

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Contact Privacy Inc. Customer 0162636820 / Andrea Banfi,
Canva Templates
Case No. D2022-2195

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 0162636820, Canada / Andrea Banfi, Canva Templates, Italy.

2. The Domain Name and Registrar

The disputed domain name <canvabundle.com> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 16, 2022. On June 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 17, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 20, 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 June 21, 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 June 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on August 3, 2022. The Center received an email communication from the Respondent on August 3, 2022.

The Center appointed Karen Fong as the sole panelist in this matter on August 9, 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 which is headquartered in Australia, is an online graphic design platform founded in 2012 and its services are provided under the brand name CANVA. It has within a relatively short time achieved great acclaim and in June 2020 was valued at USD 6 billion. It currently has 60 million active users per month in 90 countries.

The CANVA trade mark is registered in many jurisdictions around the world. The earliest trade mark registration submitted in evidence is Australian Trade mark Registration No 1483138 registered in Class 9, on March 29, 2012 (the "Trade Mark"). The Complainant offers its services from its main website at "www.canva.com". It had more than 308 million visits per month between February and April 2022. It also has a portfolio of domain names under various generic Top-Level Domain ("gTLD") and country code Top-Level Domain extensions for the Second-level Domain CANVA as well as a strong social media presence under the CANVA trade mark.

The Respondent who is based in Italy, based on the information disclosed by the Registrar, registered the Domain Name on September 22, 2021. The Domain Name previously redirected Internet users to the website "www.socialtemplatebundle.com" which advertised the sale of social media templates that can be customized with the Complainant's CANVA offerings. The Domain Name is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name was registered and is being used in bad faith. The Complainant requests transfer of the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions. In the Respondent's late email communication, the Respondent stated that the website at the disputed domain name was no longer active and was meant for a client¹.

¹ For purposes of the UDRP, the Panel notes that the Rules define "the Respondent" as "the holder of a domain-name registration against which a complaint is initiated". Accordingly, whereas the Respondent may have designed or hosted the website on behalf of a client, references made within the Decision to the "Respondent" are addressed to "Andrea Banfi, Canva Templates". Additional factors such as the Respondent's intentional targeting of the Complainant via the Respondent's listed organization, "Canva Templates"; the Respondent's apparent control over the disputed domain name, given the now inactive website; and, the Respondent's lack of supporting evidence regarding any alleged agreement with a client for purposes of the website hosted at the disputed domain name, reinforces the Panel's determination on the Respondent identity.

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) The Domain Name is identical or confusingly similar to the trade marks or service marks in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) The Domain Name was registered and is being used in bad faith.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Name contains the Complainant's Trade Mark in its entirety together with the term "bundle". The addition of this word does not prevent a finding of confusing similarity between the Complainant's Trade Mark and the Domain Name. For the purposes of assessing identity and confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") which in this case is ".com". It is viewed as a standard registration requirement (section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel finds that the Domain Name is confusingly similar to the Trade Mark in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#) that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such a *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain

name. If the respondent does come forward with some allegations of evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not commonly known by the Domain Name. It has not authorised, licensed or otherwise permitted the Respondent to use the Trade Marks in the Domain Name or for any other purpose. Further, the redirecting of the Domain Name to a website for services which makes reference to the Complainant's Trade Mark and services without authorisation does not constitute a *bona fide* offering of goods or services or legitimate noncommercial or fair use of the Domain Name. The fact that the Domain Name is now being passively held also does not amount to *bona fide* offering of goods or services or a legitimate noncommercial or fair use under the Policy. Moreover, the composition of the Domain Name itself, replicating the Trade Marks, carries a risk of implied affiliation that cannot constitute fair use since it effectively impersonates or suggests sponsorship or endorsement by the Complainant (section 2.5.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered and Used in Bad Faith

To succeed under the Policy, the Complainant must show that the Domain Name has been both registered and used in bad faith. It is a double requirement.

The Panel is satisfied that the Respondent must have been aware of the Trade Mark when he/she registered the Domain Name given the reputation of the Trade Mark and the fact that it was registered prior to registration of the Domain Name. The very incorporation of the Trade Mark in the Domain Name, the redirection to a website which references the Complainant's Trade Mark and services, and the offering of services on that website which may be used in conjunction with the Complainant's services confirms the Respondent's awareness of the Trade Mark. It is therefore implausible that the Respondent was unaware of the Complainant when it registered the Domain Name.

In the [WIPO Overview 3.0](#), section 3.2.2 states as follows:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

The clear absence of rights or legitimate interests coupled with no explanation for the Respondent's choice of the Domain Name are also significant factors to consider (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). In light of the above, the Panel finds that the Respondent deliberately registered the Domain Name in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The Domain Name was directed to a website which has been set up for the commercial benefit of the Respondent. It is highly likely that Internet users when typing the Domain Name into their browser, or finding them through a search

engine would have been looking for a site operated by the Complainant rather than the Respondent. The Domain Name is likely to confuse Internet users trying to find the Complainant's website. Such confusion will inevitably result due to the fact that the Domain Name comprises the Trade Mark and a descriptive term "bundle" which may be used to describe the Complainant's services.

The website connected to the Domain Name is calculated to give the impression that it has been authorized by or connected to the Complainant when this is not the case. It was set up to deliberately mislead Internet users that it is connected to, authorised by or affiliated with the Complainant. From the above, the Panel concludes that the Respondent intentionally attempted to attract, for commercial gain, by misleading Internet users into believing that the Respondent's services were those of or authorised or endorsed by the Complainant. The fact that the Domain Name now directs to an inactive page does not prevent a finding of bad faith given the totality of circumstances and prior use.

The Panel therefore concludes that the Domain Name was registered and is being used in bad faith under paragraph 4(b)(iv) 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 Domain Name, <canvabundle.com> be transferred to the Complainant.

/Karen Fong/

Karen Fong

Sole Panelist

Date: September 5, 2022