

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Ngo Van Sy, Van Sy  
Case No. D2022-2254

### **1. The Parties**

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

The Respondent is Ngo Van Sy, Van Sy, Viet Nam.

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

The disputed domain name <canvaprovn.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2022. On June 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 23, 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.

On June 27, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On June 28, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on July 4, 2022. In accordance with paragraph 5 of the Rules, the due date for Response was July 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 25, 2022.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on August 12, 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 paragraph 7 of the Rules.

#### **4. Factual Background**

The Complainant is an online graphic design platform founded in 2012. The Complainant has been valued at USD 6 billion as of June 2020 and currently has more than 60 million active users per month with customers in 190 countries. The Complainant's online platform is available in approximately 100 languages, including Vietnamese and Japanese. The Complainant markets its offerings to users based in various jurisdictions through the use of country-specific websites.

The Complainant offers its services, as a basic package, for free. The Complainant also offers a paid version named "Canva Pro", which has many more features and design capabilities and is used by millions of individuals across the globe. The Complainant also offers a design school which provides tutorials, courses and events, and maintains blogs and learning resources on design, marketing, branding and photography.

The Complainant holds a number of registered trademarks for the CANVA term (the "CANVA mark"), including United States of America trademark registration Nos. 4316655 (registered on April 9, 2013) and 6114099 (registered on July 28, 2020), and international trademark Nos. 1204604 (registered on October 1, 2013) and 1429641 (registered on March 16, 2018).

The Complainant offers services from its main website, "www.canva.com". The Complainant's app is also available on mobile phone devices. The Complainant is also the holder of numerous exact-match CANVA domain names, under both generic Top-Level Domain ("gTLD") and country code Top-Level Domain ("ccTLD") extensions, including <canva.biz>, <canva.club>, <canva.co.in>, <canva.fi>, <canva.us>, and <canva.cn>.

The disputed domain name was registered on October 1, 2021 and resolved to a website displaying the Complainant's CANVA mark and logo, and offering to sell accounts/access to the Complainant's "Canva Pro" service.

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

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

First, the disputed domain name incorporates the Complainant's distinguished CANVA mark clearly and exactly, and is only preceded by the terms "pro" and "vn". It is clear that the additions of "pro" and "vn" do not preclude the recognizability of the Complainant's CANVA mark in the disputed domain name. Indeed, these additions have specific connotations to the Complainant's offerings ("pro" referring to the Complainant's premium "Canva Pro" service and "vn" functioning as a country signifier for "Viet Nam", which is a customer base of the Complainant), and so their inclusions serve to increase the likelihood of ensuing Internet user confusion.

Second, to the best of the Complainant's knowledge, the Respondent has not registered any trademarks for "canva", "canvaprovn", or any similar string. The Complainant also cannot find evidence to suggest the Respondent holds unregistered rights in any such term. Moreover, the Respondent is not connected or affiliated with the Complainant and has not been licensed by the Complainant to use domain names that feature its CANVA mark. The Respondent previously used the disputed domain name to brandish the Complainant's CANVA mark and logo, and advertise the sale of accounts/access to the Complainant's "Canva Pro" offering. The Respondent has not been authorized to use the Complainant's CANVA mark

commercially, and has not made any attempt to disclaim its lack of connection with the Complainant. The Respondent's prior use of the disputed domain name was evidently calculated to derive revenue by creating the false impression that the resolving website was authorized by, or otherwise associated with, the Complainant. The Respondent did not take steps to mitigate the perceived association between the disputed domain name's website and the Complainant's official offerings, and, on the contrary, capitalized on the likelihood of confusion by repeatedly featuring the Complainant's logo and encouraging Internet users to register for the Complainant's services. Given the nature of the disputed domain name's string and the website to which it resolved, it is clear that the disputed domain name carries a risk of implied affiliation and cannot constitute fair use.

Third, the Complainant notes that anyone with access to the Internet can find the CANVA mark clearly on public trademark databases. Additionally, all top Google search results for the CANVA mark pertain to the Complainant's offerings. This shows that the simplest of Internet searches would have unequivocally brought the Complainant's established rights in the CANVA mark to the Respondent's attention. In view of the above factors, it is clear that the Respondent should have been aware of the Complainant's CANVA mark at the time of the disputed domain name's registration. The Respondent's use of the disputed domain name shortly after the disputed domain name's registration constitutes further evidence that the Respondent targeted the Complainant and intended to capitalize on the CANVA mark through the disputed domain name's creation. The Respondent's presentation of such content shortly after the disputed domain name's registration therefore amounts to additional evidence of bad faith registration. The Complainant further notes that it sent cease and desist correspondence to the Respondent on November 9 and 16, 2021. The Respondent did not reply to such correspondence, which may constitute further evidence that it knowingly acted in bad faith. The Respondent therefore had the opportunity to explain its registration of the disputed domain name but chose not to do so.

