



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

CIIDRC case number:	22089-UDRP	Decision date:
Domain Name:	shopifyinc.com	
Panel:	David L. Kreider	
Complainant:	Shopify Inc.	
Complainant's representative:	Daniel M. Anthony of Smart & Biggar	
Respondent:	Carolina Rodrigues / Fundacion Comercio Electronico	

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 December 6, 2023, counsel for the above-named Complainant filed a Complaint under the UDRP and the UDRP Rules.
2. On December 6, 2023, the Registrar of the disputed domain name **<shopifyinc.com>** (the "Domain Name") was notified of this proceeding.
3. On December 7, 2023, the Registrar, GoDaddy.com LLC, transmitted by email to CIIDRC its verification response informing who is the Registrant, Respondent, in this administrative proceeding. The Registrar also confirmed that the Domain Name was placed on a Registrar LOCK.
4. On December 8, 2023, CIIDRC, as Service Provider, confirmed compliance and commencement of the dispute resolution process.

5. Under UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice to the Respondent on December 8, 2023, via email.
6. The deadline for response was set as December 28, 2023. No response was received by the deadline or since.
7. The Complainant in this administrative proceeding has elected for a Panel consisting of a single member.
8. CIIDRC appointed the undersigned, David L. Kreider, Chartered Arbitrator (UK), as a single-member Panel in the above-referenced matter, who submitted a Statement of Acceptance and Declaration of Impartiality and Independence to CIIDRC on January 6, 2024.
9. Absent exceptional circumstances, and under Rule 15 (b), the Panel's decision is due by January 26, 2024.

The Domain Name was registered on March 4, 2019.

This matter is conducted under 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

Headquartered in Ottawa, Canada, the Complainant, Shopify Inc. ("Complainant" or "Shopify"), was established in September 2004. Under its registered trademark SHOPIFY (the "Mark"), including among them Canadian Registration No. TMA787767 (filed on October 22, 2009, and registered on January 18, 2011), and United States Trademark Registration No. 38404212 (filed on November 12, 2009, and registered on August 31, 2010), the Complainant operates, "the world's leading cloud-based e-commerce platform designed for small and medium-sized businesses". Shopify is among the five (5) largest publicly traded Canadian companies by market capitalization, employing over 10,000 people across the globe and offering its services through its official websites via its domains "shopify.com" and "shopify.ca".

The Complainant avers that the Respondent registered the Domain Name in bad faith to impersonate the Complainant and confuse Internet users.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

The Complainant submits that "shopify" is a coined and invented word, and not a word traders would legitimately use unless seeking to create an impression of an association with the Complainant. As a coined and invented term, therefore, the registered Mark is deserving of the highest level of protection. Given the

strength of the SHOPIFY Mark, moreover, the inclusion of “inc” in the Domain Name does nothing to distinguish the Domain Name from the Complainants registered Mark.

The Complaint alleges that the Respondent has no authorization, rights, or legitimate interests in the Domain Name. The Respondent’s incorporation of “shopify” into the Domain Name was always without the Complainant’s permission or authorization. The Domain Name <shopifyinc.com>, redirects visitors to the Complainant’s official website, hosted at “shopify.com”. The Complainant avers that the Respondent registered the Domain Name in bad faith to impersonate the Complainant and confuse Internet users.

- **Respondent**

The Respondent failed to submit a response to the Complaint timely, or at all.

- **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 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 Domain Name <shopifyinc.com> incorporates the Complainant’s registered SHOPIFY Mark as its dominant feature. Adding the three letters “inc” does nothing to distinguish the domain name from the Mark. Rather, the Complainant avers, the inclusion of the term “inc” serves to increase the likelihood for confusion with the Complainant’s registered Mark because, taken as a whole, “shopifyinc.com” incorporates, *verbatim*, the official business name of the Complainant, “Shopify Inc.”. It is well-established in UDRP jurisprudence that, where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the

relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for UDRP standing. WIPO Overview 3.0, par. 1.7.

The Complainant's rights in the registered Mark are shown by registration certificates for the Mark held by it and submitted as evidence in these proceedings. Where, as here, the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. WIPO Overview 3.0, par. 1.2.1. Further, the Respondent has not submitted a response to the Complaint or sought to refute the Complainant's claims which the Panel accepts are true.

The Panel finds that the Claimant has proven the first element at Policy Paragraph 4(a)(i).

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

The Complainant alleges that the Respondent is not affiliated with Shopify and did not receive the Complainant's permission to incorporate "shopify" as part of the Domain Name; to point the Domain Name to the Complainant's official website; or otherwise, to impersonate the Complainant. The Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name but is infringing the Complainant's well-known Mark and impersonating the Complainant.

Where, as here, 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. If the respondent fails to do so, the complainant is deemed to have satisfied the second element.

The Respondent has not submitted a response to the Complaint or sought to refute the Complainant's claims which the Panel accepts are true.

The Panel finds that the Claimant has proven the second element at Policy Paragraph 4(a)(ii).

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

The Complainant notes the *possibility* that the Domain Name could be used for purposes of phishing schemes or other wrongful purposes, arguing: "There is a strong suspicion that the domain will be used to conduct phishing scams on the Complainant's customers or some other bad faith purpose". The Panel notes, however, that the Complainant offers no evidence of any such activities by the Respondent.

The Complainant argues persuasively, however, that there is no conceivable good faith use to which the Domain Name, which wholly incorporates its registered SHOPIFY Mark, could possibly be put.

In this regard, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith, including specifically where a respondent redirects a domain name to the complainant's (or a competitor's) website. Moreover, a respondent redirecting a domain name to the complainant's website can establish bad faith insofar as the respondent retains control over the redirection, thus creating a real or implied ongoing threat to the complainant. WIPO UDRP Overview 3.0, par. 3.1.4.

In *Securitas AB v. Davina Rodrigues of Valencia, Spain / Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. D2016-0890 regarding the domain name, <centralsecuritas.com>, the panel found on similar facts:

“At the time of filing of the Complaint, the disputed domain name was diverted to the Complainant's official website. This Panel agrees with the majority of the UDRP Panels that such use or nonuse of a disputed domain name is conclusive evidence of bad faith registration and use of that name. See, *CSC Holdings, Inc. v. cablevisionlightpath.com Inc.*, WIPO Case No. D2004-1057 (‘The Panel finds that the Respondent was simply trying to avoid the appearance of bad faith when the domain name at issue automatically redirected to Complainant’s website, “www.lightpath.net”. If ownership of the domain name at issue remains with the Respondent, it can obviously be re-directed to another website of Respondent’s choosing. The Panel cannot conclude that bad faith is not present simply because no measurable harm has yet been done.’); *De Beers UK Limited v. Scott van Iperen*, 14088959380, WIPO Case No. D2016-0167; and *Statoil ASA v. Domains By Proxy, LLC / John Brendon, supra.*”

Adopting the line of reasoning expressed in *Securitas AB v. Davina Rodrigues et al.* and the above-cited UDRP decisions, the Panel finds the Complainant’s evidence of the Respondent’s bad faith registration and use of its SHOPIFY Mark conclusive. Moreover, the Respondent has failed to appear and has not sought to challenge the Complainant’s evidence.

The third element at Policy Paragraph 4(a)(iii) is satisfied.

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 Domain Name <shopifyinc.com> be transferred to the Complainant.

Made as of January 10, 2024.

DAVID L. KREIDER



