

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) /
Jonathan dos Santos Padilha
Case No. D2022-2994

1. The Parties

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

The Respondent is Domain Admin, Privacy Protect, LLC (PrivacyProtect.org), United States of America ("United States") / Jonathan dos Santos Padilha, Brazil.

2. The Domain Name and Registrar

The disputed domain name <canvaprovalicio.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 August 12, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 13, 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 August 16, 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 August 18, 2022.

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 August 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 13, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on September 23, 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.

4. Factual Background

The Complainant was founded in 2012. It operates the online graphic design platform Canva, which is available in approximately 100 languages. The users of this platform are provided with access to thousands of images and templates to choose from when creating graphic designs for presentations, social media posts, and print products through a “drag-and-drop” methodology. The Complainant offers a basic package for free and a paid version named “Canva Pro” with many more features and design capabilities. The Complainant markets its offerings to users in various jurisdictions using country-specific websites, including one for Brazil.

The Complainant was valued at USD 6 billion as of June 2020 and currently has more than 60 million active users per month with customers in 190 countries. The Complainant offers services from its main website at “www.canva.com”. The Similarweb traffic statistics indicate that it has received about 300 million visits per month between May and July, 2022.

The Complainant is the owner of the following trademark registrations of the sign “CANVA” (the “CANVA trademark”):

- the International trademark CANVA with registration No.1204604, registered on October 1, 2013 for goods in International Class 9;
- the International trademark CANVA with registration No.1429641, registered on March 16, 2018 for goods and services in International Classes 9, 40 and 42;
- the Brazilian trademark CANVA with registration No. 914660462, registered on April 30, 2019 for goods in International Class 9; and
- the United States trademark CANVA with registration No.6114099, registered on July 28, 2020 for goods and services in International Classes 9 and 42.

The disputed domain name was registered on December 1, 2021. It resolves to a website that offers for sale lifetime access to the Canva Pro version of the Complainant’s service.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the CANVA trademark, because it incorporates this trademark in combination with the words “pro” and “vitalicio” (translated as “lifetime” in English). According to the Complainant, the addition of “pro” and “vitalicio” (the former of which directly forms part of the name of the Complainant’s “Canva Pro” offering) does not preclude the recognizability of the CANVA trademark in the disputed domain name.

The Complainant submits that the Respondent lacks rights or legitimate interests in the disputed domain name. It maintains that the Respondent is not known by the CANVA trademark or by the disputed domain name, has not registered any trademarks and is not affiliated with the Complainant or licensed by the latter to use domain names that feature the CANVA trademark. The Complainant submits that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, it uses the disputed domain name to advertise the sale of lifetime access subscriptions to the Complainant’s “Canva Pro” offering. The Complainant submits that the Respondent has not been authorized to advertise the sale of lifetime subscriptions in respect of the Complainant’s ‘Canva Pro’ offering, and its

conduct contravenes the Complainant's Terms of Use.

The Complainant also submits that the Respondent is using the disputed domain name to pass off as the Complainant. This is indicated by the website's consistent use of the Complainant's CANVA trademark and logo, similar colors to the Complainant's official site, use of the 'Canva Pro' icon as a favicon and the inclusion of claims that the Respondent's website is the only official Canva Pro Lifetime website.

The Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith. It points out that the CANVA trademark predates the registration of the disputed domain name by more than nine years, and given the composition of the disputed domain name, the Respondent must have selected it because it gives Internet users the impression that the disputed domain name would resolve to a site offering unlimited "Canva Pro" access. The Complainant submits that the Respondent has done exactly so, attempting to attract and misleadingly divert Internet users to its own website, which prominently features the CANVA trademark and logo, along with other visual indicia akin to the Complainant's main website, and advertises the sale of lifetime access to the Complainant's "Canva Pro" offering.

The Complainant notes that it sent cease and desist correspondence to the Respondent in February 2022, to which the Respondent failed to reply.

The Complainant adds that the Respondent does not disclaim its association with the Complainant, as the disclaimer on its website attempts to differentiate itself from what is claimed to be a fake third-party website, which gives Internet users the misleading impression that the disputed domain name is "official" and has been authorized by the Complainant.

B. Respondent

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

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (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 was registered and is being used in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]".

The Respondent however did not make any submission in this proceeding.

A. Identical or Confusingly Similar

The Complainant has provided evidence and has thus established its rights in the CANVA trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) portion of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD portion of the disputed domain name.

