



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**

**DOMAIN NAME DISPUTE**

**ADMINISTRATIVE PANEL**

**DECISION**

CIIDRC case number:	<b>20543-UDRP</b>	<b>Decision date: May 10, 2023</b>
Domain Name:	<b>Shopify-shopping.com</b>	
Panel:	<b>Gerald M. Levine, Ph.D., Esq.</b>	
Complainant:	<b>Shopify Inc.</b>	
Complainant's Representative	<b>Daniel Anthony of Smart &amp; Biggar</b>	
Respondent:	<b>PrivacyGuardian.org Llc</b>	

**1. PROCEDURAL HISTORY**

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre to the Panel:

1. On April 5, 2023, the above-named Complainant filed a Complaint pursuant to the UDRP and the UDRP Rules.
2. On April 5, 2023, the Registrar, Name Silo, LLC, was notified of this proceeding, and on the same date, the Registrar transmitted by email to CIIDRC its verification response informing who is the Registrant, Respondent, in this administrative proceeding. The Registrar also confirmed that the < **shopify-shopping.com** > domain name was placed on a Registrar LOCK.
3. Pursuant to UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice of Commencement to the Respondent by email on April 7, 2023.
4. The deadline for the Respondent's response was set as April 27, 2023.
5. No response was received by the deadline.
6. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member.
7. On May 1, 2023 CIIDRC appointed Gerald M. Levine Ph.D., Esq., as a single-member Panel to hear and decide this dispute.

The record reflects that <shopify-shopping.com> (hereinafter the “Disputed Domain Name”) was registered on March 23, 2023.

This matter is conducted pursuant to the Uniform Domain Name Dispute Resolution Policy (the Policy) and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) of the Internet Corporation for Assigned Names and Numbers (ICANN).

## **2. FACTS ALLEGED BY THE PARTIES**

The Complainant, Shopify Inc. (the “Complainant”) is a very well-known cloud-based e-commerce platform designed for small and medium-sized businesses. It has offered its services for more than fifteen (15) years around the world in association with the coined trademark SHOPIFY, registered in a number of national jurisdictions.

The Complainant states that did not authorize Respondent to register the Disputed Domain Name, that the Respondent has no rights or legitimate interests in its continued registration, and that it registered and is using the Disputed Domain Name in bad faith. At the time of filing of the complaint, the URL resolved to a shopping page, but it presently resolves to a warning page: “Dangerous Webpage Blocked.” Intrepid searchers who ignore the warning are either likely to be ensnared into some kind of deceptive scam or worse. The registration of the Disputed Domain Name openly impersonates the Complainant.

The Respondent has not appeared to answer the complaint.

## **3. CONTENTIONS OF THE PARTIES**

- **Complainant**

The Complainant operates the leading cloud-based commerce platform designed for small and medium-sized businesses. Its software is used by merchants to run business across all sales channels, including web, tablet and mobile storefronts, social media storefronts, and brick-and-mortar and pop-up shops. Shopify’s platform provides merchants with a single view of business and customers and enables them to manage products and inventory, process orders and payments, build customer relationships and leverage analytics and reporting. The company was founded on September 28, 2004, and is headquartered in Ottawa, Canada.

The Complainant is among the top twenty (20) largest publicly traded Canadian companies by market capitalization and employs over 5,000 people across the globe. It offers its services through various websites, including those accessible through the domains “shopify.com” and “shopify.ca.”

- **Respondent**

The Respondent whose identity is hidden behind its proxy PrivacyGuard.org llc (the “Proxy”) has not appeared, and neither has the Proxy. As the beneficial holder of the Disputed Domain Name has chosen to have its Proxy stand in its place it shall be responsible for the consequences of its and its Proxy’s default.

- **Remedy Sought**

The Complainant requests the Disputed Domain Name be transferred to it.

#### 4. JURISDICTIONAL ISSUE

UDRP Rule 1 defines the Respondent as “the holder of a domain-name against which a complaint is initiated.” In this case, the beneficial holder of the Disputed Domain Name has chosen to hide its identity behind a Proxy shield. Where a registrar discloses the registrant as a proxy service the Panel has discretion to determine the identity of the beneficial owner or true registrant, which may be the proxy as stand-in for the undisclosed principal. Such is the case here.

