



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL DECISION

CIIDRC case number:	20836-UDRP	Decision date: May 25, 2023
Domain Name:	Shopify-analytics.com	
Panel:	Zak Muscovitch	
Complainant:	Shopify Inc.	
Complainant's representative:	Daniel Anthony of Smart & Biggar LLP	
Respondent:	Michael Cao	

1. This matter is conducted pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy or "UDRP"), the Rules for the Uniform Domain Name Dispute Resolution Policy (the "Rules") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), and the Supplemental Rules ("Supplemental Rules") of the Canadian International Internet Dispute Resolution Centre ("CIIDRC").

2. On April 26, 2023, the Complainant filed a UDRP Complaint (the "Complaint") with the CIIDRC in respect of the domain name, Shopify-analytics.com (the "Domain Name" or the "Disputed Domain Name").

3. On April 26, 2023, the CIIDRC notified the registrar of the Domain Name, namely Cloudflare, Inc. (the “Registrar”) of the existence of the Complaint pursuant to Section 1 of Appendix “E” of ICANN’s Temporary Specification for gTLD Registration Data (the “Temp Spec”). On April 26, 2023, the Registrar responded to the CIIDRC’s notification in accordance with the Temp Spec (the “Registrar Verification”) and; a) confirmed that the Domain Name was registered with the Registrar “using the English language”; b) confirmed that it had locked the Domain Name in accordance with Rule 4(b) of the UDRP Rules; and c) provided the Domain Name’s full Registration Data to the CIIDRC.

4. On April 27, 2023, the CIIDRC confirmed that the Complaint was administratively compliant with the UDRP, the UDRP Rules, and the CIIDRC Supplemental Rules.

5. On April 27, 2023, the CIIDRC commenced the UDRP proceeding and forwarded a Notice of Commencement along with the Complaint and Annexes to the Respondent by email in accordance with the email address provided by the Registrar in the Registrar Verification. The Respondent was not mailed with the aforementioned documents as neither the Complaint nor the Registrar Verification contained an apparently valid mailing address for the Respondent. No other means of contacting the Respondent was provided in the Complaint or in the Registrar Verification, nor was an email address for the Respondent apparent from any active web page associated with the Domain Name in accordance with Paragraph 2(a)(c) of the UDRP Rules.

6. As set out in the Notice of Commencement, the CIIDRC set May 17, 2023 as the deadline for a Response from the Respondent. No response was received before the deadline or since.

7. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member and the undersigned Panelist was appointed on May 18, 2023. The CIIDRC set June 1, 2023 as the due date for delivery of the Panelist’s decision to the CIIDRC.

8. The Complaint was commenced against “DATA REDACTED” as the Respondent based upon the Whois information obtained by the Complainant and included in its Complaint. The ICANN Temp Spec states that UDRP complaints will not be deemed defective for failure to provide the name of the Respondent and all other relevant information required by Section 3

of the UDRP Rules if such contact information is not available in the Whois records (now referred to by ICANN as the RDDS or Registration Directory Service). The Temp Spec further provides that in such an event, a Complaint may file a “Doe” Complaint and the Provider (in this case the CIIDRC) shall provide the relevant contact details of the Respondent after receiving the Complaint. The Registrar Verification contained certain information, inter alia including a Registrant Name, a Registrant Email address, and what appeared to be an incomplete or incorrect Registrant Address.

9. The information from the Registrar Verification was included in the Notice of Commencement transmitted to both parties. As such, the Complainant was made aware of the name of the Respondent, Michael Cao, as per the Registrar’s records. At this juncture, the Complainant could have amended its Complaint to reflect the provided name of the Respondent but has not done so. Nevertheless, the CIIDRC identified Michael Cao as the named Respondent in the Notice of Commencement. In the circumstances, the Panel recognized Michael Cao as the Respondent in this proceeding however recommends that in the future it would be preferable from a procedural perspective, for the Complaint be formally amended by the Complainant so as to include the name of Respondent as disclosed in the Registrar Verification, as otherwise the originally named Respondent could be considered to be the formal Respondent.

Facts Alleged by the Parties

10. The Complainant, Shopify Inc. (“Shopify”) states that it was founded in 2004 and is based in Ottawa, Canada. The Complainant states that it is a very well-known cloud-based e-commerce platform designed for small and medium-sized businesses. The Complainant states that its platform is used by online merchants to manage products and inventory, process orders and payments, manage customer relationships, and to leverage analytics and reporting. The Complainant further states that offers its services under its SHOPIFY trademark which is a coined term registered as a trademark in numerous jurisdictions. The Complainant states that it offers its services through various websites, including those accessible through the domains, “shopify.com” and “shopify.ca”.

