



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

CIIDRC Case No.:	24781-UDRP	Decision date: April 28, 2025
Disputed Domain Name:	<shopifydesigners.com>	
Panel:	María Alejandra López G.	
Complainant:	Shopify Inc.	
Complainant's representative:	Daniel Anthony of Smart & Biggar LP	
Respondent:	Muhammad Saqib, self-represented.	

1. PROCEDURAL HISTORY

The Complainant was filed electronically with the CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE ("CIIDRC") on February 24, 2025.

On February 25, 2025, CIIDRC transmitted by email to the Registrar Internet Domain Service BS Corp., a request for registrar verification in connection with the disputed domain name. After several follow-up actions and complaints submitted to ICANN by the CIIDRC, on March 21, 2025, the Registrar transmitted by email to CIIDRC its verification response advising of the identity of the Respondent and providing the following contact details for the disputed domain name, Muhammad Saqib, 'idomains@ymksolutions.org', +92.3000926377, Houston, Texas, United States, as the Registrant, administrative, technical and billing contact of the disputed domain name, and confirmed that the disputed domain name was placed on a Registrar LOCK. The Complainant was informed of the Respondent's information as provided by the Registrar and subsequently declined to amend the Complaint.

CIIDRC verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999 and approved by ICANN on October 24, 1999, the Rules for Uniform Domain Name Dispute

Domain Name: shopifydesigners.com

24781-UDRP

Resolution Policy (the “UDRP Rules”) approved by ICANN on September 28, 2013, and in effect as of July 31, 2015, and the CIIDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”) in effect as of May 9, 2018.

Following the UDRP Rules, paragraphs 2 and 4, CIIDRC formally notified the Respondent of the Complaint, to the person listed on the Respondent’s registration as administrative, technical, and billing contact, and to ‘idomains@ymksolutions.org’, and to each corresponding postmaster’s email address by e-mail, including a Written Notice with a specific user, login information for the Case, and the link to the Complaint (and Annexes) to the Respondent. The proceedings commenced on April 1, 2025. Following the UDRP Rules, paragraph 5, the due date for the Response was April 21, 2025. The Respondent did not submit any response by the due date. Accordingly, CIIDRC notified the Respondent’s default on April 23, 2025. On April 23, 2025, the Respondent submitted a late Response.

On April 24, 2025, according to the Complainant’s request to have the dispute decided by a single-member Panel, CIIDRC appointed María Alejandra López García as a Panelist. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by CIIDRC to ensure compliance with the UDRP Rules, paragraph 7.

Having reviewed CIIDRC’s records, this Administrative Panel (“the Panel”) finds that CIIDRC has discharged its responsibility under paragraph 2(a) of the UDRP Rules “to employ reasonably available means calculated to achieve actual notice to Respondent” through submission of electronic and Written Notices, as defined in the UDRP Rules paragraph 2(a)(i) and (ii). Therefore, the Panel may issue its decision based on the documents submitted and by the Policy, the UDRP Rules, the CIIDRC Supplemental Rules, and any rules and principles of law that the Panel deems applicable.

2. FACTS ALLEGED BY THE PARTIES

The Complainant is a Canadian company founded on September 28, 2004, with is headquartered in Ottawa, Canada. The Complainant is a very well-known cloud-based e-commerce platform designed for small and medium-sized businesses. The Complainant has offered its services for more than fifteen (15) years around the world in association with the coined trademark SHOPIFY, registered in numerous jurisdictions.

The Complainant’s 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. The Complainant’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 Complainant is among the five (5) largest publicly traded Canadian companies by market capitalization and employs over 10,000 people across the globe. The Complainant offers its services through various websites, including those accessible through the domains “shopify.com” and “shopify.ca.”

The Complainant owns among others, the following trademark registrations:

- Canadian Trademark for **SHOPIFY** (word mark), Reg. No. TMA787767, registered on January 18, 2011, and in force until January 18, 2026, in International Classes (“ICs”) 35 and 42.
- United States Trademark for **SHOPIFY** (word mark), Reg. No. 3840412, registered on August 31, 2010, and (initially) in force until September 3, 2030, in IC 9.
- Canadian Trademark for **S SHOPIFY** (and design), Reg. No. TMA700694, registered on November 13, 2007, and in force until November 13, 2032, in IC 42.

