



DECISION

Hot Pancakes Ltd. v. Amber Murphy / Carlos Pinto de Abreu e Associados / Domain Manager / Domain Licenses Limited
Claim Number: FA2111001972226

PARTIES

Complainant is **Hot Pancakes Ltd.** (“Complainant”), represented by **R. Omar Riojas** of **Goldfarb & Huck Roth Riojas, PLLC**, Washington, USA. Respondent is **Amber Murphy / Carlos Pinto de Abreu e Associados / Domain Manager / Domain Licenses Limited** (“Respondent”), represented by **Hozaifa Cassubhai** of **Bailey Duquette PC**, New York, USA.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are **<bellaforrest.net>**, **<bellaforrest.org>**, **<bellaforrest.com>**, **<forrestbooks.com>**, **<shadebooks.com>**, **<morebellaforrest.com>**, **<harleymerlin.com>**, registered with Nom-iq Ltd. dba COM LAUDE.

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Charles A. Kuechenmeister, Panelist
Sandra J. Franklin, Panelist
Aaron Newell, Panelist

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on November 5, 2021; the FORUM received payment on November 5, 2021.

On November 10, 2021, Nom-iq Ltd. dba COM LAUDE confirmed by e-mail to the FORUM that the **<bellaforrest.net>**, **<bellaforrest.org>**, **<bellaforrest.com>**, **<forrestbooks.com>**, **<shadebooks.com>**, **<morebellaforrest.com>**, and **<harleymerlin.com>** domain names (the Domain Names) are registered with Nom-iq Ltd. dba COM LAUDE and that Respondent is the current registrant of those names. Nom-iq Ltd. dba COM LAUDE has verified that the Respondents are bound by the Nom-iq Ltd. dba COM LAUDE registration agreement and have thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On November 19, 2021, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint setting a deadline of December 9, 2021 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent’s registration as technical, administrative, and billing contacts, and to postmaster@bellaforrest.net,

postmaster@bellaforrest.org, postmaster@bellaforrest.com,
postmaster@forrestbooks.com, postmaster@shadebooks.com,
postmaster@morebellaforrest.com, postmaster@harleymerlin.com. Also on
November 19, 2021, the Written Notice of the Complaint, notifying Respondent of
the e-mail addresses served and the deadline for a Response, was transmitted to
Respondent via post and fax to all entities and persons listed on Respondent's
registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on December 9,
2021.

Complainant filed a Reply to Respondent's Response on December 27, 2021.

On December 17, 2021, pursuant to Complainant's request to have the dispute
decided by a three-member Panel, the FORUM appointed Charles A.
Kuechenmeister as Panel Chair, and Sandra J. Franklin and Aaron Newell as
Panelists.

Having reviewed the communications records, the Administrative Panel (the
"Panel") finds that the FORUM has discharged its responsibility under Paragraph
2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the
"Rules") "to employ reasonably available means calculated to achieve actual
notice to Respondent" through submission of Electronic and Written Notices, as
defined in Rule 1 and Rule 2.

RELIEF SOUGHT

Complainant requests that the Domain Names be transferred from Respondent
to Complainant.

PRELIMINARY ISSUE: CONCURRENT COURT PROCEEDINGS

On or about October 21, 2020, Complainant and a company named CS&P, SA
(CS&P) filed a civil action, No. 2020 CLE/gen/00720, in the Supreme Court of the
Commonwealth of The Bahamas, Common Law & Equity Division, against
Respondent and a bank located in the Bahamas in which they seek, among other
things, relief in the nature of a declaratory judgment that Respondent's seeking to
hold herself out as the ultimate beneficial owner of the Complainant corporation
is fraudulent misconduct (copy of Statement of Claim submitted as Respondent
Exhibit W). Respondent filed a Defence and Counterclaim in this same action in
which she seeks, among other things, judicial declarations (i) that all shares of
Complainant's corporate stock are held for her benefit, and (ii) that the funds in
the disputed bank account held in the name of Complainant, *in addition to any
other assets held in the name of Complainant* [emphasis supplied] are
beneficially the property of Respondent (copy of Defence and Counterclaim
submitted as Respondent Exhibit X). While there is no express mention of the

Domain Names in any of the court pleadings, and while the Domain Names themselves are presently registered to Respondent, the BELLA FORREST trademark incorporated into them is registered to Complainant with the USPTO (TESS report submitted as Complaint Exhibit E), and with the Intellectual Property Office of the United Kingdom (screenshot of web page of the United Kingdom Intellectual Property Office submitted as Complaint Exhibit F). As such, it is one of the assets of Complainant and is thus subject to the parties' competing claims before the court. Control of the BELLA FORREST mark will be crucial if not determinative of any dispute over the Domain Names. Respondent lists additional legal disputes involving these parties pending in courts in Portugal, Cyprus, Switzerland (copy of criminal complaint filed against SC&P and Carlo Scevola *et al.* submitted as Respondent Exhibit CC), and the State of New York, in which the parties' competing claims for control of the Complainant corporation are involved (Response pp. 11, 12).

