

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. miracleellis
Case No. D2022-2034

1. The Parties

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

The Respondent is miracleellis, United States of America.

2. The Domain Name and Registrar

The disputed domain name <canvavina.tech> is registered with Dotserve Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2022. On June 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 9, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 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 the same date.

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 June 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on August 10, 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 language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is an online graphic design platform founded in 2012. The Complainant's services are offered exclusively online, and the Complainant's website receives over 200 million visits per month. As of 2019, the Complainant was valued at USD 3.2 billion and has 20 million users across 190 countries. The Complainant has expanded internationally, particularly in the Asia-Pacific region, with offices in Beijing and Manilla. Its online platform is available in over 100 languages, including Vietnamese.

The Complainant has registered several trademarks consisting of CANVA, including the International trademark No. 1204604 registered on October 1, 2013 for goods and services in International Class 9. The Complainant is also the registrant of the domain name <canva.com>, reflecting its trademark, which resolves to its official website.

The disputed domain name was registered on October 18, 2021 and as of the date of this Decision does not resolve to an active website. However, the disputed domain name used to resolve to an active website purporting to sell "Canva Pro" subscriptions in Vietnamese. The Complainant sent a cease-and-desist letter to the Respondent on November 10, 2021, requesting the transfer of the disputed domain name. The Respondent did not answer the request.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's CANVA trademark, as the disputed domain name replicates the distinctive CANVA trademark, with the addition of the term 'vina'. The term 'vina' is a synonym of 'Viet', often used by Vietnamese companies. The addition of generic or descriptive terms to a trademark is insufficient to negate confusing similarity.

As regards the second element, the Complainant argues that the Respondent received no license from the Complainant to use domain names featuring the CANVA trademark and has no trademark rights on the term "canva" or any other terms used in the disputed domain name. Further, the Complainant argues that while the disputed domain name currently resolves to an error page, it was previously used to illegitimately offer access to the Complainant's paid-for 'Canva Pro' service, in the Vietnamese language. Such use is expressly prohibited in the Complainant's Terms of Use for "CANVA" services, therefore, there has been no *bona fide* offering of goods or services on the disputed domain name.

With respect to the third element, the Complainant argues that its earliest trademark registration predates the creation date of the disputed domain name by eight years. In addition, substantial goodwill has accrued since the Complainant's establishment in 2012 and CANVA has become synonymous with online graphic design. Awareness of the Complainant's brand is further demonstrated by the fact that the Respondent previously used the disputed domain name to advertise services directly related to the Complainant's official services. Passive holding of the disputed domain name does not preclude a finding of bad faith use. Given the strength of the CANVA trademark, the lack of any good faith use, and the implausibility of any active use, which would be in good faith, the Complainant submits that the passive holding of the disputed domain name does not negate a finding of bad faith use. The previous use of the disputed domain name breached the Complainant's 'Terms of Use' for CANVA services. Moreover, the Respondent has chosen to ignore the Complainant's cease-and-desist letter sent on November 10, 2021.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Matters

No communication has been received from the Respondent in this case. However, given that notice of the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent's failure to file any Response.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

6.2 Substantive Matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of its rights in the CANVA trademark. The trademark CANVA is reproduced in its entirety in the disputed domain name. The addition of "vina", which can be considered as a geographical term as a synonym of "Viet" for Vietnamese or Vietnam Nation, does not prevent a finding of confusing similarity with the Complainant's trademark which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".tech", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark. See section 1.11.1 of the [WIPO Overview 3.0](#).

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

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark CANVA and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

From the evidence put forward by the Complainant, the website to which the disputed domain name resolved redirected Internet users to a website purporting to offer access to the Complainant's paid-for 'Canva Pro' service. The Complainant contends that it has never licensed or otherwise permitted the Respondent to use the trademark CANVA. The website at the disputed domain name displayed no disclaimer as to the lack of any relationship with the Complainant. The Respondent's use of the disputed domain name in the above circumstances is not in connection with a *bona fide* offering of goods or services as contemplated by the first circumstance of paragraph 4(c) of the Policy. See section 2.8 of the [WIPO Overview 3.0](#).

Also, there is no evidence that the Respondent is commonly known by the disputed domain name in the meaning of the second circumstance of paragraph 4(c) of the Policy. Moreover, the use of the disputed domain name is not a legitimate noncommercial or fair use as contemplated by the third circumstance of paragraph 4(c) of the Policy.

Furthermore, the nature of the disputed domain name, that includes the Complainant's well-established trademark, carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

To fulfill the third requirement of the Policy, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

According to the un rebutted assertions of the Complainant, its CANVA trademark was widely used in commerce well before the registration of the disputed domain name in August 2021 and is reputed. The disputed domain name is confusingly similar to the Complainant's trademarks (reproducing the entirety of the Complainant's trademark CANVA along with the geographical term "vina"). The website associated with the disputed domain name was used to offer access to the Complainant's paid-for 'Canva Pro' service. Under these circumstances, the Panel considers that the Respondent has registered the disputed domain name with knowledge of the Complainant and its trademark and that it targeted that trademark. The Respondent provided no explanations for why it registered the disputed domain name.

As regards the use, the disputed domain name resolved to a website used to offer access to the Complainant's paid-for 'Canva Pro' service, in the Vietnamese language, in breach of the Complainant's Terms of Use for "CANVA" services. The Panel finds that with such use the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website on its website, which is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

It appears that the disputed domain name no longer resolves to an active website. The Panel finds that the passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. 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. See section 3.1.4 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has not participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible. Considering all the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the disputed domain name by the Respondent.

Based on the evidence and circumstances of this case, the Panel concludes that the disputed domain name was registered and is being used in bad faith.

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, <canvavina.tech> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: August 24, 2022