



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**

**DOMAIN NAME DISPUTE**

**ADMINISTRATIVE PANEL**

**DECISION**

CIIDRC case number:	25032-UDRP	Decision date: June 29, 2025
Domain Name:	<b>shopifydesignpro.com</b>	
Panel:	<b>Bart Van Besien</b>	
Complainant:	<b>Shopify Inc.</b>	
Respondent:	<b>Roger Hayden / Blu Forrest 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 29, 2025, Daniel Anthony of Smart & Biggar LP, on behalf of the Complainant filed a Complaint pursuant to the UDRP and the UDRP Rules.
2. On May 4, 2025, CIIDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name, and on May 5, 2025, the Registrant provided the Respondent's contact information. The Registrar also confirmed that the disputed domain name was placed on a Registrar LOCK.
3. The Complainant was informed of the Respondent's information as provided by the Registrar and subsequently declined to amend the Complaint.
4. On May 14, 2025, CIIDRC confirmed compliance of the Complaint and commencement of the dispute resolution process.
5. On May 14, 2025, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice of Complaint to the Respondent.

6. The deadline for submitting a Response was set for June 3, 2025.
7. The Respondent has failed to file its response.
8. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member.
9. CIIDRC appointed Bart Van Besien, as a single-member Panel in the above-referenced matter. He accepted the appointment.
10. The Panel finds that it is properly constituted and has submitted the Statement of Acceptance and Declaration of Impartiality and Independence.

CIIDRC will communicate the full text of the decision to the parties and the concerned Registrar.

The Domain Name was registered on August 19, 2024.

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**

### **Facts alleged by the Complainant:**

The Complainant operates the world's leading cloud-based e-commerce platform designed for small and medium-sized businesses. Its software is used by merchants to run their businesses across all sales channels, including web, tablet and mobile storefronts, as well as brick-and-mortar pop-up shops. The Complainant's platform provides merchants with tools for their businesses and customers. Additionally, the Complainant's platform allows for merchants to manage products and inventory, process orders and payments, build customer relationships and leverage analytics and reporting.

The Complainant was founded on September 28, 2004, and is headquartered in Ottawa, Canada. The Complainant is one of the largest publicly traded Canadian companies by market capitalization and employs over 10,000 people globally. It offers its services through various websites, including those accessible through the domains "shopify.com" and "shopify.ca".

The Disputed Domain Name resolves to a webpage advertising Shopify store design, development and optimization services. The Respondent states their primary goal is to "optimize your growth potential and make

sure your Shopify business stands out". They advertise a range of services, such as "Custom Shopify Store Design", "Shopify Marketing Integration", "Custom Store Setup", and "Comprehensive Shopify Features".

**The Respondent did not file a response.**

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

- **Complainant**

The Complainant claims to own dozens of SHOPIFY trademarks all around the world. The Complainant submitted evidence that it is the registered owner of the following trademarks (hereafter the "SHOPIFY Trademark(s)"):

- Word trademark "SHOPIFY": Canadian Registration No. TMA787767, filed on October 22, 2009, registered on January 18, 2011, in association with web-based services that allow users to create hosted e-commerce stores;
- Word trademark "SHOPIFY": U.S. Registration No. 3840412, filed on November 12, 2009, registered on August 31, 2010, in association with computer e-commerce software to allow users to perform electronic business transactions via a global computer network;
- Figurative trademark "S shopify & design": Canadian Registration No. TMA 700694, filed on January 19, 2006, registered on November 13, 2007, in association with web-based services that allow users to create hosted e-commerce stores to sell their goods or services online; and
- Figurative trademark "S shopify & design": United States Registration No. 3208463, filed on April 6, 2006, registered on February 13, 2007, in association with computer e-commerce software to allow users to perform electronic business transactions via a global computer network, as well as design, creation, hosting and maintenance of internet sites for third parties.

First, the Complainant claims that the Disputed Domain Name is confusingly similar to its SHOPIFY Trademarks.

