

## **ADMINISTRATIVE PANEL DECISION**

Shopware AG v. Ritesh Jhamnani  
Case No. D2023-4016

### **1. The Parties**

Complainant is Shopware AG, Germany, represented by Jonas Rechtsanwaltsgesellschaft mbH, Germany.

Respondent is Ritesh Jhamnani, India, represented by MAK LAW Firm, India.

### **2. The Domain Name and Registrar**

The disputed domain name <shopwarenet.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 26, 2023. On September 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (unknown) and contact information in the Complaint. The Center sent an email communication to Complainant on September 27, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on September 29, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on October 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2023. The Response was filed with the Center on October 25, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on November 22, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

### *Supplemental filing*

The Complaint was filed on September 26, 2023 and Complainant filed on November 17, 2023 a Supplemental Filing, rebutting Respondent's response.

Neither the Rules nor the Supplemental Rules make provision for supplemental filings, except at the request of the UDRP panel (see Rules, paragraph 12). Paragraph 10 of the Rules enjoins the UDRP panel to conduct the proceeding "with due expedition". Therefore, UDRP panels are typically reluctant to countenance delay through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not reasonably have been anticipated (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)", section 4.6).

The Panel notes that Complainant's supplemental filing addresses Respondent's arguments submitted in the Response, some of which arguably could not have been anticipated by Complainant at the time of the submission of its Complaint. In this case, after consideration of Complainant's supplemental submissions the Panel has decided to accept them for the sake of completeness, also noting that to some extent they do not address topics that Complainant could have addressed in its Complaint, and considering the matters raised in the Response (*Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. [D2001-1447](#); *AutoNation Holding Corp. v. Rabea Alawneh*, WIPO Case No. [D2002-0058](#); and *Avaya Inc. v. Ali Parsa / Ali Parsa, AVAYeRASA / Ali Parsa Koosha*, WIPO Case No. [D2018-1472](#)).

## **4. Factual Background**

Complainant is the provider of "Shopware", a leading digital commerce system used by some of the largest brands, retailers and manufacturers across B2C, D2C and B2B industries, generating a Gross Merchandise Value (GMV) of more than USD 20 billion. In addition to its headquarters in Schöppingen, Germany, and its office in New York City, United States of America, Complainant employs 400 people and relies on a global network of 1,200 sales, technology and solution partners. It has hundreds of thousands of members and gives customers access to over 5,000 extensions and certified professional support.

Complainant owns trademark registrations for SHOPWARE, including:

- European Union Trademark Registration No. 7 290 414, SHOPWARE (word), filed on October 7, 2008 and registered on April 20, 2009, for services in international classes 35, 38 and 42;
- European Union Trademark Registration No. 18 304 630 SHOPWARE (figurative), filed on September 8, 2020 and registered on February 25, 2021, for goods and services in international classes 9, 35, 38, 41, 42 and 45;
- International Trademark Registration No. 1 606 186 SHOPWARE (word), registered on March 8, 2021 for goods and services in classes 9, 35, 38, 41 and 42, 45, designating *inter alia* India;
- International Trademark Registration No. 1 606 107, Complainant's logo, registered on March 8, 2021 for goods and services in classes 9, 35, 38, 41 and 42, 45, designating *inter alia* India; and
- International Trademark Registration No. 1 606 246, SHOPWARE (figurative), registered on March 8, 2021 for goods and services in classes 9, 35, 38, 41 and 42, 45, designating *inter alia* India.

Complainant is also the owner of the domain name <shopware.com> where it maintains its main website.

The Domain Name was registered on May 5, 2023 and at the time of filing of the Complaint lead to a website (the "Website") prominently displaying Complainant's trademarks and logo and presenting itself as "the Shopware Experts" namely a team of "experienced Shopware developers". The Website states in the "About Us" section that "At Shopware Experts we are dedicated to delivering exceptional Shopware software development services" and "We specialize in Shopware development", while the copyright notice at the bottom of the page reads "- © Shopware 2023".

Currently the Domain Name leads to an inactive website.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

### **B. Respondent**

The Respondent contends that Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

Respondent submits that it is a reputable software company situated at Logix Cyber Park, Plot No C-28/29, Tower B, 9th Floor, Sector 62, Noida 201301, India, and is engaged in Web Designing, Development and Marketing Services. Respondent does not submit any evidence for this activity. He states that per Annex 8 of the Complaint, Respondent used the Domain Name for SEO purposes and conducting a detailed analysis to identify the optimal solutions and features needed for the online businesses. He claims that the services offered by the Respondent are not identical in nature to that of Complainant.

