

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd. v. Dung Nguyen  
Case No. D2022-0357

### **1. The Parties**

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

The Respondent is Dung Nguyen, United States of America (“United States”).

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

The disputed domain names <canva-lifetime.com> and <8canva.com> are registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2022. On February 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <8canva.com>. On February 3, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 3, 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 with an additional disputed domain name <canva-lifetime.com> on February 7, 2022. On February 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain name. On February 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2022. The Respondent did not submit any response.

Accordingly, the Center notified the Respondent's default on March 3, 2022.

The Center appointed Kaya Köklü as the sole panelist in this matter on March 8, 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 is a company with its registered seat in Australia, founded in 2012. It provides an online graphic design platform, where users can choose among various images and templates to create graphic designs. The Complainant offers its users a free basic package, but also various subscription opportunities.

The Complainant is the owner of the CANVA trademark. The CANVA trademark is registered in various jurisdictions covering protection *i.a.*, for graphic design applications respectively related services. For instance, the Complainant is the owner of the United States Trademark Registration No. 4316655, registered on April 9, 2013, and the International Trademark Registration No. 1204604, registered on October 1, 2013 (Annex 11 to the Complaint).

The Complainant further holds and operates its official website at "www.canva.com", with more than 200 million visits per month (Annex 7).

The disputed domain name <canva-lifetime.com> was registered on September 18, 2021.

The disputed domain name <8canva.com> was registered on September 4, 2021.

The Respondent is reportedly an individual from the United States.

The screenshots as provided by the Complainant (Annexes 13 and 14 to the Complaint) show that the disputed domain names resolved to active websites. The disputed domain name <8canva.com> resolved to a website advertising and claiming to propagate graphic design and photo edition services related to a third-party brand. The disputed domain name <canva-lifetime.com> resolved to a similarly structured website, but with different content. At that website, the Respondent advertised a life-time subscription model to the Complainant's services to a significantly lower price than the Complainant's regular annually prices (Annex 14 to the Complaint). Also, the Panel notes that on the website associated to the disputed domain name <canva-lifetime.com>, the Respondent used the CANVA trademark and the Complainant's official logo to advertise its alleged services. Also, there was a brief disclaimer stating "Who we are? We are a reseller of Canva Pro subscription. We are not a Canva's official third-party".

At the time of the decision, the disputed domain names do not resolve to active websites anymore.

Prior to initiation of this administrative proceeding, the Complainant tried to solve the dispute amicably by sending cease and desist letters to the Respondent on October 15 and 22, 2021 (Annex 20 to the Complaint).

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

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

The Complainant requests the transfer of the disputed domain names.

The Complainant is of the opinion that the disputed domain names are confusingly similar to its CANVA trademark.

It further argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

In addition, the Complainant is convinced that the Respondent has registered and is using the disputed domain names in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraphs 14(a) and 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint where no Response has been submitted.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain names are identical or confusingly similar to the trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has 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 Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#).

It is further noted that the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

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

To begin with, the Panel confirms that the Complainant has satisfied the threshold requirement of having relevant trademark rights. As evidenced in the Complaint, the Complainant is the owner of the CANVA trademark (Annex 11 to the Complaint).

The Panel finds that the disputed domain names are confusingly similar to the Complainant's CANVA trademark. Both disputed domain names fully comprise the CANVA trademark in its entirety. As stated at section 1.8 of the [WIPO Overview 3.0](#), where a trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity. In the present case, the mere addition of the number "8" respectively and the term "lifetime", does, in view of the Panel, not serve to avoid a finding of confusing similarity between the disputed domain names and the Complainant's CANVA trademark.

In view of the above, the Panel is satisfied that the Complainant has met the requirements under paragraph 4(a)(i) of the Policy.