The Disputed Domain Name contains the terms "shopify" and "design pro". The first term "shopify" is the most prominent and distinctive portion of the Disputed Domain Name and is identical to the Complainant's SHOPIFY Trademark(s). The term "shopify" is an invented word and therefore not a word that is commonly used or referred to unless seeking to create an impression of association with the Complainant. The second portion of the Disputed Domain Name, "design pro", consists of descriptive words which do not add distinctiveness to the Disputed Domain Name. Adding the descriptive words "design pro" does not add distinctiveness to the Disputed Domain Name.

Second, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

According to the Complainant, 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. In fact, the evidence supports a contrary conclusion.

The Respondent is not connected with the Complainant and was never authorized to use the SHOPIFY Trademark and branding. The Respondent included the Complainant's SHOPIFY Trademarks within the Disputed Domain Name and throughout the webpage to derive advantage from user confusion to create the illusion of an official affiliation with the Complainant, which does not exist.

The Disputed Domain Name leads to a webpage purposefully designed to suggest an affiliation with the Complainant. The Disputed Domain Name includes the Complainant's SHOPIFY Trademark in its entirety. On the webpage, the Respondent claims to be a "top Shopify eCommerce agency", providing services relating to SHOPIFY online store development. Furthermore, throughout the webpage, the Respondent uses the Complainant's imagery and branding, such as a green shopping bag logo that is confusingly similar to the Complainant's S-Bag logo and the color green, a color used by the Complainant. This was done to imply a connection with the Complainant.

The Respondent is using the Complainant's SHOPIFY Trademark within the Disputed Domain Name and on the website with an intent to derive advantage from user confusion. The Respondent's use of the Disputed Domain Name is not bona fide use under the Policy and does not confer any rights in favor of the Respondent.

There is no evidence that the Respondent has been commonly known by the Disputed Domain Name. The Respondent's website demonstrates that the term "Shopify" in the Disputed Domain Name is a direct reference to the Complainant, as the Respondent promotes itself as a "top Shopify eCommerce agency".

The Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name but is making illegitimate commercial use by infringing on the Complainant's well-known SHOPIFY Trademark(s) within the Disputed Domain Name and by incorrectly asserting an affiliation with the Complainant that does not exist.

The Respondent's use of the Disputed Domain Name can never constitute "fair use" since it improperly uses the Complainant's flagship SHOPIFY Trademark, implying a special association.

Finally, according to the Complainant, the Disputed Domain Name is being used for a commercial purpose – the sale of SHOPIFY online store development services. As such, it cannot constitute fair, non-commercial use.

Third, the Complainant claims that the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Complainant argues that the Respondent demonstrated bad faith by infringing upon the Complainant's trademark rights and actively attracting Internet users to the Disputed Domain Name's website by creating confusion as to an affiliation or endorsement between itself and the Complainant for commercial gain.

Furthermore, according to the Complainant, the evidence shows that the Respondent actually knows about the Complainant's trademark rights. The Respondent references the Complainant, claims to provide SHOPIFY online store development services, and calls itself as a "top Shopify eCommerce agency".

The Respondent is using similar branding (such as the color green) and imagery (such as the confusingly similar green shopping bag logo) on its webpage in combination with the advertisement of services directly related to the Complainant. This creates an impression that the Disputed Domain Name and associated webpage are affiliated with the Complainant (which is not the case). According to the Complainant, this constitutes bad faith registration and use.

Although the Respondent is entitled to provide SHOPIFY store development services online, the Respondent is not entitled to use the Complainant's SHOPIFY Trademark(s) in a confusing manner to attract Internet traffic to its website to sell its development services. The Respondent is redirecting Internet users searching for authorized Shopify webpages to its own webpage in a confusing and misleading manner for commercial gain within the meaning of paragraph 4(b)(iv) of the Policy.

- **Respondent**

The Respondent did not file a response.