The relevant part of the disputed domain name is therefore the second-level domain portion “canvaprovitalicio”. It consists of the elements “canva”, “pro” and “vitalicio”. The “canva” element is identical to the CANVA trademark and is easily recognizable in the disputed domain name.¹

In view of all the above, the Panel finds that the disputed domain name is confusingly similar to the CANVA trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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. See section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Respondent has not been authorized by the Complainant to use the CANVA trademark or to distribute the Complainant’s products, and that the Respondent is not carrying out a *bona fide* use of the disputed domain name. According to the Complainant, the Respondent uses the disputed domain name for a website that offers paid lifetime access to the professional version of the Complainant’s service without disclosing the lack of relationship between the Parties. Thus, the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not alleged that it has rights or legitimate interests in the disputed domain name and has not disputed the Complainant’s allegations in this proceeding.

As summarized in section 2.8.1 of [WIPO Overview 3.0](#), panels under the Policy have recognized that resellers and distributors using a domain name containing the complainant’s trademark to undertake sales of the complainant’s goods may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name, if they comply with certain cumulative requirements, among which is the requirement that the reseller’s or distributor’s website must accurately and prominently disclose its relationship with the trademark holder.

This requirement has not been complied with in the present case. The disputed domain name is confusingly similar to the CANVA trademark and resolves to a website that offers paid access to the Complainant’s service without identifying the supplier of the offered goods and without disclosing the lack of relationship between the Parties. The website at the disputed domain name states: “Este é o único site oficial do Canva Pro Vitalício” (translated in English as: “This is the only official Canva Pro Lifetime website.”) The

¹ It can be noted here regarding the second and third elements of the Policy that the “pro” element is widely used as an abbreviation for the dictionary word “professional”, and its combination with “canva” is identical to the name “Canva Pro”, used by the Complainant for the professional version of its service. The “vitalicio” element is a dictionary word in Portuguese, meaning “lifetime” in English. Looking at the combination of these three words, it does not appear as a coincidence that the Respondent has connected the disputed domain name to a Portuguese language website that offers lifetime access to the Canva Pro service of the Complainant. Rather, the composition of the disputed domain name supports a conclusion that the Respondent chose it because it describes what the Respondent is offering on the associated website.

website also displays the following notice: ATENÇÃO! Este é o único site oficial do Canva Pro Vitalício. O site canvaproitalicio.com.br é um clone mal intencionado deste site e não têm qualquer ligação conosco. Estamos tomando as devidas providências para tirar esse site do ar o quanto antes. Obs: compras realizadas no site canvaproitalicio.com.br não são de responsabilidade do Canva Pro Vitalício.” (Translated in English as “ATTENTION! This is the only official Canva Pro Lifetime website. The site canvaproitalicio.com.br is a malicious clone of this site and has no connection with us. We are taking the necessary steps to take this site offline as soon as possible. Note: purchases made on the website canvaproitalicio.com.br are not the responsibility of Canva Pro Lifetime.”) With these statements, the website creates the impression that it is the only official online location offering lifetime access to the Complainant’s Canva Pro service with the authorization of the Complainant. The Complainant denies having given such authorization, and the Respondent has made no contrary allegation or submitted any evidence supporting a different conclusion.

Considering the above, the Panel concludes that the Respondent does not meet the requirement that its website must accurately and prominently disclose its relationship with the Complainant whose product and service the Respondent offers for sale. Therefore, the Panel does not regard the Respondent’s conduct as a *bona fide* offering of goods or services and finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have 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 complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

As discussed above, the disputed domain name is confusingly similar to the CANVA trademark and is linked to a website that offers paid lifetime (“vitalicio” in Portuguese) access to the professional version of the Complainant’s service with the name Canva Pro. The website displays the CANVA trademark and does not disclose the lack of relationship with the Complainant. Rather, it contains misleading statements that it is the only official online location offering the Complainant’s services. The Respondent does not deny the Complainant’s contention that it is not an authorized seller of the Complainant’s services.

Taking the above into account, the Panel accepts that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the CANVA trademark in an attempt to attract traffic to the disputed domain name by misleading Internet users that they are reaching an official or authorized online location where paid access to the professional version of the Complainant’s service is offered, and has used the disputed domain name to offer such access for commercial gain.

Taking the above into account, the Panel finds that the disputed domain name has been registered and 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, <canvaprovincialicio.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: October 7, 2022