The disputed domain name was registered on June 3, 2024, and currently resolves to a website that features a replica of the Complainant’s SHOPIFY services, such as SHOPIFY store design and theme development.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

Concerning the first element of the Policy, in summary, the Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademark SHOPIFY; that the mere addition of a generic term as “designers” misleads Internet users into believing that the disputed domain name is associated to the Complainant.

Regarding the second element of the Policy, in summary, the Complainant contends that the Respondent has no rights in respect of the disputed domain name, given that none of the circumstances described in paragraph 4(c) of the Policy are present in this case. In particular, the Complainant addressed the use of the trademark SHOPIFY (including a mimic of the logo) throughout the entire website, where the Respondent claims to “help startups, mid-sized and enterprise business with Shopify design, development, and optimization”, and with it, suggesting an affiliation with Shopify that does not exist. Additionally, the Complainant contends that the use of a disclaimer does not cure the bad faith use of the domain or provide legitimate interests in the domain.

Regarding the third element of the Policy, in summary, the Complainant contends that the disputed domain name has been registered and is being used in bad faith, given that the Respondent knew or should have known about the Complainant’s trademark rights over SHOPIFY; that the Respondent deliberately registered and leveraged a bad faith domain to drive traffic to its website to sell its SHOPIFY design services; that the Respondent’s use of the disputed domain name, to replicate the Complainant’s business falls into paragraph 4(b)(iv) of the Policy.

Domain Name: shopifydesigners.com

24781-UDRP

- **Respondent**

Concerning each one of the elements of the Policy, the Respondent, in summary (and *verbatim*), contends as follows:

- Shopify Inc. asserts rights in the word “Shopify.” Our domain, shopifydesigners.com, adds the generic term “designers” and is not confusingly similar. It clearly denotes an independent website offering design services for Shopify® stores, not Shopify’s own site.
- shopifydesigners.com launched June 2024 to provide third-party storefront design exclusively for merchants using the Shopify platform. We hold no trademark in “Shopify,” yet use the term descriptively to identify our niche—designers for Shopify users. Prior to any notice of dispute, we registered the name to accurately describe our lawful, good-faith service.
 - Fair Use / Noncommercial Use: The site prominently displays disclaimers at the header and footer clarifying that we are not affiliated with Shopify Inc. (see Annex A and Annex B). Our domain is not used to sell, mislead, or divert customers from Shopify. We do not offer competing e-commerce software—only design services for existing Shopify merchants.
- No intent to sell the domain to Shopify Inc. or profit from its trademark; No pattern of targeting Shopify’s mark; this is a single, descriptive registration from June 2024; No misleading redirects: visitors reach a clear portfolio site describing our services; No disruption of Shopify’s business—our clientele are independent merchants already using Shopify.
- Should the Panel find the Complaint unfounded and brought in bad faith, we request a declaration of Reverse Domain-Name Hijacking under UDRP Rule 15(e).

- **Remedy Sought**

The Complainant requests the disputed domain name be transferred to it.

The Respondent requests (*verbatim*):

1. Deny Shopify Inc.’s Complaint in its entirety and allow shopifydesigners.com to remain with the Respondent; or,
2. Should the Panel determine that the domain must be transferred, grant the Respondent a transition period of six (6) to twelve (12) months during which Respondent may continue to operate the domain and migrate services; and thereafter permit Respondent to list the domain for sale, at which time Shopify Inc. shall have the first right of refusal to purchase it at fair market value.

4. DISCUSSION AND FINDINGS

4.1.1 Late Filing of Response

Domain Name: shopifydesigners.com

24781-UDRP

The late Response was filed with the CIIDRC two (2) days after the deadline for filing of the Response had expired. The Policy and the Rules do not expressly permit the late filing of a response, except as may be specifically requested by a panel.

Paragraph 10 of the Rules provides the Panel with a broad discretion to permit the late filing of a response in exceptional circumstances, as follows:

- (a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- (b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.
- (c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.
- (d) The Panel shall determine the admissibility, relevance, materiality, and weight of the evidence.

The Panel notes that the Respondent did not justify or reason the circumstances of its late Response. However, the Panel, particularly based on paragraph 10(a) and (b) of the Rules, determines, exceptionally, that it will allow the late filing of the Response in this proceeding.