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

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of proving a negative, in particular as the evidence needed to show the Respondent's rights or legitimate interests is primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain names to meet the requirements of paragraph 4(a)(ii) of the Policy. *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

With its Complaint, the Complainant has provided *prima facie* evidence that the Respondent has no rights or legitimate interests, particularly no license or alike to use the Complainant's CANVA trademark in a confusingly similar way within the disputed domain names.

There is also no indication in the current record that the Respondent is commonly known by the disputed domain names. In the absence of a Response, the Respondent has further failed to demonstrate any of the nonexclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c), or provide any other evidence of rights or legitimate interests in the disputed domain names.

In this regard, the Panel particularly believes that the Respondent cannot be assessed as a legitimate dealer or reseller for the Complainant's products in light of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("Oki Data") and thus is not entitled to use the disputed domain names accordingly. The criteria as set forth in Oki Data are apparently not fulfilled in the present case. The Panel *inter alia* notes that at the website associated to the disputed domain name <8canva.com>, the Respondent offered products of a competing third-party with other commercial origin than the Complainant (Annex 13 to the Complaint).

As regards the use of the disputed domain name <canva-lifetime.com>, the Panel believes that the Respondent did not adequately disclose the relationship, or rather the lack thereof, between the Respondent and the Complainant, thus creating the false impression that the Respondent might be an official and authorized reseller/distributor for the Complainant's subscription models. This assessment is particularly supported by the nature of the disputed domain name, which in view of the Panel carries a risk of implied affiliation or association, as stated in section 2.5.1 of the [WIPO Overview 3.0](#). In this context, the Panel particularly notes that the disclaimer on the website linked to the disputed domain name <canva-lifetime.com> was not presented in a sufficiently clear, prominent and, hence, effective manner to avoid the confusion with the Complainant. Also, the Panel believes that the subscription offers by the Respondent were not only unauthorized but also illegitimate, as the requested prices by the Respondent were undisputedly more than 50 per cent below the regular subscription fees of the Complainant.

In view of the Panel, all this takes the Respondent out of the Oki Data safe harbour for purposes of the second element.

Bearing all this in mind, the Panel does not see any basis for assessing a *bona fide* offering of goods or services by the Respondent.

Consequently, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

In the Panel's view, the Respondent has registered and is using the disputed domain names in bad faith.

The Panel is convinced that the Respondent must have had the Complainant's trademark in mind when registering the disputed domain names. It even appears that the Respondent has registered the disputed domain names solely for the purpose of creating an association with the Complainant and its online graphic design products and services.

After having reviewed the Complainant's screenshots of the websites linked to the disputed domain names (Annexes 13 and 14 to the Complaint), the Panel is convinced that the Respondent intentionally registered the disputed domain names in order to generate traffic to its own websites.

Whereas the disputed domain name <8canva.com> is used to offer competing products and services, the disputed domain name <canva-lifetime.com> prominently uses the CANVA word and figurative trademark. Bearing in mind the nature of the disputed domain names, there is, in view of the Panel, sufficient evidence that the Respondent intentionally tries to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant and its CANVA trademark as to the source, sponsorship, affiliation, or endorsement of its websites.

Furthermore, the Panel accepts the failure of the Respondent to submit a response to the Complainant's contentions as an additional indication for bad faith. The Panel is convinced that, if the Respondent had legitimate purposes in registering and using the disputed domain names, it would have responded.

All in all, the Panel cannot conceive of any plausible and legitimate use of the disputed domain names that would be in good faith, except with an authorization of the Complainant.

Noting the above, the fact that the disputed domain names do not currently resolve to an active website does not change the Panel's findings in this respect. See section 3.3. of the [WIPO Overview 3.0](#).

The Panel therefore concludes that the disputed domain names were registered and are being used in bad faith and that the Complainant has also satisfied the third element of the Policy, namely, 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 names <canva-lifetime.com> and <8canva.com> be transferred to the Complainant.

*/Kaya Köklü/*

**Kaya Köklü**

Sole Panelist

Date: March 22, 2022