

IN THE MATTER OF A COMPLAINT PURSUANT TO THE  
CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTION POLICY

Domain Name: samash.ca  
Complainant: Sam Ash Music Corporation  
Registrant: LAMUSIC  
Registrar: Lowcost Domains Inc.  
Panelist: Cecil O.D. Branson, Q.C.  
Service Provider: British Columbia International Commercial Arbitration Centre

IN THE MATTER OF A COMPLAINT PURSUANT TO THE  
CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTION RULES (THE RULES)

**ADMINISTRATIVE DECISION**

Sam Ash Music Corporation v. LAMUSIC and L.A. Musical Instruments  
BCICAC FILE NO. DCA-943 CIRA

**1. The Parties**

The Complainant is Sam Ash Music Corporation, 278 Duffy Avenue, Hicksville, New York, 11801, United States of America.

The Registrant is LAMUSIC; it's address is unknown. It's address for Administrative Contact is L.A. Musical Instruments, 260 Lakeshore Road East, Mississauga, Ontario, L5G 1G9, Canada.

**2. The Domain Name and Registrar**

The Domain Name at issue is samash.ca (the "Domain Name").

The Registrar of the Domain Name is Lowcost Domains Inc.

**3. Procedural History**

On September 7, 2006, the Complainant filed a Complaint with respect to the Domain Name with the British Columbia International Commercial Arbitration Centre (the "Centre"). The Complaint was reviewed by the Centre and found to be in administrative compliance with the requirements under Rule 4.2 of the CIRA Domain Name Dispute Resolution Rules and Policy.

By way of letter dated September 7, 2006, the BCICAC as Service Provider confirmed compliance of the Complaint and commencement of the Dispute Resolution process. The Complaint was delivered to the Registrant by courier on September 8, 2006.

The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a Panel of three to a single arbitrator. As a consequence, the undersigned agreed to accept an appointment as the Panel in this case.

The Panel has reviewed the submissions provided by the Complainant and agrees with the Centre's assessment that the Complaint complies with the formal requirements of the CIRA Policy and Rules.

This Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by BCICAC the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met. The Complainant was represented by legal counsel throughout the proceeding. The Registrant was not represented by legal counsel before the Panel.

#### 4. Factual Background

While there is no address provided for the Registrant, that for its Administrative Contact is L.A. Musical Instruments, 260 Lakeshore Road East, Mississauga, Ontario, L5G 1G9, Canada. The name of the contact person is Rob Piperni, Telephone: (905) 271-0303, Fax: (905) 271-9371, Email: info@lamusic.ca.

The Complainant's Canadian trademark SAMASH Design relates to Wares: paper goods, namely music manuscript books and sheet music paper; clothing namely t-shirts; speaker cabinets and amplifiers, electronic sound modification units; and Services: educational services namely conducting classes in music; retail store services in the field of musical instruments and related accessories; and rental of musical instruments.

The SAM ASH trademark is also registered in the United States. It has registered many trademarks and service marks comprised of or containing the words SAM ASH in the United States Patent and Trademark Office. Also, the Complainant, either itself, or through related entities, has the following domain names:

- samash.com, registered on August 31, 1995;
- samash.org, registered on August 23, 2000;
- samash.info, registered on August 27, 2001;
- samash.biz, registered on February 24, 2004;
- samashmusic.com, registered on March 25, 1999;
- samashmusic.org, registered on November 26, 2001;
- samashmusic.net, registered on November 26, 2001;
- samashmusic.info, registered on March 22, 2006;
- samashmusic.biz, registered on February 24, 2004; and
- samashmusic.us, registered on April 24, 2002.

The domain name samash.com has been in continuous use by the Complainant since its registration in 1995 and is accessed daily by thousands of viewers throughout the United States, Canada and around the world.

The Complainant's business has been in operation since 1924, starting in Brooklyn, New York. There are now forty-eight Sam Ash Musical Instrument Megastores located across the United States, each of which offers a complete selection of the latest musical equipment and accessories. It also runs a professional services division and a parts division.

The Complainant operates two websites, [www.samashmusic.com](http://www.samashmusic.com) and [www.samash.ca](http://www.samash.ca). The former website provides information regarding the Complainant's retail locations while the latter is the Complainant's retail website which offers a full array of musical instruments and accessories for sale online. Products from the Complainant may be ordered either from the Complainant's website or over the telephone, from either Canada or the United States.

