

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Trung Nguyen Thanh
Case No. D2022-3914

1. The Parties

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

The Respondent is Trung Nguyen Thanh, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvatemplates.org> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 18, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 19, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 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 October 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 October 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2022. The Respondent did not submit any formal response, however the Respondent submitted an informal communication email on November 2, 2022. On November 15, 2022, pursuant to paragraph 6 of the Rules, the Center informed the Parties that it would proceed with the panel appointment process.

The Center appointed Zoltán Takács as the sole panelist in this matter on November 21, 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 online graphic design platform founded in 2012. Users of the Complainant's services have thousands of images and templates to choose from when creating graphic designs.

As of June 2020, the Complainant has been valued at USD 6 billion and currently has more than 60 million active users per month, with customers in 190 countries around the world.

The Complainant owns a number of trademarks consisting of or comprising the CANVA trademark, including the International Trademark Registration ("IR") No. 1204604 for the word mark CANVA, registered since October 1, 2013, for goods of class 9 of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks.

The Complainant offers services from its main website "www.canva.com", which is available in approximately 100 languages through country-specific websites. The corresponding domain name <canva.com> was created on May 5, 2001.

The disputed domain name <canvatemplates.org>, registered on January 19, 2022, does not display any content and there is no evidence it was ever put to any use.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name, fully incorporating its CANVA trademark is confusingly similar to it, since the other element of the disputed domain name is the term "templates".

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) of the Policy.

The Complainant claims that given the nature of its reputation, it is highly likely that the Respondent chose and registered the disputed domain name because of its association with the Complainant and its products and services, which is showing of bad faith.

The Complainant requests that the disputed domain name <canvatemplates.org> be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not submit any formal response.

However on November 2, 2022, the Respondent submitted an informal communication email, in which he among others stated the following: "I bought the domain name this year and paid the full fee. When buying the domain name I did not know that the domain name was copyrighted or involved in any copyright. Therefore, I do not see myself as responsible for doing anything regarding this matter".

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that "where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case" (see section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Complainant produced proper evidence of having rights in the CANVA trademark, and for the purpose of this proceeding, the Panel establishes that the IR No. 1204604 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights in the CANVA mark, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".org") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain name incorporates the Complainant's CANVA trademark in its entirety and is clearly recognizable within the disputed domain name. Inclusion of the term "templates" does nothing to prevent confusing similarity.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's CANVA trademark and that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving 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 often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the CANVA trademark.

The Respondent is not connected or affiliated with the Complainant and has not received license or consent to use its CANVA trademark, which priority precedes the date of registration of the disputed domain name.

In his informal email of November 2, 2022, the Respondent denied any responsibility for choosing and registering the disputed domain name that is confusingly similar to the Complainant’s trademark, but chose not to formally respond to the Complaint, to the facts and circumstances brought forward by the Complainant. By doing so, the Respondent failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The disputed domain name fully incorporates the Complainant’s CANVA trademark. The Complainant provides its users with countless templates to help create graphics quickly and easily, and it is obvious that the term “templates” added by the Respondent to the Complainant’s trademark in composition of the disputed domain name is manifestly descriptive of the Complainant’s business. Such composition of a domain name cannot constitute fair use (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (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 CANVA trademark is distinctive and unique to the Complainant. A basic Internet search against the disputed domain name returns solely the Complainant and its businesses.

Broad reputation of the Complainant's CANVA trademark has been recognized by previous UDRP panels (see *Canva Pty Ltd v. Varinder Rajoria KnotSync Ltd.*, WIPO Case No. [D2021-2577](#)).

Previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos) to a famous or widely-known trademark by an unaffiliated entity can itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

The Respondent has registered the disputed domain name that fully incorporates the Complainant's widely-known CANVA trademark in conjunction with the term "templates", which clearly describes one of the main business interests of the Complainant.

In view of the Panel, such composition of the disputed domain in all likelihood cannot refer to anyone else but the Complainant and suggests that the Respondent clearly had in mind the Complainant and its CANVA trademark at the time of obtaining the disputed domain name. The Panel cannot conceive any other reason for the Respondent's choice to register the disputed domain name other than to exploit the reputation behind the Complainant's CANVA trademark without any authorization or rights to do so.

There is no evidence that the disputed domain name has been used in any active way. Nevertheless, from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). The Panel cannot foresee any legitimate use of the disputed domain name by the Respondent other than deliberately targeting the Complainant's business and its CANVA trademark, which establishes bad faith considering the totality of the circumstances present here.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

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 <canvatemplates.org> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: December 5, 2022