4.1.2 Requirements

Under 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, and
2. That the Respondent has no rights or legitimate interests in respect of 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 Identical or Confusingly Similar

The Complainant has sufficiently proved before the Panel that owns significant registered trademark Rights over the term SHOPIFY, *e.g.*: SHOPIFY, Canadian Registration No. TMA787767, filed October 22, 2009, registered on January 18, 2011, and in force until January 18, 2026. See WIPO Overview 3.0, section 1.2.1.

The disputed domain name exactly incorporates the well-known Trademark SHOPIFY, plus a generic term as “designers” which in accordance with the Domain Name Jurisprudence, does not prevent a finding of confusing similarity under the first element of the Policy. See WIPO Overview 3.0, section 1.8.

Domain Name: shopifydesigners.com

Concerning the gTLD in this case, a '.com', for the purposes of this specific analysis, is considered "as a standard registration requirement and as such is disregarded under the first element confusing similarity test." See WIPO Overview 3.0, section 1.11.1.

Therefore, the disputed domain name is confusingly similar to the Complainant's Trademarks SHOPIFY. Accordingly, the Panel finds the first element of the Policy has been established.

4.2.2 Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the circumstances, but without limitation, described in paragraph 4(c) of the Policy.

As multiple UDRP Panelist has established, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy "may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. See WIPO Overview, section 2.1.

In this case, the Respondent has come forward and submitted its Response, accordingly, the Panel finds that:

1. The Respondent has built an entire line of online business based on the Complainant's international reputation and well-known trademark SHOPIFY, including an evocative use of its logo, which can't constitute a *bona fide* offering of goods or services, as set out in paragraph 4(c)(i) of the Policy.
2. The Respondent has not come forward with any evidence that could possibly suggest that he was commonly known by the disputed domain name, as set out in paragraph 4(c)(ii) of the Policy.
3. The Complainant as the rightful owner of the trademark SHOPIFY possesses the legal right to exercise the *ius prohibendi* against third parties. The evidence presented does not indicate that the Complainant has authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use any of its trademarks. Consequently, the entire use of the disputed domain name by the Respondent, in this case, does not constitute a legitimate noncommercial or fair use as set out by paragraph 4(c)(iii) of the Policy. Furthermore, this use creates a false affiliation with the Complainant, which cannot confer any rights or legitimate interests in respect of the disputed domain name. See WIPO Overview 3.0, section 2.5.1.
4. Regarding the use of the disclaimer in the circumstances of this case, the Panel agrees with the Complainant and finds that such use reinforces the Respondent's knowledge of the Complainant and finds that it doesn't correspond with the *Oki Data Test's* requirements. See WIPO Overview 3.0, section 2.8.1.

Therefore, the Respondent has no rights or legitimate interests in respect of the disputed domain name. Accordingly, The Panel finds the second element of the Policy has been established.

4.2.3 Registered and Use in Bad Faith

Registration in Bad Faith:

The Complainant's trademark Rights over SHOPIFY significantly precede the disputed domain name's registration. According to the Response, the Respondent confirmed its knowledge of the Complainant's trademark SHOPIFY. However, ignoring the scope of industrial property rights over a trademark, in this case, meaning the Policy, does not excuse the Respondent from complying with them; on the contrary, doing so deliberately breaches the Domain Name's Registration Agreement. See WIPO Overview 3.0, section 3.2.1, and section 3.2.2.

Use in Bad Faith:

The Respondent is using the disputed domain name to promote its line of business rooted in the value and reputation of the Complainant's SHOPIFY trademark, with it, inevitably incurring in paragraph 4(b)(iv) of the Policy. In line with it, UDRP panels have held that the use of a domain name for illegal activity – here, found as impersonation/passing off, or other types of fraud, constitutes bad faith.

Section 3.4 of the WIPO Overview 3.0, states that:

“Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, **the respondent may host a copycat version of the complainant's website.**) Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., **to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers.**” (emphasis added).

Therefore, the disputed domain name has been registered and is being used in faith. Thus, the Panel finds that there are no grounds to determine that the Complainant has incurred in Reverse Domain Name Hijacking. Accordingly, The Panel finds the third element of the Policy has been established.

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 CIIDRC Supplemental Rules, the Panel orders that: the disputed domain name <shopifydesigners.com> be **transferred** to the Complainant.

Made as of **April 28, 2025**

Domain Name: shopifydesigners.com

24781-UDRP

SIGNATURE OF PANEL



María Alejandra López G.

