

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Wu Yu
Case No. DCO2022-0005

1. The Parties

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

The Respondent is Wu Yu, China.

2. The Domain Name and Registrar

The disputed domain name <canvapro.co> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 19, 2022. On January 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 20, 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 January 24, 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 on January 25, 2022.

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 January 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 18, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on February 25, 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 company, founded in 2012, which owns and operates an online graphic design platform that offers images and templates to choose from when creating graphic designs. The Complainant's platform offers a free basic package, and a paid version named "Canva Pro" that has more features and design capabilities, aimed predominately at professionals or graphic design teams within companies. The Complainant also offers a "design school" which provides tutorials, courses and events. The Complainant's services are offered exclusively online through its main website "www.canva.com", as well as an application available for tablet and phone devices. Per the Complaint, the Complainant has offices in Sydney (Australia), Manila (Philippines), and Beijing (China), with over 970 employees, the Complainant's website receives over 200 million visits per month, and, as of 2019, the Complainant's platform had 20 million users across 190 countries.

The Complainant holds several registered trademarks for CANVA (the "CANVA Mark") including United States Registration No. 4316655 registered on April 9, 2013, in Class 42; Australia Registration No. 1483138 registered on September 9, 2013, in Class 9; and International Registration No. 1204604 registered on October 1, 2013, in Class 9.

The Complainant has also established a social media presence and uses its CANVA Mark to promote its services under this name.¹

Prior decisions under the Policy have recognized the well-known character of the CANVA Mark.²

The disputed domain name was registered on September 11, 2021, and resolves to a parked page indicating that the disputed domain name is on sale for a price amounting to USD 299, and displaying various Pay-Per-Click ("PPC") links to third parties' websites in the field of education. According to the evidence provided by the Complainant, prior to the cease and desist letter sent by the Complainant to the Respondent, the disputed domain name was offered for sale on a third party platform for a minimum price of USD 5,000.

On October 15, 2021, the Complainant sent a cease and desist letter to the Respondent. The Complainant received no reply to the letter from the Respondent.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The CANVA Mark is well-known, having attained significant goodwill and recognition worldwide. The disputed domain name is confusingly similar to the CANVA Mark. The disputed domain name replicates the CANVA Mark in its entirety, with the addition of the word "pro", which adds to the confusion, as the Complainant offers "pro" subscriptions and services on its website, and the country code Top-Level Domain ("ccTLD") ".co" should be disregarded under the first element test as it is a standard registration requirement.

¹In particular, the Complainant has established social media presence in Facebook with 1.8 million followers; in Twitter with 186,300 followers; in Instagram with 992,000 followers; and in Pinterest with 197,400 followers.

² See, among others, *Canva Pty Ltd v. Dang Nguyen, Dŭng, Dung Nguyen*, WIPO Case No. D2021-3519; *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. D2021-2577; *Canva Pty Ltd v. Dang Nguyen*, WIPO Case No. D2021-1169; *Canva Pty Ltd v. Domain Administrator*, WIPO Case No. D2020-1208; *Canva Pty Ltd v. Jeffrey Walsh*, WIPO Case No. D2021-1290; *Canva Pty Ltd v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2021-2395; and *Canva Pty Ltd. v. Bruno Henrique Lima De Castro*, WIPO Case No. D2021-2347.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent does not have any trademark rights (registered or unregistered) to the term “canva” or the term “canvapro”, and the Respondent has no license or authorization to use the Complainant’s trademarks. The disputed domain name has no generic meaning, and there is no *bona fide* offering of goods or services attached to the disputed domain name. The Respondent is using the disputed domain name to unfairly capitalize upon and take advantage of its similarity with the CANVA Mark, in connection to a PPC site containing links related to other products and services, creating an impression of association with the Complainant, in order to earn revenue from third-parties links and redirections.

The disputed domain name was registered and is being used in bad faith. Due to the reputation of the Complainant’s platform, it appears on any search over the Internet, and the Complainant’s trademarks can be found on public trademark databases. The Respondent has chosen to ignore a cease and desist sent by the Complainant. The Respondent is intentionally using the commercial value and goodwill of the Complainant’s brand to attract and redirect Internet users to its own website, in an attempt to generate a commercial gain through PPC links, unduly taking advantage of the well-known nature of the Complainant’s mark to attract more Internet users and generate revenue. The disputed domain name is further advertised for sale for a minimum price of USD 299, and prior to the Complainant’s cease and desist letter, it was advertised for a minimum price of USD 5,000. The Respondent is engaged in a pattern of abusive conduct, registering various domain names targeting the Complainant and other third-party well-known trademarks, which are used for PPCs and offered for sale with prices above their out-of-pocket costs.³

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) that it considers supportive of its position, and requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material, and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

The Complainant indisputably has rights in the CANVA Mark, both by virtue of its trademark registrations and as a result of its goodwill and reputation.

The disputed domain name incorporates the CANVA Mark adding the term “pro”, which does not avoid the direct perception of the trademark being reproduced in the disputed domain name. The Panel considers that the CANVA Mark is recognizable in the disputed domain name, and the ccTLD “.co” is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity.

