

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Domain Admin, Domain Whois Protection Service / Ho Quoc Huan

Case No. D2022-1798

1. The Parties

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

The Respondent is Domain Admin, Domain Whois Protection Service, Viet Nam / Ho Quoc Huan, Viet Nam.

2. The Domain Name and Registrar

The Disputed Domain Name <canva100k.com> (the “Disputed Domain Name”) is registered with P.A. Viet Nam Company Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 18, 2022. On May 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 20, 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 May 30, 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 May 31, 2022.

On May 30, 2022, the Center transmitted another email communication to the Parties in English and Vietnamese regarding the language of the proceeding. On May 31, 2022, the Complainant submitted its request that English be the language of the proceeding. 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 of the Complaint in both English and Vietnamese, and the proceedings commenced on June 8, 2022. In

accordance with the Rules, paragraph 5, the due date for Response was June 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 30, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on July 5, 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 is an online graphic design platform founded in 2012, which offers its users thousands of images and templates to choose from when creating graphic designs through an "easy-to-use" online platform. The Complainant's services are offered exclusively online through its main site "www.canva.com" to offer its services, as a basic package, for free, besides offering a paid version named "Canva Pro" with more features and design capabilities aimed predominately at professionals or graphic design teams within companies. The CANVA website is now available in Vietnamese, among other approximately 100 languages.

The Complainant holds several registered trademarks for the CANVA term (the "CANVA trademarks") for design-related goods/services in a variety of countries, including, but not limited to Australia Registration No. 1483138 registered on September 9, 2013, in Class 9; United States Registration No. 4316655 registered on April 9, 2013, in Class 42; and International Registration No. 1204604 registered on October 1, 2013, in Class 9.

In addition, the Complainant is the owner of some domain names featuring the trademark CANVA, including, but not limited to, <canva.biz> registered on March 19, 2012; <canva.us> registered on January 7, 2013; and <canva.cn> registered on December 8, 2013.

The Disputed Domain Name was registered on September 19, 2021. As of the date of this Decision, the Disputed Domain Name resolves to an inactive website. However, the Disputed Domain Name was used to resolve an active website using the Complainant's CANVA trademarks and purporting to sell "Canva Edu" subscriptions in Vietnamese.

The Complainant sent a cease and desist letter to the Respondent on October 13, 2021, requesting a transfer of the Disputed Domain Name. The Respondent then responded to the cease and desist letter in English on October 21, 2021, informing that the website under the Disputed Domain Name would be closed.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

First, the Complainant asserts that the Complainant holds trademark registrations for CANVA in many jurisdictions. Further, the Complainant contends that its CANVA trademarks have attained goodwill and recognition, which is a distinctive identifier associated with the Complainant's services.

Second, the Complainant argues that the Disputed Domain Name is confusingly similar to the CANVA trademarks owned by the Complainant because the Disputed Domain Name incorporates the Complainant's

distinguished CANVA trademarks in its entirety, and the addition of the term “100k” within the Disputed Domain Name would not avoid confusing similarity.

Finally, the Complainant submits that the generic Top-Level Domain (“gTLD”) “.com” is disregarded under the first element as it is a standard registration requirement.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant contends that, to the best of the Complainant’s knowledge, the Respondent does not retain any registered or unregistered right to the term “canva”, or any other terms used in the Disputed Domain Name. Neither has the Respondent received any license from the Complainant to use domain names featuring the CANVA trademarks.

Second, the Complainant argues that there is no evidence that the Respondent has used or prepared to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Instead, the Respondent has used the Disputed Domain Name to advertise commercial offerings in connection with the Complainant’s CANVA trademarks. Furthermore, the Respondent has not made any attempt to disclaim its lack of connection with the Complainant.

Third, the Complainant contends that the Respondent has not ever been known by the CANVA trademarks, nor by “canva100k”, and the ownership of the Disputed Domain Name does not confer rights or legitimate interests on the Respondent.

In addition, the Complainant submits that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain to divert consumers misleadingly or to tarnish the CANVA trademarks. Notably, the Respondent used the Disputed Domain Name to redirect Internet users to a website that offered services in connection to the Complainant to generate revenue as a result of customer’s false impression of affiliation with the Complainant. In addition, the Respondent’s website does not contain any disclaimer to the perceived association between the website under the Disputed Domain Name and the Complainant.

