



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	20758-UDRP	Decision date: May 12, 2023
Domain Name:	Shopify-8.com	
Panel:	Peter Müller	
Complainant:	Shopify Inc.	
Complainant's Representative:	Daniel Anthony of Smart & Biggar	
Respondent:	sasd	

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 10, 2023, Daniel Anthony of Smart & Biggar filed a complaint on behalf of Shopify Inc. pursuant to the UDRP and the UDRP Rules.
2. On April 10, 2023, CIIDRC transmitted by email to the Registrar, NameSilo, a request for registrar verification in connection with the disputed domain name. On the same date the Registrar responded advising of the identity of the Respondent. The Registrar also confirmed that the disputed domain name was placed on a Registrar LOCK.
3. Under Paragraph 4 (c) "the Provider shall review the Complaint for administrative compliance with the Policy and the Rules." On April 10, 2023, CIIDRC confirmed compliance of the Complaint with the UDRP Rules and commencement of the dispute resolution process.

4. Pursuant to UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice of Commencement along with the Complaint to the Respondent on April 10, 2023.

5. The Respondent failed to file its response by the due date of May 1, 2023.

6. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member.

7. CIIDRC appointed Peter Müller as a single-member panel in the above-referenced matter. He accepted the appointment.

8. The Panel finds that it is properly constituted and has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by CIIDRC to ensure compliance with the UDRP.

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 is a cloud-based e-commerce platform designed for small and medium-sized businesses founded on September 28, 2004, and headquartered in Ottawa, Canada. It is among the top twenty 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.” The Complainant owns several trademarks for SHOPIFY, including Canadian trademark registration no. TMA787767, filed October 22, 2009, registered on January 18, 2011, in association with web-based services that allow users to create hosted e-commerce stores, and U.S. trademark registration no. 3840412, filed November 11, 2009, registered on August 31, 2010, in association with downloadable software for use in e-commerce and the retail industry (hereinafter referred to as the “SHOPIFY Marks”).

The Domain Name was registered on March 18, 2023, and resolves to an online shopping page.

3. CONTENTIONS OF THE PARTIES

3.1 Complainant

The Complainant contends that the Domain Name is confusingly similar to the SHOPIFY Marks as the Domain Name fully includes such marks and as the last portion “-8” is merely a number and does not add any distinctiveness to the Domain Name.

The Complainant further argues that the Respondent has no rights or legitimate interests in the Domain Name. In this regard, the Complainant states that the Complainant has never licensed or otherwise permitted the Respondent to register the Domain Name incorporating any of its trademarks, that there is no evidence of the

Respondent's use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services, that the Respondent is not connected with the Complainant but is improperly using the SHOPIFY Marks within the Domain Name, and that there is no evidence that the Respondent has been commonly known by the Domain Name.

Finally, the Complainant states that the Domain Name was registered and is being used in bad faith. With regard to bad faith registration, the Complainant argues that the Respondent registered the Domain Name over a decade after the Complainant's rights were established, wholly incorporates the SHOPIFY Marks in the Domain Name, and that there is no reason to believe that the Respondent was not aware of Complainant and its trademarks at the time they registered the disputed domain name. With regard to bad faith use, the Complainant contends that the Respondent is engaged in active infringement of the SHOPIFY Marks, for the purposes of leveraging the goodwill of such marks to intentionally attract Internet users to its website by creating a likelihood of confusion as to affiliation of the Respondent's website for commercial gain. The Complainant further alleges that the Respondent's website sells highly discounted (and likely) fraudulent goods and appears to be leveraging the SHOPIFY Mark to grant some legitimacy to the site.

3.2 Respondent

No administratively compliant Response has been filed.

3.3 Remedy Sought

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 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 is being used in bad faith.

The Panel will consider each of these requirements in turn.

4.2 Analysis

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

The inquiry under the first element is in two parts. The first issue is whether the Complainant has UDRP-relevant rights in a trademark and the second is whether any such trademark is identical or confusingly similar to the disputed domain name. Failure on either of the two issues would result in a failure to meet the requirements of Paragraph 4(a)(i) of the Policy and ultimately in failure of the Complaint.

The Complainant provided evidence that it owns registered rights in the trademark “SHOPIFY”, which predate the registration of the Domain Name by over a decade.

Furthermore, it is well established that a domain name generally is to be considered as confusingly similar under the Policy where the trademark is recognizable within the disputed domain name. In the present case, the Domain Name fully includes the SHOPIFY Marks and the additional element “-8” does not prevent a finding of confusing similarity under the first element. As a result, the Panel finds that the Domain Name is confusingly to the SHOPIFY Marks and that the Complainant satisfied the requirements of Paragraph 4(a)(i) of the Policy.

4.2.2 That the Respondent has No Rights or Legitimate Interest in the Domain Name

Even though the Policy requires the complainant to prove that the respondent has no rights or legitimate interests in the disputed domain name, it is the consensus view among UDRP panels that a complainant has to make only a *prima facie* case to fulfill the requirements of Paragraph 4(a)(ii) of the Policy. As a result, once a *prima facie* case is made, the burden of coming forward with evidence of the respondent's rights or legitimate interests in the disputed domain name will then shift to the respondent (*cf.* section 2.1 of the WIPO Overview 3.0).

The Complainant has substantiated that the Respondent has no rights or legitimate interests in the Domain Name. The Panel finds that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name and that the burden of production has been shifted to the Respondent.

The Respondent did not deny these assertions in any way and therefore failed to come forward with any allegations or evidence demonstrating any rights or legitimate interests in the Domain Name.

Based on the evidence before the Panel, the Panel cannot find any rights or legitimate interests of the Respondent either. The use of the Domain Name in connection an online shopping page which sells highly discounted goods is no *bona fide* use under the Policy.

Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the Domain Name under Paragraphs 4(a)(ii) and 4(c) of the Policy.

4.2.3 That the Respondent has Registered and Used the Domain Name in Bad Faith

The Panel is satisfied that the Respondent registered and used the Domain Name in bad faith.

First, the Panel is satisfied that the Respondent registered the Domain Name with full knowledge of Complainant and its SHOPIFY Marks and therefore in bad faith. The SHOPIFY Marks consist of an invented word, are well-established, and are likely to be considered well-known among online store providers without further ado. Therefore, given that the Respondent is using the disputed domain name in connection with an online shopping page, it is inconceivable that the Respondent registered the disputed domain name in good faith.

Second, by using the Domain Name in connection with a commercial online shopping page, the Respondent was, in all likelihood, trying to divert traffic intended for the Complainant’s website to its own for commercial gain as set out under Paragraph 4(b)(iv) of the Policy.

Consequently, the Panel finds that the Respondent registered and used the Domain Names in bad faith and that the Complainant satisfied the requirements of Paragraph 4(a)(iii) of the Policy.

5. 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 that orders that disputed domain names <shopify-8.com> be transferred to the Complainant.

Made as of May 12, 2023

SIGNATURE OF PANEL



