

ADMINISTRATIVE PANEL DECISION

Shopify Inc. v. Sina Esfandyari
Case No. DIR2024-0005

1. The Parties

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

The Respondent is Sina Esfandyari, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <iranshopify.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 30, 2024. On April 3, 2024, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On the same day, IRNIC transmitted by email to the Center its verification 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 the Complainant on the same day, providing the registrant and contact information disclosed by IRNIC, and inviting the Complainants to submit an amendment to the Complaint. The Complainant filed an amendment to Complaint on the same day. Hard copies of the Complaint were received by the Center on April 5, 2024.

The Center verified that the Complaint and the amended Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 8, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was April 28, 2024. The Respondent did not file any response. Accordingly, on April 29, 2024, the Center notified the Respondent’s default.

The Center appointed Andrea Mondini as the sole panelist in this matter on May 1, 2024. 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.

4. Factual Background

The Complainant was founded on September 28, 2004, is headquartered in Ottawa, Canada and is an e-commerce platform designed for small and medium-sized businesses and employs over 10,000 people across the world.

The Complainant holds several domain names containing the term “shopify” and offers its services through various websites, among them those accessible through the domain names <shopify.com> and <shopify.ca>.

The Complainant owns numerous trademark registrations in several jurisdictions, including:

Trademark	Jurisdiction	Registration Number	Registration Date	International Class
SHOPIFY	Canada	TMA787767	January 18, 2011	35, 42
SHOPIFY	United States of America	3840412	August 31, 2010	9
S Shopify & Design	Canada	TMA700694	November 13, 2007	42
S Shopify & Design	United States of America	3208463	February 13, 2007	9, 42

Because the Respondent did not file a Response, not much is known about the Respondent.

The disputed domain name <iranshopify.ir> was registered on July 16, 2017.

According to the evidence submitted with the Complaint, the disputed domain name resolves to a website purporting to provide e-commerce retail services specializing in the import and supply of Android boxes and accessories.

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.

Notably, the Complainant contends as follows:

The disputed domain name is confusingly similar to the SHOPIFY trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, and the addition of the geographical term “Iran” is not sufficient to avoid confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The trademark SHOPIFY has been extensively used to identify the Complainant and its services. The Respondent has not been authorized by the Complainant to use this trademark, is not commonly known by the disputed domain name, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods and services.

The disputed domain name was registered in bad faith because it is obvious that the Respondent had knowledge of both the Complainant and its well-known trademark SHOPIFY at the time it registered the disputed domain name.

The Respondent is using the disputed domain name in bad faith, by operating a website purporting to provide e-commerce retail services and specialising in the import and supply of Android boxes and accessories, thereby creating a likelihood of confusion with the Complainant. The impression created by this website would lead consumers to believe that the Respondent is somehow associated with or authorized by the Complainant, when in fact it is not.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7¹.

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 SHOPIFY is reproduced within the disputed domain name.

Although the addition of a geographic term such as here "Iran" may bear on assessment of the second and third elements, in the present case 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 addition of the Top-Level Domain ("TLD") ".ir" in the disputed domain name is a standard registration requirement and as such may be disregarded under the confusing similarity test under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

¹ Given the similarities between the .IR Policy and Rules and the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules, the Panel finds UDRP precedent generally to be relevant to this case (except to the extent of relevant differences between the policies, such as the absence of a conjunctive requirement for bad faith under the Policy). See *VALEO v. Iman Soltanian*, WIPO Case No. [DIR2023-0001](#).

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 for a complainant to prove that 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, 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 rebutted the Complainant’s prima facie showing and 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. Notably, the unauthorized use of the Complainant’s trademark in combination with the term “Iran” in the disputed domain name and on the Respondent’s website posted thereunder does not constitute a use of the disputed domain name in connection with a bona fide offering of goods and services.

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

C. Registered or 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 or 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.

In the view of the Panel, noting that the Complainant has shown that its trademark SHOPIFY is well known, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant’s well-known trademark. In the circumstances of this case, this is evidence of registration in bad faith.

Moreover, the impression given by the disputed domain name and the website posted thereunder may cause Internet users to believe that the Respondent is somewhat affiliated with or authorized by the Complainant when, in fact, it is not. The Panel holds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website in the sense of Policy, paragraph 4(b)(iv).

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy with regard to the disputed domain name.

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, <iranshopify.ir>, be transferred to the Complainant.

/Andrea Mondini /

Andrea Mondini

Sole Panelist

Date: May 15, 2024