

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

(Beijing Office)

ADMINISTRATIVE PANEL DECISION

Case No. CN-0900298

Complainant: The Masque Sound and Recording Corporation

Respondent: Ruben Rodriguez

Domain Name: masquesoundasia.com

Registrar: REGISTER.COM, INC.

1. Procedural History

The Complainant of this case is The Masque Sound and Recording Corporation with address at 21 East Union Avenue, East Rutherford, New Jersey 07073, United States of America. Its authorized representatives are Beijing Tang Hongbing (唐红兵) and Pei Yi (裴奕) at Royalty and Young IP Law Firm.

The Respondent of this case is Ruben Rodriguez.

The Disputed Domain Name is masquesoundasia.com. The Registrar of the Disputed Domain Name is REGISTER.COM, INC..

A Complaint, made pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy") implemented by the Internet Corporation for Assigned Names and Numbers ("ICANN") on 24 October 1999, and under ICANN Rules for Policy and Asia Domain Name Dispute Resolution Center ("ADNDRC") Supplemental Rules for Policy, was received by ADNDRC Beijing Office on August 27, 2009. On August 28, 2009, ADNDRC Beijing Office confirmed receipt of the complaint and requested the Registrar by email for the provision of information at their WHOIS database in respect of the Disputed Domain Name.

On September 3, 2009, the Registrar confirmed the registration information.

On October 10, 2009, ADNDRC Beijing Office transmitted the Complaint to the Respondent by email.

On October 15, 2009, ADNDRC Beijing Office notified the Complainant by email that the Complaint was reviewed and forwarded to the Respondent and confirmed with the parties and Registrar by email that the captioned case was formally commenced. ADNDRC Beijing Office also requested the Respondent to file a Response within the 20 days scheduled time.

On November 6, 2009, ADNDRC Beijing Office notified the Complainant that it had not received the Response from the Respondent and the case would be heard by default and the Panelist(s) for this matter would be shortly appointed.

On November 9, 2009, ADNDRC Beijing Office gave notice to the potential candidate of the Panelist Dr. Lulin Gao, requesting him to confirm whether he would accept the appointment as a Panelist for this case, and if so, whether he could maintain impartiality and independence between the parties in this case. On the same day, ADNDRC Beijing Office received a declaration of impartiality and independence and a statement of acceptance from the Panelist Dr. Lulin Gao.

On November 10, 2009, ADNDRC Beijing Office informed the parties by email that Dr. Lulin Gao would be the sole Panelist of this case and transferred the files of this case to the Panel.

On November 10, 2009, the Panel received the file from the ADNDRC Beijing Office and should render the Decision on or before November 24, 2009.

2.Factual Background

For the Complainant

The Complainant, Masque Sound and Recording Corporation, was incorporated in the US in 1936, and started its business from producing sound effects records and renting equipment for Broadway shows. The business soon expanded beyond rental and effects records and toward providing complete audio systems for live entertainment. With a history

and experiences of over 70 years, the Complainant has become one of the most renowned companies providing integrated sound solutions for Broadway shows, touring musicals, live concerts, live television broadcasts, sporting event shows, corporate events and conventions.

The Complainant started its business from producing sound effects records and renting sound equipment for Broadway shows, and remains a leading provider in this field during the years. In the early fifties, the Complainant became the first company to adopt tape technology for theaters. By adopting leading technologies, the Complainant's "MASQUE SOUND" branded services soon expanded to provide complete sound reinforcement solutions, including audio equipments and sound engineering design, for television productions, touring musicals, live concerts, worship events and corporate events. In 2002, the Complainant acquired the industry's leading manufacturer Professional Wireless Systems, which greatly enhanced the Complainant's capacities to provide direct, secure solutions for performance and technical RF (Radio Frequency) communications. The complainant's productions of Broadway shows and touring events include early productions such as Oklahoma, South Pacific, Grease and Cats, as well as the more recent Mamma Mia!, The Lion King, Mary Poppins and Jersey Boys. For TV live broadcasts, programs such as Regis & Kelly Live, Emeril Live, Monday Night Football, CNN Town Hall Meetings and major sporting events such as Olympics, World Cup Soccer and NFL Super Bowl Half Time Show all have chosen "MASQUE SOUND" branded services for professional sound reinforcement and processing support. For live concerts, touring musicals and corporate events, the Complainant is also well equipped to provide personalized services from engineering design to on-site installation and coordination to meet particular needs of an event. The Complainant's sound equipments provided for rental include microphones, amplifiers, cables, mixing boards and consoles, speakers and speaker processors, effects machines, power distribution devices and so on. The Complainant also manufactures a series of specialized sound devices under "MASQUE SOUND" trademark.

