

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Privacy service provided by Withheld for Privacy ehf /  
Juan Marcelo Pompa Martinez  
Case No. D2022-1577

### **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 / Juan Marcelo Pompa Martinez, Paraguay.

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

The disputed domain name <canvaprofesional.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 April 29, 2022. On May 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 2, 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 May 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 25, 2022.

The Center appointed Federica Togo as the sole panelist in this matter on June 2, 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 online graphic design platform founded in 2012.

The Complainant is the registered owner of several trademarks for CANVA, e.g. International registration 1204604 CANVA (word) registered on October 1, 2013, for goods in class 9 and designating several countries worldwide.

The disputed domain name <canvaprofesional.com> was registered on October 17, 2021.

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolves to a website comprising pay-per-click links related – amongst others – to services and products in competition with the Complainant.

Finally, the Complainant sent a cease and desist letter to the Respondent on November 9, 2021. The Respondent did not reply to it.

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

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

It results from the Complainant's undisputed allegations that 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 online platform is easy-to-use, intuitive and utilizes a "drag-and drop" methodology. The Complainant offers its services, as a basic package, for free. The Complainant offers a paid version named "Canva Pro", which has more features and design capabilities, aimed predominantly at professionals or graphic design teams within companies. The Complainant's services are offered exclusively online and third-party web traffic statistics show that the Complainant's website consistently receives over 200 million visits per month. Furthermore, the Complainant launched its app for the iPad, which grew access to "CANVA" services. The Complainant's app is now available on phone devices. Additionally, the Complainant's business has grown through acquisitions of Zeetings, Pexels and Pixabay. The Complainant has 977 employees spread across offices in Sydney, Manila and Beijing. As of 2019, "CANVA" was valued at USD 3.2 billion circa and has 20 million users circa across 190 countries. The Complainant also offers a design school, which provides tutorials, courses and events, and helps businesses and graphic designers perfect their work. It also maintains blogs on design, marketing, branding and photography. The Complainant has also established a social media presence and uses its trademark "CANVA" to promote its services under this name, in particular on: Facebook: 1.8 million followers – "www.facebook.com/canva/"; Twitter: 186.3k followers - "www.twitter.com/canva"; Instagram: 992k followers – "www.instagram.com/canva/"; Pinterest: 197.4k followers – "www.pinterest.co.uk/canva/".

In addition, the Complainant uses the domain name <canva.com>, which resolves to its main website, in order to offer its services.

The Complainant contends that its trademark CANVA is distinctive and well-known worldwide.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's trademark CANVA, since it replicates the distinctive CANVA trademark in its entirety, with the addition of the word "profesional" (Spanish translation of "professional") within the second-level domain; the trademark CANVA is recognizable within the disputed domain name.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent has not received any license to use the CANVA trademark in a domain name. Since the disputed domain name resolves to a Pay-Per-Click (PPC) webpage containing links related to other products and services, including some in competition with the

Complainant, the Respondent is using the disputed domain name to unfairly capitalize upon and take advantage of the similarity with the CANVA mark. The Respondent has deliberately used the distinctive trademark CANVA, which is not a term a trader would legitimately choose unless seeking to create an impression of association with the Complainant, in order to earn revenue from third-parties links and redirections. Furthermore, it believes that the Respondent is not commonly known by the distinctive term “canva”.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant’s undisputed allegations, due to the reputation of the CANVA trademark and services, the Respondent must have been aware of the Complainant and its CANVA trademark when registering the disputed domain name. Additionally, the Respondent has chosen to ignore a cease and desist notice sent by the Complainant’s representatives in order to put the Respondent on notice of the Complainant’s trademarks and rights and with a view to resolving the matters amicably (e.g. requesting the transfer of the disputed domain name). Furthermore, because of the strong reputation of the CANVA trademark, the use of PPC links by the Respondent on the disputed domain name constitutes a clear attempt to generate a commercial gain, particularly by misleading online users with the disputed domain name and subsequently redirecting these online users to third-party websites.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to “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”. Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for the term CANVA. Reference is made in particular to International registration no. 1204604 CANVA (word) registered on October 1, 2013, for goods in class 9 and designating several countries worldwide.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark where the disputed domain name incorporates the complainant’s trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark CANVA is fully included in the disputed domain name, followed by the term "profesional". Furthermore, it is the view of this Panel that the addition of the term "profesional" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

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

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark CANVA or the registration of the disputed domain name.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

In addition, it results from the undisputed evidence before the Panel that the disputed domain name resolves to a parking website comprising pay-per-click links that compete with or capitalize on the Complainant's trademark. UDRP panels have found that the use of a domain name to host a parked page comprising pay-per-click links does not represent *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see [WIPO Overview 3.0](#) at section 2.9, with further references). This Panel shares this view and notes that the Complainant's trademark CANVA has gained a significant reputation, as stated by previous UDRP panels (see *e.g. Canva Pty Ltd v. Domain Administrator*, WIPO Case No. [D2021-1977](#)). Therefore, such use can neither be considered as *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence

of the disputed domain name's registration and use in bad faith.

Based on the evidence submitted by the Complainant, the Panel shares the view of other UDRP panels and finds that the Complainant's trademark CANVA has gained a significant reputation. Therefore, this Panel has no doubt that the Respondent positively knew or should have known that the disputed domain name consisted of the Complainant's trademark when registered the disputed domain name. Registration of the disputed domain name in awareness of the CANVA mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith (see *e.g.*, *Carrefour SA v. Matias Barro Mares*, WIPO Case No. [D2020-3088](#); *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#)).

The Complainant also proved that the disputed domain name resolves to parking website comprising pay-per-click links that compete with or capitalize on the Complainant's trademark, so that the Panel is satisfied that the disputed domain name, incorporating in its entirety the Complainant's trademark that has gained a reputation, is being used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at point 3.2.1):

- (ii) the Respondent's failure to substantially reply to the cease and desist letter sent by the Complainant which made him aware of the CANVA marks;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

## 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 <canvaprofesional.com> be transferred to the Complainant.

*/Federica Togo/*

**Federica Togo**

Sole Panelist

Date: June 15, 2022