- **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 that:

1. the Domain Name is Identical or Confusingly Similar to a trademark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the Domain Name; and
3. 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

### **Preliminary issue: Respondent identify**

On April 29, 2025, the Complainant addressed the Complaint to “Redacted for Privacy”, this being the name mentioned in the publicly accessible Whois register as “Registrant” for the Disputed Domain Name, at the time of filing the Complaint.

On the basis of the registrar verification, CIIDRC informed the Complainant that the underlying “Registrant” for the Disputed Domain Name is in fact “Roger Hayden / Blu Forrest LLC”. The Complainant declined to amend the Complaint.

The Panel notes that CIIDRC sent its communications regarding the Complaint and the deadlines to the underlying Registrant “Roger Hayden / Blu Forrest LLC”, by using this party’s contact details as registered at the time of registration of the Disputed Domain Name.

Therefore, the Panel is of the opinion that the Complaint was correctly notified by CIIDRC to “Roger Hayden / Blu Forrest LLC” as a Respondent. The Panel concludes that, despite the use of a privacy or proxy registration service, the Respondent in this case is “Roger Hayden / Blu Forrest LLC” and that this Respondent is deemed to be on notice of the proceeding.

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

The Disputed Domain Name consists of the Complainant’s SHOPIFY Trademark, with the addition of the words “design pro” and the gTLD “.COM”.

The entire word trademark of the Complainant (as well as the dominant element of its figurative trademark) is recognizable in the Disputed Domain Name. The Panel is of the opinion that the mere addition of the descriptive terms “design pro” does not prevent a finding of confusing similarity under the first element of paragraph 4(a)(i) of the Policy. In addition, the gTLD “.COM” may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the complainant has rights.

For these reasons, the Panel concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

#### 4.2.2 Rights or Legitimate Interests in respect of the Domain Name

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that 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 burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the Panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues 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;
- The Respondent is not connected with the Complainant and did not have any authorization of the Complainant to use the Complainant's SHOPIFY Trademarks in a domain name.
- The Respondent is using the Disputed Domain Name to suggest an affiliation with the Complainant and confuse consumers, by using the Complainant's registered SHOPIFY Trademarks and by presenting itself as a "top Shopify eCommerce agency".
- There is no evidence that the Respondent has been commonly known by the Disputed Domain Name.
- The Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name but is making an illegitimate use by infringing on the Complainant's well-known SHOPIFY Trademark(s) within the Disputed Domain Name and by incorrectly asserting an affiliation with the Complainant.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the Disputed Domain Name. The Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so.

The Panel finds that the Respondent does not appear to have any rights or legitimate interests in respect of the Disputed Domain Name from a combination of the following facts:

- The Disputed Domain Name includes the entire SHOPIFY Trademark of the Complainant, with the addition of the descriptive words "design pro". The addition of these descriptive words does not create rights or legitimate interests in the Disputed Domain Name.

- There is no evidence that the Respondent is or has been commonly known, by the Disputed Domain Name or by the term “SHOPIFY”.
- The WHOIS information does not provide any information that might indicate any rights of the Respondent to use the Disputed Domain Name or the term “SHOPIFY”.
- The Respondent does not seem to have any consent or authorization to use the SHOPIFY Trademarks or variations thereof and does not seem to be related to the Complainant. On the contrary, the Complainant states that it has an official partner program for app developers but that the Respondent is not a member of this partner program.
- The Respondent did not show to have any trademark rights or other rights regarding the terms “SHOPIFY” or “shopifydesignpro” (or similar terms).
- The Complainant’s SHOPIFY Trademarks have been registered and widely used well before the registration date of the Disputed Domain Name.
- The website of the Respondent contains the SHOPIFY Trademark and a logo that is similar to the Complainant’s logo. This is not contested by the Respondent, and the Respondent does not offer any explanation in this regard.
- There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain or to misleadingly divert consumers. On the contrary, it appears that the Respondent is taking advantage (or at least intends to take advantage) of the Complainant’s name and registered SHOPIFY Trademarks to attract consumers and thus creating a likelihood of confusion with the Complainant’s SHOPIFY Trademarks.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