11. The Complainant provides supporting material from its own website showing the services

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that it offers. The Complainant also provides an article from Forbes.com showing that Shopify is based in Ottawa, Canada and is a publicly traded company on the New York Stock Exchange with a market capitalization of over \$39 billion dollars and 7000 employees as of September 21, 2022. The aforementioned article also states that the Complainant's revenue was \$4.6 billion with profits of \$2.9 billion. The Complainant also submitted a list of the "Largest Canadian companies by market capitalization" prepared by CompaniesMarketCap.com which shows the Complainant listed at #18, right behind CIBC, BCE, and Lululemon Athletica.

12. The Complainant states that it owns dozens of trademarks registered around the world and provides what it says are representative examples including, Canadian Trademark Registration No. TMA787767 for SHOPIFY in connection with e-commerce services etc., registered January 18, 2011, United States Trademark Registration No. 3840412 in connection with e-commerce software etc., registered August 31, 2010.

13. The Complainant states that the Disputed Domain Name was registered by the Respondent on March 29, 2023 which corresponds to the Creation Date for the Domain Name as shown in both the Whois data provided by the Complainant and in the Registrar Verification. Although a Creation Date is not necessarily the date that the Respondent registered the Domain Name, given the relatively short period of time since the Creation Date to the filing of the Complaint, it appears likely that the Creation Date is also the date on which the Respondent registered the Domain Name.

14. The Complainant notes that "Shopify" is an invented word and states that accordingly, "Shopify" is not a word that traders would legitimately choose unless seeking to create an impression of association with the Complainant. The Complainant states that at no point did the Complainant give the Respondent permission to incorporate "Shopify" as part of a domain name, use "Shopify" as part of its own business or trade name, or to otherwise impersonate the Complainant. The Complainant states that the last portion of the Disputed Domain Name, "-analytics" is merely a descriptive word and does not add any distinctiveness to the Disputed Domain Name.

15. The Complainant states that the Disputed Domain Name is used for a website purporting

to provide “Shopify Analytics” services to Shopify shop owners in the nature of messaging services to contact customers and the Complainant provides a copy of the said website. The website does not include the Complainant’s logo but contains a heading stating, “Why Shopify Analytics?” and contains a footer stating “Built by Shopify-Analytics, LLC”. The remainder of the website contains headings and text apparently related to a messaging service that enables users to “monitor and chat with website visitors, respond to support tickets, organize contacts, and create a help center to empower customers to help themselves”. The look and feel of the website is minimally related to the Complainant’s own website in that both generally use a green and black colour scheme to some extent, but it does not appear that the Respondent’s website attempts to visually mimic or pass itself off as that of the Complainant’s. The website does however, contain some rather strange content, such as references to “Taxonomy” which is presented as an apparent brand name of certain open source software with its code “available on GitHub”.

16. The Panelist exercised its discretion to review the live website associated with the Domain Name on the Internet in order to confirm its existence and nature. Pursuant to Rule 10 of the UDRP Rules, the Panelist shall conduct the administrative proceeding in such a manner as it considers appropriate under the circumstances and it is well established that a Panelist may undertake limited factual research into matters of public record such as reviewing a relevant publicly available website (See for example, [*ESO Solutions v. Internet Consulting Services Inc.*](#), CIIDRC Case No. 17944-UDRP, August 18, 2022 <esosuite.com>).

17. Notably the website that is now associated with the Domain Name as of the date of within decision, is not the same website as included as an exhibit to the Complaint. Rather, it is a completely different website that makes no reference to SHOPIFY whatsoever and instead reference “TaxPal” bookkeeping software. The links on the website such as “sign in”, “get started”, and “pricing” are nonfunctional. The Panelist however does not rely upon this second website as evidence in this proceeding as it does not form part of the Complaint delivered to the Respondent and in any event is unnecessary to satisfactorily resolve this matter.

18. The Respondent did not respond to the Complaint.

Discussion and Findings

19. 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.

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

20. As aforesaid, the Complainant is the registrant of Canadian and United States registered trademarks for SHOPIFY. The Disputed Domain Name incorporates the Complainant's trademark in its entirety and adds a descriptive word, namely "analytic" separated by a dash. The fact that a domain name wholly incorporates a complainant's registered mark, particularly where the mark is highly distinctive, is generally sufficient to establish identity or confusing similarity for purposes of the Policy (See: [*Six Continent Hotels, Inc. v. The Omnicorp*](#), WIPO Case No. D2005-1249). In this case, the Panel accepts that SHOPIFY is a highly distinctive term and the addition of the merely descriptive term, "analytics" which is very much associated with the Complainant's services, is insufficient to remove the Disputed Domain Name from the realm of confusing similarity (See for example; [*Westfield Corp. v. Hobbs*](#), D2000-0227 (WIPO May 18, 2000) ([westfieldshopping.com](#)). The Panel accordingly finds that the Disputed Domain Name is confusingly similar to the Complainant's SHOPIFY trademark.

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

21. It is now well established that the Complainant must first make a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name and then the burden shifts to the Respondent to show that it does in fact have rights or legitimate interest in the domain name (see for example [*Hanna-Barbera Prods., Inc. v. Entm't Commentaries*](#),

FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP Paragraph 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name).

