

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Super Privacy Service LTD c/o Dynadot /
Capuz Ernilyn Oboza, Capuz Ernilyn Oboza
Case No. D2022-0227

1. The Parties

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

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America (“United States”) / Capuz Ernilyn Oboza, Capuz Ernilyn Oboza, Philippines.

2. The Domain Name and Registrar

The disputed domain name <designwithcanva.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2022. On January 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 26, 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 January 26, 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 January 28, 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 February 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2022. Informal communications were sent to the Center by the Respondent on February 8, 2022.

The Center appointed Tobias Zuberbühler as the sole panelist in this matter on February 24, 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 currently has more than 60 million active users per month with customers in 190 countries. The Complainant also offers a “design school”, which provides tutorials, courses and events.

The Complainant owns trademark registrations in various jurisdictions, including the Australian trademark CANVA (Reg. No. 1483138, registered on March 29, 2012), the United States trademark CANVA (Reg. No. 4316655, registered on April 9, 2013), and the International trademark CANVA (Reg. No. 1204604, registered on October 1, 2013).

The Complainant further holds the domain name <canva.com> under which the official website of the Complainant is available. The Complainant advertises and sells its services through its <canva.com> domain name. The Complainant holds various other domain names incorporating the CANVA trademark.

The disputed domain name was registered on September 27, 2021 and resolved to a website advertising online gambling services unconnected to the Complainant. At some point in time, the website has been deactivated.

Before initiating the present proceedings, the Complainant sent two cease and desist notifications to the Respondent. The Respondent did not reply to either communication.

5. Parties' Contentions

A. Complainant

The Complainant alleges that it has satisfied all elements of the Policy, paragraph 4.

B. Respondent

The Respondent did not submit a formal Response.

In its two email communications of February 8, 2022, the Respondent mainly expressed that it was someone looking for an old domain name, buying it back and hoping to sell it at a higher price. It alleged that, “[w]hile searching for a domain name, I don’t know the existence of a disputed domain name, I hope that your team and Icanm will consider and handle my case in the most reasonable way.”

In line with the Panel’s authority pursuant to the Rules, paragraph 10, the Panel has considered the Respondent’s unsupported assertions, and notes that the Respondent’s submissions do not alter the outcome of the case.

6. Discussion and Findings

Based on the facts and evidence introduced by the Complainant, and with regard to paragraphs 4(a), (b) and (c) of the Policy, the Panel concludes as follows:

A. Identical or Confusingly Similar

The Complainant has submitted sufficient evidence to demonstrate its registered rights in the CANVA trademark.

The CANVA trademark is wholly reproduced in the disputed domain name.

A domain name is “identical or confusingly similar” to a trademark for the purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of other terms in the domain name (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.8, “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements”. Hence, the Panel holds that the addition of the terms “design” and “with” (which are connected to the Complainant’s business) to the Complainant’s CANVA trademark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

The Complainant has thus fulfilled the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

There are no indications before the Panel of any rights or legitimate interests of the Respondent in respect of the disputed domain name. The Complainant contends that the Respondent is neither affiliated with the Complainant nor making any *bona fide* use of the disputed domain name.

The Respondent used the disputed domain name to advertise online gambling services. The Complainant has credibly alleged that the Respondent used the disputed domain name for generating revenue while taking advantage of the Complainant’s trademark notoriety. This cannot be considered as a *bona fide* offering of goods or services or a noncommercial use.

Furthermore, the composition of the disputed domain name, wholly incorporating the Complainant’s trademark and two additional terms (which in the Panel’s view are likely meant to appear connected to the Complainant’s area of activity), cannot constitute fair use in these circumstances as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that the Complainant, having made out a *prima facie* case which remains unrebutted by the Respondent, has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the circumstances of this case, including the composition of the disputed domain name and reputation of the Complainant’s trademark, it can be inferred that the Respondent was aware of the Complainant’s trademark when registering the disputed domain name. Even if it was not aware of the Complainant’s trademark and business, the Respondent could have taken some efforts to screen the registration of the disputed domain name against readily available online databases (or conduct a mere Internet search) to avoid the registration of a trademark-abusive domain name.

The Panel finds that the reproduction of the Complainant’s trademark along with the terms “design” and “with” creates a likelihood of confusion between the Complainant’s trademark and the disputed domain name.

The evidence and allegations submitted by the Complainant support a finding that the Respondent was using the disputed domain name in an attempt to attract Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of his website for his own commercial benefit. The Respondent therefore used the disputed domain name in bad faith (see *Claudie Pierlot v. Yinglong Ma*, WIPO Case No. [D2018-2466](#)).

Accordingly, the Complainant has also fulfilled 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 <designwithcanva.com> be transferred to the Complainant.

/Tobias Zuberbühler/

Tobias Zuberbühler

Sole Panelist

Date: March 11, 2022