domain name in bad faith.

The Respondent's pattern of registrations:

- He registered the domain name after an announcement.
- He appears to have learnt from this case not to (i) offer to sell a domain name for a price significantly higher than he paid for it or (ii) register domain names using the BuyThisDomainName designation, because this could be used against him to support a bad faith argument.

(b) Mydeco: On 2 June 2006, the complainant registered "mydeco.com". On 5 December 2006, By Design (UK) Limited was incorporated. In late May 2007, the complainant announced the launch of the new online business "mydeco". At that time, "mydeco.co.uk" was registered to a German company and due to expire on 29 June 2007. Both the complainant and the Respondent had a system in place ready to re-register "mydeco.co.uk". On 30 June 2007, the Respondent registered it and offered to sell it to the complainant.

Nominet did not find an Abusive Registration. There was no pattern of registrations at that time (2007) that would support an Abusive Registration. If this distinction is maintained, there is now evidence (set out further below), of a pattern of registrations for non-personal names that supports the Complainant's position that this Domain Name is an Abusive Registration.

The Respondent's pattern of registrations:

- Again, he registered the domain name after an announcement.

(c) Masdarcity: The complainant, Abu Dhabi Future Energy Company, is a Middle Eastern company that had used the MASDAR trade mark since 2006. It had unregistered trade mark rights in MASDAR in multiple jurisdictions and UAE trade mark applications for MASDAR. It launched the "Masdar Initiative" in the Middle East in March 2006. This attracted significant publicity. On 8 May 2008, the complainant announced the "Masdar City" development and, again, attracted significant publicity. That same day (as in this Complaint), the Respondent registered "masdarcity.com". A few days later, on 13 May 2008, he registered "masdarcity.net". The Respondent initially used the webpages at these domain names to link through to other websites (as he does in this Complaint, and as is standard practice for a holding webpage). The Respondent tried to show that the complainant had no rights and that he had developed trade mark rights for MASDAR in the UK by "the parking of his domains with NameDrive which served up advertisements on the websites". The Respondent filed a UK trade mark application for MASDAR after the complainant's announcement, which was subsequently withdrawn.

The Panel found "the consistency and timing with which Respondent acted to register domain names containing Complainant's mark MASDAR on the dates of pivotal, broadly publicized announcements by Complainant could hardly be coincidence" and was "not, therefore, persuaded that Respondent has proven the existence of "rights or legitimate interests" in the domain name".

The Panel held, on a balance of probabilities, that the Respondent registered the domain names in bad faith. The Panel also held the Respondent had made inaccurate representations regarding his involvement in previous UDRP proceedings and concluded that his "intentions respecting the use and registration of the disputed domain names are inaccurate and lack credibility" and that he "engaged in a pattern of conduct involving the disregard of the trademark rights of others".



The Respondent's pattern of registrations:

- Again, he registered domain names after an announcement; in this case (as in this Complaint), on the same day as the announcement.
- The announcement involves the Middle East, which indicates he monitors announcements in and relating to the Middle East.
- He filed a UK trade mark application after the announcement.
- This is the case in this Complaint.

(d) Essque: The complainant, Tiara Hotels, also a Middle Eastern company, had operated since at least 2006. On 6 November 2008, its parent company announced it was re-branding it as "Essque Hotels". Shortly after, on 16 November 2008, the Respondent registered "essque.com".

The Respondent rejected the complainant's offer to purchase "essque.com" for reasonable expenses up to \$1,000. The Respondent used a third party, Mr Rumaiji, to attempt to sell the "essque.com" to the complainant at a price in excess of reasonable costs. On 13 January 2009, the Respondent filed a UK trade mark application for ESSQUE in class 35.

The Respondent's website at [www.essque.com](http://www.essque.com) advertised an electronics retail operation. The website gave no address or contact details other than an email address. There was no company or business operating under the name "Essque Electronics" on the UK Companies House register. The complainant contended that the website was created solely to thwart any legal claims against the Respondent's domain name by giving the impression that the domain was being used for a legitimate business purpose. The Panel stated that the "Respondent states that he uses the Domain Name for a business that sells electronics, yet he submitted no evidence whatsoever of any sales of electronics, or even any interest in the electronics business by Respondent prior to his registration of this Domain Name".

As in Masdarcity (above), the Panel held that the timing of the announcement and registration dates were key to determining the Respondent's intentions in registering "essque.com". The Panel held that the Respondent's claim that he has rights and legitimate interests in the domain name was "not credible" and "all of Respondent's efforts, including the posting of a simple webpage that purports to sell electronics, the filing of a UK trademark application, and the Respondent's offer to purchase Complainant's domain name "essque.net", appear to have been designed to create a pretext of trademark rights, but the Panel finds them unpersuasive. Rather than show some legitimate interest in ESSQUE as a Domain Name for an electronics retailer, these steps (along with Respondent's unsuccessful effort to distance himself from Mr. Rumaiji's effort to sell the Domain Name) reinforce the Panel's view that Respondent is a cybersquatter who has concocted a process to try to extract maximum value from Complainant for this Domain Name while masking his cybersquatting conduct".

The Panel held that the Respondent registered and used the Domain Name in bad faith and his "effort to cover his tracks by posting a pre-textual web page, his purported interest in purchasing one of Complainant's domain names, and his

repeated efforts to delay the adjudication of this case, are more consistent with the actions of a cybersquatter than they are with the actions of a genuine brand owner. Indeed, if Respondent's behaviour is consistent with anything, it is with his own behaviour in the earlier case of Abu Dhabi Future Energy Company v. John Pepin, where the Panel concluded that the Respondent had "engaged in a pattern of conduct involving the disregard of the trademark rights of others".

The Respondent's pattern of registrations:

- Again, he registered domain names after an announcement.
- Again, the announcement involves the Middle East, indicating he monitors announcements in and relating to the Middle East.
- He filed a UK trade mark application after the announcement.
- He purported to trade from the website as a "pretext" or smokescreen to attempt to demonstrate he has a legitimate interest in the domain name.
- This is the case in this Complaint.

#### Conclusion:

The Respondent is a cybersquatter engaged in a pattern of registrations for domain names corresponding to trading names or trade marks in which the Respondent has no apparent legitimate rights. More recently, the Respondent has focussed on announcements in the Middle East. As stated in *Essque*, the Respondent is a serial cybersquatter who has an "uncanny habit" of registering domain names similar to others' marks after significant announcements. He has developed a practice of filing UK trade mark applications and including links through to other websites as a smokescreen to attempt to seek to demonstrate a legitimate interest and circumvent the Criteria.