For the Respondent

The Respondent registered the Disputed Domain Name on January 1, 2009.

3. Parties' Contentions

The Complainant

The Complainant's contentions are as follows:

I. The major part of the disputed domain name, "masquesoundasia", is confusingly similar to "MASQUE SOUND" in which the Complainant enjoys prior trademark and trade name rights.

a. The Complainant enjoys prior trade name right and trademark right in "MASQUE SOUND".

US Registration No.2,009,705 for "MASQUE SOUND" on services "rental of sound equipment and related accessories, namely, microphones, wireless microphones, microphone accessories, cables, cable connectors, signal processing equipment, mixing boards and consoles, amplifiers, communications equipment, speakers, speaker processors, video cameras, video monitors, intercom packages, paging packages, power distribution devices, tape machines, effects machines, taped sound effects, cases, computers, custom rigging hardware, signal analyzers, custom interfaces, audio racks, speaker towers, and batteries" in Intl. Class 41, registered on October 22, 1996.

US registration No.2,026,468 for "MASQUE SOUND" on goods "sound equipment, namely microphone test boxes, cable analyzers, and musical instrument digital interface remote controls" in Intl. Class 9, registered on December 31, 1996.

The above "MASQUE SOUND" marks are both in valid term now.

"MASQUE SOUND", as a coined mark of the Complainant, is of originality and distinctiveness. Since its founding in 1936, "MASQUE SOUND" has been used as the Complainant's trade name for more than seventy years.

Also since 1936, the Complainant has adopted and used "MASQUE

SOUND” as its trademark and service mark on its sound equipments and rental services of sound equipments. At present, the Complainant holds two trademark registrations for “MASQUE SOUND” under Nos.2,009,705 and 2,026,468 in the US.

It can be observed from Annex 2 of the Complaint that the Complainant’s “MASQUE SOUND” marks in Class 9 and 41 have both been firstly used since 1936 and then registered since 1996, which are much earlier than the registration date of the disputed domain name.

Therefore, the Complainant holds prior trade name right and trademark right in “MASQUE SOUND”.

b. “MASQUE SOUND”, as the Complainant’s trade name and trademark, has been used for a long time in commerce and enjoyed a high reputation in the world before the registration of the disputed domain name.

For its professional services of many years, the Complainant has earned outstanding reputation for “MASQUE SOUND” mark in the industry. The clients of the Complainant include such famous companies and events as CNN, ESPN, FOX, Coca-Cola, Wal-Mart, Disney World Concerts and The New York Shakespeare Festival, as well as famous artists and musicians such as Jon Bon Jovi, Jill Scott, John Adams and Celtic Woman. Through long-term and extensive exposure on media, the Complainant’s trade name and trademark “MASQUE SOUND” has earned full public awareness and been well recognized as a well-known brand in the world.

Additionally, the “MASQUE SOUND” mark has also been continuously used on the Complainant’s commercial invoices for the sales and rental of sound equipments.

The above-mentioned evidences effectively prove that the Complainant’s “MASQUE SOUND” mark has enjoyed high reputation in the world long before the registration of the disputed domain name.

c. The major part of the disputed domain name “masquesoundasia” is confusingly similar to “MASQUE SOUND” in which the Complainant has prior legitimate interests.

The major part of the disputed domain name, the term “masquesoundasia” is apparently composed of two parts, “masquesound” and “asia”. It is a common sense that “asia” refers to the word “Asia” which cannot indicate the source of any goods or services for being just a generic term in geographic category. Thus, the distinctive part of the disputed domain name should be the term “masquesound”, and that the term is literally identical with the Complainant’s registered “MASQUE SOUND” mark. Since the difference between capital and small letters could be ignored in the use of domain names, the major part of the disputed domain name “masquesoundasia” should be determined confusingly similar to the Complainant’s trade mark and trade name “MASQUE SOUND”.

Therefore, the major part of the disputed domain name is confusingly similar to “MASQUE SOUND” in which the Complainant enjoys prior trademark and trade name rights, which has met the first requirement as set forth under Paragraph 4(a)(i) of the Policy.

II. The Respondent has no legitimate interests in the major part of the disputed domain name.

The Respondent’s name or address has no connection with “masquesound” or “masquesoundasia”. There is no such evidence indicating that the Respondent has ever registered or used “masquesound” or “masquesoundasia” as its business name or trademark in any jurisdiction. The Complainant has never authorized or licensed the Respondent to use in any form the “MASQUE SOUND” trademark or to register the disputed domain name. Therefore, the Respondent has no legitimate interests in the major part of the disputed domain name, which has met the second requirement as set forth under Paragraph 4(a)(ii) of the Policy.

