

## **ADMINISTRATIVE PANEL DECISION**

Shopify Inc. v. Domains By Proxy, LLC / Asel Dzhumashova, 444 Internet Marketing LTD

Case No. DNL2024-0022

### **1. The Parties**

The Complainant is Shopify Inc., Canada, represented by Smart & Biggar LP, Canada.

The registrant of the disputed domain name is Domains By Proxy, LLC. The effective domain name user and party in interest in these proceedings is Asel Dzhumashova, 444 Internet Marketing LTD, Kyrgyzstan (the "Respondent").

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

The disputed domain name <shopify-help.nl> is registered with SIDN through GoDaddy.com.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 7, 2024. On May 8, 2024, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name.

On May 13, 2024, SIDN transmitted by email to the Center its verification response confirming that Domains By Proxy, LLC is listed as the registrant and providing the contact details.

On May 14, 2024, the registrar in its turn transmitted by email to the Center further information about the effective domain name user and party in interest in these proceedings.

The Center sent an email communication to the Complainant on June 3, 2024, providing the information disclosed by SIDN and the registrar, and inviting the Complainant to amend the Complaint in this light. The Complainant filed an amended Complaint on June 4, 2024.

The Center verified that the Complaint as amended satisfies the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the "Regulations").

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the registrant of the disputed domain name and the effective domain name user and party in interest in these proceedings of the Complaint and the proceedings commenced on June 5, 2024. In accordance with the Regulations, article 7.1, the due date for Response was June 25, 2024. The Center did not receive any response apart from an email request from the Respondent on June 4, 2024 (see paragraph 5.B below). Accordingly, the Center notified the Respondent's default on June 27, 2024.

The Center appointed Alfred Meijboom as the panelist in this matter on July 3, 2024. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

#### **4. Factual Background**

The Complainant was founded on September 28, 2004, and is a cloud-based e-commerce platform, which offers software for use by merchants to run business across all sales channels, including web, tablet and mobile storefronts, social media storefronts, and brick-and-mortar pop-up shops. The Complainant is among the five largest publicly traded Canadian companies by market capitalization and employs over 10,000 people across the globe.

The Complainant is owner of many trademark registrations for SHOPIFY, including:

- European Union trademark SHOPIFY with registration number 008727083 of July 29, 2010, for, inter alia, computer software and installing webpages on the Internet; and
- European Union trademark SHOPIFY with registration number 014499156 of March 26, 2017, for, inter alia, web-based services and computer software for use in e-commerce.

The Complainant offers its services through various websites, including those accessible through the domain names <shopify.com> and <shopify.ca>.

The disputed domain name was registered on February 25, 2022, and resolves to a website in Dutch and English which offers maintenance, management and technical development of Shopify websites. The website homepage notably displays the Complainant's trademark SHOPIFY in green, and the website disclosed that the services are offered by "a Dutch team based in Bishkek, Kyrgyzstan" for which reasons it claims to be able "to offer very competitive rates". The website introduces an individual Marco Bannink as the "team leader" and provides full contact details.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's SHOPIFY trademarks, which it incorporates entirely. According to the Complainant the second portion of the disputed domain name, "-help", is merely a descriptive term which does not add any distinctiveness to the disputed domain name, but merely describes how the Respondent offers services to "help" people set up their Shopify websites or manage their Shopify stores.

The Complaint alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name because 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, but rather leads to a webpage purposefully designed to suggest an affiliation with the Complainant, and the Respondent is not affiliated with the Complainant, nor was the Respondent authorized to use the Complainant's SHOPIFY trademarks in the disputed domain name or on its webpage. The Complainant further contends that there is

no evidence that the Respondent has been commonly known as the disputed domain name as the Respondent's website demonstrates that "Shopify" in the disputed domain name is a direct reference to the Complainant, as it promotes itself as "professional Shopify expert" and "Shopify developers".

According to the Complainant, the disputed domain name was registered in bad faith because the evidence shows that the Respondent deliberately chose to register the disputed domain name to attract Internet users to its website where it can sell its "Shopify" website development services by confusing them with the disputed domain name. The Complainant alleges that the Respondent is entitled to provide its "Shopify" store development services online, but it is not entitled to use the Complainant's SHOPIFY trademarks in a confusing manner to attract traffic to its website to allow the Respondent to sell its development services, which therefore constitutes use of the disputed domain name in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. The Respondent did, however, send an e-mail to the Center on June 4, 2024, which reads "Please put the domain then in my husband's name Marco Bannink [...] We have lost so much time already. He is a Dutch national." And on July 3, 2024, the Respondent sent an email to the Center reading "People i have no idea what this all is. We already give up this domain."

## **6. Discussion and Findings**

As the Respondent has not filed a response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the panelist considers it to be without basis in law or in fact.

The Panel notes that, in accordance with article 16.4 of the Regulations, the Center has fulfilled its obligation to employ reasonably available means to achieve actual notice of the Complaint to the Respondent. Based on article 2.1 of the Regulations, a request to transfer the disputed domain name must meet three cumulative conditions:

- (a) the disputed domain name is identical or confusingly similar to:
  - i. a trademark, or trade name, protected under Dutch law in which the complainant has rights; or
  - ii. a personal name registered in the General Municipal Register ('gemeentelijke basisadministratie') of a municipality in the Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in the Netherlands under which the complainant undertakes public activities on a permanent basis; and
- (b) the Respondent has no rights to or legitimate interests in the disputed domain name; and
- (c) the disputed domain name has been registered or is being used in bad faith.

