

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Nguyen Lap Chau Giang

Case No. D2022-0180

1. The Parties

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

The Respondent is Nguyen Lap Chau Giang, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvame.xyz> (“Disputed Domain Name”) is registered with P.A. Viet Nam Company Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 20, 2022. On January 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 25, 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, and that the language of the Disputed Domain Name’s registration agreement was Vietnamese. The Center sent an email communication to the Complainant on January 27, 2022, informing it of the language of the registration agreement. On January 28, 2022, the Complainant filed a first amended complaint, re-iterating its position that the proceeding should be held in English. On February 4, 2022, the Center sent an email communication to the Complainant, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed a second amended Complaint on February 4, 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 in English and Vietnamese, and the proceedings commenced on February 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 1, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on March 4, 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, Canva Pty Ltd, is an online graphic design platform founded in 2012 by Melanie Perkins, Cliff Obrecht and Cameron Adams. Users of the Complainant's services have thousands of images and templates to choose from when creating graphic designs, through an "easy-to-use" online platform.

The Complainant uses its main site "www.canva.com" to offer its services, as a basic package, for free, besides offering a paid version named "Canva Pro" with more features and design capabilities. Global organizations such as Skyscanner and Engie, among many others, use the Complainant's Canva Pro services.

The Complainant's services are offered exclusively online, which is inherently global. Within its first year, the Complainant had 750,000 users and raised USD 3 million in seed funding. According to Similarweb's statistics, the Complainant's website consistently receives over 200 million visits per month.

The Complainant's trademark CANVA has been registered for design-related goods/services in Classes 09 and 42, in a variety of countries under a number of trademark registrations, including, but not limited to, United States of America Trademark Registration No. 4316655 registered on April 9, 2013; Australian Trademark Registration No. 1483138 registered on September 09, 2013; and International Registration No. 1204604 registered on October 1, 2013.

The Disputed Domain Name was registered on July 8, 2021. As the date of this Decision, the Disputed Domain Name is resolving to an active website using the trademark CANVA and logo, purporting to sell Canva Pro subscriptions.

The Complainant sent a Cease and Desist letter to the Respondent via the Registrar on August 10, 2021, and a reminder on August 18, 2021, requesting for the transfer of the Disputed Domain Name. However, the Respondent did not respond to the Cease and Desist letter.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

First, the Complainant contends that the Complainant owns CANVA trademark registrations. Further, the Complainant asserts that the CANVA trademark has attained the goodwill and recognition, which is a distinctive identifier associated with the Complainant's services.

Second, the Complainant submits that the Disputed Domain Name is confusingly similar to the Complainant's CANVA trademark. The Disputed Domain Name contains the whole trademark CANVA, and the English word "me". The addition of a generic or descriptive term to a trademark is insufficient to negate confusing similarity.

Finally, the Complainant submits that the addition of the generic Top-Level Domain ("gTLD") ".xyz", featured in the Disputed Domain Name, should be disregarded when assessing the distinctiveness of the Disputed Domain Name.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant submits that the elements set forth in the Policy, paragraph 4(c) are not fulfilled.

First, the Complainant submits that the Respondent does not have any trademark rights to the term "canva" or any other terms used in the Disputed Domain Name. There is also no evidence that the Respondent retains unregistered trademark rights to the term "canva" or any other terms used in the Disputed Domain Name. Neither has the Respondent received any license from the Complainant to use domain names featuring the trademark CANVA.

Second, the Complainant submits that the Respondent is using the Disputed Domain Name to host a website advertising and claiming to propagate services related to those offered by the Complainant. The Respondent is purporting to offer versions of the Complainant's paid-for service, Canva Pro, which is not only unauthorized but also illegitimate. The Respondent's website does not contain any disclaimer, and uses the CANVA logo to create an impression of affiliation with the Complainant. Therefore, the Respondent cannot claim a *bona fide* commercial undertaking or fair use where its service offering is not genuine and/or is attained fraudulently.

The Complainant also contends that the Respondent is not commonly known by the distinctive term "canva", nor is offering any legitimate goods or services by the term "canva". Therefore, there is no plausible reason for the registration and use of the Disputed Domain Name, other than the motive of taking advantage of the goodwill and valuable reputation attached to the trademark CANVA.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant submits that the Respondent registered the Disputed Domain Name in bad faith. The Complainant's earliest trademark registration predates the creation date of the Disputed Domain Name by eight years. The Complainant, its trademark mark CANVA and its *Canva Pro* offering have obtained substantial goodwill and reputation worldwide. In this regard, awareness of the Complainant's brand is demonstrated by the fact that the Respondent has chosen to host content on the Disputed Domain Name which evidently relates to the Complainant's official services. Further, the Respondent's failure to respond to a cease-and-desist letter from the Complainant may properly be considered a factor in finding bad faith registration of the Disputed Domain Name.

Second, the Complainant asserts that the Respondent uses the Disputed Domain Name in bad faith prior to the dispute. The Complainant submits that the Disputed Domain Name clearly comprises of the Complainant's globally distinctive trademark CANVA, thus, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's CANVA mark.

Further, the Disputed Domain Name is resolving to a website advertising for sale subscriptions for the Complainant's *Canva Pro* services, with lower prices. The Complainant submits that the likely fraudulent use of some of the Complainant's services is evidence of bad faith use. The website is also devoid of any disclaimer, or other indication, that it is not affiliated with the Complainant. Such use is sufficient to show that the Respondent's use of the Disputed Domain Name is in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Procedural Issues

(i) The Respondent's Identity

The Panel notes that at the time the Complaint was filed on January 20, 2022, the Respondent was identified as "Nguyen Lap Chau Giang" at address "TP HCM, VN". On January 25, 2022, the Registrar revealed the detailed contact information of the Respondent. The Center sent an email communication to the Complainant on February 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same date, the Complainant filed an amended Complaint, replacing the Respondent's address "TP HCM, VN" with the correct address disclosed by the Registrar.

