

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Jessica Cordeiro

Case No. D2023-0397

### **1. The Parties**

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

The Respondent is Jessica Cordeiro, Brazil.

### **2. The Domain Name and Registrar**

The disputed domain name <kitcanvaenergiasolar.com> (the “Disputed Domain Name”) is registered with Wix.com Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 27, 2023. On January 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 1, 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.

The Registrar also indicated that the language of the Registration Agreement was French. The Complaint was filed in English. The Center sent an email communication to the Complainant on February 1, 2023, inviting the Complainant to provide sufficient evidence of an agreement between the Parties for English to be the language of proceeding, a Complaint translated into French, or a request for English to be the language of proceedings. The Complainant confirmed its request for English to be the language of proceedings on February 1, 2023. The Respondent did not submit any arguments.

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 in both French and English, and the proceedings commenced on February 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2023.

The Center appointed Isabelle Leroux as the sole panelist in this matter on March 10, 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.

On March 10, 2023, the Respondent sent an informal communication in Portuguese.

#### 4. Factual Background

The Complainant is an online graphic design platform founded in 2012. The Complainant currently has more than 100 million active users per month with customers across 190 countries.

For the needs and purposes of its activities, the Complainant is the owner of numerous trademarks, including the following:

- Australian wordmark, CANVA, No. 1483138, registered on September 9, 2023 in class 9, and duly renewed;
- United States of America wordmark, CANVA, No. 4316655, registered, on April 9, 2013, in class 42;
- International wordmark, CANVA, No. 1204604, registered on October 1, 2013, in classes 9 and designating China, Colombia, European Union, United Kingdom, Israel, Mexico, New Zealand, Philippines, Russian Federation, Singapore, the United States of America;
- International wordmark, CANVA, No. 1429641, registered on March 16, 2018, in classes 9, 40 and 42 an designating China, Colombia, Algeria, Egypt, Indonesia, Japan, Republic of Korea, Morocco, Mexico, Norway, Romania, Serbia, Russian Federation, Ukraine, Venezuela (Bolivarian Republic of);
- Brazilian wordmark, CANVA, No. 914660462, registered on April 30, 2019, in class 9.

Hereafter the “Trademarks” or “Trademark”.

The Complainant also owns several domain names containing the sign CANVA, including the following:

- <canva.biz> registered on March 19, 2012
- <canva.club> registered on December 5, 2018
- <canva.co.in> registered on January 7, 2013
- <canva.fi> registered on December 12, 2017
- <canva.us> registered on January 7, 2013
- <canva.cn> registered on December 8, 2013

The Disputed Domain Name <kitcanvaenergiasolar.com> was registered on June 29, 2021, and redirects to the following domain name <marketingsolar.com.br/site>. The latter reverts to a site in Portuguese offering editable template packages.

#### A. Complainant

The Complainant claims that:

- a) The Disputed Domain Name is identical or at least confusingly similar to the Complainant’s Trademarks since it incorporates the Complainant’s company name and Trademarks in their entirety with the addition of the terms “kit”, “energia”, and “solar”.
- b) The Respondent has no rights nor legitimate interests in the Disputed Domain Name since:
  - The Respondent does not own any CANVA trademark;
  - The Respondent is not commonly known under the Disputed Domain Name;
  - The Complainant has never granted any license or authorization of use to the Respondent;
  - There is no evidence that the Respondent has a history of using, or preparing to use, the Disputed Domain Name in connection with a *bona fide* offering of goods and services.

- c) The Respondent registered and used the Disputed Domain Name in bad faith given the following factors:
- The Complainant's earliest CANVA trademark predates the registration of the Disputed Domain Name by more than nine years;
  - Various prior UDRP panels have affirmed the renown and distinctiveness of the CANVA Trademark (see, for example, *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#));
  - All top Google search results for the CANVA mark pertain to the Complainant's offerings;
  - The Complainant's representative sent a cease-and-desist letter to the Respondent on August 13<sup>th</sup>, 2021. The Respondent replied to the letter on the same day clearly admitting its knowledge of the Complainant's offering and agreeing to transfer the Disputed Domain Name after a period of time had passed.

Finally, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

## **B. Respondent**

The Respondent did not submit a formal response. The Respondent sent an email stating that she did not understand English.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

First of all, the Panel finds that the Complainant has provided evidence that it has prior rights in the CANVA Trademarks and they have been filed and registered several years before the Disputed Domain Name.

Then, the Panel notices that the Disputed Domain Name is composed of the reproduction of the Trademark in its entirety, to which has been added the terms (i) "kit", "energia", and "solar", and (ii) the generic Top-Level Domain (gTLD) ".com".

The addition of the terms "kit", "energia" and "solar" does not avoid a finding of confusing similarity since the CANVA Trademark is still recognizable within the Disputed Domain Name.

Furthermore, the gTLD ".com" is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Consequently, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark. The first element of paragraph 4(a)(i) of the Policy is thus fulfilled.

### **B. Rights or Legitimate Interests**

Numerous UDRP panels have found that, even though the Complainant bears the general burden of proof under paragraph 4(a) (ii) of the UDRP, the burden of production shifts to the Respondent once the Complainant makes a *prima facie* showing that the Respondent lacks rights or legitimate interests. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Hence, after the Complainant has made a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name, it will be deemed to have satisfied paragraph 4(a)(ii) of the UDRP when the Respondent fails to submit a response.

In this case, the Complainant brings forward the following elements:

- No license or authorization has been granted by the Complainant to the Respondent;

- The Respondent is not known under the Disputed Domain Name, nor does it have any trademark rights on the term “canva”; and

- The Respondent has not used the Disputed Domain Name for a *bona fide* offering goods and services and the Disputed Domain Name resolves to another domain name <marketingsolar.com.br>.

Therefore, the Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Respondent has not come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name.

Given these circumstances, the Panel finds that the second element of paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

The Complainant states it has currently more than 100 million active users per month with customers across 190 countries covering 100 languages. The Panel finds that the Complainant does not prove that the wordmark CANVA is a reputed Trademark, however it does has submitted sufficient elements proving that its Trademark as gained reputation (Annexes 4 to 11).

Furthermore, the 2021 exchanges between the Complainant and the Respondent show that the Respondent was aware of the existence of the Complainant and agreed to transfer the Disputed Domain Name (Annex 19) and did not.

Accordingly, the Panel considers that the Respondent could not plausibly ignore the existence of the Complainant’s Trademarks at the time the Disputed Domain Name was registered.

The Panel finds that the registration was therefore made in bad faith.

As to the use of the Disputed Domain Name in bad faith, the Panel has evidenced that the Disputed Domain Name redirects to another domain name <marketingsolar.com.br/site>. This shows that 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 capitalizes on the Complainant’s CANVA Trademark.

Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain Name by the Respondent that would not be illegitimate.

Consequently, the Panel finds that the Disputed Domain Name was registered and used in bad faith, so that the third and final element of the Policy is met.

## **6. 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 <kitcanvaenergiasolar.com> be transferred to the Complainant.

*/Isabelle Leroux/*

**Isabelle Leroux**

Sole Panelist

Date: April 11, 2023