

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Elphas Minyato
Case No. D2022-1065

1. The Parties

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

The Respondent is Elphas Minyato, Kenya.

2. The Domain Name and Registrar

The disputed domain name <canvaprint.xyz> 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 March 28, 2022. On March 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 30, 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 April 1, 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 April 4, 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 April 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 26, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 30, 2022.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on May 10, 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 was founded in 2012 and operates an online graphic design platform that allows users to create graphic content such as leaflets, social media posts and websites. For that purpose, the Complainant offers thousands of images and templates for users to choose from and allows users to publish their designs as interactive websites. The Complainant also offers a “design school” which provides tutorials, courses and events.

The Complainant holds a multitude of trademarks consisting of the word(s) CANVA or CANVA PRINT:

- Australian Trademark No. 1483138 CANVA (word), registered on March 29, 2012 for goods in Class 9.
- United States Registration No. 4316655 CANVA (word), registered on April 9, 2013 for services in Class 42.
- International Trademark Registration No. 1204604 CANVA (word), registered on October 1, 2013 for goods in Class 9.
- Australian Trademark No. 2004675 CANVA PRINT (word), registered on April 22, 2019 for services in Class 40.
- Brazilian Trademark Registration No. 914660462 CANVA (word), registered on April 30, 2019 for goods in Class 9.
- United Kingdom Trademark No. UK00003396035 CANVA PRINT (word), registered on July 19, 2019 for services in Class 40.
- European Union Trade Mark No. 018042224 CANVA PRINT (word), registered on September 20, 2019 for services in Class 40.
- United States Registration No. 6114099 CANVA (fig.), registered on July 28, 2020 for goods and services in Classes 9 and 42.

The Complainant further holds the domain <canva.com>, which resolves to the Complainant’s main website “www.canva.com”, from where it offers its services under the CANVA brand. The online platform is available to users in approximately 100 languages and also markets its offerings through the use of country-specific sites with languages including but not limited to English, French, German, Portuguese, and Spanish. Currently, the Complainant has around 30 million active users per month with customers in 190 countries.

As of June 2020, the Complainant has been valued at USD 6 billion. It has established a significant social media presence with around 1.7 million “likes” on Facebook and around 1 million followers on Instagram. Furthermore, it has been subject of extensive media coverage since its foundation, including frequent mentions in third-party lists collating the best online graphic design tools.

The disputed domain name <canvaprint.xyz> was registered on August 14, 2021 and resolves to an inactive website. Previously and at least until October 21, 2021, it resolved to a website offering design and printing services.

Before initiating the present proceedings, the Complainant sent a cease and desist letter to the Respondent on October 21, 2021, to which the Respondent has not replied.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy is established in the present case:

(1) The Complainant is of the opinion that the disputed domain name is identical to the CANVA PRINT trademarks and at the very least confusingly similar to the CANVA trademarks, in each of which it enjoys rights.

Regarding its CANVA trademarks, the Complainant argues that the addition of a descriptive or generic word such as "print" to the trademark is insufficient to avoid confusing similarity, as had been recognized by numerous UDRP panels before.

Moreover, the Complainant argues that the disputed domain incorporates the CANVA PRINT trademarks in their entirety without any addition or adornment. In this respect, the generic Top-Level Domain ("gTLD") ".xyz" should be disregarded as it is a standard registration requirement.

(2) Further, the Complainant is of the opinion that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant argues that the Respondent is not known as "canva" or "canva print". Those terms were distinctive and not used in commerce by any other party than the Complainant. The Respondent has no trademarks or unregistered rights to "canva" or "canva print", nor were they granted any license from the Complainant.

The Complainant asserts that the Respondent now only holds the disputed domain name passively, as it does not display active content. Previously, by hosting a graphic design platform, the Respondent had taken unfair commercial advantage by evoking the impression that the website was operated by or linked to the Complainant. The Respondent intended to redirect internet users to their own website with the intention to generate monetary revenue as a result of customer confusion. This was further evidenced by the subsequent removal of the content from the website following the cease and desist letter sent to the Respondent.

(3) Finally, the Complainant submits that the disputed domain name was registered and has been used in bad faith.

The Complainant argues that the CANVA and CANVA PRINT trademark registrations significantly predate the date of the registration of the disputed domain name. Additionally, the trademarks could have been easily found via public trademark databases or popular Internet search engines.

Regarding the registration, the Complainant argues that it has accrued substantial reputation in the personalized design industry, which the Respondent must have been aware of. This was further illustrated by the initial use of the domain to offer services identical to those of the Complainant. The Complainant finds it inconceivable that the Respondent arbitrarily chose a domain name similar to the Complainant's trademarks. Such choice strongly suggests opportunistic bad faith on part of the Respondent.

The fact that the Respondent did not reply to the cease and desist letter infers bad faith behavior, in particular because the Respondent did not provide a response to supply good faith evidence but chose to remove the content from the disputed domain name.