The Registrant registered the Domain Name on December 25, 2005. After this date, visitors seeking to visit the website [www.samash.ca](http://www.samash.ca) were redirected to the website located at [www.lamusic.ca](http://www.lamusic.ca). The website located at [www.lamusic.ca](http://www.lamusic.ca) is the official website for the Registrant's music business. Also pre-recorded CD-roms to access the website are to be found at [www.samash.ca](http://www.samash.ca); thus, when a user enters the domain name [samash.ca](http://samash.ca) it is automatically forwarded to the website at [www.lamusic.ca](http://www.lamusic.ca).

On February 23 and 24, 2006, the Complainant, through its authorized legal representatives in Canada, informed the Registrant by email and courier of its rights in the SAM ASH Trademarks and requested that the Domain Name be transferred to the Complainant. The couriered notice was accepted on February 24, 2006 by S. Bell, a copy of proof of its receipt has been provided by the Complainant. There was no response to this by the Registrant.

## 5. Discussion and Findings

### Procedural and Other Matters

As the Complainant, Sam Ash Music Corporation, is the owner of the trademarks SAM ASH Design and [samash.com](http://samash.com) registered in the Canadian Intellectual Property Office as aforesaid, and as this Complaint relates to those trademarks, the Complainant meets the Canadian Presence requirements per paragraph 1.4 of the Policy and paragraph 2(q) of the Canadian Presence Requirements for Registrants.

### Effect of Failure of Registrant to File a Response

Section 5.8 of the Rules provides that:

*"If Registrant does not submit a Response within the period for submission of a Response, or any period extended pursuant to Paragraph 5.4 or 5.6, the Panel shall decide the proceedings on the basis of the Complaint."*

However, as stated in *Browne & Co. Ltd. v. Bluebird Industries* (CIRA Decision No. 00002):

*"This requirement does not preclude the Panel from assessing the integrity and credibility of the evidence as disclosed in the Complaint."*

In the case before it, the Panel sees no reason to question the integrity and credibility of Complainant's evidence.

### Applicable Law

Pursuant to Section 12.1 of the Rules, the Panel shall apply the laws of Ontario, or if the Registrant is domiciled in Quebec, the laws of Quebec or, if a preference for laws of another Province or Territory has been indicated by both Parties, the laws of the other Province or Territory and, in any event, the laws of Canada applicable therein. The Registrant is domiciled in the United States of America. The Complainant has not stated preference for any applicable law and therefore the Panel will render its decision in accordance with the Policy, the Rules and any rules and principles of law applicable in the Province of Ontario and the laws of Canada applicable therein.

### Overview of the Policy

Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the proceeding. The onus is on the Complainant to prove, on a balance of probabilities that:

(a) the Registrant's dot-ca Domain Name is Confusingly Similar to a Mark in which the Complainant's had Rights prior to the date of registration of the Domain Name and continues to have such Rights; and

(b) the Registrant has registered the Domain Name in bad faith as described in paragraph 3.7.

The Complainant must also provide some evidence that:

(c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

### Confusing Similarity Between Domain Name and Complainant's Marks

The Complainant asserts that the Domain Name is "Confusingly Similar" to one or more of the Complainant's corresponding marks, namely:

- SA: TMA 507,913
- SAMASH.COM: TMA 526,226

The Complainant has provided sufficient evidence to demonstrate that it has registered the above-mentioned Marks in Canada and that said registrations are still enforced.

In this regard, the Complainant has Rights in the Marks pursuant to paragraph 3.3 of the Policy.

Paragraph 3.4 of the Policy provides a definition of "Confusingly Similar", and it reads as follows:

*"A domain name is "Confusingly Similar" to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the idea suggested by the Mark as to be likely to be mistaken for the Mark."*

In applying this definition, it is important to note that paragraph 1.2 of the Policy provides that for the purpose of the Policy a domain name means:

*"For the purposes of this Policy, "Domain Name" means the domain name excluding the "dot-ca" suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA."*

The test to be applied is one of first impression and imperfect recollection, *Government of Canada v. Bedford*, CIRA Decision May 27, 2003, p. 15:

*"Accordingly, for each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing that the Complainant's corresponding Mark only having an imperfect recollection of it, would likely state the Domain Name (without the dot-ca suffix) for Complainant's corresponding Mark based upon the appearance, sound or the idea suggested by the Mark."*

The samash.ca Domain Name, without the dot-ca suffix, is identical to Complainant's Marks.