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

With regard to the assessment of identity or confusing similarity, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")<sup>1</sup>). It is also well established precedent that the Top-Level

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<sup>1</sup> In view of the fact that the Regulations are substantially similar to the Uniform Domain Name Dispute Resolution Policy ("UDRP"), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore [WIPO Overview 3.0](#),

Domain “.nl” may be disregarded in assessing identity or confusing similarity between the trademark on the one hand and the disputed domain name on the other hand (see, e.g., *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. [DNL2008-0008](#)).

Applying the criteria of article 2.1 of the Regulations, and finding that the Complainant’s European Union trademarks SHOPIFY as identified above in paragraph 4 are trademarks protected under Dutch law, the Panel finds that the disputed domain name incorporates the Complainant’s SHOPIFY trademarks in its entirety, with the mere addition of “-help”, which addition does not prevent a finding of confusing similarity under the Regulations.

Consequently, the Panel finds that the requirement of article 2.1(a) of the Regulations has been satisfied.

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

Article 2.1(b) of the Regulations requires the Complainant to demonstrate that the Respondent has no rights to or legitimate interests in the disputed domain name. This condition is met if the Complainant makes out a prima facie case that the Respondent has no such rights or legitimate interests and if the Respondent fails to rebut this (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd.*, WIPO Case No. [DNL2008-0002](#)).

The Complainant put forward that the Respondent was not authorized to use the SHOPIFY trademarks in the disputed domain name and has not been commonly known by the disputed domain name, which the Respondent has not refuted.

However, the disputed domain name resolves to a website which seem to offer genuine services in connection to the Complainant’s software, and the Complainant has not argued otherwise. On the contrary, the Complainant acknowledged that the Respondent is “naturally (..) entitled to provide their Shopify store development services online.” In this respect, “panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name” (section 2.8.1 of the [WIPO Overview 3.0](#)). The Panel therefore needs to determine if the disputed domain name complies with the so-called *Oki Data* criteria. In *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “Oki Data decision”), the panel set out four criteria in which an authorized sales or service agent of trademarked goods may use the trademark at issue in its domain name. This decision has been confirmed to be of relevance for the Regulations (e.g., *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. [DNL2010-0024](#), *Maison Louis Latour v. Jos Beeres Wijnkoperij*, WIPO Case No. [DNL2011-0074](#), and *Separett AB v. Ecosave*, WIPO Case No. [DNL2022-0012](#)). The Panel notes that these considerations equally apply to a situation involving an unofficial service supplier in relation to genuine products, which the Respondent appears to be. The essential issue addressed by the Oki Data decision is whether, in such circumstances, there is a bona fide offering of relevant goods or services, and an absence of any associated deception.

To resolve this issue, the Oki Data decision provides the following cumulative criteria:

1. the respondent must actually be offering the goods or services under the trademark; and
2. the respondent must only be offering those goods or services; and
3. the respondent must not try to take all of the relevant domain names so as to deprive the trademark owner of the ability to register its trademark as a domain name; and
4. the website must accurately describe the relationship between the respondent and the trademark owner.

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may be relevant to the determination of this proceeding (see, e.g., *LEGO Juris A/S v. Stichting RIBW ZWWF*, WIPO Case No. [DNL2011-0042](#) and *Arie Hendrik den Draak v. RAPIDE Internet*, WIPO Case No. [DNL2019-0013](#)).

In the present case, the decision tilts in the Complainant's favor because the Respondent's website does not describe the Respondent's relationship with the Complainant, for instance by using a disclaimer, and

furthermore refers to the Respondent's "sister website" which, as the Panel understands, offers similar services for Magento – a product that competes with the Complainant's products. The Panel therefore finds that the Respondent failed to meet two elements of the Oki Data test. Moreover, the Panel finds that the composition of the disputed domain name together with the website at the disputed domain name create a risk of Internet user confusion.

Consequently, the Respondent has no rights or legitimate interests in the disputed domain name and the Panel finds that the Complainant has satisfied the requirement of article 2.1(b) of the Regulations.

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

Article 2.1(c) of the Regulations requires the Complainants to show that the disputed domain name was registered or is being used in bad faith.

The Panel finds that the Respondent had the Complainant's SHOPIFY trademarks in mind when it registered the disputed domain name, as the Respondent used the disputed domain name to resolve to a website which offers services in connection to the Complainant's software and, thus, was registered and used to target the Complainant's SHOPIFY trademarks. As the Complainant undisputedly alleged that the Respondent was not authorized to do so and lacked rights or legitimate interests in the disputed domain name, the disputed domain name has been registered and is being used in bad faith.

The Panel is therefore satisfied that the Complainants have met the requirement of article 2.1(c) of the Regulations.

## **7. Decision**

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the disputed domain name <shopify-help.nl> be transferred to the Complainant.

*/Alfred Meijboom/*

**Alfred Meijboom**

Panelist

Date: July 17, 2024