

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Nguyen Minh Duc
Case No. D2022-0429

1. The Parties

The Complainant is Canva Pty Ltd, Australia, represented by SafeNames Ltd., United Kingdom.

The Respondent is Nguyen Minh Duc, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvapro.info> (the “Disputed Domain Name”) is registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2022. On February 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name in which the contact information differed from the listed contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on February 11, 2022.

On February 10, 2022, the Center transmitted another email communication to the Parties in English and Vietnamese regarding the language of the proceeding. On February 11, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on February 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2022. The Respondent did not submit any

response. Accordingly, the Center notified the Respondent's default on March 14, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on March 31, 2022. 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, Canva Pty Ltd, is an online graphic design platform founded in 2012. Users of the Complainant's services have thousands of images and templates to choose from when creating graphic designs, through an "easy-to-use" online platform.

The Complainant uses its main site "www.canva.com" to offer its services, as a basic package, for free, besides offering a paid version named "Canva Pro" with more features and design capabilities. The Complainant's services are offered exclusively online, which is inherently global. Within its first year, the Complainant had 750,000 users and raised USD 3 million in seed funding. According to Similarweb's statistics, the Complainant's website consistently receives over 200 million visits per month.

The Complainant's trademarks CANVA have been registered for design-related goods/services in Classes 9 and 42 in a variety of countries under a number of trademark registrations, including, but not limited to, the Australian trademark No. 1483138 registered on September 9, 2013, United States registration No. 4316655 registered on April 9, 2013, and International trademark registration No. 1204604 registered on October 1, 2013.

The Disputed Domain Name was registered on September 17, 2021. As of the date of this Decision, the Disputed Domain Name resolves to a parked hosting website. However, the Disputed Domain Name used to resolve to an active website using the trademarks CANVA and purporting to sell "Canva Pro" subscriptions.

The Complainant sent a Cease and Desist letter to the Respondent on October 13, 2021, requesting for a transfer of the Disputed Domain Name. However, the Respondent did not respond to the Cease and Desist letter.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

First, the Complainant submits that the Complainant is the registered owner of trademark registrations for CANVA in many jurisdictions. Further, the Complainant contends that its trademarks CANVA have attained goodwill and recognition, as a distinctive identifier associated with the Complainant's services.

Second, the Complainant asserts that the Disputed Domain Name is confusingly similar to the trademarks CANVA owned by the Complainant since the Disputed Domain Name incorporates the Complainant's trademarks CANVA in its entirety, and the addition of the term "pro" is insufficient to avoid confusing similarity. Instead, the term "pro" has direct connotations to the Complainant's "Canva Pro" offering.

Finally, the Complainant argues that the generic Top-Level Domain (“gTLD”) “.info” is disregarded under the first element as it is a standard registration requirement.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant contends that there is no evidence that the Respondent holds any registered or unregistered right to the term “canva” or “canvapro”. Moreover, the Respondent has not received any license from the Complainant to use domain names featuring the CANVA trademarks.

Second, the Complainant argues that there is no evidence that the Respondent has used, or prepared to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Instead, the Respondent has used the Disputed Domain Name to impersonate the Complainant’s commercial offerings under the trademarks CANVA.

Third, the Complainant contends that the Respondent has not ever been known by the trademarks CANVA, nor by “canvapro”, since the Respondent has no connection or affiliation with the Complainant and has not received license or consent to use the trademarks CANVA in any way. The mere ownership of the Disputed Domain Name does not confer rights or legitimate interests on the Respondent.

In addition, the Complainant submits that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks CANVA since (i) the Respondent’s use of the Disputed Domain Name is to impersonate and capitalise on the likelihood of Internet-user confusion with the Complainant’s trademarks CANVA and (ii) the Disputed Domain Name, in respect of its composition, carries a risk of implied affiliation.

Finally, the Complainant contends that the Complainant has presented a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Thus, the burden of production now shifts to the Respondent to show that it has rights or legitimate interests in the Disputed Domain Name.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant submits that its earliest CANVA trademark registration predates the creation date of the Disputed Domain Name by more than 9 years, and the Complainant has accrued substantial goodwill and recognition in its CANVA trademarks.

Second, the Complainant contends that the Respondent should have been aware of the Complainant’s CANVA mark at the time of registration of the Disputed Domain Name since a search on public trademark databases or Internet search engines would have revealed the Complainant’s CANVA trademarks.

In addition, the Complainant submits that the Respondent’s inclusion of the term “pro” to the CANVA trademark in the Disputed Domain Name is further evidence that the Respondent registered the Disputed Domain Name to capitalise on the Complainant’s offerings. Further, the Respondent did not reply to the Complainant’s Cease and Desist letter, which may constitute evidence that it has knowingly acted in bad faith.

Forth, the Complainant submits that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s CANVA trademarks since (i) the Disputed Domain Name comprises entirely the CANVA trademarks and is identical to the name of the Complainant’s “Canva Pro” offering, which clearly carries a risk of implied affiliation with the Complainant’s offerings; and (ii) the website under Disputed Domain Name brandishes a confusingly similar variation of the Complainant’s logo and purports to sell “Canva Pro” subscriptions.

Furthermore, the Respondent has attempted to deceive Internet users, evidently under the pretext of deriving commercial gain, by including information about the Complainant and presenting its copied and

false testimonials. Also, the Respondent's lack of presenting a disclaimer on the website under the Disputed Domain Name amounts to evidence of bad faith under the Policy.