Accordingly, the Panel finds that the samash.ca Domain Name is Confusingly Similar, within the meaning of paragraph 3.4(b) of the Policy, to the Complainant's Marks.

The Administrative Panel is satisfied that the Complainant has met the first requirement.

#### **No Legitimate Interest in the Domain Name**

Paragraph 4.1 of the Policy requires that the Complainant provide some evidence that the Registrant has no legitimate interest in the Domain Name.

Paragraph 3.6 of the Policy sets forth an exhaustive list of criteria for determining whether the Registrant has a legitimate interest in a Domain Name. It reads as follows:

*"The Registrant has a legitimate interest in a Domain Name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:*

*(a) the Domain Name was a Mark, the Registrant used the Mark in good faith and the Registrant had rights in the Mark;*

*(b) the Registrant used the Domain Name in Canada in good faith in association with any wares, services or business and the Domain Name was clearly descriptive in Canada in the English or French language of (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services, or operation of the business, or (iii) the place of origin of the wares, services or business;*

*(c) the Registrant used the Domain Name in Canada in good faith in association with any wares, services or business and the Domain Name was understood in Canada to be the generic name thereof in any language;*

*(d) the Registrant used the Domain Name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;*

*(e) the Domain Name comprised the legal name of the Registrant or was a name or surname or other reference by which the Registrant was commonly identified; or*

*(f) the Domain Name was the geographical name of the location of the Registrant's non-commercial activity or place of business.*

In paragraph 3.6(b), (c) and (d), the Policy says "use by the Registrant includes but is not limited to, use to identify a website."

The Complainant says

*"Paragraph 3.6 of the Policy sets out the criteria upon which the Registrant may claim a legitimate interest in the Domain Name. The Complainant submits that the Registrant's use of the Domain Name does not satisfy any of these criteria. In particular, the Registrant has been using the Domain Name to link Internet visitor's who seek to visit the website of the Complainant (but who enter the Domain Name samash.ca) to its own competing business and website located at [www.lawmusic.ca](http://www.lawmusic.ca). By choosing to register a Domain Name which corresponds to a famous Trademark as well as a highly visited corresponding dot com website (samash.com), the Registrant is profiting from visitors seeking information about the Complainant.*

*The Registrant has never been commonly known by the name "SAM ASH", or the samash.ca Domain Name. Further, SAM ASH is not a clearly descriptive term. (Policy, s. 3.6(b)).*

*The Mark "SAM ASH" does not have any generic meaning in Canada as it is exclusively associated with the business of the Complainant and its founder. "SAM ASH" is not a known geographical name of a location, and to the Complainant's knowledge, the Registrant does not carry out any non-commercial activity or have any place of business in a geographical entity called "SAM ASH". (Policy, s. 3.6(c) and (f)).*

*There is no evidence that the Registrant has used the Domain Name in good faith in association with a non-commercial activity. (Policy, s. 3.6(d)).*

*The Domain Name is not the legal name of the Registrant nor is it the name by which the Registrant is commonly identified (Policy, s. 3.6(e)).*

*The Complainant has not licensed or otherwise permitted the Registrant to use the Complainant's SAM ASH Trademarks, nor has the Complainant licensed or otherwise permitted the Registrant to apply for or use any Domain Name incorporating those marks..."*

Based on the foregoing, the Complainant submits therefore that the Registrant does not have any legitimate interest in the dispute Domain Name.

The evidence demonstrates that the Registrant has never used the Domain Name in connection with or in relation to any wares, services or business. Therefore, the Registrant cannot rely on any of the "legitimate interests" listed in sub-paragraph 3.6(a), (b), and (c) of the Policy.

Further, "samash" is not the legal name, surname or other reference by which the Registrant was commonly identified and therefore the Registrant cannot invoke sub-paragraph 3.6(e) of the Policy.

Finally, the evidence further demonstrates that the Registrant has never used the Domain Name in association with a non-commercial activity, and therefore cannot avail itself of the provisions of subparagraph 3.6(d) and (f) of the Policy.

It is clear that the Registrant has no legitimate interest in the Domain Name samash.ca.

The Administrative Panel is satisfied that the Complainant has met the second requirement.