This Domain Name is part of pattern. The timing of both it and the Registration after the Complainant's Announcement follows this pattern. The Complainant's solicitors wrote to Pepin on 16 December 2010 regarding the Domain Name. On 21 December 2010, he transferred the Domain Name to Inshallah. Pepin is the director and sole shareholder of Inshallah. On the balance of probabilities, this transfer is an attempt to move the Domain Name away from Pepin's pattern of registrations and previous domain name disputes and is part of his sophisticated cybersquatting approach. It is an attempt to seek to demonstrate a legitimate interest in the Domain Name and circumvent the Criteria.

Other registrations and disputes involving parties connected to the Respondent following a similar pattern

Kevin Reed is the company secretary of Inshallah, the Respondent company. In September 2007 in Citismithbarney, "citismithbarney.com" was registered to Kevin Reed who transferred it to Pepin. However, in Mydeco (also September 2007) and Masdarcity (December 2008), Pepin denied any relationship or connection other than a shared address with Kevin Reed. In Mydeco, Pepin's position was that "some while ago Mr Reed used the Respondent's address as his contact address but after some disagreement that is definitely no longer the case and I do not and never have worked with Mr Reed", and there is reference to the "ftalphaville.co.uk" decision that "Mr Reed did use the Respondent's address

"some long while ago" but no longer does so". In Masdarcity, the Panel held that the Respondent's "inaccurate representations...about various subjects, including his involvement in prior UDRP proceedings, and his [representation] that he was only involved in one UDRP case, and denies any meaningful connections to Kevin Reed and S.N. Pepin, is disingenuous at best" and his statements were "inaccurate and lack credibility".

Given that Pepin and Reed are involved with Inshallah (the current Domain Name registrant) and these decisions, it can be concluded that the Respondent's actions can be connected to those of Reed and the previous cases concerning Reed. Reed has been the respondent in at least the following cases:

- (a) F. Hoffmann-La Roche v Kevin Reed on 27 January 2006 for "tamiflu-vaccine.com" (decision: transferred);
- (b) The Financial Times Limited v Mr Kevin Reed on 1 February 2007 for "ftalphaville.co.uk" (transferred); and
- (c) the Citismithbarney decision above because "citismithbarney.com" was transferred from Reed to the Respondent, who consented to judgment in favour of, and transfer to, the complainant.

It is unclear if Pepin is SN Pepin or is connected to SN Pepin in some way. However, in the February 2007 "ftalphaville.co.uk" decision, Nominet decided that Reed is in some way connected to (i) SN Pepin and (ii) Pepin. SN Pepin has been the respondent, or has been connected to, at least the following decisions:

- (a) Caesar's Entertainment Inc v S N Pepin on 1 July 2005 for "caesars-wembley.co.uk" and "caesarswembley.co.uk" (transferred); and
- (b) the "tamiflu-vaccine.com" decision above because "tamiflu.com" was registered to Kevin Reed, c/o SN Pepin.

### **Blocking registration**

The Domain Name is an Abusive Registration because it was registered as a blocking registration against the VIACLOUD name and mark in which the Complainant has Rights. The Respondent registered the Domain Name on the same day as the Announcement. As is clear from his previous disputes, he monitors announcements by Middle Eastern companies. On the balance of probabilities, the Domain Name was registered in response to the Announcement to prevent the Complainant from registering it. The Complainant offered to reimburse the Respondent's reasonable expenses in return for the transfer of the Domain Name and the Respondent has refused, without providing any explanation for a credible interest in the Domain Name.

Pepin has a history of vexatious conduct. A vexatious litigant order was made by the High Court of England and Wales against him on 27 May 2004. He has therefore been forbidden by a High Court Judge to issue civil proceedings in any court in England and Wales without the Court's permission. The Court will grant such an order against a party who has issued claims or made applications that

are totally without merit under its inherent jurisdiction to prevent abuse of its process.

### **Other factors**

The Domain Name may also be an Abusive Registration because, on the balance of probabilities, it may have been registered with the intention of selling, renting or otherwise transferring it to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly associated with acquiring or using the Domain Name.

Pepin did not accept the Complainant's offer to pay the Respondent's reasonable expenses to transfer the Domain Name. He has not offered to sell the Domain Name to the Complainant, or made a counter-offer. However, this may be because the Respondent has learnt from previous disputes that this could be used against him to support an Abusive Registration argument.

In Essque, he used a third party to attempt to sell a domain name to the complainant at a price in excess of reasonable costs. The Respondent has not used a third party in this case. This may be because, again, the Respondent has learnt this could be used to support an Abusive Registration argument.

The Domain Name may also be an Abusive Registration because, on the balance of probabilities, it may have been registered for the purpose of unfairly disrupting the business of the Complainant. In *British Telecommunications v One in a Million*, the Court of Appeal held that all circumstances of the case should be considered to determine whether the registrant registered the domain name with the intention to use it for passing off and/or as an instrument of fraud. The Respondent has (i) made only nominal smoke screen use of the [www.viacloud.co.uk](http://www.viacloud.co.uk) website as a holding page with links through to other websites and (ii) applied for a UK trade mark after the Announcement and his Domain Name registration (consistent with the pattern of registrations in *Masdarcity* and *Essque*), in an attempt to demonstrate that he has a legitimate interest in the Domain Name and circumvent the Criteria.

VIACLOUD is a coined word with no specific meaning. The Respondent cannot therefore claim to use the Domain Name for any generic purpose. This is consistent with WIPO's conclusion when considering any potential claim Kevin Reed (C/O SN Pepin) could have made to TAMIFLU in the "tamiflu-vaccine.com" decision.

In relation to the Respondent's credibility, in a telephone call on 23 December 2010 from Pepin to the Complainant's solicitors, he referred to the Abusive Registration reference in the 16 December 2010 letter. He stated that, having read that letter, he had looked on the Nominet website to find out what this involved. He therefore appeared to suggest that he had not heard of Nominet proceedings when this is clearly not the case.

## **Summary**

The Respondent is engaged in a pattern of registrations for domain names that correspond to trading names/trade marks in which the Respondent has no legitimate rights. He has been involved in previous disputes. More recently, the Respondent has focussed on announcements in the Middle East. As stated in Essque, the Respondent is a serial cybersquatter who has an "uncanny habit" of registering domain names similar to other's marks immediately after significant public announcements are made.

The cases above reference the Respondent's registration timing following public announcements, association with over one thousand domain names, association with Kevin Reed and SN Pepin who have also been through the dispute process, association with a third party (Mr Rumaiji in Essque) used to try to sell his domain name to a complainant, various prior Nominet and UDRP disputes and shrewd behaviour as a cybersquatter.

It is clear from Masdarcity and Essque that the Respondent is engaged in a pattern of registering domain names and corresponding trade marks of Middle Eastern companies almost immediately after public announcements.

The practice of filing UK trade mark applications is an attempt to circumvent the Criteria.

The Respondent purports to trade under the Abusive Registrations by including links through to other websites, as is standard practice for a holding webpage. The purported trading from the websites is used as a "pretext" or smokescreen in an attempt to demonstrate he has a legitimate interest in those Abusive Registrations, again in an attempt to circumvent the Criteria.

