



Asian Domain Name Dispute Resolution Centre

(Seoul Office)

ADMINISTRATIVE PANEL DECISION

Case No. KR-2000222

Complainant: Haimarrow Food Service. Co., Ltd.

Respondent: Gregg Ostrick (Authorized Representative : John Berryhill)

Disputed Domain Name(s): <momstouch.com>

1. The Parties and Contested Domain Name

The Complainant is Haimarrow Food Service. Co., Ltd., Republic of Korea.

The Respondent is Gregg Ostrick, United States of America (“United States”), represented by John Berryhill, United States.

The domain name at issue is <momstouch.com>, registered with Name.com (“Registrar”).

2. Procedural History

The Complaint was filed with the Seoul Office of the Asian Domain Name Dispute Resolution Center (ADNDRC)[“Center”] on September 15, 2020, seeking for a transfer of the disputed domain name.

On September 23, 2020, the Center sent an email to the Registrar asking for the detailed data of the registrant. On September 30, 2020, Name.com transmitted by

email to the Center its verification response, providing the Respondent and its contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Centre's Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, the Centre formally notified the Respondent of the Complaint. The proceedings commenced on October 14, 2020. On October 30, 2020, the Respondent expressly requested an additional four (4) calendar days in which to respond to the Complaint, and the Center automatically granted the extension and notified the Parties thereof. The due date for the Response was November 7, 2020.

On November 3, 2020, the Center received a notice that the Respondent commenced a legal proceeding against the Complainant. On November 7, 2020, a Response was submitted by the Respondent.

On November 17, 2020, the Center appointed Mr. Ho-Hyun Nahm as the Sole Panelist in the administrative proceeding and with the consent for the appointment, impartiality and independence declared and confirmed by the Panelist, the Center, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

3. Factual background

A. Complainant

The Complainant has been operating and developing the brand Mom's Touch since 2004, and now it has over 1,200 outlets in the Republic of Korea. It is a Kotean chicken & burger brand. The Complainant has expanded its business in Taiwan and

Singapore. The Complainant is in the process of launching the brand in the United States and Malaysia as well.

B. Respondent

Respondent is known for registering generic pharaes or words as domain names.

4. Parties' Contentions

A. Complainant

i) The Complainant's marks 'MOM'S TOUCH', 'MOM'S TOUCH with its Korean phonetic equivalent', and/or 'MOM'S TOUCH with a device' were registered with the Korean Intellectual Property Office (KIPO) (Reg. No. 40-495861 registered on June 19, 2001; Reg.No.41-69782 on August 14, 2001; Reg. No. 40-1372016 registered on June 27, 2018), with the United Statres Patent and Trademark Office (USPTO) (Reg.No. 5,413,149 registered on February 27, 2018), and with some other trademark authorities. The disputed domain name is identical or confusingly similar to the Complainant's mark.

ii) The Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent is not using the disputed domain name to provide any information, or use it as a form of media, or for any business purposes. The disputed domain name's resolving website displays that the disputed domain is for sale.

iii) The Respondent registered and used the disputed domain name in bad faith. The Respondent has purchased the disputed domain name, and listed it on to domain name selling website for unreasonably high price. As a result of the Complainant's contacting the seller, they offered \$24,500 for the price quote. The Respondent has infringed on the Complainant's marks and intellectual property rights by registering

the disputed domain name incorporating the Complainant's marks and seeking to make profit by reselling it.

B. Respondent

i) The Respondent argues that the Panel should terminate the UDRP proceeding pending resolution of the federal court proceeding that is ongoing in the United States District Court for the District of Colorado (*see below*).