Finally, the Respondent clearly used the CANVA-contained disputed domain name to advertise commercial services in connection with the Complainant's CANVA mark. The Respondent developed a false impression of association by featuring the Complainant's distinctive CANVA logo, purporting to provide access to the Complainant's "Canva Pro" offering, and by failing to disclaim its lack of connection to the Complainant. Rather than attempting to mitigate the prospect of misleading Internet users as to the source of the disputed domain name, the Respondent's conduct was clearly designed to capitalize on the likelihood of confusion through its recurring presentation of the CANVA mark, logo and other visual indicia (e.g., information relating to the "Canva Pro" service).

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the Registration Agreement for the disputed domain name is Japanese.

However, the Complainant requests that English be the language of the proceeding with the reasons that the disputed domain name is solely composed of letters from the Latin alphabet, that the Respondent has registered other domain names which encompass various English words or terms, that the Respondent failed to respond to the Complainant's English-language cease and desist correspondence to convey that it does not understand English/would like to receive correspondence in another language and that the English language is popular in Viet Nam, where the Respondent is located, and that the Complainant's representatives are based in the United Kingdom and requiring a translation would result in the incurrence of

additional expense and unnecessary delay.

Although the Respondent does not expressly agree with the Complainant on the language of the proceeding, the Respondent did not submit any objection to the Complainant's request that English be the language of the proceeding when the Center had sent a notification regarding the language of the proceeding to the Parties by email both in English and Japanese. Considering that the Respondent is located in Viet Nam, where English is quite popular, and even assuming that the Respondent is conversant in Japanese, the necessity for conducting the proceeding in Japanese will not be so critical to justify the costs of translation and delay. The Panel also notes that part of the website content is displayed in English, thus suggesting that the Respondent is familiar with English.

In view of these circumstances of the administrative proceeding, the Panel decides that English should be the language of the proceeding in the spirit of fairness and justice intended by the Policy.

## **6.2 Substantive Elements of the Policy**

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 in bad faith.

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

The Complainant holds rights in the CANVA mark. The disputed domain name <canvaprovn.com> includes the Complainant's CANVA mark in its entirety, combined with the suffixes, the term "pro" and the geographic identifier "vn". The addition of the suffixes does not prevent the Complainant's CANVA mark from being recognizable in the disputed domain name, and therefore, does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's CANVA mark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is generally accepted that the ".com" gTLD extension may be disregarded when assessing the confusing similarity between a trademark and the disputed domain name because such gTLD extension is viewed as a standard registration requirement. See section 1.11.1 of the [WIPO Overview 3.0](#).

In light of the above, the Panel considers the disputed domain name to be confusingly similar to the CANVA mark in which the Complainant has rights under paragraph 4(a)(i) of the Policy.

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

The Complainant asserts that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services, and that the Respondent is not known, nor has ever been known, by the distinctive CANVA mark or the disputed domain name.

The Respondent previously used the disputed domain name's website by displaying the Complainant's CANVA mark and logo, and offering to sell accounts/access to the Complainant's "Canva Pro" service in November 2021, shortly after the disputed domain name's registration. Even if the Respondent currently has stopped using the disputed domain name's website, it cannot be said that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the CANVA mark.

Therefore, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The burden to put forward evidence to show that it has rights or legitimate interests in the disputed domain name shifts to the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)), but the Respondent failed to submit any response in this proceeding and there is no evidence of the existence of any rights or legitimate interests before the Panel.

Consequently, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraph 4(a)(ii) of the Policy.

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

The Complainant's graphic design services are offered exclusively online, which make them inherently global. The Complainant's services have achieved significant reputation and acclaim during this decade. As a result, the CANVA mark is well known around the world in the field of graphic design (see *Canva Pty Ltd v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Adhitya Tri Arifianto*, WIPO Case No. [D2021-3495](#)). Thus, the Respondent must have intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's CANVA mark at the registration of the disputed domain name.

The Respondent's previous use of the disputed domain name for purporting to provide access to the Complainant's "Canva Pro" offering and the Respondent's current passive holding of the disputed domain name are considered to be made in bad faith (see *ArcelorMittal (Société Anonyme) v. Whois Privacy Protection Foundation / Sivian Menier*, WIPO Case No. [D2021-0078](#)). The Respondent's failure to respond to the Complainant's cease and desist letter on November 9 and 16, 2021 reinforces the inference of bad faith registration and bad faith use (see *Sanofi v. Domain Administrator, See PrivacyGuardian.org / onlinestore, willam jhonson*, WIPO Case No. [D2019-2846](#)).

In conclusion, the Panel finds that the disputed domain name has been registered and is being used in bad faith 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 <canvaprovn.com> be transferred to the Complainant.

/Yuji Yamaguchi/

**Yuji Yamaguchi**

Sole Panelist

Date: August 26, 2022