

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Mauro Higashi, Mauro Kiyoshi, William Aparecido de Souza Santana

Case No. D2023-1519

1. The Parties

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

The Respondents are Mauro Higashi, Mauro Kiyoshi, William Aparecido de Souza Santana, Brazil.

2. The Domain Names and Registrars

The disputed domain name <lucrando-com-canva.com> is registered with Hostinger, UAB.

The disputed domain name <lucrandocomcanva.org> is registered with Hosting Concepts B.V. d/b/a Registrar.eu.

The disputed domain name <lucrandocomcanva.website> is registered with Tucows Inc. (the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On April 6, 2023, April 7, 2023 and April 10, 2023, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondents (Whois Privacy Protection Foundation, Domain Admin, Redacted for Privacy) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 13, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on April 18, 2023.

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 Respondents of the Complaint, and the proceedings commenced on April 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on May 10, 2023.

The Center appointed John Swinson as the sole panelist in this matter on May 15, 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.

4. Factual Background

The Complainant was founded in 2012 and operates a popular online graphic design platform. Users of the Complainant's services have many images and templates to choose from when creating graphic designs. The Complainant's services are offered exclusively online and are available globally in approximately 100 languages.

The Complainant owns a portfolio of trademark registrations including Australian trademark registration number 1483138 for CANVA that has a registration date of March 29, 2012; and Brazilian trademark registration number 914660462 for CANVA that has a registration date of April 30, 2019.

The Complainant concerns three disputed domain names, that were registered on the following dates:

<lucrandocomcanva.org> - July 4, 2022 (called "First DDN" below)

<lucrandocomcanva.website> - April 2, 2022 (called "Second DDN" below)

<lucrando-com-canva.com> - June 18, 2022 (called "Third DDN" below)

The Respondents did not file a response, so little information is known about the Respondents. According to the Registrars' records, the Respondents all have addresses in San Paulo, Brazil.

The term "lucrando" in each of the disputed domain names is Portuguese for "profit" or "gain".

The Complainant sent two letters to the Respondents, including a detailed cease-and-desist letter in October 2022, but no response was received to these letters.

At the time of filing the Complaint, the First DDN resolved to a website that sold courses regarding how to use the Complainant's Canva system. The website suggested that a person who took such a course could then earn money as a graphic designer. The website included the Complainant's CANVA mark in a similar logo format to that used by the Complainant.

At a time prior to the filing the Complainant, the Second DDN had content that was similar to that of the website at the First DDN. At the time the Complaint was filed, the Second DDN did not resolve to an active website.

At one time, the Third DDN redirected to the website at the First DDN. At the time the Complaint was filed, the Third DDN did not resolve to an active website.

At the present time, the First DDN resolves to a pay-per-click website, and the Second DDN and the Third DDN do not resolve to an active 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 names.

Notably, the Complainant contends that the Complainant currently has more than 100 million active users per month (MAUs) with customers across 190 countries, and as a result, the Complainant's services have achieved significant reputation and acclaim.

The Respondent has not been licensed by the Complainant to use domain names that feature its CANVA trademark and, to the best of the Complainant's knowledge, the Respondents do not have trademark rights in "canva" or "lucrando". There is no plausible reason for the registration of the disputed domain names other than to take advantage of the goodwill and valuable reputation attached to the CANVA brand, as the Respondents have no connection or affiliation with the Complainant and has not received any license or consent to use the mark in any way.

The Complainant submits that the Respondents have clearly registered the disputed domain names to target the Complainant's brand intentionally. It is inconceivable to believe the Respondents have chosen to register the disputed domain names, which has no descriptive or generic meaning, for any reason other than to target the Complainant's trademark.

B. Respondents

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The *onus* of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that (i) at one time, the websites at the First DDN and the Second DDN had similar content; (ii) at one time, the Third DDN diverted traffic to the website at the First DDN, and (iii) the Respondents all provided the Registrars with addresses in the same area of San Paulo, Brazil, with two of the addresses being the same.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

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 1.7.

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 names. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, for example, "com" and "lucrando") may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

While 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 often-impossible 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. 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names.

At one time, the websites at two of the disputed domain names offered courses regarding use of the Complainant's products. This does not constitute a *bona fide* offering of goods or services, since the Respondent attempts to imply an affiliation with the Complainant based on the nature of the disputed domain names, which are confusingly similar to the Complainant's CANVA mark, and purport to sell CANVA courses, which are part of the Complainant's offerings and compete with the Complainant's services. Previous panels have found using a domain name wholly incorporating the complainant's mark and selling services in relation to the complainant cannot constitute a *bona fide* offering of goods or services (see, for example, *AB Electrolux v. Alexander Kleshchin*, WIPO Case No. [D2022-4515](#)).

The websites at the disputed domain names are now inactive or resolve to a pay-per-click advertising page. This does not constitute a *bona fide* offering of goods or services for the purposes of the second element of the Policy.

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.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the current non-use of two of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of two of the disputed domain names does not prevent a finding of bad faith under the Policy.

In the present case, the Panel further notes that two of the disputed domain names resolved to websites prominently displaying the Complainant's mark and offering services in relation to the Complainant's CANVA system. This indicates that the Respondent was clearly aware of the Complainant and its CANVA mark when registering the disputed domain names, and that the Respondent was seeking to cause confusion for the Respondent's commercial benefit or has an intent to profit in some fashion from the Complainant's trademark.

Based on the available record, the Panel finds the third element of the Policy has been 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 names <lucrendo-com-canva.com>, <lucrendocomcanva.org> and <lucrendocomcanva.website> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: May 28, 2023