

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Privacy service provided by Withheld for Privacy ehf /
chamod kavinda

Case No. D2022-1481

1. The Parties

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / chamod kavinda, Sri Lanka.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2022. The original Complaint concerned two domain names: <canvaprofessional.com>, which is the subject of the current decision, and <canvaprofesional.com>. On April 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with these two domain names. On April 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the two domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 27, 2022, providing the registrant and contact information for multiple underlying registrants disclosed by the Registrar, and inviting the Complainant to either amend the Complaint adding the Registrar-disclosed registrants as the formal Respondents and provide relevant arguments or evidence demonstrating that all the named Respondents are, in fact, the same entity and that all domain names are under common control, or indicate which of the two domain names will no longer be included in the current Complaint. The Complainant filed an amended Complaint on April 29, 2022.

On April 29, 2022, the Complainant filed a request for partial withdrawal with regard to the domain name <canvaprofesional.com>. That domain name became subject to separate proceedings and is no longer part of the proceedings at issue in this decision. On May 2, 2022, the Center sent a Notification of Requested partial Withdrawal with regard to the domain name <canvaprofesional.com> and continued the case only for the Domain Name.

The Center verified that the Complaint and 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 May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. Informal Respondent communication indicating they currently do not need the Domain Name and an attempt to settle the dispute was received on May 3, 2022. Accordingly, the Center sent a possible settlement email to the Parties on May 3, 2022. On May 4, 8, and 9, 2022, the Center received email communications from the Respondent arguing that they needed the Domain Name for their local business. On May 10, 2022, the Center received an email communication from the Complainant expressing an attempt to settle the dispute, but the Complainant requested no suspension. The Respondent did not submit any formal Response. Accordingly, the Center notified the Parties on May 25, 2022, that it would proceed to the panel appointment process.

The Center appointed Gregor Vos as the sole panelist in this matter on June 1, 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 an Australian online graphic design platform. The Complainant was founded in 2012 and in 2019 the Complainant had 20 million users in 190 countries. One of the Complainant’s services is the Canva Pro-package,

The Complainant is the owner of the following United States of America (“United States”), Australian, and International trademark registrations (hereinafter jointly referred to as the “Trademarks”):

- United States registration No. 4316655 for CANVA, registered on April 9, 2013;
- Australian registration No. 1483138 for CANVA, registered on March 29, 2013; and
- International registration No. 1204604 for CANVA, registered on October 1, 2013, with designation of *inter alia* China, the European Union, and the United Kingdom.

The Domain Name was registered on October 11, 2021, and is not currently active.

5. Parties’ Contentions

A. Complainant

With the Complaint, the Complainant seeks that the Domain Name is transferred to the Complainant. The Complaint is based on the following factual and legal grounds: the Domain Name is identical or confusingly similar to the Trademarks of the Complainant, the Respondent has no rights or legitimate interests in the Domain Name and the Domain Name has been registered and is being used in bad faith.

Firstly, according to the Complainant, the Domain Name is confusingly similar to the Trademarks. The Trademarks are incorporated in the Domain Name in their entirety, with the mere addition of the element “professional”.

Secondly, according to the Complainant, the Respondent has no rights or legitimate interests in the Domain Name. The Complainant first notes that the Respondent does not have any trademark rights to the terms

“canva” or “canva professional”. Furthermore, the Complainant has never authorized, licensed, permitted or otherwise consented to the Respondent’s use of the Trademarks in the Domain Name. Moreover, the Respondent does not provide a *bona fide* offering of products or services, and is not commonly known under the names “canva” or “canva professional”, nor does the Respondent offer any goods or services by the term “canva” or “canva professional”. Also, the Domain Name would resolve to a Pay-Per-Click (PPC) webpage. Therefore, the Respondent is only using the reputation of the Trademarks to earn revenue from third-parties links and directions. Further, the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, because the Respondent is attracting for commercial gain Internet users to its website linked to the Domain Name.

Finally, the Complainant submits that the Respondent has registered and used the Domain Name in bad faith. According to the Complainant, the Trademarks have generated substantial goodwill and reputation since their creation, nine years before the registration of the Domain Name. Also, the Respondent has chosen to ignore a cease and desist letter, which is an indication of bad faith behavior. With regard to use of the Domain Name in bad faith, the Complainant claims that the Respondent is intentionally using the value and goodwill of the Complainant’s Trademarks to attract for commercial gain Internet users to the website linked to the Domain Name through the PPC links.