#### **4.2.3 Registration and Use of the Domain Name in Bad Faith**

The Complainant argues that the Respondent has registered and is using the Disputed Domain Name in bad faith, from a combination of the following facts:

- The Respondent infringes upon the Complainant's trademark rights and actively attempts to attract Internet users to the Disputed Domain Name's website by creating confusion as to an affiliation or endorsement between itself and the Complainant for commercial gain.
- The Respondent had actual knowledge of the Complainant and its registered SHOPIFY Trademarks at the time of registration and use of the Disputed Domain Name.
- The Respondent incorrectly claims to be a "top Shopify eCommerce agency". Even if the Respondent would be a certified Shopify partner, it would still be acting in bad faith by registering a domain name incorporating the term "Shopify" despite the express prohibition against such actions in the Complainant's Partnership Agreement.

These arguments and allegations are not contested by the Respondent, who did not file a response.

The Panel weighs these arguments and facts as follows:

First, as mentioned already, the Disputed Domain Name reproduces the Complainant's SHOPIFY Trademarks entirely, with the mere addition of the descriptive terms "design pro". Given the fact that the Complainant has a partner program for app developers and given the scope of the Complainant's registered SHOPIFY Trademarks, the addition of these terms increases the risk of confusion among the public.

Second, the Complainant's SHOPIFY Trademarks predate the registration of the Disputed Domain Name with several years.

Third, the Complainant added screenshots of the Respondent's website. From these screenshots, it follows that the Respondent is actively using the Complainant's SHOPIFY Trademark(s) and is presenting itself as a "top Shopify eCommerce agency" providing "Expert Shopify Services". The Respondent is trying to create the false impression that it is affiliated with the Complainant, or that it is endorsed by the Complainant, or that it is a member of the Complainant's official partner program for web or app developers.

Fourth, the Panel emphasizes that the term "SHOPIFY" has no general meaning in any language. It is therefore inconceivable that the Respondent would have come up with a domain name consisting of this term, combined with the wording "design pro", and combined with the references to the Complainant's services on its website, without having prior knowledge of the Complainant and its SHOPIFY Trademarks and activities.

Fifth, the Respondent does not seem to use the Disputed Domain Name for a bona fide offering of goods or services, and not for a legitimate non-commercial or fair use. On the contrary, it appears that the Respondent is taking advantage (or at least intends to take advantage) of the Complainant's name and registered SHOPIFY Trademarks to attract consumers for commercial gain, in an effort to boost its own services.

Sixth, the Respondent did not contest any of the Complainant's arguments and did not provide any explanation concerning its choice for registering and using a domain name that includes the Complainant's registered SHOPIFY Trademark with the addition of generic or descriptive wording.

Given the arguments and facts described above, the Panel finds that the Disputed Domain Name is not being used for any bona fide offering of goods or services. The Disputed Domain Name is rather used to misleadingly attract internet users for commercial gain, which is evidence of bad faith (see WIPO overview 3.1.). On the balance of probabilities, it seems evident to the Panel that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence and scope of the Complainant's SHOPIFY Trademarks at the time of registration and use of the Disputed Domain Name. The Panel is convinced that the Respondent had the Complainant and its SHOPIFY Trademarks in mind when registering and subsequently using the Disputed Domain Name. The Panel concludes that the Disputed Domain Name was registered and is being used for the purpose of misleading Internet users.

For all the reasons set out above, the Panel concludes that the Disputed Domain Name was registered and is being used in bad faith within the meaning of 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 that: the Complaint is accepted and that the Disputed Domain Name <shopifydesignpro.com> is to be transferred to the Complainant, Shopify Inc.

Made as of June 29, 2025

SIGNATURE OF PANEL



Bart Van Besien

