

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Hoi Nguyễn Đình
Case No. D2022-0561

1. The Parties

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

The Respondent is Hoi Nguyễn Đình, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvapro.live> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2022. On February 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 18, 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 February 21, 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 February 21, 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 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 17, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on March 30, 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. Users of the Complainant's services have thousands of images and templates to choose from when creating graphic designs. 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 uses its main site "www.canva.com" to offer its services.

The Complainant offers its services, as a basic package, for free. The Complainant offers a paid version named "Canva Pro", which has more features and design capabilities. The Canva Pro service offering is a well-known version of the Complainant's services, aimed predominately at professionals or graphic design teams within companies.

The CANVA brand is well-known around the world. The Complainant's services are offered exclusively online, which is inherently global. Within its first year, the Complainant had 750,000 users and raised USD 3 million in seed funding.

The Complainant has expanded internationally, particularly in the Asia-Pacific region, with offices in Beijing and Manila. The CANVA website is now available in Vietnamese and the Complainant's business operations have expanded into the region.

The Complainant launched its app for the iPad, which grew access to CANVA services. The Complainant's app is now available on phone devices. Additionally, the Complainant's business has grown through acquisitions of Zeetings, Pexels, and Pixabay. The Complainant has 977 employees spread across offices in Sydney, Manila, and Beijing. As of 2019, the Complainant was valued at USD 3.2 billion and has 20 million users across 190 countries.

The Complainant also offers a "design school" which provides tutorial, courses, and events. The design school helps businesses and graphic designers perfect their work, offering courses such as "Social media mastery", "Graphic Design Basics" and "Presentations to impress". The Complainant also maintains blogs on design, marketing, branding and photography.

Within the field of graphic design, the Complainant has achieved considerable acclaim. It is frequently featured in third-party lists collating the best online graphic design tools available.

The services offered under the CANVA online tool relate to a variety of uses. Online users can create leaflets, social media posts, and even website designs. The Complainant offers many website templates to its users, featuring model site designs. Users can publish their designs as interactive websites.

To date, the Complainant holds several registered trademarks for the trademark CANVA (the "CANVA Mark"):

United States Registration No. 4316655 registered on April 9, 2013, in Class 42; Australia Trademark No. 1483138 registered on September 9, 2013, in Class 9; and International Registration No. 1204604 registered on October 1, 2013 in Class 9.

The Complainant has also established a social media presence and uses its CANVA Mark to promote its services under this name, in particular:

- Facebook: 1.4 million "likes" – www.facebook.com/canva/;
- Twitter: 133,900 "followers" – "www.twitter.com/canva/"; and,
- Instagram: 402,000 "followers" – "www/Instagram.com/canva/".

The disputed domain name was registered on August 12, 2021 and resolves to a website purporting offer the Complainant's services.

5. Parties' Contentions

A. Complainant

The Complainant contends that it owns trademark rights in the CANVA trademark and that its registrations constitute *prima facie* evidence of such rights.

The Complainant further contends that the disputed domain name is confusingly similar to the CANVA trademark. The Complainant further contends that the entirety of the CANVA trademark is contained in the disputed domain name with the addition of the descriptive term "pro" which does not negate the confusing similarity. The Complainant notes that it actually offers a package named "Canva Pro," which is an advanced paid-for version of the Complainant's services, aimed at corporate clients.

The Complainant further contends that the generic Top-Level Domain ("gTLD") ".live" should be disregarded as a necessary element in a domain name.

The Complainant asserts that it has satisfied the elements of paragraph 4(a)(i) of the Policy.

The Complainant further asserts that the Respondent lacks rights or legitimate interests in the disputed domain name, pursuant to paragraph 4(a)(ii) of the Policy.

The Complainant further asserts that there is no evidence that the Respondent retains any unregistered trademark rights in the term "canva" or any other term used in the disputed domain name. Neither has the Respondent received any license for the Complainant to use the CANVA trademark in a domain name or in any other way. The Complainant further asserts that the Respondent can demonstrate none of the circumstances where the Respondent can prove rights or legitimate interests in the disputed domain name.

The Complainant submits that the Respondent is using the disputed domain name to host a website offering services related to those offered by the Complainant. Using the disputed domain name and the CANVA trademark in a manner competitive with the Complainant constitutes bad faith under the Policy.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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.

Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademark CANVA on the basis of its multiple trademark

registrations. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.2.1).

It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a registered trademark. Numerous UDRP panels have recognized that the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant’s registered mark. Such findings were confirmed, for example, within the case *Quixtar Investments Inc. v. Dennis Hoffman*, WIPO Case No. [D2000-0253](#).

The Respondent’s incorporation of the Complainant’s trademark in full in the disputed domain name is evidence that the disputed domain name is confusingly similar to the Complainant’s marks. Mere addition of the expression “pro” in the disputed domain name does not prevent a finding of confusing similarity with the Complainant’s marks. Furthermore, the addition of the generic Top-Level Domain (“gTLD”) “.live” does not prevent the confusing similarity either. As noted in [WIPO Overview 3.0](#), section 1.8: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.” Similarly, the gTLD “.live” does not generally preclude a finding of confusing similarity between the disputed domain name and the complainant’s trademarks in accordance with the well-established practice of previous UDRP panels (see also section 1.11 of [WIPO Overview 3.0](#)).

Therefore, the Panel holds that the combination of the term “pro”, which makes a direct reference to the paid service provided by the Complainant, with the Complainant’s trademark CANVA and the applicable gTLD “.live” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s CANVA mark, which remains clearly recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In accordance with paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel observes that there is no relationship, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Panel also finds that there is no indication that the Respondent is commonly known by the disputed domain name, since the Respondent is an individual with no apparent connection with the CANVA trademark.

The Panel concludes that the Respondent deliberately chose to include the Complainant’s CANVA trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate, noncommercial or fair use. The Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent is using the domain names to resolve to the Respondent’s website where it offers competing services under the Complainant’s CANVA trademark. Such conduct, involving the misrepresentation that the Respondent’s website is in some way connected to the Complainant’s does not, on its face, amount to the use of the domain names for a *bona fide* offering of goods or services.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Given the above, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on its website or location.

With regard to the bad faith at the time of registration, the Panel notes that it is not likely that the Respondent was not aware of the Complainant and its CANVA trademark. On the contrary, the Panel finds that it is likely that the Respondent was aware of the Complainant and its rights and reputation in the CANVA mark at the time the disputed domain name was registered. Bad faith can be presumed based on the widely evidenced recognition of the Complainant's marks, such that the Respondent was aware or should have been aware of the Complainant's well-known marks and claims of rights thereto.

It is also evidenced that the Respondent's website offers services confusingly similar to those offered by the Complainant and directly reproduces the Complainant's CANVA trademark. The Respondent has used the disputed domain name to attract visitors to its website where it offers services in direct competition with the Complainant, under the Complainant's CANVA trademark. Consequently the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (Policy, paragraph 4(b)(iv)).

Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name 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 <canvapro.live> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: April 13, 2022