

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. mahbod tabatabaie mahbod tabatabaie
Case No. D2023-1516

1. The Parties

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

The Respondent is mahbod tabatabaie mahbod tabatabaie, Tajikistan.

2. The Domain Name and Registrar

The disputed domain name <canvafarsi.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 18, 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 (“Redacted for privacy”) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 18, 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 April 19, 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 April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2023.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on June 1, 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 by Melanie Perkins, Cliff Obrecht and Cameron Adams.

The users of the Complainant's services have thousands of images and templates to choose from, when creating graphic designs.

The Complainant's CANVA offerings relate to many uses and contexts (e.g., for presentations, social media posts, and a range of print products).

The online platform is easy-to-use, intuitive and utilizes a 'drag-and-drop' methodology. As a result, the Complainant's services have achieved significant reputation and acclaim.

The Complainant was valued at USD 40 billion in September 2021, and currently has more than 100 million active users per month (MAUs) with customers across 190 countries.

The Complainant offers services from its main website "www.canva.com". Third-party Internet traffic statistics indicate that the Complainant's main website received an average of more than 370 million visits per month between October and December 2022.

The CANVA brand is well known around the world. The Complainant's services are offered exclusively online, which make them inherently global.

The Complainant uses region-specific sites to market its products or services.

The Complainant launched its app for the iPad in 2014, which grew access to CANVA services. The Complainant's app is available on both the App Store and Google Play; it has been downloaded more than 100 million times on Google Play. Additionally, the Complainant's business has grown through the acquisitions of Zeetings, Pexels and Pixabay. The Complainant also maintains blogs and learning resources on design, marketing, branding, and photography.

The Complainant also offers a "design school", which provides tutorials, courses, and events. The "design school" helps businesses and graphic designers to perfect their work with courses such as "Print Advertising", "Typography & Layout" and "Creating a logo".

The Complainant holds a number of registered trademarks for the "canva" term, some of which are exhibited below:

Trademark	Origin	Registration number	Registration date	Classes covered
CANVA	Australia	1483138	March, 29, 2012	9
CANVA	United States of America	4316655	April 9, 2013	42
CANVA	International Registration	1204604	October 1, 2013	9
CANVA	International Registration	1429641	March 16, 2018	9, 40, 42
CANVA	Brazil	9144660462	April 30, 2019	9
CANVA and design	United States of America	6114099	July 28, 2020	9, 42
CANVA and design	International Registration	1689790	March 21, 2022	9, 40, 42, 45

The Complainant is also the holder of numerous domain names that include their trademark CANVA, under generic Top-Level Domain ("gTLD") and country code Top-Level Domain ("ccTLD") extensions. Examples of these registrations are presented in the table below:

Domain Name	Registration Date
<canva.biz>	March 19, 2012
<canva.club>	December 5, 2018
<canva.co.in>	January 7, 2013
<canva.fi>	December 16, 2017
<canva.us>	January 7, 2013
<canva.cn>	December 8, 2013

The disputed domain name <canvafarsi.com> was registered on May 6, 2022, it resolves to a website using an altered version of the Complainant's logo and advertising the sale of commercial packages and services pretending to pass itself off as the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its CANVA trademark. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, the Complainant states that the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that disputed domain name has been registered and is being used in bad faith

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established that it has registered trademark rights in the CANVA trademark. As noted in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1: "Where the Complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case."

In order to establish the confusing similarity test, panels typically do a side-by-side comparison between the trademark and the domain name to establish if the complainant's trademark is recognizable within the domain name.

In this case, the disputed domain name <canvafarsi.com> incorporates the trademark CANVA in its entirety with the word "farsi". As stated in [WIPO Overview 3.0](#), section 1.7: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Panels have also established that, where the relevant trademark is recognizable, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of

confusing similarity under the first UDRP element (see [WIPO Overview 3.0](#), section 1.8). The Complainant's CANVA mark remains clearly recognizable in the disputed domain name; the addition of the word "farsi" does not prevent a finding of confusing similarity.

The gTLD ".com" does not prevent the confusing similarity between the disputed domain name and the Complainant's trademark CANVA. As stated by section 1.11.1 of the [WIPO Overview 3.0](#), "[t]he applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test".

For the foregoing reasons, the Panel finds that the disputed domain name is confusingly similar to the CANVA trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) before any notice to you of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to 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, even if it has acquired no trademark or service mark rights; 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 or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent does come forward with evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not referred to or commonly known by the disputed domain name or any related trademark. The Complainant also claims that it has not authorized the Respondent to use the trademark in any way including use in a domain name, and also that the Respondent has no rights to or legitimate interests in respect of the disputed domain name based on the Complainant's prior use of its trademark CANVA.

The Complainant argues that the Respondent is not affiliated or related to the Complainant in any way, or licensed or otherwise authorized to use the CANVA mark in connection with a website, a domain name or for any other purpose. The Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain, is not commonly known by the disputed domain name and has not acquired any trademark or service mark rights in that name or mark.

Additionally, the Complainant submits that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The disputed domain name currently resolves to a site which, while brandishing an altered version of the Complainant's distinctive CANVA logo, purports to offer the sale of its own or third-party commercial packages and courses. The "about us" section at the bottom of the disputed domain name's homepage indicates that the site is controlled by "Mahdis Web Group", which is purportedly active in the field of web software design and development services.