### **Bad Faith Registration**

Paragraph 3.7 of the Policy sets forth an exhaustive list of criteria for determining whether a Registration registered Domain Name in "Bad Faith":

*"For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered Domain Name in Bad Faith if, and only if:*

*(a) The Registrant registered the Domain Name or acquired the Registration primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the Domain Name or acquiring Registration.*

*(b) The Registrant registered the Domain Name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a Domain Name provided that the Registrant alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights and Marks from registering the Marks as domain names; or*

*(c) the Registrant registered the Domain Name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.*

The Registrant's purpose in registering the Domain Name may be determined by common sense inferences from the Registrant's conduct and other surrounding circumstances. *Canadian Broadcasting Corporation v. Quon*, DCA 681-CIRA; *Government of Canada v. Bedford*, May 27, 2003.

The Complainant asserts that "as it is difficult, if not impossible to show bad faith with concrete evidence, the Panel is to take into consideration surrounding circumstances and draw inferences to determine whether or not the Registrant's actions fall within paragraph 3.7 of the Policy. (*Canadian Broadcasting Corporation v. William Quon*, CDRP Decision No. 00006 @ p. 13; and *Coca-Cola Ltd. v. Heman*, CDRP Decision No. 0014 @ p. 9)".

The Complainant submits that the Registrant has registered the Domain Name in bad faith. The evidence establishes that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant (Policy s. 3.7(c)).

The Complainant asserts either of the two interpretations of "competitor" applies in this case, one being that the Registrant disrupts the business of a competitor if it offers goods and services that it can compete with or rival the goods or services offered by the Trademark owner. The other is that the competitor is someone who acts in opposition to another, including competing for Internet users and that there is no requirement that the Registrant be a commercial business competitor or someone that sells competing products. (*Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, CDRP Decision No. 00020).

The Complainant says in this case the Registrant falls within the ambit of both interpretations, particularly that of being a business competitor of the Complainant. The Registrant disrupts the business of a competitor if it offers goods or services that compete with, or rival, the goods or services offered by the Trademark owner. See: *CanadaDrugs.com Partnership v. NC Britain Holdings Ltd. a/a Minit Drugs*, CDRP Decision No. 00028; *Browne & Co. Ltd./Lee v. Bluebird Industries*, CDRP Decision No. 00002; *Sleep Country Canada Inc. v. Pilfold Ventures, Inc.*, CDRP Decision No. 00027; and *Credit Counseling Society of British Columbia v. Solutions Credit Counseling Service*, CDRP Decision No. 00031.

It has been held that where a competitor uses a Domain Name in association with similar or identical services and where the use of the Domain Name creates a likelihood of confusion among end users as to the affiliation, sponsorship or endorsement of the website: (*Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, CDRP Decision No. 00020; *Sotheby's (Canada) Inc. v. PII Technologies Inc. and Keith Lihou*, CDRP Decision No. 00026; *General Motors Acceptance Corporation v. Bob Woods*, CDRP Decision No. 00051; and *RGIS Inventory Specialists v. Accu Trak Inventory*, CDRP Decision No. 00053).

Where a Domain Name bears no connection to a Registrant, it is reasonable to infer that the Domain Name was acquired primarily for the purpose of disrupting the business of the Complainant: *Browne & Co. Ltd.* (supra).

The Complainant further asserts that the Registrant is using the Domain Name to direct internet users seeking information about or products from the Complainant to its own website located at [www.lamusic.ca](http://www.lamusic.ca), which is remarkably similar in its design to the Complainant's website located at [www.samash.com](http://www.samash.com). Further, from a review of the Registrant's website, it is clear that the Registrant is in the business of selling musical instruments and accessories as it does from a three-story superstore catering to a wide variety of musical needs. Also, it is argued that through the use of Complainant's Trademark and well-known business operation, the Registrant profits from its scheme of misdirecting Internet traffic. This is further exacerbated by the likely confusion causing potential customers to be deceived into trading with the Registrant.

In conclusion, the Complainant submits that it has presented sufficient evidence to establish a prima facie case that the Registrant has acted in bad faith as defined in paragraph 3.7(c) of the Policy. Accordingly, says the Complainant, the onus shifts to the Registrant to either justify or explain why its conduct should not be considered in bad faith. The Registrant has not done so and therefore this Administrative Panel is satisfied that the Complaint has met the third requirement.



6. **Decision**

Based on the information provide to it and on its findings of fact, this Administrative Panel concludes that the Complainant has established its case. The Complainant seeks transfer of the subject Domain Name to it. This Administrative Panel so orders.



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Cecil O.D. Branson, Q.C.  
Presiding Panelist

Dated: October 15, 2006