In situations where concurrent court proceedings are pending, in some cases UDRP panels have chosen to proceed with the UDRP filing. *eProperty Direct LLC v. Miller*, FA 836419 (FORUM Jan. 3, 2007) (holding that the panel could decide the dispute under Rule 18(a) of the Policy "since the legal proceedings referred to by the parties appear to be concluded and Orders made. Moreover,... those Orders do not touch directly on the disposition of the disputed domain name or on the parties' intellectual property rights."), *W. Fla. Lighting v. Ramirez*, D2008-1122 (WIPO Oct. 2, 2008) (deciding to proceed under the UDRP despite concurrent court proceedings because "the Panel does not find that it is necessary or advantageous to await a judicial determination of the issues raised in the federal litigation in order to reach a decision strictly under the Policy. This administrative proceeding under the Policy concerns only control of the Domain Name, not any of the other remedies at issue in the federal litigation. It is not binding on the court, and it does not preclude the prosecution of any claims, defenses, or counterclaims in the federal litigation"), *Mary's Futons, Inc. v. Tex. Int'l Prop. Assocs.*, FA 1012059 (FORUM Aug. 13, 2007) (choosing to proceed under the UDRP despite concurrent court proceedings for multiple reasons, including that the proceedings appeared to be filed in a court that did not commonly adjudicate intellectual property issues and that the court proceedings were filed by the respondent on the same day the response in these proceedings was filed).

These cases, however, did not involve the complex, fact-sensitive conflict between these litigants for control of the assets of one of the parties, including a trademark relevant to the Domain Names. As noted above, that mark is one of the corporate assets of the Complainant corporation, and the parties' litigation is directly concerned with the right to control and enjoy the benefit of those assets. Neither the Statement of Claim nor the Defence and Counterclaim mentions or directly involves the Domain Names in the litigation. Nevertheless, as stated

above, this litigation will determine which party, Respondent or SC&P, has the right to control the Complainant corporation and its assets, including the BELLA FORREST trademark. Should SC&P prevail in this litigation, it may need to bring a UDRP proceeding or some other type of litigation to recover the Domain Names from Respondent, but its commencement of such a proceeding at this time is at best premature. Except as to the <shadebooks.com> and <harleymerlin.com> Domain Names, which are addressed below, these parties' dispute cannot be resolved except by a full evidentiary hearing, with the benefit of live witness testimony and opportunity for cross-examination. This Panel is neither intended nor empowered to conduct such a process, and under these circumstances it should not attempt to resolve the Domain Name issues. *Swisher Int'l, Inc. v. Kirby Mastrangelo*, FA2110001969097 (FORUM Nov. 24, 2021) (denying complaint where "there are a number of disputed facts" and resolution "would require a complete evidentiary record, the opportunity to present witnesses, expert opinions, and to cross examine those witnesses and experts"), *Dice Partners, Inc. v. J.C.*, D2012-0992 (WIPO June 25, 2012) (denying complaint where "documents disclose sharp conflicts of fact between the parties, including allegations of fraud . . ."). Nor would it be appropriate or useful for the Panel to attempt to anticipate or predict the form and substance of any judgment rendered by the Bahamian court. *AmeriPlan Corp. v. Gilbert* FA105737 (FORUM Apr. 22, 2002) (Regarding simultaneous court proceedings and UDRP disputes, Policy ¶ 4(k) requires that ICANN not implement an administrative panel's decision regarding a UDRP dispute "until the court proceeding is resolved." Therefore, a panel should not rule on a decision when there is a court proceeding pending because "no purpose is served by [the panel] rendering a decision on the merits to transfer the domain name, or have it remain, when as here, a decision regarding the domain name will have no practical consequence."). For the foregoing reasons, the Panel elects not to conduct a UDRP analysis with respect to the <bellaforrest.net>, <bellaforrest.org>, <bellaforrest.com>, <forrestbooks.com>, and <morebellaforrest.com> Domain Names and finds that the Complaint should be dismissed as to them.ⁱ