Respondent further asserts that he was unaware of Complainant's trademark and that there is no trademark "shopware" of Complainant registered in India and that Respondent purchased the Domain Name "with due diligence and a clear understanding that no such Trademark exists in India".

Respondent states further that the Domain Name was filed with "genuine intentions to use it for legitimate, official purposes". He states that the website of the Respondent concerns services which are "specifically related to SEO and design and development".

Respondent offers to transfer the Domain Name to Complainant against "USD 500 inclusive of maintenance amount and the attorney fee hired for handling the said complaint", which Complainant denied.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered or is being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “net”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The generic Top-Level Domain (“gTLD”) “.com” is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

Based on the available record, the Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record and the arguments put forward by Respondent, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

As per Complaint, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolved at the time of filing of the Complaint to the Website, which suggested falsely that it is of an affiliated entity or an authorized partner of Complainant.

Per Complaint, Respondent is not an affiliated entity or an authorised partner of Complainant and no agreement, express or otherwise, exists allowing the use of Complainant’s trademarks on the Website and the use of the Domain Name by Respondent.

The Domain Name falsely suggested that the Website is an official site of a partner of Complainant or of an entity affiliated to or endorsed by Complainant. The Website extensively reproduced, without authorization by Complainant, Complainant’s trademarks and logo, without any disclaimer of association (or lack thereof) with Complainant. On the contrary, the copyright notice mentioned Complainant’s trade name.

The above, along with the fact that the Domain Name was registered with a privacy shield service at the time of filing of the Complaint, speaks against any rights or legitimate interests held by Respondent (*Ann Summers Limited v. Domains By Proxy, LLC / Mingchun Chen*, WIPO Case No. [D2018-0625](#); *Carrefour v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#)).

Respondent's statement that no rights of Complainant existed in India does not change the above, not only because as Complainant demonstrated Complainant had trademark rights in India at the time of registration of the Domain Name but also because per the Policy, for Complainant to bring a Complaint it is not required that it has trademark rights in the country of the Respondent (see [WIPO Overview 3.0](#), section 1.1.2).

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. As per Complaint, Complainant's SHOPWARE trademark was used and registered at the time of registration of the Domain Name. Therefore the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)). This is confirmed by the content of the Website which expressly referred to Complainant's SHOPWARE software and used Complainant's trademark logo and colours.

As regards bad faith use of the Domain Name, Complainant has demonstrated that the Domain Name was used to resolve to the Website, which prominently displayed Complainant's registered trademarks and logos, thereby giving the false impression that it was operated by Complainant, or a company affiliated to Complainant or an authorised partner of Complainant. The Domain Name was therefore used to intentionally create a likelihood of confusion with Complainant's trademark and business as to the source, sponsorship, affiliation, or endorsement of the website it resolves to. This can be used in support of bad faith registration and use (*Booking.com BV v. Chen Guo Long*, WIPO Case No. [D2017-0311](#); *Ebel International Limited v. Alan Brashear*, WIPO Case No. [D2017-0001](#); *Walgreen Co. v. Muhammad Azeem / Wang Zheng, Nicenic International Group Co., Limited*, WIPO Case No. [D2016-1607](#); *Oculus VR, LLC v. Sean Lin*, WIPO Case No. [DCO2016-0034](#); and [WIPO Overview 3.0](#), section 3.1.4).

Last, the Panel considers the apparent initial concealment of the Domain Name holder's identity through use of a privacy shield at the time of filing the Complaint, all to be further indicative of bad faith (*BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#)).

The argument of Respondent that Complainant has no trademark rights in India is factually incorrect, the Panel notes that Complainant had trademark rights in India at the time of registration of the Domain Name, and those trademark rights continue to be valid at the time of drafting the decision.

Furthermore, the argument of Respondent that he performed a due diligence and found no trademarks of Complainant in India, therefore he was acting in good faith, is also not convincing because of the existence of such rights of Complainant in India, the operation of Complainant's main website on the Internet under a very similar domain name namely <shopware.com>, and also because of the direct reference of

Complainant's goods, trademarks and logos on the Website, which shows Respondent's clear knowledge of Complainant and its business.

As regards the argument of Respondent that the services he offers are different, this again does not change the Panel's findings, since the Website makes clear reference to Complainant's products and presents Respondent as providing services in relation to such products.

The Domain Name currently leads to an inactive website. The non-use of a domain name would not prevent a finding of bad faith (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Based on the available record, the Panel finds that Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <shopwarenet.com> be transferred to Complainant.

*/Marina Perraki/*

**Marina Perraki**

Sole Panelist

Date: December 6, 2023