This Domain Name is part of that pattern. This Complaint involves an announcement in the Middle East. The Respondent registered the Domain Name on the same day. He then filed a UK trade mark application for VIACLOUD. The Domain Name directs to a website that includes links through to other websites. The trade mark and website are attempts to show a legitimate interest and circumvent the Criteria. On the balance of probabilities, the Domain Name is an Abusive Registration registered 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.

## **Respondent:**

The Respondent provided skeleton and detailed Responses, relevant edited extracts of which follow:

Preliminary points regarding the Complainant and the Respondent

The DRS Complaint has been made in the name "Viacloud WLL". This is a Bahraini company, which does not have any registered or any other office in the UK.

The Respondent to this complaint has been named by the Complainant as being "Inshallah Ltd". The Respondent company has a Registered office and Trading address in the UK. The Respondent, Inshallah Ltd, owns a registered UK trade mark for the mark VIACLOUD that has been valid for over 1 year.

The Complainant, Viacloud WLL, has no registered office in the UK and indeed they have no trading or other office in the UK and have not traded in the UK or Europe. The Complainant does not own any trade mark rights in the UK or Europe as at the time of this response, i.e. 26th April 2011.

The Complainant claims to own VIACLOUD trade mark registrations and application(s) in Bahrain; in Jordan; Community trade mark ("CTM") registration no. 9506932 dated 9 November 2010; and CTM application no. 9507062 filed on 9 November 2010.

It is accepted that the named Complainant owns the trade marks in Bahrain and Jordan, BUT the Complainant does not own the CTM or the CTM application as they are owned by an entirely separate company with offices only in Bahrain, namely VIACLOUD HOLDING COMPANY S.P.C.

The Complainant, Viacloud WLL is not the owner of the CTM or CTM application as has been stated. The Respondent checked with the OHIM offices who keep the register of CTM's and they advised that neither CTM 9506932 or 9507062 have been recorded as being assigned to any other company, and neither do they have any record of any license having been granted, and under the CTM Regulations any license must be recorded with OHIM in order to be enforceable.

So despite it's contentions, at all material times the Complainant Viacloud WLL, has not had either registered or common law rights in the name VIACLOUD within the United Kingdom. It is settled law that the mere mention of a name in an article does not give the publisher any common law or other rights in a name. The Complainant Viacloud WLL, therefore, has absolutely no rights in the name VIACLOUD in the jurisdiction as it has sought to contend. Neither Viacloud WLL nor any related company has ever traded in the UK.

The DRS complaint has been made strictly in the name Viacloud WLL, but Nevertheless, I should state for good measure that , VIACLOUD UK LTD is a dormant company that has not traded at all .

The recorded owner of the CTM and CTM application VIACLOUD HOLDING COMPANY S.P.C, does not have any office in the UK nor Europe and to best of my knowledge has not traded in either the UK or Europe as at this time or any material times.

The Complainant seeks to say that the name VIACLOUD is a made up name, but in fact they must know full well that this is 2 generic English words, namely "Via" and "Cloud" which is hardly unique or made up as claimed by the Complainant. Putting 2 generic words together does not need Einstein, and given the prevalence of Cloud Computing it is a very very popular word .

There are literally thousands of results for "via cloud" on the internet. [Some results for a search on "via cloud", and a list of UK companies who use "via" at the beginning of their name were exhibited to the Response.] For the Complainant to therefore aver that it is, quote, "a coined word with no specific meaning" is to be honest stupid. It is simply two generic words joined together.

The fact is that the Respondent has a valid UK trade mark for word only that the Complainant was aware of but has chosen not to object to. The proper course would be for the Complainant to object to the Respondent's trade mark and then consider DRS. The DRS should not be used to bypass the UK IPO who validly granted the trade mark to the Respondent.

The DRS should not be used to "go behind" trade mark and company laws. If a complainant has a problem with a trade mark then it knows that it can object to that trade mark, or if it believes that the company is not a separate legal entity to its directors or secretary then it can go to Court, but it cannot and should not abuse the DRS to try and take away validly held property such as the domain name in question.

The facts are that the Respondent has a valid trade mark which the Complainant could have objected to but hasn't, the Respondent has traded for nearly a year and the Complainant has done nothing for nearly 11 months that they have been aware of the Respondent's trade mark and use of the domain.

The Respondent, in contrast to the complainant, does have Registered Trade Mark rights in the United Kingdom by its trade mark number 2537379 which was Registered by the UK IPO on 30th April 2010 and which, in any event, pre-dates the CTM and CTM application which are referred to above by about a year.

The UK IPO date of record of the assignment of the trade mark of 29th June 2010 contradicts the contention by the complainant that the domain name [viacloud.co.uk](http://viacloud.co.uk) was only transferred to the Respondent, Inshallah Limited, because the Complainant wrote to the Respondent on 16th December 2010. The date of 29th June 2010 shows that the Complainant's contention is not correct. The letter of 16th December 2010 from Osborne Clarke to John Pepin was addressed to the Registered address of the Company, which is not the personal address of John Pepin. It was only then that it was realised that the details in the WHOIS failed to reflect the name "Inshallah Ltd". Either way, the Respondent owned the domain name from the date that it also owned the trade mark. The Respondent also owns the domain name [Viacloud.eu](http://Viacloud.eu) and the Twitter page [twitter.com/#!/viacloud](https://twitter.com/#!/viacloud). It is clearly shown from the [viacloud.eu](http://viacloud.eu) website that it only accepts orders from customers based in the United Kingdom.

The Complainant seeks to aver that Inshallah Ltd (the Respondent) is responsible for alleged, but not admitted, matters related to a director of Inshallah Ltd, John Pepin. That is not legally correct and as most people will know a Limited company is a separate legal entity from the directors until or unless a Court of law decides otherwise, and with the greatest respect, a DRS is not a forum that should decide such matters where the evidence is neither under oath or tested. The Respondent therefore respectfully contends and requests that the Expert who decides this complaint should, in compliance with the rules of the DRS, and company law, ignore all and any arguments that the Complainant has put forward in his complaint that relate to the director John Pepin or any matter that is not directly attributable to Inshallah Ltd as a corporate body.

The domain has been owned by Inshallah Ltd since the date that it owned the UK Trade Mark. John Pepin is the sole shareholder but there are plans for 2 more directors to join shortly. The domain is owned by the Company, not by Pepin.

It is denied that the Complainant, Viacloud WLL, has any trade mark or common law rights in the UK or Europe and even if it did the Respondent's rights are earlier rights. Rights in Bahrain and Jordan do not give rights anywhere that they want them. They need to register a trade mark and trade, something Viacloud WLL does not have or do within either UK or Europe.

The Complainant does not own either the recently granted CTM or the CTM application and no licence or assignment has been recorded by OHIM as is required to make such rights enforceable by Viacloud WLL.

