

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Tuan Dang
Case No. D2023-2672

1. The Parties

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

The Respondent is Tuan Dang, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvapro150k.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2023. On June 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 22, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 28, 2023, 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 on June 29, 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 sent notification to the Respondent of the Complaint, and the proceedings commenced on July 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 30, 2023. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent’s default on August 25, 2023.

The Center appointed Petra Pecar as the sole panelist in this matter on August 31, 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, established in 2012, is an online graphic design platform. With a valuation of USD 40 billion as of September 2021, it serves over 100 million monthly users across 190 countries.

The Complainant's main website attracts 400 million visits each month. The Complainant offers both a free version and a premium "Canva Pro" variant with advanced features. Introduced in 2014, their mobile app has garnered over 100 million downloads on Google Play. Catering to users in approximately 100 languages. The Complainant also runs a design school.

The Complainant is the holder of several marks for CANVA, including:

- United States of America Registration CANVA No. 4316655, registered on April 9, 2013, for services in Class 42;
- International Registration CANVA No. 1204604, registered on October 1, 2013 for several jurisdictions, including China, European Union, Mexico and Russian Federation (the), for goods in Class 9; and
- International Registration CANVA No. 1429641, registered on March 16, 2018 for several jurisdictions, including India, Japan, and Türkiye, for goods and services in Classes 9,40 and 42.

The Complainant holds several domain names consisting of CANVA mark across both generic Top-Level Domains ("gTLD") and country-code Top-Level Domains, including <canva.biz>, <canva.club>, <canva.co.in>, <canva.fi>, <canva.us>, and <canva.cn>.

The disputed domain name was registered on February 11, 2023 and resolved to a website that displayed the CANVA mark, and an offer of a lifetime access to the Complainant's "Canva Pro" product.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has registered marks for the term "CANVA" across various jurisdictions and that the brand has pronounced reputation and recognition in the marketplace. The Complainant has built a significant following on social media, boasting millions of followers and subscribers. The Complainant actively promotes its services using the CANVA mark, especially on platforms like Facebook, Instagram, Twitter, and Pinterest. Strong recognition identifies CANVA as a unique mark of the Complainant's products and services. Previous UDRP panels found that disputed domain names that have incorporated the CANVA mark have been deemed to be confusingly similar to the Complainant's CANVA mark, which can be observed in prior cases such as *Canva Pty Ltd v. Jose de Souza Silva*, WIPO Case No. [D2022-1316](#), and *Canva Pty Ltd v. Domain Admin, Domain Whois Protection Service / Ho Quoc Huan*, WIPO Case No. [D2022-1798](#).

The Complainant contends that the disputed domain name incorporates the mark CANVA in its entirety, followed by the descriptors "pro" and "150k". Established views indicate that domain names of this nature are commonly considered confusingly similar to the registered mark. The Complainant further argues that the introduction of supplementary terms to a domain name does not negate its confusing similarity, particularly when the mark remains recognisable. The term "canva pro" in the disputed domain name aligns with the Complainant's premium service offering, "Canva Pro". The Complainant states that the ".com" gTLD in the disputed domain name should be disregarded, deeming it a registration component that should not be a factor in the evaluation of confusing similarity.

The Complainant asserts that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not registered marks such as "canva" and does not possess the Complainant's license to use the CANVA mark in domain names. The disputed domain name use by the Respondent

seems to advertise the Complainant's Canva Pro service without any authorization, which goes against the Complainant's policies. The Complainant points out that the Respondent appears to misuse the CANVA brand and has not been associated with the disputed domain name or CANVA mark in any recognized manner. The Complainant contends that the disputed domain name may deceive users into believing there is an association with the Complainant.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith. The CANVA mark of the Complainant predates the disputed domain name registration by over 10 years. Public trademark databases and top Google search results clearly display the CANVA mark, indicating the Respondent likely knew of the Complainant's rights upon registering the disputed domain name. The Respondent, after receiving a cease and desist letter from the Complainant in March 2023, failed to respond. Such non-responsiveness is often viewed as additional evidence of bad faith. The Respondent's website continued to direct users to a site appearing to offer "Canva Pro" access.

The Complainant further argues that the Respondent's use of the disputed domain name was intentional to mislead Internet users for profit by creating a likelihood of confusion with the Complainant's CANVA mark. The site's content and the Respondent's use of the CANVA mark are meant to give an impression of official affiliation with the Complainant's services. Past panels decisions have deemed such behavior as indicative of bad faith.

Additionally, the Respondent does not sufficiently disclaim its lack of connection with the Complainant on its website, potentially misleading users into thinking they are accessing official Complainant's offerings. The misleading nature is further reinforced by certain texts on the Respondent's site, presenting an illusion of legitimacy. Even though the Respondent removed some references to "Canva Pro" after the cease and desist letter, the Complainant argues that it does not rectify the ongoing misleading nature of the site.

