

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Higor Aparecido Ferreira
Case No. D2022-0375

1. The Parties

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

The Respondent is Higor Aparecido Ferreira, Brazil.

2. The Domain Name and Registrar

The disputed domain name <megacanva.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 3, 2022. On February 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 4, 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 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 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 3, 2022.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 14, 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 disputed domain name was registered on August 13, 2021 (Annex 1 to the Complaint).

The Complainant owns several registered trademarks for CANVA, e.g. United States Registration No. 4316655, registered April 9, 2013, covering class 42; Australian Registration No. 1483138, registered March 29, 2012, covering class 9; as well as the International Registration No. 1204604, registered October 1, 2013, covering the class 9 and designated for various jurisdictions around the world (Annex 11 to the Complaint).

The Complainant moreover uses the domain name <canva.com> to address its main website offering its services under the mark CANVA (Annexes 4 and 5 to the Complaint).

The disputed domain name resolves to a pay-per-click (“PPC”) webpage containing links related to products and services (Annex 13 to the Complaint).

The Complainant sent a cease-and-desist letter to the Respondent requesting to transfer the disputing domain name; the Respondent did not reply (Annex 16 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant 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. The Complainant's online platform is easy to use and utilizes a “drag-and-drop” methodology; as a result, the Complainant's services have achieved significant reputation and acclaim.

The Complainant offers its services, as a basic package, for free and a paid version named “Canva Pro” via its main website addressed under <canva.com>.

Furthermore, the Complainant launched its app for the iPad, which grew access to CANVA services; the Complainant's app is also available on phone devices.

The CANVA brand is well-known around the world; the Complainant's services are offered exclusively online, which is inherently global. The Complainant's business was valued in 2019 at USD 3.2 billion and has 20 million users across 190 countries.

Finally, the Complainant owns numerous registrations protecting the mark CANVA in the United States of America and around the world.

The disputed domain name, which merely adds the term “mega” to the Complainant's CANVA mark, is confusingly similar to the Complainant's CANVA mark.

Moreover, the Respondent has no rights or legitimate interests in the disputed domain name; the Complainant has not licensed nor authorized the Respondent to use the Complainant's CANVA mark, nor does the Respondent have any legal relationship with the Complainant that would entitle the Respondent to use the CANVA mark. The Respondent is not making a *bona fide* offering of goods or services at the disputed domain name, is not commonly known by the disputed domain name and is not making a legitimate noncommercial or fair use of the disputed domain name.

The Complainant registered and uses the disputed domain name in bad faith: the Complainant's earliest trademark registration predates the creation date of the disputed domain name by nine years; the

Complainant's online presence is global – hence, the Respondent must have been aware of the Complainant and its rights when registering the disputed domain name. Moreover, the disputed domain name resolves to a pay-per-click webpage containing links related to other products and services; therefore, the Respondent uses the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that

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

A. Identical or Confusingly Similar

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the trademark CANVA.

The disputed domain name is confusingly similar to the Complainant's registered trademark CANVA since it entirely contains this distinctive mark and only adds the word "mega" as prefix to the mark CANVA.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)").

Finally, it has also long been held that general Top Level Domains ("gTLDs") are generally disregarded when evaluating the confusing similarity of a disputed domain name.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

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 (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

The Complainant has rights in and is the owner of the distinctive registered trademark CANVA registered and used in many jurisdictions around the world since 2013; the disputed domain name was registered in 2021. Moreover, the Complainant registered and is using the domain name <canva.com> for addressing its main website, offering its services globally.

It is inconceivable for this Panel that the Respondent registered the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the entirety of the Complainant's distinctive trademark CANVA, which has a strong global presence and was extensively used by the Complainant prior to the registration of the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

The disputed domain name is also being used in bad faith since it resolves to a website offering competing PPC links.

UDRP panels have found that the use of a domain name to resolve to a website comprising PPC links does not represent a *bona fide* use of a domain name where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users; here, the PPC links take unfair advantage of the reputation of the Complainant's trademark CANVA, and in so doing disrupt the Complainant's business and attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Moreover, the Complainant sent a cease-and-desist letter to the Respondent asking the Respondent to resolve the matter amicably and to transfer the disputed domain name; the Respondent did not reply and continued to use the disputed domain name to address a website using PPC advertisement links; this is additional evidence of bad faith usage (see *International Business Machines Corporation v. Privacy Protection / Yabani Eze*, WIPO Case No. [D2021-0727](#)).

On the basis of these facts and findings, the Panel finds that the disputed domain name was registered and is being used in bad faith according to 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 <megacanva.com>, be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: March 21, 2022