

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Lucas Pinheiro and Jeivison Luiz Carvalho de Souza  
Case No. D2022-0853

### **1. The Parties**

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

The Respondents are Lucas Pinheiro, Brazil, and Jeivison Luiz Carvalho de Souza, Brazil.

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

The disputed domain names <megapackcanva.com> and <canvacreate.com> are 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 March 11, 2022. On March 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 12, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondents are listed as the registrants and providing the contact details. In response to a notification by the Center, the Complainant filed an amended Complaint on March 29, 2022, requesting the consolidation of multiple Respondents.

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 Respondents of the Complaint, and the proceedings commenced on April 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 21, 2022. On April 13, 2022, one of the Respondents sent an informal email communication in Portuguese to the Center regarding the disputed domain name <megapackcanva.com>. The Respondents did not submit any formal response.

The Center appointed Edoardo Fano as the sole panelist in this matter on May 24, 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.

The Panel has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center (and noting the above-mentioned informal response), the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), “to employ reasonably available means calculated to achieve actual notice to the Respondent”. Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a formal response from the Respondents.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is Canva Pty Ltd., an Australian company providing an online design platform and owning several trademark registrations for CANVA, including the following:

- United States Trademark Registration No. 4,316,655 for CANVA, registered on April 9, 2013;
- Australian Trademark Registration No. 1483138 for CANVA, registered on September 9, 2013;
- International Trademark Registration No. 1204604 for CANVA, registered on October 1, 2013;
- European Union Trade Mark Registration No. 017056656 for CANVA, registered on December 15 2017;
- Brazilian Trademark Registration No. 914660462 for CANVA, registered on April 30, 2019.

The Complainant also operates on the Internet, its official website being “www.canva.com”.

The Complainant provided evidence in support of the above.

According to the WhoIs records, the disputed domain name <megapackcanva.com> was registered on May 8, 2021, and the disputed domain name <canvacreate.com> was registered on October 19, 2021. The disputed domain name <megapackcanva.com> is currently resolving to a website where the Complainant’s logo is reproduced and several package deals to some “Canva” templates are advertised. The disputed domain name <canvacreate.com> is currently inactive. The Complainant provided evidence that both disputed domain names were previously resolving to almost identical websites, advertising the same products and services as currently found in the website at the disputed domain name <megapackcanva.com>.

On October 19, 2021, the Complainant’s representatives sent a cease-and-desist letter to the Respondent owning the disputed domain name <megapackcanva.com>, without receiving any reply; on that same day, the other disputed domain name, *i.e.*, <canvacreate.com>, was registered.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain names are confusingly similar to its trademark CANVA, as the disputed domains name wholly contain the Complainant’s trademark with the addition of the descriptive terms “megapack” and “create”.

Moreover, the Complainant asserts that the Respondents have no rights or legitimate interests in respect of the disputed domain names since they have not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, they are not commonly known by

the disputed domain names, nor they are making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names. The Respondents, in the website at the disputed domain names, were advertising packs of graphic design templates and reproducing the Complainant's logo.

The Complainant submits that the Respondents have registered the disputed domain names in bad faith, since the Complainant's trademark CANVA is distinctive. Therefore, the Respondents targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as to an affiliation between the Respondents and the Complainant, qualifies as bad faith registration and use.

## **B. Respondent**

The Respondents have made no formal reply to the Complainant's contentions.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#)).

In this case, the Respondent owning the disputed domain name <megapackcanva.com> submitted one informal email communication in Portuguese on April 13, 2022, stating the following:

“Olá [WIPO], tudo bem? Entendi que foi aberto um processo de arbitragem de contestação sobre o nosso domínio megapackcanva.com. Gostaríamos de entender qual a acusação, não estamos infringindo nenhum tipo de propriedade intelectual, nós utilizamos a ferramenta Canva para criar as artes para nossos clientes, não estamos copiando o Canva, mas sim divulgando o canva para as outras pessoas. Sobre o domínio, a nossa marca é Mega Pack Canva e não Canva. Utilizamos a palavra Canva para as pessoas entenderem que são produzidas dentro da ferramenta do Canva, não estamos tentando se passar por proprietário do canva ou algo do gênero, quanto às mensagens enviadas, solicito que seja em português, para que seja claro o entendimento, obrigado. Att. Lucas Pinheiro”.