The Respondent has never been involved in any abusive registrations of domains.

The viacloud.co.uk and viacloud.eu domains were registered for a legitimate business and the Respondent company, Inshallah Ltd, holds a valid UK trade mark. The date of ownership by the Respondent on December 2010 is wrong as is explained above. Indeed even the director, Mr Pepin, held trade mark rights from the date that he filed the trade mark application in January 2010 and so his registration could not have been said to be abusive in his own right.

However, as has been said several times above, this is about Inshallah Ltd who are the Respondent, not Mr Pepin.

The Respondent, Inshallah Ltd, does not accept responsibility for the any matters that Mr Pepin is alleged to have been involved with in his own capacity.

Furthermore, the Complainant seems to be saying that because he may have had a couple of UDRP's or DRS's ruled against him, that that precludes him for life from ever registering another domain or trade mark ever again and that that must also apply to any company of which he may be a director. That is a ridiculous contention and each case must be heard on its own merits.



Even if Mr Pepin has lost a few domains in UDRP or DRS procedures, which are not at all fully contested or on oath procedures and, as the US Courts of Appeal ruled [in the Barcelona.com proceedings] are prone to intervention of the Courts, "Because the administrative process prescribed by the UDRP is "adjudication lite" as a result of its streamlined nature and its loose rules regarding applicable law, the UDRP itself contemplates judicial intervention, which can occur before, during, or after the UDRP's dispute resolution process is invoked." [From Barcelona.com, US Court of Appeals 4<sup>th</sup> Circuit Decision 02-1396]. Even though the owner of Barcelona. com lost at UDRP and then in the 2 lower Courts, he succeeded in reclaiming the domain name, also being awarded around \$1.20 Million costs against the original UDRP complainant.

As regards the Complainant's references to MasdarCity and Essque, the latter of these, essque.com has not been transferred to the complainant in that case due to ongoing litigation. The former is currently being reviewed for proceedings in the USA.

As can be seen from the decision of the US Court of Appeal, such procedures as UDRP and DRS are not a replacement for Court proceedings as the UDRP and DRS are "adjudication lite" which is why the matters raised by the Complainant in this DRS relating to Mr Pepin should not be taken into account in coming to a decision as they require much more than the DRS can provide to determine all issues raised.

The Complainant unfairly and inappropriately asks that the Expert act in the role of a Judge in a Commercial Court and a Judge in a Patent Court by asking that the Expert determine that the Respondent, Inshallah Ltd, is not a Limited Company but a kind of new and unique hybrid, and that the Trade Mark that the Respondent Inshallah Ltd owns and predates any rights that the Complainant contends that it has (but in fact does not) is invalid.

The Complainant in other words does not seek a DRS decision based on the rules but seeks for the Expert to step outside the DRS rules and decides matters that can and only should be decided by a proper Court of law.

This, as much as anything contained in the Response, is why the Expert should deal only with pure facts, only with matters done in the Respondent company name and not make assumptions or decisions that ignore UK company and trade mark laws. The Complaint in no way proves any of the prongs of the DRS rules required to succeed, and the Respondent has a legitimate trade mark and right to the domain name. The Respondent therefore respectfully requests that the Expert rule for the Respondent and that the domain be retained in ownership of Inshallah Ltd.

Throughout the Complaint, the Complainant refers to the "Respondent" as being guilty of various things relating to UDRP and domain names. How on earth can the Respondent Company, Inshallah Limited, be responsible for something dating back to 2006 (for one example), when the Respondent company did not even come into existence until April 2010?

So now the Complainant wants the Expert to not only ignore Company and Trade Mark Laws, it now wants the Expert to rule that something that may have occurred back in 2006 to Mr Pepin should effect a decision about the property owned by the Respondent, which did not even exist until April 2010.

The Complainant again seeks to refer to 5 year old material that is not the concern of Inshallah Limited (the Respondent). I ask the Expert to rule that this is not material that is relevant to the Respondent. I again refer to the evidence above.

Mr Pepin's personal matters are not relevant to the Respondent Company Inshallah Ltd. Mr Pepin asserts that the matters relating to the Vexatious Litigation Order against him are irrelevant and they are not at all as the Complainant has presented them.

Regarding payment for the Domain Name, the Complainant states, "The Complainant offered to reimburse the Respondent's reasonable expenses in return for the transfer of the Domain Name and the Respondent has refused, without providing any explanation for a credible interest in the Domain Name" (see 16 December 2010 letter). The Complainant knows full well that the offer was declined, because it is being used by Respondent for a bona fide business.

The Complainant makes some massive suppositions and conclusions that are entirely wrong. The Respondent did not at all register the domain name for reselling to the Complainant or any other party. The Complainant has spent time trying to persuade Mr Pepin to attend a meeting at the Complainant's representatives offices so that they could, they said, put forwarded a proposal to him. This shows how tricky the Complainants are in that their intentions were very clearly to try and get the Respondent to make an offer and then present it to Nominet.

With regard to Complaint It is ridiculous nonsense for the Complainant to aver that, quote, "VIACLOUD is a coined word with no specific meaning". As the Respondent has noted above, Via+Cloud are 2 separate very common generic words joined together.

What I do not like is the inference that everyone who happens to own a domain name that another company wants is automatically a "cybersquatter". You cannot rightfully refer to someone as a "cybersquatter" unless they are knowingly registering domains of well known trade marks. As I have said in the Response above, the various decisions that the Complainant has referred to existed 5 years or so before the company was even established, the company is a separate legal entity, and owns a trade mark for VIACLOUD.

At all times the Respondent has used the domain name within the parameters of the trade mark.

The Respondent has never attempted to sell the domain and does not want to, despite the Complainants attempts to trick us into offering it for sale.

The Respondent contends that the Complainant has not proven its complaint at all and asks that the Expert dismiss this Complaint and order the domain name be retained by the Respondent Inshallah Limited.

### **Complainant's Reply**

The Complainant's case is that "viacloud.co.uk" is an Abusive Registration because it was registered in a manner which, at the time that it was registered by Mr Pepin and then acquired by Inshallah, took unfair advantage of or was unfairly detrimental to the Complainant's Rights. In addition to the Abusive Registrations grounds set out in the Complaint, it is the Complainant's position that "viacloud.co.uk" was also registered by Pepin and acquired by Inshallah for the purposes of selling "viacloud.co.uk" to the Complainant at a price higher than that paid by the Respondent to register "viacloud.co.uk".

The Respondent has not provided any information or evidence to rebut the Abusive Registration factors and evidence in the Complaint. In particular the Respondent has not provided any evidence that "viacloud.co.uk" was registered for legitimate purposes, with no evidence of any trading activity or other legitimate activity being conducted under the "viacloud.co.uk" domain or the mark VIACLOUD. As a matter of trade mark law, the fact that the Respondent has a UK trade mark registration for VIACLOUD does not give the Respondent the right to use the trade mark VIACLOUD.

