

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Debora Oliveira

Case No. D2023-1783

1. The Parties

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

The Respondent is Debora Oliveira, Brazil.

2. The Domain Name and Registrar

The disputed domain name <renovecanva.site> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 2023, 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 for the disputed domain name.

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 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on June 19, 2023. 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

According to the Complainant's undisputed allegations, it is an online graphic design platform founded in 2012. The Complainant's CANVA offerings relate to many uses and contexts (e.g., for presentations, social media posts, and a range of print products) and users have thousands of images and templates to choose from when creating graphic designs. The Complainant has more than 100 million active users per month with customers across 190 countries.

The Complaint is based amongst others on Brazilian trademark CANVA (verbal) registration no 914660462, registered on April 30, 2019, for goods in class 9.

The disputed domain name was registered on June 8, 2022. It further results from the undisputed evidence provided by the Complainant that the disputed domain name resolved to a website which purports to advertise the sale of a commercial package with editable templates. The header on the top of the landing page included a banner showing the Complainant's CANVA mark in ("+ 100 ARTES EDITÁVEIS NO CANVA PARA ESTÉTICA").

Finally, the Complainant's representatives sent a cease-and-desist letter to the Respondent in September 2022 in Portuguese language, to which, however, the Complainant did not receive any response.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark. The disputed domain name incorporates the Complainant's CANVA mark in full. This mark is only preceded by the term "remove", which does, however, not prevent a finding of confusing similarity.

The Complainant, secondly, submits that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Respondent is neither affiliated with the Complainant nor has it been authorized to use the CANVA mark in any manner. Moreover, the Respondent is not commonly known by the disputed domain name. According to the Complainant, the Respondent is neither making a noncommercial fair use of the disputed domain name, nor is the Respondent making a *bona fide* offering of goods or services. Rather, the disputed domain name's composition, and the Respondent's use of the corresponding site, gives Internet users the false impression that it is endorsed, authorised or otherwise connected to the Complainant. Finally, the Respondent has used the disputed domain name to attract and misleadingly divert Internet users to its own advertisement and sale of a commercial package that capitalises on the renown of the Complainant's CANVA mark.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. In its view, the disputed domain name is intended to divert Internet users away from the Complainant's own website to the Respondent's website and therefore to disrupt the Complainant's business. Further, it is clear to the Complainant that the Respondent registered and is using the disputed domain name to intentionally create a false affiliation, and likelihood of confusion, with the Complainant and its CANVA mark in order to divert Internet users from the Complainant's legitimate website for the Respondent's own commercial gain.

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”.

Furthermore, 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 should 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 is satisfied that the registrant of record for the disputed domain name is the Respondent and 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 – amongst others – the registered owner of Brazilian trademark CANVA (verbal) no 914660462 registered on April 30, 2019, for goods in class 9.

Many UDRP panels have found that a domain name is confusingly similar to a complainant’s trademark for purposes of the first element, where the relevant trademark is recognizable within the domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (cf. section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This Panel shares the same view and notes that the Complainant’s registered trademark CANVA is included in full in the disputed domain name and is recognizable therein. Furthermore, the combination of the trademark CANVA with the additional term “remove” as prefix does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

Finally, the generic Top-Level Domain (“gTLD”) “.site” is viewed as a standard registration requirement and is as such to be disregarded under the first element confusing similarity test ([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 in the present proceeding, the Complainant has not authorized the Respondent's use of the trademark CANVA, *e.g.*, by registering the disputed domain name comprising said mark entirely.

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.

Finally, it results from the Complainant's undisputed allegations that the disputed domain name resolved to a website which purports to advertise the sale of a commercial package with editable templates. The header on the top of the landing page included a banner showing the Complainant's CANVA mark in ("+ 100 ARTES EDITÁVEIS NO CANVA PARA ESTÉTICA"). The Panel assesses this use as being commercial, so that it cannot be considered 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 pursuant to paragraph 4(c)(iii) of the Policy.

Furthermore, such use as described above cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. In fact, this Panel considers that a registrant has no legitimate interest in a domain name that is similar to a third party's mark, where the composition of the domain name is associated to the business of the trademark holder, and that is being used to address consumers in the same business as the trademark holder operates ([WIPO Overview 3.0](#) at section 2.5).

Finally, previous UDRP panels have found that once a 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 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.

One of these circumstances is that the respondent by using the domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand. It results from the Complainant's documented allegations that the disputed domain name has been connected to a website which purports to advertise the sale of a commercial package with editable templates. The header on the top of the landing page included a banner showing the Complainant's CANVA mark in ("+ 100 ARTES EDITÁVEIS NO CANVA PARA ESTÉTICA"). For the Panel, it is therefore evident that the Respondent positively knew the Complainant's CANVA mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name, having registered it due to its similarity with the Complainant's CANVA mark. Registration of the disputed domain name which contains a third party's mark, in awareness of said mark, to take advantage of its similarities with the mentioned mark, and in the absence of rights or legitimate interests amounts to registration in bad faith.

The finding of bad faith registration and use is supported by the further circumstances resulting from the case at hand, which are:

- (i) the Respondent's failure to submit a response;
- (ii) the Respondent's failure to reply to the cease-and-desist letter;
- (iii) the Respondent's failure to provide any evidence of actual or contemplated good-faith use; and
- (iv) the implausibility of any good faith use to which the inherently misleading disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant 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, <renovecanva.site>, be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: July 3, 2023