III. The Respondent has registered and been using the disputed domain name in bad faith.

Since it was registered, the disputed domain name has been directed to an English-Chinese website, and deliberately used by the Respondent, for commercial benefit, to mislead Internet users and create likelihood of confusion, which can be proved by the following facts:

a. On the website to which the disputed domain name is being directed, the Respondent is promoting similar sound equipments and rental services of the same in the name of “Masque Sound Asia”, which would be likely to mislead the public into believing that the Respondent is a branch or subsidiary of the Complainant located in Asia;

b. On the home page of the Chinese version of the website, the Respondent claims that “Masque Sound Asia comes from the US”, which is implying a connection between the Respondent and the Complainant which is actually nonexistent;

c. The Respondent’s statements on the home page and under the topic “RENTALS” of the website such as “Masque Sound Asia delivers expertise in the art and technology of concert sound. From Pop and R&B to Metal and India, Masque Sound Asia provides outstanding sonic quality for the artist and audience alike... Our clients include Fortune 500 companies and some of the largest and most successful production companies world-wide” are directly copied from corresponding text under the topic “CONCERTS”, “CORPORATE & SPECIAL EVENTS” and “THEATER” of the Complainant’s official website www.masquesound.com, except that the name “Masque Sound” is replaced with “Masque Sound Asia”, which has caused confusion as to the relationship between the Respondent and the Complainant (please also refer to Annex 3);

d. Some of the brand names of sound equipments for rental and sales listed on the website such as “SENNHEISER” and “YAMAHA” are also provided on the Complainant’s website under the topic “SALES DIVISION”, and the manufacturers of these brands also have close business relationship with the Complainant.

It’s obvious that the Respondent registered and uses the disputed domain name for the purpose of making unfair benefits by intentionally creating likelihood of confusion with the Complainant’s “MASQUE SOUND” mark concerning the source, sponsorship, affiliation or endorsement of the Respondent’s website and the products and services on the website.

Therefore, the disputed domain name was registered and is being used by the Respondent in bad faith, which has met the third requirement as

set forth in Paragraph 4(b)(iv) of the Policy.

This Complaint has therefore met all three requirements as set forth in the Policy.

Pursuant to the Policy, also based on afore-mentioned facts and reasons, the Complainant requests the Panel to order the disputed domain name “masquesoundasia.com” to be transferred to the Complainant.

The Respondent

The Respondent did not submit Response within the scheduled time limit.

4. Panel’s Findings

As stipulated in the Paragraph 4(a) of the Policy, when claiming a domain name registered by Respondent, the Complainant must prove each of the followings:

- (i) that the domain name of the Respondent's is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

Based on the relevant stipulations under the Policy, the Rules and ADNDRC Supplemental Rules, the Panel needs to determine whether the Complainant satisfies each of the afore-said prerequisites. If the answer is yes, the Panel will make a final decision in accordance with the facts and relevant stipulations under the Policy, the Rules and the ADNDRC Supplemental Rules; if not, the Complainant’s claims shall be rejected.

Identical or Confusing Similarity

Pursuant to Paragraph 4(a) (i) of the Policy, the Complainant must prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has right.

The Complainant claims that it enjoys both trademark right and trade name right over “MASQUE SOUND”. Since a dispute between a trade name and a domain name is not within the scope of proceeding of the Policy, the Panel does not consider the Complainants’ claim on the trade name.

With respect to the claim on the trademark right, the Complainant provided the Copies of the Registration Certificates of the marks “MASQUE SOUND (Reg. No.: 2,009,705 and 2,026,468)” in US as evidence, which were registered in 1996 and are still valid. Since the Complainant’s trademarks were registered well before the Respondent registered the Disputed Domain Name (January 1, 2009), the Panel is of the view that the Complainant enjoys prior trademark rights to “MASQUE SOUND”.

Then, what the panel needs to do is to make a conclusion on the identity or confusing similarity between the Complainant’s registered trademark “MASQUE SOUND” and the Disputed Domain Name “masquesoundasia.com”. The panel notes that the Disputed Domain Name can be deemed to be composed of two parts: “masquesound” and “asia”. Obviously, “asia” equals to “Asia”, which is a geographic term having no function of indicating the inherent feature of Disputed Domain Name. Thus, the identifying part of the Disputed Domain Name shall be “masquesound”. The Panel also notices that except the space between “masque” and “sound”, the distinctive part of the Disputed Domain Name is exactly identical to “MASQUE SOUND” mark in which the Complainant has right. What’s more, the combination of “masquesound” and “asia” does no help to distinguishing the Disputed Domain Name from the Complainant’s mark, but on the contrary, it may more easily mislead the public into believing that the Respondent is an affiliate of the Complainant in Asia or that the Respondent has some kind of relationship with the Complainant and thus cause confusion.