FINDINGS AS TO <shadebooks.com> AND <harleymerlin.com>

As discussed above, both parties have asserted claims involving alleged fraudulent misconduct and unlawful diversion of corporate assets against each other, which as to most of the Domain Names can only be resolved by a full evidentiary hearing. This is not true, however, with respect to the <shadebooks.com> and <harleymerlin.com> Domain Names. Complainant has asserted its ownership of the BELLA FORREST mark, but it does not assert rights in any other trademark, and neither of these two Domain Names bears any similarity at all to the BELLA FORREST mark. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, states that the test for confusing similarity "typically involves a side-by-side comparison of the domain

name and the relevant trademark to assess whether the mark is recognizable within the domain name.” This test is almost universally followed by UDRP panels when assessing the confusingly similar element. Complainant’s BELLA FORREST mark is not even remotely recognizable within either of these Domain Names. Accordingly, the Panel finds that Complainant has not met the requirements of Policy ¶ 4(a)(i) and is not entitled to a transfer of these Domain Names.

REVERSE DOMAIN NAME HIJACKING

Respondent asks the Panel to make a finding of bad faith in the filing of the Complaint in this proceeding. Without a final resolution of the competing claims for control of the Complainant corporation, however, it is difficult for the Panel to make such a finding with respect to most of the Domain Names. Should SC&P prevail in its claims for control of the corporation, Complainant may well have a viable claim to the Domain Names in which its mark is recognizable. The only firm evidence of bad faith associated with the filing of the Complaint available to the Panel at this time, however, is Complainant’s obvious and very troubling lack of candor in failing to disclose the pending litigation in the Bahamas. Apart from that, all of Respondent’s claimed bases for a finding of bad faith filing depend upon a finding that Respondent is entitled to control of the corporation. As discussed above, this Panel is not equipped to make that determination. The evidence before the Panel is not sufficient to support a finding of reverse domain name hijacking with respect to the <bellaforrest.net>, <bellaforrest.org>, <bellaforrest.com>, <forrestbooks.com>, and <morebellaforrest.com> Domain Names.

This is not true, however, with respect to the <shadebooks.com> and <harlemerlin.com> Domain Names. It is plain from a simple comparison of Complainant’s mark with these two names that Complainant could not possibly prevail on its claim for them. Complainant either knew or should have known this when it filed the Complaint. Its filing as to these two Domain Names was in bad faith and an abuse of process, and Complainant is guilty of reverse domain name hijacking with respect to these two domains.

DECISION

Complainant having failed to establish all three elements required under the ICANN Policy as to the <shadebooks.com> and <harlemerlin.com> Domain Names, the Panel concludes that relief shall be **DENIED** with respect to these two Domain Names. Accordingly, it is Ordered that the <shadebooks.com> and <harlemerlin.com> Domain Names be **RETAINED BY RESPONDENT**.

Due to the extensive factual determinations that must be made, and in light of litigation pending before the Supreme Court of the Commonwealth of the Bahamas, Common Law & Equity Division, involving the right to control the

Complainant corporation, the Panel elects not to conduct a UDRP analysis of the parties' claims with respect to the <bellaforrest.net>, <bellaforrest.org>, <bellaforrest.com>, <forrestbooks.com>, and <morebellaforrest.com> Domain Names at this time. Accordingly, it is Ordered that the Complaint be and it hereby is ordered **DISMISSED**, without prejudice to the right of the Complainant to re-file the same with respect to these Domain Names at such time as the right to control the Complainant corporation is finally determined.

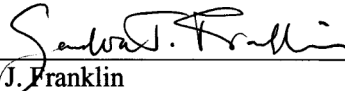
Respondent's claim of reverse domain name hijacking is **DENIED** with respect to the <bellaforrest.net>, <bellaforrest.org>, <bellaforrest.com>, <forrestbooks.com>, and <morebellaforrest.com> Domain Names.

Respondent's claim of reverse domain name hijacking is **GRANTED** with respect to the <shadebooks.com> and <harleymerlin.com> Domain Names.



Honorable Charles A. Kuechenmeister
Arbitrator

Charles A. Kuechenmeister, Panelist



Sandra J. Franklin
Arbitrator

Sandra J. Franklin, Panelist



AARON B. NEWELL, Esq.
Panelist

Aaron Newell, Panelist
Dated: December 30, 2021

ⁱ On December 27, 2021, Complainant filed a Reply to Respondent's Response in which it reiterated and supplemented its allegations pertaining to the merits of the case in the original Complaint. It did not address the issue of whether this Panel should conduct a UDRP analysis in light of the pending litigation, except to

point out that the pleadings in the pending litigation do not specifically mention the Domain Names.