³ In this respect, the Complainant contends that the Respondent also owns the following domain names: <gmzail.cm> (which targets the GMAIL brand, and is offered for sale for USD 4,960), <bmwco.us> (which targets the BMW brand, and is offered for sale for a minimum offer of USD 1,999), <facebk.cm> (which targets the FACEBOOK brand, and is offered for sale accepting offers), and <bocsh-home.cn> (which displays various PPCs).

It is to be noted that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered identical or confusingly similar to that mark for purposes of the Policy. Furthermore, the applicable TLD in a domain name is considered a standard technical registration requirement and, as such, is generally disregarded under the first element confusing similarity test. See sections 1.7 and 1.11, [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

B. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that demonstrating 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 primarily if not exclusively within the respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests.

The Complainant's above-noted assertions and evidence in this case effectively shift the burden of production to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case. However, the Respondent has not replied to the Complainant's contentions, not providing any explanation or evidence of rights or legitimate interests in the disputed domain name.

A core factor in assessing fair use of a domain name is that it does not falsely suggest affiliation with the Complainant's trademark. See section 2.5, [WIPO Overview 3.0](#). The disputed domain name incorporates the CANVA Mark in its entirety, adding the term "pro" that directly refers to the Complainant's paid subscription services aimed predominately at professionals. The Panel considers that the disputed domain name carries a risk of implied affiliation with the Complainant, giving the impression that it may be referring to the Complainant's paid subscription services and/or a new platform related to these services owned or controlled by the Complainant or a related company.

The Panel further considers that the Complainant has made out a strong *prima facie case* that the Respondent could not have rights or legitimate interests in the disputed domain name, not being authorized to use the CANVA Mark, and there is no evidence that suggests that the Respondent is commonly known by the disputed domain name.

In this respect, the Panel notes that the Respondent's name, provided in the registration of the disputed domain name, was concealed under a privacy registration service, and has no resemblance with the term "canva" or the term corresponding to the disputed domain name "canvapro".

The Panel further notes that the term "canva" is a coined term, which is not included in the dictionary in any language.⁴

The Panel, under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has further corroborated that the Respondent owns no trademark containing or consisting of the terms "canva", "canvapro", or "canava pro".⁵

⁴ Albeit the term "canva" is similar to the English term "canvas", it is not included, as such, in the dictionary in any language.

⁵ In this respect, the Panel has consulted the WIPO Global Brand Database searching for any trademark belonging to the Respondent that includes these terms.

The Panel has further corroborated that the disputed domain name resolves to a parked website offering the disputed domain name for sale and displaying various PPC links. The Panel considers that such use competes with or capitalizes on the reputation and goodwill of the CANVA Mark, or otherwise misleads Internet users, not being considered a *bona fide* offering of goods or services under the Policy. See section 2.9, [WIPO Overview 3.0](#).

All the above-mentioned circumstances lead the Panel to conclude that the Respondent has not rebutted the Complainant's *prima facie* case, and nothing in the case file gives reason to believe, in a balance of probabilities, that the Respondent has or has had any rights or legitimate interests in respect of the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel notes the worldwide well-known character of the Complainant and its trademark CANVA, particularly in the field of design, which has been recognized by previous decisions under the Policy.⁶

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain name:

(i) the disputed domain name incorporates the CANVA Mark in its entirety, adding the term “pro”, which is related to part of the Complainant's services contributing to increase the intrinsic likelihood of affiliation;

(ii) the term “canva” is a coined term;

(iii) the CANVA Mark is well-known worldwide and the Complainant operates online, being its design platform available and extensively used worldwide, and particularly in China, where the Complainant operates and has a location (in Beijing), and the Respondent is apparently located according to the Registrar verification;

(iv) according to the evidence provided by the Complainant, the disputed domain name is used to resolve to a parked website where it is offered for sale, and various PPC links to third party's websites are displayed;

(v) according to the evidence provided by the Complainant, the price requested for the disputed domain name has been significantly reduced after the remittance of a cease and desist letter to the Respondent, (from USD 5,000 to USD 299); and

(vi) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name, and has not come forward to deny the Complainant's assertions of bad faith, choosing not to reply to the cease and desist letter or to the Complaint.

It is further to be noted that, according to the evidence provided by the Complainant, the Respondent owns other domain names including third parties' well-known trademarks. This circumstance indicates a pattern of bad faith, targeting the Complainant's trademarks and its platform as well as other reputed trademarks, and preventing the Complainant and other legitimate owners of these well-known trademarks from reflecting their marks in corresponding domain names. See section 3.1.2, [WIPO Overview 3.0](#).

⁶ See footnote number 2, *supra*.

In this respect, the Panel, under its general powers, has corroborated that the Respondent has been apparently involved in over 30 other cases under Policy, all being decided with the transfer of the respective domain names to the corresponding complainants.⁷

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel considers that the disputed domain name was registered and is being used targeting the CANVA Mark, in bad faith, with the intention of obtaining a free ride on the established reputation of the Complainant and its trademark. The circumstances of this case show that the Respondent's purpose has been selling the disputed domain name for a price exceeding its out-of-pocket registration costs, and misleadingly diverting Internet users to unrelated websites for commercial gain, preventing the Complainant from reflecting its trademark in the corresponding domain name, which constitutes bad faith under the Policy.

Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain name has been registered and is being used in bad faith.

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 <canvapro.co> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: March 1, 2022

⁷ In this respect, the Panel has consulted the WIPO Panel Decisions Database searching for any prior disputes associated with the Respondent.