ii) Should the Panel choose not to terminate the proceeding, then the Respondent submits that the evidence does not show that the Respondent registered the domain name in 2006 in bad faith. The Respondent registered a common phrase as a domain name, more than ten years before the Complainant claims to have conducted any business in a jurisdiction of which the Respondent would have a reasonable likelihood of being aware. The Respondent argues that it has rights and legitimate interests in the disputed domain name. Mr. Ostrick registered the domain name because "mom's touch" is a common English phrase which refers to maternal care and concern. Applying a "mom's touch" to things is an ordinary phrase. When the disputed domain name was registered in 2006, the Respondent would have no reason to know, and did not know, that the phrase was used by a fast food restaurant in Korea as a brand of restaurant. As to the fact that the disputed domain name was offered for sale, the mere fact of offering a descriptive domain name for sale is not of itself indicative of bad faith. The Respondent has not used the domain name for any purpose relating to the Complainant's trademark claim in this common phrase for the narrow purpose of fast food restaurants. The Complainant presents no evidence that the Respondent has used the disputed domain name to pretend to be the Complainant, to infringe the Complainant's narrow rights in fast food restaurants, or to otherwise use the phrase "mom's touch" in the limited secondary meaning the Complainant claims in relation to fast food restaurants.

5. Findings

For the reasons set forth below, the Panel finds that the Complaint should be dismissed without prejudice.

6. Procedural Issue: Concurrent Court Proceedings

The Respondent has informed the Panel through its submissions that the following legal proceeding is pending. The Panel finds that the legal proceeding addresses the same subject matter as the Complaint.

GNO, Inc. v. Haimarrow Food Service, Co., Ltd.

United States District Court, District of Colorado, Civil Action No. 20-cv-03237-SKC; Claim filed on October 29, 2020.

The Panel notes that this case was brought by GNO, Inc. pursuant to 15 U.S.C.1114(2)(D)(iv)–(v) and for declaratory relief pursuant to 28 U.S.C. § 2201 against Haimarrow Food Service Co., Ltd. to establish that GNO, Inc.'s registration and use of the disputed domain name <momstouch.com> is not unlawful under the Anticybersquatting Consumer Protection Act (15 U.S.C. § 1125(d) ("ACPA")) or otherwise under the Lanham Act (15 U.S.C. § 1051, et. seq.), and to prevent the transfer of the disputed domain name to the Respondent which is being sought in an administrative proceeding under the UDRP in a proceeding captioned: Haimarrow Food Service Co., Ltd. v. Gregg Ostrick, ADNDRC Case No. KR-2000222.

The Respondent contends that this legal proceeding has been filed in accordance with UDRP Paragraph 4(k), in the Mutual Jurisdiction. The registrar in this dispute is Name.com LLC of Denver Colorado. In the Complaint, the Complainant has agreed to the jurisdiction of the registrar for independent resolution of this dispute, notwithstanding any decision which may issue from this UDRP Proceeding.

Rule 18 of the Policy provides in pertinent part: Effect of Court Proceedings

(a) *In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.*

Applying Rule 18, the Panel finds that this matter should not be decided until the aforementioned court proceeding is resolved. See *AmeriPlan Corp. v. Gilbert*, FA 105737 (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.").

Previous panels have also chosen to dismiss UDRP complaints when an action regarding the same subject matter was pending in federal court. See *Enerflex Ltd. v. Ryan Garvey*, FA2007001904623 (FORUM Aug. 26, 2020); *Harvest Dispensaries, Cultivations & Production Facilities, LLC v. Martin Higgins / HARVEST*, FA1901001823636 (FORUM Feb. 26, 2019); *Holley Performance Products, Inc. v. Tucows.com Co.*, FA1007001333239 (FORUM Aug. 19, 2010); *Sun Ray Chinese School, Inc. v. Hui Chiu / MEI HSU*, FA1604001668860 (FORUM May 16, 2016).

Therefore, the Panel concludes that the best course of action in the present proceeding is to defer to the United States District Court and dismiss the UDRP proceeding without prejudice of any filing of a future UDRP complaint as appropriate after the conclusion of the legal proceeding in the federal court.

7. Decision

Pursuant to UDRP Rule 18(a), the Complaint of Haimarrow Food Service. Co., Ltd. with respect to the disputed domain name <momstouch.com> is hereby **DISMISSED without prejudice.**



Ho-Hyun Nahm
Sole Panelist

Dated: December 1, 2020