The information below is in response to specific matters in the Response.

#### **1. Viacloud: Group company structure**

Viacloud WLL ("WLL") is the Complainant on behalf of the Viacloud group. WLL is the Complainant on the basis that it owns the VIACLOUD Bahraini and Jordanian trade mark registrations (dated 2006) and is the "viacloud.com" registrant (registered in 2004). Viacloud Holding Company SPC ("SPC") owns the two VIACLOUD Community trade marks ("CTM"). Since lodging the Complaint, CTM application no. 9506932 has matured to registration.

SPC is a company in the Viacloud group. SPC is a Bahraini company formed on 28 April 2010 (prior to that date, WLL was the Viacloud group parent company). Under Bahraini law, it is not allowed to trade. It can only invest in companies. SPC is now the parent company of WLL and Viacloud UK Holdings Limited. SPC is the ultimate owner of nine UK companies, including Viacloud UK Limited ("VUKL"), through its shareholding in Viacloud UK Holdings Limited.

In relation to any jurisdiction point asserted by the Respondent, Nominet's definition of "Rights" is "rights enforceable by the Complainant, whether under English law or otherwise". Nominet's guidance on Rights provides that a "trade mark of any type might be helpful in demonstrating rights in the disputed domain name, but is not required". The Complainant's Rights include the

registered and unregistered trade marks identified above, and are enforceable under English law or otherwise.

The Response refers to Viacloud's trading in the UK. Viacloud's 17 January 2010 announcement in the press and online refers to the launch of Viacloud's service in the European market through its agreement with T-Mobile UK.

Respondent's evidence does not show that VUKL is a dormant company. VUKL was exempt from audit in 2009. Viacloud obtained an exemption from Companies House not to file accounts that year because the company was only formed in the second half of 2009. VUKL is an active company, trading in the UK since 1 January 2010. Its VAT number is 101756738. It has filed VAT returns with HMRC. It will have to file 2010 accounts at Companies House.

2. Inshallah Limited: acting under the control, direction and for benefit of Mr Pepin

It is clear that Pepin registered Inshallah for the sole purpose of carrying the pattern of abusive registrations set out in the Complaint through another guise, in order to avoid any allegation of pattern of behaviour. Pepin is the only director and shareholder of Inshallah. He therefore controls and directs Inshallah and Inshallah's business is conducted for his benefit. Furthermore, the WHOIS record for "viacloud.co.uk" shows it was transferred from Pepin to Inshallah on 21 December 2010 after the Complainant's solicitors wrote to him on 16 December 2010. The Respondent has not provided any evidence that "viacloud.co.uk" was transferred on an earlier date.

The Response refers to Kevin Reed being "effected by any decision" in his capacity as the company secretary. This is not correct. As a matter of company law, the company secretary is purely an operational position. In any event, as set out in the Complaint, Mr Reed has a similar pattern of abusive registration behaviour and has been found to be connected to Pepin by Nominet in an abusive registration decision.

The Response refers to future directors. It is notable that no such directors have been appointed. The Respondent has not identified who these future directors will be. In any event, there is nothing to suggest that any future directors are not associated with Pepin and/or Mr Reed and their activity of making abusive registrations.

3. Inshallah Limited: No evidence to rebut abusive registration

The Respondent has not given any explanation for the timing of the "viacloud.co.uk" registration relative to the Complainant's announcement of the UK launch. Similarly, the Respondent has not provided any legitimate reason for the "viacloud.co.uk" registration, such as evidence that Inshallah is trading or evidence of any business activities.

3.1 Activity under "viacloud.co.uk"

The Respondent has not provided evidence of any trade from the [www.viacloud.co.uk](http://www.viacloud.co.uk) website.

The website is a standard parked page. When the URL [www.viacloud.co.uk](http://www.viacloud.co.uk) is typed into an internet browser, it re-directs to <http://www.ndparking.com/viacloud.co.uk>. If you click "Contact the owner of this domain" in the top of that page, you are re-directed to a NameDrive page that invites inquiries "about the domain [viacloud.co.uk](http://www.viacloud.co.uk)". This is an invitation to sell the domain.

Furthermore, the standard trading information, such as contact details, the company registered name, address and number, required for a trading website under the e-Commerce Regulations 2002 and the Companies (Trading Disclosures) Regulations 2008 (together, the "Regulations") is not included on this website.

The website is a clear example of the Respondent looking to block the "[viacloud.co.uk](http://www.viacloud.co.uk)" domain.

### 3.2 Activity under "[viacloud.eu](http://www.viacloud.eu)"

The Respondent has not provided any evidence of trade from the [www.viacloud.eu](http://www.viacloud.eu) website.

The screenshot provided by the Respondent states the website is under construction. The website is a holding page. It is another smokescreen to attempt to demonstrate a legitimate interest in VIACLOUD. The WHOIS record shows that like "[viacloud.co.uk](http://www.viacloud.co.uk)", the domain name [viacloud.eu](http://www.viacloud.eu) was registered on 17 January 2010. The record does not provide the original registrant. However, it does show that "[viacloud.eu](http://www.viacloud.eu)" was transferred to "K Reed, Inshallah Limited" on 22 December 2010, again, after the 16 December letter to Pepin.

Again, the standard trading information company, such as the registered name, address and number, required for a trading website under the Regulations is not included on this website.

### 3.3 Twitter

The Respondent has not provided any evidence of use of the Twitter account. The evidence shows that, as at 12 May 2011, the only use made was to include a link to the [viacloud.co.uk](http://www.viacloud.co.uk) website on 19 April 2011 and again on 10 May 2011.

### 3.4 Other trading activity

The Respondent has not provided any other evidence that it is trading under the VIACLOUD name. No accounts, evidence of sales or marketing material have been provided. As at 12 May 2011, there are no hits for the Respondent's

Viacloud websites in at least the first five pages of a Google search for "Viacloud". This indicates there has been no marketing activity by the Respondent.

#### 4. Nominet DRS rules

A registrant that registers a domain name with Nominet is bound by Nominet's terms and conditions. The contract of registration includes the terms and conditions, Rules and the DRS Policy and Procedure, which prohibit Abusive Registrations.

The passage highlighted by the Respondent in the Barcelona.com USCA Decision indicates that the UDRP in this matter operates in an equivalent way to the Nominet domain name registration system and DRS.

The DRS process, therefore, provides a contractual process for resolving third party disputes relating to breaches of Nominet's terms and conditions of domain name registration.

The remainder of the Barcelona.com judgment turns on matters of US jurisdiction and law, which have no application to this Complaint.

#### 5. Previous domain name disputes

The Respondent has not provided any evidence of Pepin's suggestion that the result of the UDRP and Nominet disputes he has been involved in have had a different outcome to that stated in the Complaint. The Respondent has not provided any evidence of any court proceedings in relation to any of those disputes.