Accordingly, the evidence presented by the Complainant the Panel finds that the Respondent's use of the disputed domain name, and adapted CANVA logo, to advertise its own/third-party commercial services, but that conduct could not be considered as a *bona fide* offering of goods or services. To the contrary, the Respondent's use of the disputed domain name and adapted CANVA logo gives Internet users the false impression that the offerings at the resolving site are associated with the Complainant when this is not the case.

The Panel finds that, supported by the evidence presented in this case by the Complainant, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the CANVA mark. On the contrary, the Panel finds that the Respondent has clearly used the site at the CANVA-contained disputed domain name to attract and misleadingly divert Internet users to a site which advertises the sale of its purportedly own/third-party commercial packages and courses. As noted above, the disputed domain name's site brandishes an altered version of the Complainant's distinguished CANVA logo, this use reinforces the false impression among Internet users arriving at the site that the site is authorized or endorsed by the Complainant. Additionally, the site displayed at the disputed domain name does not attempt to disclaim any perceived association that it may be affiliated with the Complainant.

In conclusion, according to this Panel, in the present case, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services nor making any legitimate noncommercial or fair use of the disputed domain name.

The Panel finds therefore that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests onto the Respondent.

For the foregoing reasons the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the requirements of paragraph 4(a)(ii) of the Policy therefore are fulfilled.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith.

The Panel finds that the Respondent must have been aware of the CANVA trademark considering the trademark registration for CANVA predates the registration of the disputed domain name by almost than 10 years.

As the Panel stated before, the disputed domain name incorporates the Complainant's trademark CANVA and was registered almost 10 years after the CANVA trademark registration.

Given the distinctiveness and the well-established reputation of the Complainant's trademark, in all likelihood, the Respondent could not ignore the Complainant's CANVA trademark at the time it registered the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith with a deliberate intent to create an impression of an association with the Complainant. See [WIPO Overview 3.0](#), section 3.2.2.

The Panel finds that the Respondent registered the disputed domain name for the purpose of trading on the reputation of the Complainant and its CANVA mark and that the Respondent was aware of the importance of the CANVA trademark.

The Respondent has intentionally registered and is using the disputed domain name in bad faith. It is apparent from the composition of the disputed domain name that the Respondent chose to register the disputed domain name that is confusingly similar to the Complainant's trademark CANVA with the trademark

in mind whether to obtain a direct or indirect benefit out of the disputed domain name. The Panel finds that the Respondent more likely than not was fully aware of the fact that it incorporated a well-recognized and distinctive trademark in which the Respondent had absolutely no prior rights.

Concerning the use of the disputed domain name, the evidence submitted by the Complainant shows that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's CANVA mark. The Respondent has sought to capitalize on the Complainant's CANVA offerings through its use of the disputed domain name to advertise its own offering of editable templates. The Respondent's use of the CANVA mark, both in the disputed domain name and in the name of its commercial offering, creates the false impression that the disputed domain name's site is authorized, endorsed, or otherwise associated with the Complainant (see *Canva Pty Ltd v. Jose de Souza Silva, ABC do Canva*, WIPO Case No. [D2022-1316](#)).

The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's CANVA mark. According with the evidence presented in the present case the Respondent has been capitalizing on the Complainant's CANVA offerings through its use of a confusingly similar domain name and brandishing of an altered version of the Complainant's distinctive CANVA logo on the resolving site.

Also, this Panel notes that the Complainant further highlights that the Respondent fails to disclaim its lack of connection with the Complainant on the website at the disputed domain name, which affirms the risk of Internet-user confusion. Other panels have repeatedly found that such conduct, particularly in circumstances where there is a likelihood of Internet-user confusion, constitutes evidence of bad faith under the Policy. See, for example, *KIKO S.p.A. v. Registration Private, Domains by Proxy, LLC / Blake Spencer*, WIPO Case No. [D2019-1301](#). Likewise, the Panel finds that the Complainant intended to communicate with the Respondent by sending a cease-and-desist letter to the Respondent in September 2022. The Complainant did not receive a response to this correspondence, and UDRP panels have repeatedly found that a respondent's failure to respond to the cease-and-desist letter may constitute additional evidence of its bad faith (see, for example, *Sanofi v. Domain Administrator, See PrivacyGuardian.org / online store, William Johnson*, WIPO Case No. [D2019-2846](#), in which the panel stated that the respondent's failure to respond to a cease-and-desist letter sent by the complainant "further reinforces the inference of bad faith registration and bad faith use"). The Respondent had the opportunity to explain its registration of the disputed domain name but chose not to do so. The Respondent clearly registered the disputed domain name for the purpose of trading on the reputation of the Complainant and its CANVA trademark.

All the above circumstances confirm the Respondent's bad faith in the disputed domain name under the Policy.

Therefore, the Panel finds that the disputed domain name was registered and is being used in bad faith under paragraph 4(a)(iii) 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 <canvafarsi.com> be transferred to the Complainant.

/Ada L. Redondo/

Ada L. Redondo

Sole Panelist

Date: June 15, 2023