

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. yu xuan deng, 宇富科技有限公司 (Yu Fu Ke Ji You Xian Gong Si)

Case No. D2023-1773

### **1. The Parties**

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

The Respondent is yu xuan deng, 宇富科技有限公司 (Yu Fu Ke Ji You Xian Gong Si), Taiwan Province of China.

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

The disputed domain name <canva.tapei> is registered with Gandi SAS (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on April 26, 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 in English on May 5, 2023.

On April 26, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant submitted its request that English be the language of the proceeding on May 5, 2023. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on May 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 31, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on June 13, 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 headquartered in Australia and founded in 2012. Users of the Complainant's services have thousands of images and templates to choose from when creating graphic designs. As a result, the Complainant's services have achieved significant reputation and the Complainant has been valued at USD 40 billion as of September 2021, and currently has more than 100 million active users per month with customers in 190 countries. The Complainant offers services from its main site, "www.canva.com", which received an average of more than 400 million visits per month between January and March 2023. The Complainant's online platform is available in approximately 100 languages, including Chinese. The Complainant markets its offerings to users based in various jurisdictions, including Taiwan, through the use of region-specific sites.

The Complainant owns an extensive international trademark portfolio for the mark CANVA, including the following registrations: CANVA, Australian mark, registered on March 29, 2012 under No. 1483138; and CANVA, United States word mark, registered on April 9, 2013 under No. 4316655. The Complainant also has a strong online presence and owns a large domain name portfolio of official domain names which contain its trademark CANVA, including <canva.cn>, registered on December 8, 2013.

The disputed domain name was registered on November 21, 2021, and is therefore of a later date than the abovementioned trademark registrations of the Complainant. The Complainant submits evidence that the disputed domain name directs to an inactive webpage.

The Complainant also provides evidence that it attempted to resolve this dispute amicably through its cease-and-desist letter of November 25, 2022, to which the Respondent did not reply.

#### **5. Parties' Contentions**

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

The Complainant essentially contends that the disputed domain name is identical to its trademarks for CANVA, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its trademarks are intensively used and well known and provides evidence of its company and marketing materials. The Complainant also refers to a number of prior UDRP decisions in which earlier panels have recognized the Complainant's rights in the CANVA marks and considered that such marks are internationally well known, see for instance, *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#). The Complainant particularly contends that the Respondent is holding the disputed domain name passively, without making any concrete use of it. The Complainant also argues that given the international fame of its trademarks, the Respondent cannot have been unaware of them at the time of registration of the disputed domain name. Moreover, the Complainant contends that the Respondent is merely passively holding the disputed domain name in bad faith. The Complainant essentially argues that there are no justifications for the Respondent's use of its trademarks in the disputed domain name and that such registration and use were conducted in bad faith.

The Complainant requests that the disputed domain name be transferred to it.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding.

In considering the language of this proceeding, the Panel has carefully taken into account all elements of this case, and considers the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited in a timely manner by the Center in both Chinese and English to present its response and arguments in either Chinese or English, but chose not to do so); the fact that the disputed domain name contains the Complainant's CANVA trademark in its entirety and that it is written in Latin letters and not in Chinese characters and, finally, the fact that Chinese as the language of this proceeding could lead to unwarranted delay of the proceeding and costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this proceeding shall be English.

### **6.2. Discussion and Findings on the Merits**

The Policy requires the Complainant to prove three elements:

- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has shown that it has valid rights in the mark CANVA, based on its use and registration of the same as a trademark in a number of jurisdictions.

Moreover, as to whether the disputed domain name is identical or confusingly similar to the Complainant's mark, the disputed domain name consists of only the Complainant's registered trademark for CANVA, followed by the generic Top-Level Domain ("gTLD"), namely ".taipei". The Panel refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1, which states: "The 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." The Panel concludes that the disputed domain name contains only the Complainant's trademark CANVA, and that the disputed domain name is therefore identical to this trademark owned by the Complainant.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's registered trademark for CANVA, and concludes that the Complainant has satisfied the requirements of the first element under the Policy.

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

On the basis of the evidence and arguments submitted, the Panel accepts that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making a legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Further, reviewing the facts of this proceeding, the Panel notes that the disputed domain name directs to an inactive webpage and that there are no elements in this case that point to the Respondent having made any reasonable and demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Panel therefore finds that the Respondent is holding the disputed domain name merely passively, without making any substantive use of it, and that such use does not confer any rights or legitimate interests in the disputed domain name on the Respondent (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#) and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

Furthermore, the Panel agrees with the Complainant that the nature of the disputed domain name, being identical to the Complainant's trademarks for CANVA, carries a high risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant and its products or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing elements, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and finds that the Complainant has satisfied the requirements of the second element under the Policy.

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

The Panel finds that the registration of the disputed domain name, which is identical to the Complainant's internationally well-known and intensively used trademarks for CANVA, is clearly intended to mislead and divert consumers away from the Complainant's official website to a website which may be linked to the disputed domain name by the Respondent. The Panel has also considered that the Complainant has a strong Internet presence and that previous panels under the UDRP have also recognized the CANVA marks as internationally well known (see for instance (see, for example, *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#)). Based on these facts, the Panel finds that the Respondent's registration of the disputed domain name constitutes an intentional attempt to target the Complainant's well-known trademark, of which the Respondent could not reasonably be unaware. Furthermore, even a cursory Internet search at the time of registration of the disputed domain name would have shown that the Complainant owned registered trademarks in CANVA and uses them extensively, and also specifically targets Chinese speakers through its official <canva.cn> domain name. Based on the above elements, the Panel finds that the registration of the disputed domain name was obtained in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directs to an inactive website and that there are no elements in this case that point to the Respondent having made any reasonable and demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. In this regard, the [WIPO Overview 3.0](#), section 3.3, provides: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." The Panel has reviewed all elements of this case, and attributes particular relevance to the

following elements: the fact that the disputed domain name is identical to the Complainant's trademarks for CANVA, the international fame and high degree of distinctiveness of the Complainant's trademarks, the fact that the Respondent did not reply to the Complainant's cease-and-desist letter, and the unlikelihood of any good-faith use to which the disputed domain name might be put by the Respondent. In these circumstances, the Panel considers that the passive holding of the disputed domain name by the Respondent constitutes use in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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.taipei> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: June 22, 2023