

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Keith Kong

Case No. D2023-1124

### **1. The Parties**

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

The Respondent is Keith Kong, Malaysia.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 2023, 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 March 15, 2023 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 March 16, 2023.

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 March 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondent sent the Center informal emails on March 16 and 28, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on May 9, 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

The Complainant is an online graphic design platform founded in 2012 that operates under the brand CANVA.

The Complainant owns numerous trademark registrations in different regions of the world for the brand CANVA, such as the Australian registration n°. 1483138, registered on March 29, 2012; the United States of America registration n°. 4316655, registered on April 9, 2013; the International registration n°. 1204604, registered on October 1<sup>st</sup>, 2013; the International registration n°. 1429641, registered on March 16, 2018; and the Brazilian registration n°. 914660462, registered on April 30, 2019.

In addition, the Complainant also owns several domain names reflecting its trademark CANVA, such as <canva.com>, <canva.biz>, <canva.club>, <canva.co.in>, <canva.fi>, <canva.us> and <canva.cn>.

The Respondent registered the disputed domain name on June 25, 2022.

The Panel accessed the disputed domain name on May 20, 2023, when it was not linked to any active website<sup>1</sup>. The Complainant brought evidence that the disputed domain name was recently used to display advertisement of marketing designer services, to offer access to “Canva Pro” accounts and to setup mail exchange records.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical to the Complainant’s trademark CANVA. The consensus view among panels is that, where a complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold of having trademark rights for the purpose of standing to file a UDRP case. The Complainant holds numerous trademark registrations for the term “canva” registered in various jurisdictions. The Complainant also relies on the goodwill and recognition that has been attained under the same CANVA brand. The disputed domain name clearly contains, in its entirety without alteration or adornment, the CANVA trademark, and is therefore ‘identical’ for the purposes of this element of the Policy. The Panel shall disregard the generic Top-Level domain (“gTLD”) “.monster” featured in the disputed domain name, as it is a standard registration requirement.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. To the best of the Complainant’s knowledge, the Respondent has not registered any trademarks for the term CANVA and there is no evidence that the Respondent holds any unregistered right to the term “canva”. Moreover, the Respondent has not received any license from the Complainant to use a domain name that features the CANVA trademark. Paragraph 4(c) of the Policy stipulates some circumstances where a respondent can demonstrate a right or legitimate interest in a domain name. None of the circumstances apply in this case and there is no *bona fide* offering of goods or services attached to the disputed domain name. The disputed domain name currently resolves to an inactive website. However, the disputed domain name was previously used to display an advertisement webpage for a marketing designer, unrelated to the Complainant, which purported to sell ‘Canva Pro’

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<sup>1</sup> Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8, “[n]oting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision... This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name...”.

accounts/access. This cannot constitute a *bona fide* offering of goods or services, since the Respondent attempts to imply an affiliation with the Complainant based on the nature of the disputed domain name. The Respondent is not known, nor has it ever been known, as CANVA. The CANVA trademark is distinctive and not used in commerce other than by the Complainant. Therefore, there is no plausible reason for the registration of the disputed domain name other than to take advantage of the goodwill and valuable reputation attached to the CANVA brand. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name and the burden of production shifts to the Respondent to show that it has a right or legitimate interest in the disputed domain name.

- The disputed domain name was registered and is being used in bad faith. The Complainant's earliest CANVA trademark registration predates the creation date of the disputed domain name by more than 10 years. In addition, the Complainant has accrued substantial goodwill and recognition since the Complainant's establishment in 2012. Anyone who has access to the Internet can find the Complainant's trademarks on public trademark databases. The Respondent has clearly registered the disputed domain name to target the Complainant's brand intentionally. A cease-and-desist letter was sent to the Respondent. The Respondent was given the opportunity to provide evidence of any actual or contemplated good faith use but chose not to respond. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to their website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of their website or location or of a product or service on their website or location, as well as by creating a likelihood of confusion with the Complainant's CANVA mark. The Respondent's use of the disputed domain name to host unrelated content and sell 'Canva Pro' accounts/access, is an indication of bad faith use. Finally, the Complainant notes the Respondent's activation of mail exchange (MX) records for the disputed domain name, suggesting that the Respondent has likely engaged in or will engage at some point in phishing activity. Previous panels have found bad faith 'passive use' simply where the complainant has a distinctive and established mark and the respondent provides no evidence of any actual or contemplated good faith use

## **B. Respondent**

The Respondent did not reply to the merits of the Complainant's contentions, but just sent two messages to the Center requesting the *removal* or *suspension* of the disputed domain name.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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**

The Panel has no doubt that "CANVA" is a term directly connected with the Complainant's trademark.

Annex 13 to the Complaint shows numerous trademark registrations for CANVA.

The disputed domain name consists of the Complainant's trademark CANVA followed by the gTLD ".monster".

It is already well established that the addition of a gTLD extension is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is identical to the Complainant's trademark, and that the Complainant has satisfied the first element of the Policy.

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

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use 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; 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 trademark at issue.

The Panel notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is currently not linked to any active website and the Complainant – an online graphic design platform – brought evidence that the disputed domain name previously resolved to a website advertising designer services and offering access to “Canva Pro” accounts.

The Complainant has not licensed or authorized the use of its trademark to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

Actually, the Respondent has not indicated any reason to justify why it has chosen the specific term “canva” to compose the disputed domain name, a term that has no dictionary meaning.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2022), the trademark CANVA was already well-known and directly connected to the Complainant's designing platform.

Previous uses of the disputed domain name suggest that the Complainant would be a graphic designer, with knowledge of the Canva platform.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's trademark, as well as that the adoption of the expression “canva.monster” could be a mere coincidence.

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

UDRP panels have frequently found that the apparent lack of so-called active use of the domain name (passive holding) does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

The non-collaborative posture of the Respondent, *i.e.*, (a) not presently using the disputed domain name, (b) not indicating any intention to use it, and (c) not at least providing justifications for the use of a famous third party trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion. Such circumstances, together with (d) the lack of any plausible interpretation for the adoption of the term “canva.monster” by the Respondent, (e) the evidence provided by the Complainant's demonstration of previous uses of the disputed domain name to advertise services that are related to the Complainant's activities, to offer for sale access to ‘Canva Pro’ accounts and to activate mail exchange (MX) records, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third element 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 disputed domain name <canva.monster> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: May 24, 2023