B. Respondent

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

6. Discussion and Findings

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

"A Panel shall decide a 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", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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 and is being used by the Respondent in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. A trademark registration provides a clear indication that the rights in the trademark belong to the complainant (see WIPO

Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.2.1).

The disputed domain name, <canvapro150k.com>, consists of the Complainant’s mark CANVA and the term “pro”. Additionally, the disputed domain name integrates “150k” and the gTLD “.com”. The Complainant’s CANVA mark is prominently recognizable within this disputed domain name, and the addition of any other elements does not prevent the finding of confusing similarity.

Referring to the [WIPO Overview 3.0](#), section 1.8: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

Additionally, the gTLD “.com” is not typically viewed as an obstacle to recognizing a confusing similarity between the disputed domain name and the Complainant’s registered marks. Therefore, Panel determines that the combination of the Complainant’s CANVA mark with “pro 150k” and the “.com” gTLD does not affect the finding of confusing similarity between the disputed domain name and the Complainant’s CANVA mark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence to rebut that presumption. If the respondent fails to do so, a complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1).

The Respondent failed to provide any evidence of authorization to use the CANVA mark or to register the disputed domain name containing the CANVA mark. According to the Complainant, the Respondent is not associated or connected with the Complainant in any way, and the Complainant has not granted the Respondent any license or authorization to use or register any domain name that includes the Complainant’s CANVA mark.

The Respondent has further failed to provide a response to the Complaint, thereby failing to present any information or factors that could potentially justify prior rights or legitimate interests in the disputed domain name.

From the Panel’s evaluation, there is no evidence that the Respondent has registered trademarks for “canva”, “canvapro150k”, or similar terms. Furthermore, there appears to be no evidence of the Respondent engaging in any legitimate or fair use of the disputed domain name, whether for noncommercial or *bona fide* activities. Rather, the Respondent is using the disputed domain name to offer permanent access to the Complainant’s product. Noting the lack of any disclaimer, the disputed domain name’s content exacerbates the confusion caused by the incorporation of the Complainant’s trademark in the construction of the disputed domain name. Further to section 2.8 of the [WIPO Overview 3.0](#), such use of the disputed domain name does not amount to a *bona fide* offering nor noncommercial fair use. In addition, the Panel concludes that the nature of the disputed domain name, which consists of the Complainant’s CANVA mark combined with the term “pro 150k”, suggests an affiliation with the Complainant. This perceived affiliation underscores that a fair use cannot be constituted, referencing section 2.5.1 of the [WIPO Overview 3.0](#).

Based on the above, the Panel finds that the second element of paragraph 4(a)(ii) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires a complainant to demonstrate that the respondent registered and is using the disputed domain name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”.

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 the respondent’s website or location or of a product or service on its website or location.

The registration of the Complainant’s CANVA mark predates the disputed domain name registration by almost a decade.

From the evidence presented by the Complainant regarding the webpage associated with the disputed domain name, it becomes evident that the Respondent had knowledge of the Complainant and their engagement in the design and graphics sector, particularly pertaining to the CANVA mark, at the time of the disputed domain name registration. Given the prominence of the CANVA mark in online searches and public databases, it is evident that the Respondent should have been aware of the Complainant’s rights in CANVA mark.

Concerning the use of the disputed domain name, it seems that the Respondent’s approach is aimed at causing confusion about its affiliation with the Complainant’s CANVA mark, which is evident as the disputed domain name directs users to a page, which displays the Complainant’s CANVA mark and offering for the Complainant’s products. The disputed domain name has been used to present design and graphic information and contains a form available for users to upgrade their account. Moreover, the Panel finds that the disputed domain name has been used to direct users to a site purporting to offer permanent access to the Complainant’s “Canva Pro” service. Such disputed domain name use raises considerable concerns about the Respondent’s intent. Past panels, as cited in the [WIPO Overview 3.0](#), section 3.4, have determined that using a domain name for illicit activities constitutes bad faith. Based on the evidence, the Panel concludes that the Respondent’s actions, both in registration and use of the disputed domain name, are indicative of bad faith, consistent with the Policy.

Furthermore, lack of response to the Complainant’s efforts to address the matter with the Respondent through cease and desist correspondence is an act often construed as an indication of bad faith. While the Respondent did take some reactive steps by removing specific references to “Canva Pro” after receiving the correspondence, the disputed domain name continued to mislead users by directing them to a site suggesting permanent or lifetime access to “Canva Pro” services. Such reaction is still misleading and an act of adjustments after official communication which do not absolve the Respondent of bad faith. The lack

of response coupled with some adjustments strongly suggests that the Respondent's registration and use of the disputed domain name was and remains in bad faith.

The Panel concludes that the disputed domain name was registered and used in bad faith and that consequently, the Complainant has satisfied the requirement under paragraph 4(a)(iii) 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, <canvapro150k.com>, be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: September 14, 2023