(ii) Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement is Vietnamese.

As the Complaint was filed in English, the Center, in its communication dated January 27, 2022, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding.

On January 28, 2021, the Complainant filed an amended Complaint, requesting that English be the language of the proceeding.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) of the Rules is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred and possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

(i) the fact that the Complainant, an Australian business entity, does not appear to be able to communicate in Vietnamese, and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;

(ii) the English language is quite popular in Viet Nam, where the Respondent is located; and the Disputed Domain Name includes an English word "me";

(iii) the Respondent did not object for English to be the language of the proceeding and did not submit a response in either English or Vietnamese.

(iv) the Center formally notified the Respondent of the Complaint in English and Vietnamese, and the Panel would have accepted a response in either English or Vietnamese.

Therefore, in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

(iii) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. D2010-1413, and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The Complainant is required to establish the following: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First of all, the Panel finds that the Complainant has clearly evidenced that it has registered trademark rights to CANVA, well before the Disputed Domain Name was registered.

Second, the Disputed Domain Name comprises the Complainant's CANVA trademark, in which the Complainant has exclusive rights. The difference between the Disputed Domain Name and the trademark is the addition of the suffix "me", which is a non-distinctive English word.

The Panel finds that CANVA remains the dominant element in the Disputed Domain Name. It is well established that the addition of other terms (such as "me") to a trademark does not prevent a finding of confusing similarity. Thus, in the Panel's view, the addition of the said suffix does nothing to prevent the trademark from being recognizable in the Disputed Domain Name, nor to prevent a finding of confusing similarity, as it was found in previous UDRP decisions (see, e.g. *Schering Corporation, a subsidiary of Merck & Co., Inc. v. Private Whois claritgeneric.com*, WIPO Case No. [D2012-0027](#), *Google Inc. v. Shaheen Younas*, WIPO Case No. [D2012-1365](#), *The American Automobile Association, Inc. v. Cameron Jackson / PrivacyDotLink Customer 2440314*, WIPO Case No. [D2016-1671](#)).

Third, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".xyz" to the Disputed Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see, e.g., *Groupon, Inc. v. Whoisguard Protected, Whoisguard, Inc. / Vashti Scalise*, WIPO Case No. [D2016-2087](#), *Carrefour SA v. Privacy Service Provided by Withheld for Privacy ehf / Jean Yves, agricole*, WIPO Case No. [D2021-4409](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's CANVA trademark, and the first element of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel finds that the Complainant has made a *prima facie* evidence on that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute them.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the Complainant, once a *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (see, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this present case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted for evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that no license, permission or authorization of any kind to use the Complainant's trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to CANVA or the Disputed Domain Name. Thus, the Panel finds that the Respondent has no rights in the trademark CANVA.

A reseller or distributor may be making a *bona fide* offering of goods or services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc.*, *supra* (“*Oki Data*”), including:

- the Respondent must actually be offering the goods or services at issue;
- the Respondent must use the site to sell only the trademarked goods or services (otherwise, there is the possibility that the Respondent is using the trademark in a domain name to bait consumers and then switch them to other goods or services);
- the site itself must accurately and prominently disclose the Respondent's relationship with the trademark owner; and
- the Respondent must not try to “corner the market” in domain names that reflect the trademark, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, at the time of this Decision, the Disputed Domain Name is resolving to a website selling subscriptions to the Complainant's paid-for service, *Canva Pro*, as shown in the Annex 14 of the Complaint. The Panel further finds that the Respondent did not place any statement or disclaimer accurately and prominently disclosing its relationship with the Complainant.

The Panel finds that the website under the Disputed Domain Name is also presenting the Complainant's CANVA logo in the header and embedding an official video from the Complainant's YouTube channel. These indications may mislead consumers into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality.

With such a view, the Panel finds that the use of the Disputed Domain Name wholly incorporating the Complainant's CANVA trademark does not meet the *Oki Data* criteria and thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the CANVA trademark and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence relating to the Respondent's registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's trademark CANVA has been registered in a variety of jurisdictions around the world. In addition, the Complainant's trademark CANVA has been registered and put in used among other countries, including in Viet Nam, where the Respondent resides. These trademark registrations well predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the trademark CANVA in its entirety, adding the word “me” at the end. Given the extensive use of the trademark CANVA and *Canva Pro* service by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, it is very unlikely that

the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its trademark CANVA when it registered the Disputed Domain Name, and the Panel considers the registration is an attempt by the Respondent as to take advantage of the reputation and goodwill of the Complainant's trademark.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it is resolving to a website that advertises for sale of subscriptions for the Complainant's service, *Canva Pro*, at lower prices. In addition to the adoption of the Complainant's trademark CANVA as a uniquely distinctive part in the Disputed Domain Name, the Respondent uses the Complainant's CANVA logo and embeds an official video of the Complainant's YouTube channel on the website.

The Panel takes the view that any Internet users seeking to purchase the Complainant's CANVA services would very likely mistakenly believe that the Respondent is either the Complainant or associated with the Complainant, while no such connection exists in fact. Such misleading behavior is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy, on the part of the Respondent.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is established.

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 <canvame.xyz> be transferred to the Complainant.

Pham Nghiem Xuan Bac

Sole Panelist

Date: March 18, 2022