Non-appearance by either the beneficial owner or the Proxy is discussed in *Padberg v. Eurobox Ltd.*, D2007-1886 (WIPO March 10, 2008) in which the Panel asked: “So who is the Respondent for the purposes of 3(b)(v) of the Rules?” It answered: “In the Panel’s opinion the only sensible answer to this question is that it is prima facie the entity that is recorded in the registrar’s register as revealed by a Who-Is search.”

The Rules do not include a definition of Respondent “at the time the complaint is submitted to the provider,” But the Forum’s Supplemental Rule 1(d) defines “[t]he Holder of a Domain Name Registration” as used in the Rules as “the single person or entity listed in the WHOIS registration information at the time of the filing of the Complaint with the Forum; and once the Registrar has verified the information, is limited to the single person or entity as verified by the Registrar.” That “single person” in this case is PrivacyGuardian.org Llc

The Forum’s Supplement Rule is consistent with the consensus of views. See *Puma SE v. Client Care, Web Commerce Communications Limited*, Claim No. D2022-0015; *Brooks Sports, Inc. v. Domain Admin / Whoisprotection.cc*, FA2102001932380 (Forum March 15, 2021), among others. See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) at section 4.4.5, as follows:

Panel discretion

In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed.

As the Proxy is the only person disclosed by the registrar then “prima facie” it is the Respondent. Accordingly, the caption is corrected to reflect PrivacyGuardian.org Llc. as the Respondent as a stand-in for the beneficial registrant.

## 5. DISCUSSION AND FINDINGS

### 5.1 Decision

- a) The Complainant has shown that it has a right in the trademark SHOPIFY and that the Disputed Domain Name is identical or confusingly similar to that mark;
- b) The Respondent lacks rights or legitimate interests in the Disputed Domain Name; and
- c) The Respondent registered and is using the Disputed Domain Name in bad faith.

### 5.2 Requirements

In accordance with Paragraph 4 of the Policy, the onus is on the Complainant to prove:

1. That the Domain Name is Identical or Confusingly Similar to a trademark or service mark in which the Complainant has rights;
2. That the Registrant has no rights or legitimate interests in the Domain Name; and
3. That the Domain Name has been registered and being used in bad faith.

The Panel will consider each of these requirements in turn.

### 5.3 Analysis

#### **6.2.1 That the Domain Name is Identical or Confusingly Similar to a Mark in which the Complainant has Rights**

Paragraph 4(a)(i) of the Policy requires a two-step inquiry, a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. Here, the Complainant has adduced evidence of its right through trademark registrations in Canada and the United States of the term SHOPIFY.

For the second step, the Panel has compared SHOPIFY to the Disputed Domain Name. It is not identical to the Complainant’s mark in that the Respondent has added the word “shopping” to the mark. The addition is referential to the Complainant’s business, thus does not act to distinguish the domain name from the mark. See *Lacoste Alligator S.A. v. Priscilla, Ranessa, Angel, Jane, Victor, Olivier, Carl, Darren, Angela, Jonathan, Michell, Oiu, Matthew, Pamela, Selima, Angela, John, Sally, Susanna*, WIPO Case No: D2010-0988 the Respondent added “cheap” to “Lacoste’ (<cheaperlacoste.com>) (holding it “is long established by past panel decisions that a domain name incorporating a trademark in its entirety with the addition of generic and non-distinctive prefixes and/or suffixes is confusingly similar to the trademark.”

Accordingly, the Complainant has satisfied its burden under Paragraph 4(a)(i) of the Policy

### **6.2.2 That the Respondent has No Rights or Legitimate Interest in the Domain Name**

The determination on this element of the Policy begins with the Complainant offering prima facie evidence that the Respondent lacks right or legitimate interests in the Disputed Domain Name. If that proof is accepted, the burden shifts to the Respondent to produce evidence that it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant has adduced evidence sufficient in itself to establish that the Respondent registered and is using the Disputed Domain Name without the Complainant's permission. It further contends that there is no discernible evidence that would support a right or legitimate interest and that if there is any it would be the Respondent's burden to produce. The Policy sets out a nonexclusive list of three circumstances at Paragraph 4(c). If any one of these circumstances is shown to be present it would rebut the Complainant's contentions. These circumstances are as follows:

- (i) Before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- (ii) The respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) The respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As the Respondent has not appeared and as the Complainant has established that none of these circumstances are objectively present, the Panel finds that the Complainant has established that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Complainant has satisfied its burden under Paragraph 4(a)(ii) of the Policy.