Finally, the Complainant contends that the Complainant has presented a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Thus, the burden of proof now shifts to the Respondent to show that it has rights or legitimate interests in the Disputed Domain Name.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant argues that its earliest CANVA trademark registration predates the registration of the Disputed Domain Name by more than 9 years, and the Complainant has accrued substantial goodwill, and international recognition in its CANVA trademarks.

Second, the Complainant submits that the Respondent should have been aware of the Complainant’s CANVA mark at the time of registration of the Disputed Domain Name, since simple Internet searches would have unequivocally brought the Complainant’s established rights in the CANVA mark to the Respondent’s attention.

In addition, the Respondent did not sufficiently reply to the Complainant’s cease and desist letter but solely responded on October 21, 2021, to note that it “closed domain www.canva100k.com” without answering subsequent contact attempts by the Complainant to transfer the Disputed Domain Name. The Respondent’s sole response does not deny prior knowledge of the Complainant’s CANVA trademarks.

Forth, the Complainant submits that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s CANVA trademarks because the Respondent featured the Complainant’s distinctive CANVA trademarks in the Disputed Domain Name and the website thereunder to advertise commercial services in connection with the Complainant’s CANVA

brand. In addition, the Respondent failed to disclaim its lack of connection to the Complainant, and the Respondent's conduct was designed to capitalize on the likelihood of ensuing Internet user confusion.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Procedural Issues

(I) Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement is Vietnamese.

As the Complaint was filed in English, the Center, in its notification dated May 30, 2022, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding by June 2, 2022.

On May 31, 2022, the Complainant submitted to the Center an amended Complaint, requesting that English be the language of the proceeding.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

(i) the fact that the Complainant, an Australian entity, does not appear to be able to communicate in Vietnamese, and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;

(ii) the English language is quite popular in Viet Nam, where the Respondent appears to be located, and the Disputed Domain Name and its associated website contain English content. In addition, the Respondent's response to the Complainant's cease and desist was written in English. These suggest that the Respondent has knowledge of the English language and would be able to communicate in English;

(iii) the Respondent did not object to English being the language of the proceeding and did not submit a Response in either English or Vietnamese.

Therefore, for easy comprehension of the Complainant (ultimately, the Party solely taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

(II) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#), and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The Complainant is required to establish the two following elements: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Panel finds that the Complainant had clearly evidenced that it had registered trademark rights to CANVA well before the Disputed Domain Name was registered.

Second, the Disputed Domain Name consists of the Complainant's CANVA trademarks in its entirety in which the Complainant has exclusive rights. The difference between the Disputed Domain Name and the trademark is the addition of the suffix "100k".

According to the evidence provided by the Complainant, the Disputed Domain Name used to resolve to an active website, in which the Panel finds the statement in Vietnamese "THIẾT KẾ NHƯ CHUYÊN GIA CHỈ VỚI 100K" (in English: DESIGN LIKE A PROFESSIONAL FOR ONLY 100K) and "Canva Edu Riêng – 100k" (in English: Individual Canva Edu – 100k). Thus, the term "100k" can be reasonably interpreted in Vietnamese as "100 thousand Viet Nam dong", which is the price for the Respondent's service offered on the website under the Dispute Domain Name.

It is well established that the addition of a merely descriptive term to a trademark does not prevent confusing similarity. Thus, in the Panel's view, the addition of the said term does nothing to prevent the CANVA trademarks from being recognizable in the Disputed Domain Name, nor to prevent confusing similarity, as it was found in previous UDRP decisions (see, e.g., *Price Costco International, Inc. v. Huynh Van Duc*, WIPO Case No. [D2020-0321](#); *Philip Morris Products S.A. v. Ong Nguyen Ngoc Ha*, WIPO Case No. [D2019-2509](#); and *Facebook, Inc. v. Domain Admin Privacy Protect, LLC (PrivacyProtect.org) / Do Viet Dung*, WIPO Case No. [D2019-1121](#)).