#### 6. Vexatious litigant order ("VLO")

The Respondent has not provided any evidence in relation to the facts surrounding the VLO made against Pepin on 27 May 2004. There is no evidence that the information provided in the Response relates to that VLO. There is no evidence of any steps that may have been taken to set VLO aside since that date and that order is still in place.

#### 7. VIACLOUD is not a generic word

The Response states that "via" and "cloud" are each generic words. The Respondent has not put forward any evidence to demonstrate that the combination of these two words as "Viacloud" is generic.

The combination of two generic words does not mean that the word resulting from that combination is generic, as found by the European Court of Justice in the so-called BABY-DRY case. In that case, the combination of "baby" and "dry" to get BABY-DRY was a syntactically unusual juxtaposition and a lexical invention. It was not generic.

The internet print outs referring to the use of Cloud computing are not evidence that "Viacloud" is a generic word.

In any event, the Complainant does not use Cloud computing in the services that it offers. The Respondent has not provided any evidence of any services.

## 8. Settlement

The Respondent refers to the Complainant's attempts to persuade Pepin to attend a meeting so that they could put forward a proposal to him. This is not a complete or accurate account. The complete chronology is as follows:

The 16 December 2010 letter to Pepin explained that Viacloud is entitled to make a complaint to Nominet pursuant to its Policy, requesting transfer of "viacloud.co.uk". Viacloud offered to pay Pepin's reasonable out of pocket expenses.

Pepin referred to the VIACLOUD UK trade mark in his 22 December 2010 response and stated, on that basis, "I trust that you will withdraw your threatened proceedings, otherwise I will consider issuing proceedings to protect ourselves".

The Complainant's 24 December 2010 response asked Pepin to confirm what proceedings he was considering issuing. He failed to explain this in his reply email and stated that any action taken by Viacloud would be met by a reaction. After the Complaint was lodged, the Respondent contacted Viacloud's representatives also inviting proposals to settle.

However, the Respondent did not set out any valid legal cause of action against Viacloud. [The requirements the Respondent would need to meet in order to serve proceedings on the Complainant, Viacloud WLL, as a non-UK company based outside the UK jurisdiction, were explained in an open letter of 14 April 2011 to the Respondent.]

It was unclear to Viacloud what proposals the Respondent expected to settle the matter, the Complainant having already offered the Respondent's out of pocket expenses in registering "viacloud.co.uk". This was explained to the Respondent in a separate 14 April 2011 letter made "without prejudice save as to costs" and subsequent emails.

When the Respondent refused to explain the proposals he expected to settle the matter in correspondence the Complainant invited the Respondent to a meeting to discuss settlement in oral discussions. The Respondent indicated that he would only attend such discussion if the Complainant first set out proposals for settlement in writing.

It is implicit in the chain of correspondence that the Respondent was inviting the Complainant to make a financial offer for the domain name so that he could seek to negotiate a price for the domain name above its out of pocket expenses

without further prejudicing his position under this Complaint. This is consistent with the evolution of the Respondent's previous pattern of behaviour outlined in the Complaint.

## **6. Discussions and Findings**

### **General**

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

### **Complainant's Rights**

The Complainant has clearly demonstrated prior rights in registered trade marks for VIACLOUD in at least Bahrain and Jordan.

That is entirely sufficient for the purposes of the Policy, which recognises expressly that "Rights" include rights "whether under English law or otherwise".

The Expert is not concerned that the CTM registrations may be held in the name of a different company in the Complainant's corporate group. The Respondent's assertions regarding the need to record licences at OHIM are incorrect in any event and, were it to be relevant, the Expert would accept the addition of Viacloud Holding Company SPC as a joint Complainant. However, the Expert does not consider that to be necessary.

The VIACLOUD mark is identical to the Domain Name ignoring the .co.uk suffix.

Consequently, the Expert finds that the Complainant meets the requirements of Paragraph 2(a)(i) of the Policy, and has Rights in respect of a name or mark, which is identical or similar to the Domain Name.

### **Abusive Registration**

The Complainant also has to show that the Domain Name is 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 a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant's submissions and supporting evidence, the following examples appear to be potentially applicable in this case:

3a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is 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;

...

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;

...

The factors listed in Paragraph 3 of the Policy are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In the present case, it is pertinent to note that the Complainant has only alleged that the Domain Name is an Abusive Registration on the grounds that it (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; and has not alleged that the Domain Name (ii) has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Complainant has presented a significant volume of evidence, both circumstantial and factual in nature, relating principally to the prior activities of the original registrant of the Domain Name, Mr Pepin, and has argued that Pepin and the nominal Respondent, Inshallah Limited (a company formed after the Domain Name was first registered and of which Pepin is the sole director), share common design and should effectively be treated as one and the same for the purposes of this Complaint.

Mr Pepin has argued that he and the company have separate legal identities, so that any evidence as to his own prior conduct in relation to other domain name disputes should be disregarded and should not be held against Inshallah Limited as the named Respondent in these proceedings. He has also sought to argue that the legal distinction between the company and its director(s) and the fact that the Respondent itself has a registered trade mark in the UK should rule out the application of the DRS to this dispute on the basis that “the DRS should not be used to “go behind” trade mark and company laws.”.

If Inshallah Limited could be said to have acquired the Domain Name in good faith and without any knowledge of the prior conduct of the original registrant, it might be reasonable to treat it separately. However, that is plainly not the situation here. Inshallah Limited, as embodied by Mr Pepin himself as the sole director, cannot claim to be ignorant of Mr Pepin’s own prior conduct or motivation for obtaining the Domain Name.

If the Domain Name was an Abusive Registration, when it was first registered by Mr Pepin, he could not remove that taint simply by passing the Domain Name on to a limited company, which he has incorporated himself and of which he is the only director. The fact that Mr Pepin only formally transferred the registration of the Domain Name from himself to Inshallah after receiving notice of the Complainant’s claims, also means that his own conduct cannot be excluded from scrutiny.

The DRS is an administrative system for dealing with disputes about domain name registrations, not trade mark or company law. It is applied under the registration contract by which all .co.uk domain registrants, including Mr Pepin and Inshallah Limited are bound. The Policy does not require determinations of company law or trade mark law and, in the Expert’s view, it would still be quite justifiable under the terms of the Policy to find a domain name registration to have been an Abusive Registration, despite the subsequent acquisition of trade mark rights, particularly if such were to be considered as merely an attempt to paste a legitimate veneer over what was an Abusive Registration *ab initio*.

The Complainant’s evidence of Mr Pepin’s past activities would certainly appear to add significant weight to the Complainant’s contentions that he has a history as a serial cybersquatter, who has contrived some sophisticated tactics, allegedly merely as pretexts to circumvent DRS and UDRP criteria under the respective dispute policies for .uk and .com domains.