B. Respondent

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

6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a), and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant’s undisputed factual presentations.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

- i. the Domain Name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- iii. the Domain Name has been registered and is being used in bad faith.

Only if all three elements have been fulfilled, the Panel is able to grant the remedies requested by the Complainant. The Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to having rights pursuant to paragraph 4(a)(i) of the Policy, it is noted that the Complainant is registered as the owner of the CANVA Trademarks. Consequently, the Panel finds that the Complainant has proven that it has rights in the Trademarks.

With regard to the assessment of identity or confusing similarity of the Domain Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant’s Trademarks and the Domain Name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). In cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered confusingly

similar to that mark (see section 1.7 of the [WIPO Overview 3.0](#)).

In the present case, the Trademarks are incorporated in their entirety in the Domain Name. The addition of the generic Top-Level Domain “.com” and the element “professional” does not prevent a finding of confusing similarity with the Trademarks (see sections 1.8 and 1.11 of the [WIPO Overview 3.0](#)). Consequently, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name. The onus of proving this requirement, like each element, falls on the Complainant. Given the difficulty in proving a negative, however, it is usually sufficient for a complainant to make out a *prima facie* case that a respondent lacks rights or legitimate interests. If a complainant does establish a *prima facie* case, the burden of production shifts to the respondent (see, e.g. [WIPO Overview 3.0](#), section 2.1; *Sanofi v. Cimpress Schweiz GmbH*, WIPO Case No. [D2017-0522](#)).

Paragraph 4(c) of the Policy lists three non-limitative examples of instances in which a respondent may establish rights or legitimate interests in the disputed domain name.

The Complainant has substantiated that none of these circumstances apply in this case. By defaulting, the Respondent has failed to rebut the *prima facie* case established by the Complainant. Furthermore, based on the record before it, the Panel does not see an indication that any of the circumstances of paragraph 4(c) of the Policy is present.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. Paragraph 4(a)(ii) of the Policy is thereby fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four non-limitative circumstances which may be considered as evidence of registration and use in bad faith of a domain name.

In the present case, the Trademarks are registered by the Complainant and predate the registration date of the Domain Name. In light of the well-known character of the Trademarks, at least in the field of online graphic design, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Name without knowledge of the Complainant's activities and its Trademarks under which the Complainant is doing business. The well-known character and high acquired distinctiveness of the Trademarks of the Complainant has been confirmed by earlier UDRP panels (see e.g. *Canva Pty Ltd v. Dang Nguyen, Dũng, Dung Nguyen*, WIPO Case No. [D2021-3519](#); *Canva Pty Ltd v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2021-2395](#); and *Canva Pty Ltd v. Contact Privacy Inc. Customer 12410081353 / Tanner*, WIPO Case No. [D2021-2387](#); also see section 3.2.2 of the [WIPO Overview 3.0](#)).

Also, the Panel found that the Respondent lacks any rights to or legitimate interests in the Domain Name and finds that the Respondent is taking unfair advantage of the Domain Name by having diverted Internet users to a PPC site that includes links of a commercial nature. Therefore, the Panel finds from the present circumstances that 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, that are incorporated in their entirety in the Domain Name, as to the source, sponsorship, affiliation or endorsement (see e.g. *“Dr. Martens” International Trading GmbH / “Dr. Maertens” Marketing GmbH v. Joan Mitchell*, WIPO Case No. [D2018-0226](#)).

Further, even if the current inactive page is taken into account, it is generally accepted by UDRP panels that the non-use of a domain name does not prevent a finding of bad faith (section 3.3 of the [WIPO Overview 3.0](#)). In light of the well-known character of the Trademarks, the lack of any rights or legitimate interest in the

Domain Name by the Respondent, and in the absence of any conceivable good faith use of the Domain Name, the Panel finds from the present circumstances that the Respondent has intentionally sought to take unfair advantage of or otherwise abuse the Trademarks.

Finally, the lack of reply to the cease and desist letter sent by the Complainant prior to commencing these proceedings suggests bad faith behavior of the Respondent (see *e.g. Facebook, Inc. and Instagram, LLC v. C W / c w, c w*, WIPO Case No. [D2018-1159](#)).

Therefore, the Panel finds that the Domain Name has been registered and is being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

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 Domain Name, <canvaprofessional.com> be transferred to the Complainant.

/Gregor Vos/

Gregor Vos

Sole Panelist

Date: June 15, 2022