



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

CIIDRC case number:	23061-UDRP	Decision date: May 18, 2024
Domain Name:	shopify.reviews	
Panel:	David L. Kreider	
Complainant:	Shopify Inc.	
Complainant's representative:	Daniel Anthony of Smart & Biggar LLP	
Respondent:	Paul Marzolla	

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 19, 2024, Daniel Anthony, counsel for the above-named Complainant filed a Complaint pursuant to the UDRP and the UDRP Rules.
2. On April 22, 2024, the Registrar of the disputed domain name was notified of this proceeding.
3. On April 23, 2024, the Registrar transmitted by email to CIIDRC its verification response informing who is the Registrant, Respondent, in this administrative proceeding. The Registrar also confirmed that the domains were placed on a Registrar LOCK.
4. The Complainant was advised of the registrant information on April 23, 2024. The Complainant declined to amend the Complaint.

5. On April 24, 2024, CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.
6. On April 24, 2024, pursuant to UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice of Complaint to the Respondent.
7. The deadline for a response was set as May 14, 2024. No response was received by the deadline or since.
8. The Complainant in this administrative proceeding has elected for a Panel consisting of a single member.
9. In accordance with Rule 5 (d), CIIDRC appointed the undersigned, David L. Kreider, as a single member Panel in the above-referenced matter, who completed and returned to CIIDRC a statement of acceptance and declaration of impartiality and independence.
10. Absent exceptional circumstances, and pursuant to Rule 15 (b), the decision is due by May 31, 2024. CIIDRC will communicate the full text of the decision to the parties and the concerned Registrar.

The Domain Name was registered on February 17, 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

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”.

Shopify avers that the Respondent, Paul Marzolla of Fort Lee, New Jersey, USA, has no authorization, rights, or legitimate interests in respect of the Domain Name and that the Respondent registered the Domain Name in bad faith to attract Internet traffic for commercial gain by creating a likelihood of confusion with the Complainant’s well-known Mark.

The Respondent failed to submit a response to the Complaint timely, or at all, and has not sought to challenge or refute the Complainant’s claims.

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 the generic Top-Level Domain (“gTLD”) “REVIEWS” in the Domain Name does nothing to distinguish the Domain Name from the Complainant’s 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 <shopify.reviews>, redirects internet users to a different Respondent-owned website, <fundingpilot.com>, purporting to provide “startup business loans”, business lines of credit, secured business loans, and real estate loans.

- **Respondent**

The Respondent failed to submit a response to the Complaint.

- **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

The Panel finds that the Complainant enjoys registered rights in and to the SHOPIFY Mark which pre-date the registration of the Domain Name.

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

The Domain Name comprises the Complainant's registered SHOPIFY Mark, standing alone. It is well-established in UDRP jurisprudence that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for UDRP standing purposes. *WIPO Overview 3.0*, par. 1.7. Accordingly, the Panel finds that the Domain Name is identical to the Mark.

Except in relatively rare circumstances where the applicable gTLD itself forms part of the relevant trademark (which is not the case here), the gTLD satisfies an administrative requirement and may be disregarded for purposes of determining confusing similarity or identity.

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 Rights or Legitimate Interests in respect of the Domain Name

The Domain Name redirects internet users to a website, <fundingpilot.com>, purporting to provide "startup business loans", business lines of credit, secured business loans, and real estate loans. The Respondent's use of the Mark is without the Complainant's authorisation or permission. Furthermore, there is no evidence that the Respondent, Paul Marzolla, has ever been commonly known by the Domain Name.

The Complainant alleges that the Domain Name is being used by the Respondent to redirect traffic to its Funding Pilot website and not for any legitimate non-commercial or fair use without intent for commercial gain.

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 Registration and Use of the Domain Name in Bad Faith

The Panel finds that the Respondent has registered and is using the Domain Name in bad faith intentionally to attract, for commercial gain, internet users to the Respondent's Funding Pilot website, 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 of a product or service on the website, and by re-directing internet users seeking to find SHOPIFY products or services on the internet to the Respondent's Funding Pilot website.

The Respondent's use of the "REVIEWS" gTLD enhances and promotes misdirection and the likelihood of confusion because internet users seeking third-party "reviews" of the Complainant's products or services via the Domain Name will be misdirected to the Respondent's Funding Pilot website which contains no reviews of any sort.

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 <shopify.reviews> be transferred to the Complainant.

Made as of May 18, 2024

SIGNATURE OF PANEL