However, neither Mr Pepin, nor Inshallah Limited has been found to have made three or more Abusive Registrations within the preceding two years, so there is no automatic presumption under Paragraph 3(c) of the Policy that the present registration is an Abusive Registration. As outlined further below, there are also discrepancies and other factors in this case which differentiate it in some important respects from the previous situations, and raise some doubts as to whether the Domain Name should necessarily be deemed to be an Abusive Registration, even in view of the similarities the Complainant has chosen to emphasise.

One key factor is that, at the date of registration of the Domain Name, the Complainant did not itself have any registered trade mark rights for the VIACLOUD mark directly applicable in the UK. Its corporate group's Community Trade Marks were only applied for in November 2010. Mr Pepin, however, had a UK national registration for VIACLOUD (registered for different services to the Complainant), which was applied for on 27 January, 2010 and registered, unopposed, on 30 April 2010, and for which an assignment to Inshallah Limited was officially recorded on 29 June 2010.

The Complainant has asserted that it "has built up a considerable reputation and goodwill worldwide in and to the name VIACLOUD", and that "[i]t is therefore the owner of unregistered trade mark rights in the mark VIACLOUD". In the letter of 16 December 2010 to Mr Pepin, it was also asserted that the mere registration of the Domain Name "amounts to actionable passing off", following the Court of Appeal decision in *British Telecommunications plc v. One in A Million Ltd and Others*.

Contrary to the Respondent's apparent belief, the lack of registered rights in the UK would not prevent the Complainant from having rights of action if it were shown to have established goodwill in its VIACLOUD brand in the UK through, for example, significant marketing efforts directed at the relevant public here, even if it would have been necessary for customers to go abroad to enjoy its services (c.f. *Hotel Cipriani SRL & Ors v. Cipriani (Grosvenor Street) Limited & Ors* ([2010] EWCA Civ 110). The goodwill would need at least to predate the earliest use of the Domain Name (c.f. *Inter Lotto (UK) Ltd v Camelot Group plc* [2003] All ER (D) 513).

However, the Complainant has not provided any convincing evidence of the prior existence of UK goodwill in the VIACLOUD mark for it to have founded such a passing off action. The *One in A Million* case involved very well-known UK businesses and trade marks (e.g. BT, Sainsburys, Marks & Spencer, Virgin). From the evidence, the Expert does not believe that VIACLOUD would be anything like so well-known in the UK.

VIACLOUD may not be a generic or wholly descriptive term in relation to the Complainant's (or the Respondent's) services, but neither is it a unique or coined word like KODAK or IKEA. It is recognisably a simple combination of the two ordinary words VIA+CLOUD. As domain names cannot include spaces, in the context of the Domain Name, "viacloud" may equally be perceived as an elision of the two separate words "via cloud" omitting the space. And as both the Complainant's and the Respondent's evidence shows, there are certainly plenty of examples of use of "via cloud" by others.

In such circumstances, if the Complainant has no directly applicable rights in the UK jurisdiction, and if the name or mark VIACLOUD is not so well-known as to entitle the Complainant alone to claim protection regardless (c.f. Paris Convention Article 6bis), then even if Mr Pepin was aware of the Complainant's Press Release of 17 January, 2010 (as the Complainant asserts he must have

been) does that mean the registration of “viacloud.co.uk” on 17 January 2010 must necessarily have been an Abusive Registration?

The Complainant did not oppose, and has not subsequently chosen to challenge, Mr Pepin’s (now Inshallah’s) UK trade mark registration for VIACLOUD in Class 35. The website at [www.viacloud.co.uk](http://www.viacloud.co.uk) may have the appearances typical of a parasitic cybersquatter’s click-through, income-generating operation but, in the Expert’s view it does arguably provide at least a colourable imitation of the services of “dissemination of advertising for others via the internet, all in relation to electrical and electronic goods”, for which the Inshallah VIACLOUD mark is registered. Provision of click-through advertising is a business of a sort. It is a typical mechanism whereby domainers can generate income for themselves. Whether Mr Pepin and Inshallah are really operating such a business in a genuine manner, in due compliance with all the applicable business and accounting regulations may be questionable but, as noted above, the Complainant has not alleged that the Domain Name is an Abusive Registration because of the manner in which it is currently being used.

The Complainant has referred in particular to two prior UDRP decisions with apparently similar fact patterns: D2008-1560 (masdarcity.com & masdarcity.net); D2009-0041 (essque.com). In both these cases, Pepin was the Respondent and had reportedly attempted to register UK trade marks for, respectively, MASDAR and ESSQUE. However, the Expert believes that distinctions can be drawn between those and the present case. The MASDAR trade mark application was actively opposed and was eventually withdrawn, so that mark was not registered at the time the UDRP decision was taken. Similarly, at the time the essque.com decision was taken, the trade mark application for ESSQUE was also still pending – so Pepin had no enforceable rights then. Subsequently, that mark has registered and, from a simple check of the website at [www.essque.com](http://www.essque.com) and the WHOIS record for essque.com, it is evident that, as stated in the Response, the essque.com decision has NOT been implemented, presumably because there is indeed some ongoing litigation on that case.

The domain names in those cases also did not have a direct connection with the UK jurisdiction, as is inherent in the present case.

There are other UDRP cases where the issue of a Respondent’s trade mark rights have been considered. The Expert believes the guidance proposed in D2004-0298 (medicineassist.com) is potentially adaptable to the DRS at least in part:

[from D2004-0298 Paragraph 7.26]

(i) When considering the question of “rights or legitimate interests” [...] a panel can, in an appropriate case, question the legitimacy of a trademark relied upon by a respondent. The mere fact that a trademark has been applied for or obtained by a respondent is not an absolute bar to a complainant succeeding under the UDRP. In a case where, in the opinion of the panel, a trademark has not been sought or obtained for a legitimate or bona fide purpose, but merely in order to bolster a domain name registration, the trademark can be disregarded.

(ii) The chronology of events is an important factor in determining whether the application is *bona fide* or merely a way of bolstering the respondent's domain name registration. A trademark application made subsequent to notice of a dispute or the domain name registration may indicate a lack of legitimate interest.

(iii) The knowledge and intention of the respondent at the time the disputed domain name is registered is highly relevant, but knowledge of the complainant's rights does not, in itself, preclude the respondent from having a right or legitimate interest in the domain name.

(iv) The connection, or lack of it, between the respondent and the jurisdiction in which it is seeking a trademark registration may indicate whether the trademark application or registration is "legitimate."

In that case, the Panel declined to transfer the domain name, and that case has been quoted with approval in others.

That guidance might be adapted in the present case to the effect that:

(i) As noted above, in an appropriate case, it is possible to question the legitimacy of a trademark relied upon by a respondent. The mere fact that a trademark has been applied for or obtained by a respondent is not an absolute bar to a complainant succeeding under the DRS. In a case where, in the opinion of the Expert, a trademark has not been sought or obtained for a legitimate or *bona fide* purpose, but merely in order to bolster a domain name registration, the trademark can be disregarded.

