

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Sinvaldo Pinto Oliveira
Case No. D2023-0825

1. The Parties

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

The Respondent is Sinvaldo Pinto Oliveira, Brazil.

2. The Domain Name and Registrar

The disputed domain name <canvaplus.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 23, 2023. On February 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 25, 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 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 March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 3, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on April 11, 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

Since 2012, the Complainant operates an online graphic design platform that allows users to create graphic content such as leaflets, social media posts, and websites. For that purpose, the Complainant offers thousands of images and templates for users to choose from and allows users to publish their designs as interactive websites.

The Complainant also offers a “design school” which provides tutorials, courses, and events.

The Complainant owns a portfolio of trademark registration for CANVA, including the following:

- Australian Trademark No. 1483138 CANVA (word), registered on March 29, 2012, for goods in Class 9.
- United States of America Registration No. 4316655 CANVA (word), registered on April 9, 2013, for services in Class 42.
- United States of America Registration No. 6114099 CANVA (fig.), registered on July 28, 2020, for goods and services in Classes 9 and 42.
- International Trademark Registration No. 1204604 CANVA (word), registered on October 1, 2013, for goods in Class 9.
- International Trademark Registration No. 1429641 CANVA (word), registered on March 16, 2018, for goods in Classes 9, 40 and 42.
- Brazilian Trademark Registration No. 914660462 CANVA (word), registered on April 30, 2019, for goods in Class 9.

The Complainant further owns multiple domain names consisting of the word “canva”, under both gTLD and ccTLD extensions, including <canva.com> which resolves to the Complainant’s main website, from where it offers its services under the CANVA brand. The Complainant’s online platform is available to users in approximately 100 languages and also markets its offerings to users in various jurisdictions through the use of country-specific sites, including “www.canva.com/pt_br” for Brazil where the Respondent is based.

Currently, the Complainant has around 60 million active users per month with customers in 190 countries. As of June 2020, the Complainant has been valued at USD 6 billion. It has established a significant social media presence on Facebook, Instagram, Twitter, and Pinterest. Furthermore, it has been subject of extensive media coverage since its foundation, including frequent mentions in third-party lists collating the best online graphic design tools.

The disputed domain name was registered on February 22, 2022. The uncontested evidence submitted shows that at the time of filing the Complaint, the disputed domain name resolved to a website featuring the CANVA trademark and logo, which purported to sell editable graphic design templates.

Before initiating the present proceedings, the Complainant sent a cease-and-desist letter to the Respondent, to which the Respondent has not replied.

5. Parties’ Contentions

A. Complainant

The Complainant submits and contends that:

- The disputed domain name is confusingly similar to the CANVA trademark in which the Complainant has rights. In this regard, the Complainant notes that the disputed domain name entirely incorporates the Complainant’s trademark, which is distinctive and well known. The addition of the term “plus” does not prevent a finding of confusing similarity under the first UDRP element.

- The Respondent has no rights or legitimate interests in the disputed domain name since: (i) the Complainant has no relationship with the Respondent, (ii) the Respondent has not registered any trademarks for “canva” or “canva plus” or anything similar, and he is not commonly known by the disputed domain name, and (iii) the Respondent’s use of the disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. The Complainant submits that the Respondent’s demonstrated purpose and use of the disputed domain name is to capitalize on the renown of the Complainant’s CANVA mark by misleadingly diverting Internet users to the Respondent’s website. Given the nature of the disputed domain name’s string (*i.e.*, encompassing the distinctive CANVA mark in its entirety alongside the term “plus”) it is clear that the disputed domain name carries a high risk of implied affiliation and cannot constitute fair use.
- The disputed domain name was registered in bad faith, long after registration of the Complainant’s mark CANVA, which has a strong reputation and is the subject of substantial goodwill, as recognized by previous UDRP decisions. It is therefore reasonable to conclude that the Respondent was aware of the Complainant’s mark when he registered the disputed domain name.
- The disputed domain name has been used in bad faith to give Internet users the false impression that it represents, or is otherwise affiliated with the Complainant, and to attract and divert Internet users to the Respondent’s site.
- The Respondent’s failure to respond to the Complainant’s cease and desist letter further supports the finding that the Respondent is engaged in a pattern of bad faith registration and use.

Based on the above, the Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent’s rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark CANVA based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark CANVA with addition of the term "plus", followed by the generic Top-Level Domain ("gTLD") ".com".

As highlighted in section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the addition of the generic gTLD such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, "canvaplus".

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The disputed domain name entirely incorporates the Complainant's mark CANVA and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in 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) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which the Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

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) before any notice to it of the dispute, 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, even if it has acquired no trademark or service mark rights;
- (iii) it 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 trademark or service mark at issue.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the globally registered CANVA mark, which is distinctive and well known, (b) the Respondent has not been authorized to use the Complainant's trademark in any way, and is not commonly known by the disputed domain name (c) the Respondent has used the disputed domain name to sell editable design templates in connection with the Complainant's platform, and such conduct does not constitute a *bona fide* offering of goods and services or a legitimate noncommercial or fair use of the disputed domain name.

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 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.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy. Given that the disputed domain name is composed of the Complainant’s distinctive trademark, along with the descriptive addition of “plus” that falsely conveys that the website at the disputed domain name is offering superlative services in association with the Complainant, the composition of the disputed domain name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use, particularly given the impersonating nature of the content that exacerbates said risk of implied affiliation.

Therefore, the Panel finds that the Complainants have established element 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 establish that the disputed domain name has been registered and used in bad faith.

The CANVA trademark is distinctive and well known and the date of its first registration significantly precedes the date of registration of the disputed domain name. Moreover, given the use of the disputed domain name, the Panel concludes that the Respondent knew that the disputed domain name would be confusingly similar to the Complainant’s trademark. The fact that the website at the disputed domain name features the Complainant’s CANVA trademark and logo indicates that the Respondent targeted the Complainant when he registered the disputed domain name.

The above conduct constitutes opportunistic bad faith registration (see section 3.2.1 of the [WIPO Overview 3.0](#)), as well as bad faith use of the disputed domain name under the Policy. Indeed, the Respondent has used the disputed domain name to capitalize on the renown of the Complainant’s CANVA mark. Internet users who encounter the website to which the disputed domain name resolve may believe that they are dealing with the Complainant, or with a website somehow endorsed, authorized, or operated by the Complainant (see section 3.1.4 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel finds that the disputed domain name was registered and has been used in bad faith by the Respondent, with a deliberate intent to create an impression of an association with the Complainant, and to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites or of the services offered on the Respondent’s website. The Respondent’s failure to respond to the cease-and-desist letter sent by the Complainant before initiating the present proceedings, further supports the finding that the Respondent is engaged in a pattern of bad faith registration and use.

On this basis, the Panel finds that the Complainant has satisfied the third and last element of the Policy, paragraph 4a(iii).

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, <canvaplus.com>, be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: April 24, 2023