Finally, the Complainant submits that the Respondent's use of the Disputed Domain Name is to impersonate or pass off as the Complainant, which is considered evidence of bad faith.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Procedural Issues:

(I) Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement is Vietnamese.

As the Complaint was filed in English, the Center, in its notification dated February 10, 2022, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding by February 13, 2022.

On February 11, 2022, the Complainant submitted a request that English be the language of the proceeding.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

(i) the fact that the Complainant, an Australian entity, does not appear to be able to communicate in Vietnamese, and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;

(ii) the English language is quite popular in Viet Nam, where the Respondent appears to be located, and the Disputed Domain Name and its associated website contain English content; these suggest that the Respondent has knowledge of the English language and would be able to communicate in English;

(iii) the Respondent did not object for English to be the language of the proceeding, and did not submit a Response in either English or Vietnamese.

Therefore, for the purpose of easy comprehension of the Complainant (ultimately, the Party solely taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

(II) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. D2010-1413, and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The Complainant is required to establish the two following elements: (1) that it has trademark rights, and, if so, (2) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Panel finds that the Complainant has clearly evidenced that it has registered trademark rights to CANVA, well before the Disputed Domain Name was registered.

Second, the Disputed Domain Name comprises the Complainant's CANVA trademarks, in which the Complainant has exclusive rights. The difference between the Disputed Domain Name and the trademark is the addition of the suffix "pro", which is a dictionary English word. However, it is well established that the addition of a term to a trademark does not prevent confusing similarity. Thus, in the Panel's view, the addition of the said term does nothing to prevent the trademarks CANVA from being recognizable in the Disputed Domain Name, nor to prevent confusing similarity, as it was found in previous UDRP decisions (see, e.g., *Price Costco International, Inc. v. Huynh Van Duc*, WIPO Case No. D2020-0321; *Philip Morris Products S.A. v. Ong Nguyen Ngoc Ha*, WIPO Case No. [D2019-2509](#); and *Facebook, Inc. v. Domain Admin Privacy Protect, LLC (PrivacyProtect.org) / Do Viet Dung*, WIPO Case No. [D2019-1121](#)).

Third, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".info" to the Disputed Domain Name does not constitute an element as to avoid confusing similarity for the purposes of the Policy (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. [D2012-2066](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's CANVA trademarks, and the first element of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy, including:

"(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or

services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel finds that the Complainant has made a *prima facie* evidence on that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not refute the Complainant’s contentions.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the disputed domain name (see, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. D2001-0121). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no Response was submitted providing arguments or evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant’s asserted facts, that no license, permission or authorization in any kind to use the Complainant’s trademarks CANVA has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to “canva” or “canvapro”. Thus, the Panel finds that the Respondent has no rights in the trademarks CANVA.

A reseller or distributor may be making a *bona fide* offering of goods or services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“*Ok! Data*”), including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods or services (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the site itself must accurately and prominently disclose the respondent’s relationship with the trademark owner; and
- the respondent must not try to “corner the market” in domain names that reflect the trademark, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, it is proven and evidenced by the Complainant that the Disputed Domain Name used to resolve to a website appearing to sell subscriptions to the Complainant’s paid-for service, “Canva Pro”, as shown in the Annex 15 of the Complaint. Further, the Panel conducted an independent search on “www.web.archive.org” and found that the Disputed Domain Name, at least on November 28, 2021 and December 28, 2021, resolved to such a website. On such website, the Panel finds that the Respondent did not place any statement or disclaimer disclosing accurately and prominently its relationship (or lack thereof) with the Complainant. In addition, such website further contains the Complainant’s CANVA trademarks, logo, name of the paid-for service “Canva Pro”, CEOs’ testimonials, and a copyright notice “2021 All Rights Reserved, Canva Pro”. These indications may mislead consumers into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality.

With such a view, the Panel finds that the use of the Disputed Domain Name does not meet the *Ok! Data* criteria and thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Moreover, the nature of the Disputed Domain Name, consisting of the Complainant's CANVA trademarks and the related term "pro", carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the CANVA trademarks and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's bad faith registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's CANVA trademarks have been registered in a variety of jurisdictions around the world. In addition, the Complainant's CANVA trademarks have been put in use for a number of years and has gained certain reputation in the sector of online graphic design. The Complainant's registration of the CANVA trademarks predates the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the Complainant's CANVA trademarks in its entirety, with the addition of the term "pro". Given the extensive use of the CANVA and "Canva Pro" services by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its CANVA trademarks when it registered the Disputed Domain Name. The Panel considers the registration of the Disputed Domain Name is an attempt by the Respondent as to take unfair advantage of the Complainant's goodwill and the reputation of the Complainant's CANVA trademarks.

It is well proven and evidenced by the Complainant that the website under the Disputed Domain Name used to offer for sale the subscriptions to the Complainant's paid-for service, "Canva Pro". In addition to the adoption of the Complainant's trademarks CANVA as a uniquely distinctive part in the Disputed Domain Name, the Respondent used the Complainant's CANVA trademarks and logo on the website thereunder, and placed some testimonials and the copyright notice "2021 All Rights Reserved, Canva Pro" on the website.

The Panel takes the view that any Internet users seeking to purchase the Complainant's CANVA services would likely mistakenly believe that the Respondent is either connected to or associated with the Complainant, while no such connection exists in fact. The Panel therefore finds 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 trademarks as to the source, sponsorship, affiliation, or endorsement of its website on its website, which is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it resolves to a parked hosting website. However, it does not change the Panel's finding of bad faith of the Respondent.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is established.

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 <canvapro.info> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: April 14, 2022