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark, and the Complainant has satisfied the first condition under Paragraph 4(a) of the Policy.

Rights or Legitimate Interests of the Respondent

The Panel makes the decision based on the evidence provided by both parties and in case that either party fails to meet its burden of proof, such party shall undertake the risk of the possible unfavorable result against it. The Complainant claims that the Respondent has no rights or legitimate interests in “MASQUE SOUND”, nor has it ever authorized the Respondent to use “MASQUE SOUND” mark or to register the Disputed Domain Name.

The Panel finds that the Complainant has already fulfilled the burden of proof required by the second condition under Paragraph 4(a) of the Policy, thus the burden of proof regarding the “rights or legitimate interests” is generally on the party making the defense in the dispute resolution of a domain name, the Respondent.

However, the Respondent failed to submit any Response within the time limit and thus failed to prove its rights or legitimate interests regarding the Disputed Domain Name accordingly. Given this, the Panel presumes that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel comes to the conclusion that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Accordingly, the Complainant meets the second condition under Paragraph 4(a) of the Policy.

Bad Faith

The Complainant also needs to establish the Respondent’s bad faith as set forth in the Paragraph 4(a)(iii) of the Policy. Under Paragraph 4(b) of the Policy, the following circumstances in particular shall be considered as evidence of the registration and use of a domain name in bad faith:

(i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your

documented out-of-pocket costs directly related to the domain name; or

- (ii) You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Complainant provides evidence proving that it is engaged in rental and manufacture of sound devices and providing integrated sound solutions for various concerts, musicals and corporate events and through its commercial activities and promotions, it has gained certain fame. The Complainant also provides evidence showing that the homepage under the Disputed Domain Name is a website selling, renting, installing and providing technical support for audio and sound equipments, with "MASQUE SOUND ASIA" being prominently placed on the top of the webPages.

In addition, the evidence provided by the Complainant reveals that on the website under the Disputed Domain Name, the Respondent claims that it comes from the US and the Company Profile "WHO WE ARE" on the homepage of the Disputed Domain Name reads as "Masque Sound Asia delivers outstanding sonic quality, the latest technology and superior service. It's a difference that performers and audiences notice. With a staff of expert technicians and a longstanding tradition of technical leadership, Masque Sound Asia is the one solution for Event and Entertainment Sound Reinforcement.....", which is almost exactly the same as what is on the Complainant's website, with the only difference of "MASQUE SOUND" being replaced with "MASQUE SOUND ASIA". Besides, the evidence provided by the Complainant shows that there are many other similarities between the Respondent's website and the Complainant's website, which may cause confusion or misleading among the public.


Since the Complainant's "MASQUE SOUND" mark is being used for many years and enjoys certain reputation, and the Respondent is engaged in the same industry as the Complainant, the Respondent knows or should have known the Complainant's "MASQUE SOUND" mark. Furthermore, the Respondent has no justifiable reason to register the Disputed Domain Name confusingly similar to the "MASQUE SOUND" mark, and it can't be just a accidental coincidence for the information on the Respondent's website to be exactly the same as that of the Complainant. The possibility that the Respondent knew of and copied from the website of the Complainant is relatively high. Thus the panel finds that the Disputed Domain Name has been registered in bad faith.

The evidence submitted by the Complainant proves that the website under the Disputed Domain Name may cause confusion among relevant public. Obviously, this is intentionally made by the Respondent to induce the relevant public to believe that the website under the Disputed Domain Name is the website of the Complainant or has any relationship with the Complainant and to attract relevant public to visit the Respondent's website via the Disputed Domain Name and profit commercially from such visit. Also, the registration and use of the Disputed Domain Name will inevitably prevent the Complainant from reflecting its trademark in such corresponding domain name. These findings lead the Panel come to the conclusion that the Respondent used the Disputed Domain Name in bad faith.

In light of all of the above circumstances, the Panel concludes that the Complainant has satisfied the third condition under Paragraph 4(a) of the Policy.

5. Decision

For all the forgoing reasons, the Panel has decided that the Complainant has proved sufficiently the three elements of Paragraph 4(a) of the Policy. Accordingly, the Panel directs that the Disputed Domain Name be transferred to the Complainant.

Panelist: 

Dated: November 24, 2009