Using a machine translation, the Panel understands this roughly is meant to state: “I understand that a dispute arbitration process has been opened on our domain megapackcanva.com. We would like to understand what the accusation is, we are not infringing any kind of intellectual property, we use the Canva tool to create artwork for our clients, we are not copying Canva, but sharing Canva with others. About the domain, our brand is Mega Pack Canva and not Canva. We use the word Canva for people to understand that they are produced within the Canva tool, we are not trying to impersonate the owner of Canva or anything like that, as for the messages sent, I request that it be in Portuguese, so that the understanding is clear, thank you.”

## **6. Discussion and Findings**

### **6.1 Consolidation of Multiple Respondents**

The Complainant has requested consolidation of multiple respondents and stated that both the disputed domain names belong to the same person or organization. No objection to this request was made by the Respondents.

Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.2, “[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario”. The Panel may consider a range of factors to determine

whether consolidation is appropriate, such as examining relevant registrant contact information, and any naming patterns in the disputed domain names, or other evidence of respondent affiliation that indicate common control of the disputed domain names.

The Panel notes that both the disputed domain names were resolving to similar if not identical websites and are registered with the same Registrar. Moreover, in the website at the disputed domain name <canvacreate.com> there was the wording “Copyright © 2021 Mega Pack Canva” as well as the email address “suporte@megapackcanva.com”. The Panel finds that there is evidence that the disputed domain names are subject to common control, and that it would be procedurally efficient, fair, and equitable to all Parties to accept the Complainant’s consolidation request. The Panel further notes that the Respondents did not object to the consolidation request. The Panel therefore accepts the Complainant’s consolidation request. Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, “the Respondent”.

## 6.2 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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

The Panel finds that the Complainant is the owner of the trademark CANVA both by registration and acquired reputation and that the disputed domain names are confusingly similar to the trademark CANVA.

Regarding the addition of the terms “megapack” and “create”, the Panel notes that it is now well established that the addition of terms to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, *e.g.*, *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#)). The addition of the terms “megapack” and “create” does not therefore prevent the disputed domain names from being confusingly similar to the Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top Level Domain (“gTLD”), in this case “.com”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

The Respondent has failed to file a formal response in accordance with the Rules, paragraph 5.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not commonly known by the disputed domain names and is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names. The

Respondent has argued that insofar as it uses the Complainant's tool to create artwork for its clients, it is not copying the Complainant's product, but sharing it with others, and that its brand is "Mega Pack Canva" and not "Canva". The Respondent also nominally makes reference to the principle of nominative fair use and claims that it is not trying to impersonate the Complainant.

Whether the Respondent may share the Complainant's product with others, the Panel is not in a position to say; in either event though this may not be done by creating a false impression of an association with the Complainant, and the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as they effectively impersonate or suggest sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Based on the facts of this case, the Panel finds that paragraph 4(a)(ii) of the Policy has been satisfied.

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

Paragraph 4(b) of the Policy provides that "for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the respondent has] registered or has 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 the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [the respondent has] 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) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark CANVA in the field of online design platforms is clearly established and given the composition of the disputed domain names the Panel finds that the Respondent obviously knew of the Complainant and deliberately registered the disputed domain names, especially because the disputed domain names resolve to a website offering the same services as the Complainant and reproducing the Complainant's logo.

The Panel further notes that the disputed domain names are also used in bad faith since on the relevant websites, the Respondent is offering the same services as the Complainant and reproducing the Complainant's logo, with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the disputed domain names' source, sponsorship, affiliation or endorsement.

The above suggests to the Panel that, in accordance with paragraph 4(b)(iv) of the Policy, the Respondent intentionally registered and is using the disputed domain names in order to create confusion with the Complainant's trademark and attract, for commercial gain, Internet users to its website.

Furthermore, the Panel considers that the nature of the disputed domain names, which are almost identical to the Complainant's trademark with the mere addition of the terms "megapack" and "create", further supports a finding of bad faith and intent to confuse users about a non-existent affiliation trading off of the Complainant's reputation and goodwill. See, [WIPO Overview 3.0](#), section 3.2.1.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been 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 names <megapackcanva.com> and <canvacreate.com> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: June 7, 2022