### **6.2.3 That the Respondent has Registered and Used the Domain Name in Bad Faith**

The Complainant has demonstrated to the Panel's satisfaction that SPOTIFY is a well-known mark that predates by many years the Respondent's registration of the Disputed Domain Name. It can be said without contradiction that Respondent did not invent the coined word "Spotify," but appropriated it to take advantage

of the mark's reputation to benefit from its goodwill and reputation and for the purpose of attracting Internet users to its website. Nevertheless, the burden of proof rests on the Complainant to establish that the Respondent registered and is using the Disputed Domain Name in bad faith.

The Policy provides a nonexclusive list of four circumstances any one of which if found "shall be evidence of the registration and use of a domain name in bad faith," Paragraph 4(b) (i through iv). Complainant's proof includes an invitation to visit a faux web page implying that it either is Complainant or affiliated with or sponsored by it. This use implicates the fourth circumstance of abusive registration which reads as follows:

[4(b)] (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Respondent falsely projects itself as a merchant affiliated with the Complainant through an invitation to visit a website that at the present time carries a warning: "**This is a known dangerous webpage. It is highly recommended that you do NOT visit this page.**" In its earlier incarnation as the Complainant shows, the Disputed Domain Name resolved to a website offering various merchandise (Annex G). Whichever page shows to an Internet searcher the Respondent is either using the Disputed Domain Name for "commercial gain [. . .] by creating a likelihood of confusion with the complainant's mark" or for a malign and malicious purposes to entrap or cause harm to consumers in some manner.

The evidence supports the further conclusion that the Respondent was well aware of the Complainant and was targeting both the Complainant and consumers looking to reach the Complainant's website. See *Sodexo v. Daniela Ortiz*, WIPO CLAIM No. D2021-0628 (Holding: "Where a complainant's trademark is widely known, including in a particular industry, or highly specific, and respondents cannot credibly claim to have been unaware of complainant. . ."). Further, the registration of a domain name virtually identical to a well-known mark, here by the addition of the word "shopping" to the coined term SHOPIFY, that offers a variety of merchandise over the SPOTIFY banner effectively pronounces that it has actual knowledge of the Complainant. See *INVISTA North America S.a.r.l. v. Whois Privacy Service*, FA1502001607177 (Nat. Arb. Forum April 14, 2015) (While constructive notice is generally regarded as insufficient to support a finding of bad faith, the Panel "here concludes that Respondent had actual notice of Complainant's mark because of its fame which has been established by the evidence and the absence of any known meaning of TERATE other than as an identifier of Complainant's products and that Respondent thus registered the disputed domain name in bad faith under Policy ¶ 4(a)(iii)).

The registration of a domain name that is identical or confusingly similar to a trademark by an entity that has no relation to the owner or its mark is suggestive of bad faith. See *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163; *Costco Wholesale Membership Inc., Costco Wholesale Corporation v. Nathaniel Ho/EDF RTD*, WIPO Case No. D2009-0782 (the disputed domain name consists of complainant's well-known registered trademark and the common word "drugs"); and *Singapore Airlines Limited v. European Travel Network*, WIPO Case No. D2000-0641 the Panel states that "[t]he registration of domain names obviously relating to the Complainant is a major pointer to the Respondent's bad faith and desire to 'cash in' on the Complainant's reputation."

Where a party is found to have used a disputed domain name in bad faith, the question then arises as to whether it also registered it in bad faith. Abusive registration can be found if a review of the complete record shows Respondent engaged in a nefarious purpose. Here, that purpose is demonstrable from the Respondent's contents of the resolving website as well as the warning that it is a "known and dangerous page." As use in bad faith presages registration in bad faith, the Panel finds that the Respondent also registered the Disputed Domain Name in bad faith.

On all the grounds set forth above, the Panel concludes that Respondent's registration and use of the Disputed Domain Name is an opportunistic exploitation of Complainant's SPOTIFY mark. Accordingly, the Complainant has satisfied its burden under Paragraph 4(a)(iii) of the Policy.

#### 4 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the Policy, Paragraph 15 of the Rules, and Rule 10 of the Supplemental Rules, the Panel orders <shopify-shopping.com> be transferred to the Complainant.

Made as of the 10<sup>th</sup> day of May, 2023

SIGNATURE OF PANEL



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