Third, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".com" to the Disputed Domain Name does not constitute an element to avoid confusing similarity for the Policy purposes (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. D2012 2066; *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Based on the foregoing findings, the Panel finds that the Disputed Domain Name is confusingly similar to the CANVA trademarks, and paragraph 4(a)(i) of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular, but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain

Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.”

The Panel finds that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant’s contentions and, therefore, did not refute them.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no official response was submitted with evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant’s asserted facts, that no license, permission or authorization of any kind to use the Complainant’s trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to CANVA trademarks or the Disputed Domain Name. Thus, the Panel finds that the Respondent has no rights in the CANVA trademarks.

As mentioned in section 2.8.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), in the absence of prior agreement between the parties regarding the registration or use of domain name incorporating the complainant’s trademark, a reseller or distributor may be making a *bona fide* offering of goods and services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“*Okidata*”), including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the site itself must accurately disclose the respondent’s relationship with the trademark owner; and
- the respondent must not try to “corner the market” in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, it is proven and evidenced by the Complainant that the Disputed Domain Name used to resolve to a website appearing to sell subscriptions to the paid-for service “Canva Edu”, which provide users with the features of the Complainant’s “Canva Pro” offering. On such website, the Panel finds that the Respondent did not place any statement or disclaimer disclosing accurately and prominently its relationship (or lack thereof) with the Complainant. In contrast, as provided by the Complainant, the Panel finds that the website under the Disputed Domain Name contained some elements referring to the Complainant and its CANVA trademarks, logo, name of the paid-for services “Canva Edu” and “Canva Pro”. These indications

may falsely suggest a relationship between the Respondent and the Complainant's services.

With such a view, the Panel finds that the use of the Disputed Domain Name does not meet the *Oki Data* criteria and, thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Moreover, the nature of the Disputed Domain Name, consisting of the Complainant's CANVA trademarks and the descriptive term "100k", carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that no evidence would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, following the Complainant's assertions and evidence regarding the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the CANVA trademarks and intended to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests regarding the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy, is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular, but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(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."

The above four circumstances are not exhaustive, and the Panel may find bad faith alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence concerning the Respondent's bad faith registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's CANVA trademarks have been registered in a variety of jurisdictions around the world. In addition, the Complainant's CANVA trademarks have been used for several years and have gained a certain reputation in the online graphic design sector in numerous countries, including in Viet Nam, where the Respondent resides. The Complainant's registration of the CANVA trademarks predates the Disputed Domain Name registration. Given the above mentioned circumstances of this case, it is inconceivable that

the Respondent registered the Disputed Domain Name without prior knowledge of the Complainant and the Complainant's CANVA trademarks.

Furthermore, the Panel considers the use of the Disputed Domain Name and the contents of the website thereunder and is of the view that the Respondent obviously knew of the Complainant and its CANVA trademarks when it registered the Disputed Domain Name. It seems to the Panel that the registration of the Disputed Domain Name is an attempt by the Respondent to take unfair advantage of the Complainant's goodwill and the reputation of the Complainant's CANVA trademarks, or at least to lure consumers to its website. In contrast, the use of the CANVA trademarks in the Disputed Domain Name and the website thereunder has not been approved or permitted by the Complainant as the trademark holder.

Moreover, it is well proven and evidenced by the Complainant that the website under the Disputed Domain Name was used to offer for sale the subscriptions to the paid-for service "Canva Edu", which was advertised as having the features of the Complainant's "Canva Pro" offering. The Panel would add that, besides the adoption of the Complainant's CANVA trademarks as a uniquely distinctive part in the Disputed Domain Name, the Respondent used the Complainant's CANVA trademarks and logo on the website thereunder clearly gives Internet users the impression that the website was either an official website of the Complainant, or a website that was affiliated with the Complainant, either which is not the case. As a result, the Panel finds that by using the Disputed Domain Name, 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.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it resolves to an inactive website. However, this nonuse of the Disputed Domain Name does not change the Panel's finding of the Respondent's bad faith, as stated in section 3.3 of the [WIPO Overview 3.0](#).

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith, and the third element under paragraph 4(a)(iii) of the Policy is established.

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 <canva100k.com> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: July 19, 2022