22. Complainant relies upon Paragraph 4(c)(i) of the Policy and claims that there is no evidence of the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services and contends that the evidence supports the contrary conclusion. The Complainant contends that the Respondent is not connected with the Complainant but is improperly using the Complainant's registered trademark, "Shopify" within the Disputed Domain Name with an intention to derive advantage from user confusion. The Complainant claims that such use by the Respondent is not *bona fide* use under Paragraph 4(c)(i) of the Policy and therefore does not confer any rights or interest in favour of the Respondent.

23. The Complainant also relies upon Paragraph 4(c)(ii) of the Policy, and claims that there is no evidence that the Respondent has been commonly known by the disputed Domain Name and contends that the evidence supports the contrary conclusion.

24. Lastly, the Complainant also relies upon Paragraph 4(c)(iii) of the Policy, and claims that the Respondent is not making a legitimate non-commercial or fair use of the Domain Name but is making an illegitimate commercial use of the domain name by impersonating the Complainant through use of the Complainant's registered SHOPIFY trademark in an attempt to unlawfully attract Internet users to the Respondent's website. The Complainant also contends that the Respondent's website content could not possibly constitute fair use.

25. The Panelist finds that the Complainant has made out a *prima facie* case. The Respondent has not rebutted any of the Complainant's allegations despite its onus. Moreover, the Complainant has provided evidence sufficient to show that the Respondent's use of the Domain Name is not *bona fide* nor legitimate.

26. There is no question that the Complainant's SHOPIFY trademark is well known, highly distinctive, and solely associated with the Complainant. The Respondent was therefore very likely aware of the Complainant's SHOPIFY trademark when it registered the Domain Name

without the Complainant's authorization. Moreover, the Respondent's addition of "-analytics" to the Complainant's trademark in the Disputed Domain Name, shows a likelihood that the Respondent was also aware of the Complainant's business since analytics are very much part of the platform that the Complainant provides.

27. The fact that the Respondent put the Domain Name to use in connection with a website that appears to not even purport to provide Shopify analytics related services, but rather some kind of customer monitoring and chatting software (to the extent that this is even a genuine business offering rather than a fake website altogether, which is unclear), is a sufficient indication that the Respondent's use is not for a bona fide business but rather, is improperly trying to drive traffic to his website based upon the goodwill and reputation of the Complainant's trademark. Had the Respondent actually been providing Shopify analytics services that may have been another matter. There is no evidence that the Respondent is known as Shopify or by the Domain Name itself - which barely makes an appearance on the associated website. The Respondent's use is clearly commercial in nature. Accordingly, the Complainant has made out this second part of the three-part test under the Policy and the Respondent is found to have no rights or legitimate interest in the Domain Name.

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

28. The Complainant alleges that the Respondent registered the Disputed Domain Name on March 29, 2023 which is over a decade after Shopify's trademark rights were established and that the Domain Name incorporate the Complainant's entire trademark. The Complainant alleges that there is no reason to believe that the Respondent was not aware of Complainant and its trademarks at the time that he registered the Disputed Domain Name and that the evidence suggests that the Respondent deliberately chose to register the Disputed Domain Name in bad faith.

29. There is no question that given the highly distinctive nature of the Complainant's SHOPIFY trademark combined with the descriptive term, "analytics", which is associated with the Complainant's services, that the Respondent was aware of the Complainant at the time that he registered the Domain Name and purposefully targeted the Complainant to take unfair advantage of its goodwill and reputation for the Respondent's own business purposes. Accordingly, the Panelist finds that the Respondent registered the Domain Name in bad faith.

30. Regarding bad faith use, the Complainant specifically relies upon Paragraph 4(b)(iv) of the Policy, namely;

- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

31. The Complainant alleges that the Respondent is engaged in active infringement of the Complainant's registered trademark SHOPIFY, for the purposes of leveraging the goodwill of the mark to intentionally attract Internet users to his website by creating a likelihood of confusion as to affiliation of the respondent's website for commercial gain.

32. The Complainant also alleges that the Disputed Domain Name resolves to a website which appears to offer messaging and monitoring services under the guise of being Shopify or having an affiliation with Shopify based upon the Respondent's use of the heading which says, "Shopify Analytics". The Complainant contends that this suggests a business relationship or affiliation between the Complainant and the Respondent, when in fact, there is no connection between the two.

33. The Panelist finds that the Respondent's use of the Domain Name in connection with a website which falsely represents some connection with the Complainant for the purposes of promoting the Respondent's own business or at least for the purpose of driving traffic to the Respondent's website based upon the Complainant's goodwill and reputation, constitutes bad faith use as understood by Paragraph 4(b)(iv) of the Policy.

34. Accordingly, the Complainant has made out both bad faith registration and bad faith use, both of which are required under the Policy.

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 the Disputed Domain Name be TRANSFERRED to the Complainant.

Made as of May 26, 2023

SIGNATURE OF PANEL



Zak Muscovitch

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