(ii) The chronology of events is an important factor in determining whether the application is *bona fide* or merely a way of bolstering the respondent's domain name registration. A trademark application made subsequent to notice of a dispute or the domain name registration may not prevent a finding that the domain name is an Abusive Registration.

(iii) The knowledge and intention of the respondent at the time the disputed domain name is registered is highly relevant, but knowledge of the complainant's rights does not, in itself, preclude the respondent from having a right to use it in connection with a genuine offering of goods or services.

(iv) The connection, or lack of it, between the respondent and the jurisdiction in which it is seeking a trademark registration may indicate whether the trademark application or registration is "legitimate."

The Expert recognises that there are considerable grounds for scepticism as to the *bona fides* of Mr Pepin's activities throughout the case, and as to the genuine nature of Inshallah's operations under Pepin's direction. Some of Mr Pepin's statements in the correspondence are plainly posturing, blustering, inaccurate and contradictory.

In the circumstances, the Expert does not believe that it would be inconsistent with the Policy, nor would it be unreasonable, if he were to conclude that the Domain Name was indeed an Abusive Registration.

However, the circumstances are also such as to give the Expert sufficiently nagging doubts as to whether that conclusion is really appropriate in this case.

The domain name system and the trade mark system, to some extent, are “first-come, first-served”, and registrations can be validly obtained and used if they do not conflict with the prior rights of others. As international businesses are well-aware, the fact that they may have registered trade mark rights in one jurisdiction does not guarantee that they will be able to obtain corresponding registrations and rights to use the same mark in other jurisdictions.

The Complainant in this case did have “Rights” in registered trade marks *outside* the UK at the date the Domain Name was registered, and has claimed to have other “unregistered trade mark rights” elsewhere, but it is by no means clear to the Expert that it would have been able to assert such rights in the UK at that time. It is notable that the Complainant has not subsequently attempted to do so in relation to Pepin’s trade mark registration of VIACLOUD. If the Complainant’s rights were as strong as it suggests, it could conceivably have challenged that registration on grounds such as bad faith, lack of entitlement or passing-off.

But, if the Complainant had no enforceable rights in the UK at the relevant time, and as VIACLOUD does not appear to be a particularly famous or distinctive mark meriting wider protection, it is difficult to accept that Mr Pepin must necessarily have been taking “unfair advantage of” or “was unfairly detrimental to the Complainant’s Rights” at the time the .co.uk Domain Name was registered here.

The Complainant has correctly observed that a registered trade mark is an exclusive rather than a permissive right, so that “the fact that the Respondent has a UK trade mark registration for VIACLOUD does not give the Respondent the right to use the trade mark VIACLOUD”. However, an existing UK trade mark registration is to be considered *prima facie* as valid and enforceable itself, and Section 11(1) of the Trade Marks Act 1994 expressly states that use of a registered trade mark for the goods or services for which it is registered will not infringe another registered trade mark.

The Complainant avers that the Domain Name was registered as a blocking registration against the VIACLOUD name and mark in which the Complainant has Rights. However, in the Expert’s view, the fact that the Domain Name may now block the Complainant from reflecting its own VIACLOUD name and mark in the .co.uk namespace is not, of itself, grounds for finding the Domain Name to be an Abusive Registration in the circumstances of this case.

Mr Pepin claims the Domain Name was intended for use, as it now appears to be used, and not for services conflicting with the Complainant. He would also have had expressly to confirm that he had such a “*bona fide* intention” with regard to use of the trade mark VIACLOUD when he filed his trade mark application 10 days after the Domain Name was registered.

Yet the Complainant did not get around to raising any complaint until almost 11 months later, and well after Pepin's own trade mark application had been granted and the registration had been assigned to Inshallah.

The Complainant has also asserted that the mere existence of a "Contact the owner" page accessible via the Respondent's website, and the offer by Mr Pepin to participate in settlement discussions, should be construed as offers to sell the Domain Name for some excess consideration and taken as evidence of Abusive Registration. Yet Mr Pepin has made no express proposals for any payment at all. And if one has the view that the use and registration of the Domain Name were not abusive, it would hardly be unreasonable to expect the Complainant to make an initial offer of settlement terms, as Mr Pepin has proposed. The Expert does not consider that the *absence* of express offers for sale or requests for excess compensation must automatically be interpreted as being implied offers for sale or implied requests for excess compensation.

The Complainant has presented a lot of circumstantial evidence and has asked the Expert to make a lot of presumptions in this case. The Respondent has similarly made a lot of claims, which are not exactly well-supported.

It may be that the Complainant's assertions are all correct and that Mr Pepin's original motivation and subsequent actions are as devious and lacking in *bona fides* as the Complainant claims. Conversely, it may be that Mr Pepin's claims are genuine. However, such issues can only really be examined properly in a tribunal (i.e. the Court or the Trade Marks Registry), which has the powers to require the necessary level of disclosure and cross-examination of witnesses. That is not possible, nor would it be appropriate, under the DRS. As the Complainant's solicitors helpfully explained in their letter of 14 April, 2011, because the Complainant is located outside the UK jurisdiction, the Respondent (Mr Pepin or Inshallah) would face particular difficulties if they wished to challenge the Complainant in the Court, Mr Pepin all the more so because of his Vexatious Litigant Order. Consequently, it would seem to be reasonable to expect the Complainant to be the one to initiate proceedings in a suitable forum to have the requisite issues duly examined in sufficient depth to confirm if their case is as strong as they believe.

Given the particular circumstances, chronology and complications in this case, the Expert does not feel that the doubts expressed above can be adequately resolved without such a detailed examination of those various issues including, for example: the existence and strength of the Complainant's alleged unregistered rights in the UK; the *bona fides* of Mr Pepin's motivations for registration of the Domain Name and whether Inshallah was indeed also the beneficial owner of the Domain Name from the same date Pepin assigned his trade mark registration; the validity of the Inshallah trade mark registration for VIACLOUD; and the genuineness (or otherwise) of Inshallah's business using of the Domain Name.

As it stands at present, for the reasons explained above, the Expert has sufficient doubts that the original registration by Pepin or the subsequent acquisition of

the Domain Name by Inshallah necessarily took unfair advantage of, or was unfairly detrimental to, the Complainant's (non-UK) Rights, and so is presently unable to conclude that the Domain Name is an Abusive Registration

## **7. Decision**

Having concluded that the Complainant does have Rights in respect of a name or mark, which is identical to the Domain Name, but that there are reasonable grounds for doubt that the Domain Name, in the hands of the Respondent, is necessarily an Abusive Registration, the Expert determines that no action should be taken in respect of this Complaint.

**Signed .....**  
**KEITH GYMER**

**Dated 22 September 2011**