Regarding the use of the disputed domain name in bad faith, the Complainant submits that the Respondent initially used the disputed domain name to offer services identical to those of the Complainant, which demonstrates both knowledge of the Complainant's trademarks and intention to obtain commercial benefits

by diverting unsuspecting internet users away from the Complainant and evoking the belief that the disputed domain name was in some way connected to, affiliated with, or sponsored by the Complainant.

Finally, the subsequent passive holding of the disputed domain name following the receipt of the cease and desist letter further indicates the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the complainant's trademarks; and
- (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.

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

A. Identical or Confusingly Similar

The test for identity or confusing similarity under paragraph 4(a)(i) of the Policy is limited in scope to a direct comparison between the Complainant's marks and the textual string which comprises the disputed domain name.

The Complainant has demonstrated registered trademark rights in the marks CANVA and CANVA PRINT, all of which predate the registration of the disputed domain.

The disputed domain name consists of the word "canvaprint" and the gTLD ".xyz".

Regarding the CANVA PRINT trademarks, the Panel observes that the disputed domain name consists exclusively of the Complainant's trademarks in their entirety. Its only additional element is a gTLD (".xyz"). Being a standard registration requirement, however, it is established practice to disregard the gTLD for the assessment of similarity unless it has some impact beyond its technical function (*Automobili Lamborghini S.p.A. v. CoCo (黄登通)*, WIPO Case No. [D2020-1371](#); *Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)). That is not the case here.

With respect to the CANVA trademarks, the disputed domain name contains the trademark in its entirety, only adding the term "print" and the gTLD ".xyz". With the gTLD being disregarded, the additional term "print" does not prevent a finding of confusing similarity either. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

Thus, the Panel concludes that the addition of the word "print" does not change the overall impression of the disputed domain name. The disputed domain name wholly incorporates the distinctive trademark CANVA and the addition of "print" does not prevent the Complainant's trademarks from being recognizable in the disputed domain name.

In view of the above, the Panel finds that the disputed domain name is identical to the CANVA PRINT trademarks and confusingly similar to the CANVA trademarks, in which the Complainant has rights. The requirements of paragraph 4(a)(i) of the Policy are, therefore, satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is 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 trademark or service mark at issue.

It is a consensus view under the UDRP that it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent ([WIPO Overview 3.0](#), section 2.1). If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element.

In the present case, the Complainant has not licensed or otherwise consented to the Respondent's use of the CANVA or CANVA PRINT trademarks in connection with the disputed domain name. Indeed, the Complainant has provided evidence that it is the only holder of CANVA and CANVA PRINT trademark rights and the only party using those trademarks in commerce. Conversely, there is no evidence in the case file that the Respondent holds any unregistered rights in a mark corresponding to the disputed domain name. Therefore, paragraph 4(c)(ii) of the Policy does not apply.

Furthermore, the Complainant has provided evidence that the website the disputed domain name initially resolved to was used to offer services identical to those the Complainant is offering, namely graphic design services promoted as "Canva Print Solutions". Since being notified by the Complainant, the Respondent merely passively holds the disputed domain name.

The Panel does not consider either use of the disputed domain name as covered by legitimate interests because the Respondent effectively suggested a non-existing affiliation with the Complainant. This neither constitutes a use in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, nor a fair or legitimate noncommercial use without intent for commercial gain to misleadingly divert customers under paragraph 4(c)(iii) of the Policy.

Rather, the Panel holds that the Respondent's use was designed to take unfair advantage of the Complainant's reputation by diverting customers away from the Complainant's website in order to profit from a false association with the Complainant's well-known trademarks and for the purpose of making its own commercial gain.

Considering the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks any rights or legitimate interests in the disputed domain name. Although given the opportunity, the Respondent has not replied to the Complainant's contentions and therefore failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name.

Thus, the Panel concludes that the Complainant has proven the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the Respondent registered and used the disputed domain name in bad faith.

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

“(iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s 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 registrant’s website or location or of a product or service on the registrant’s website or location.”

As regards registration, the disputed domain name was registered in August 2021, about nine years after the Complainant obtained its first trademark registration for the CANVA trademark and about two years after the registration of the respective CANVA PRINT trademarks. Furthermore, the Panel accepts the Complainant’s contention that, offering its services on the website “www.canva.com”, it has grown into a well-known and reputable service provider in the area of personalized graphic design with customers all around the world for about nine years before the disputed domain name was registered.

According to [WIPO Overview 3.0](#), section 3.1.4, even the registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Given the reputation of the Complainant’s CANVA and CANVA PRINT trademarks, the timing of the registration of the disputed domain name, and the close connection of the domain name and the trademarks, the Panel concludes that the disputed domain name has not been chosen coincidentally but consciously in order to take advantage of the Complainant’s trademarks (see also *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#)).

This point is further confirmed by the Respondent’s use in bad faith. As discussed above, the Panel takes the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to their website by consciously creating a likelihood of confusion with the Complainant’s trademarks. The disputed domain name has been used initially for a website where services identical to those of the Complainant have been offered. The website featured both an overview of the services provided and an “Order Now” button which led to a contact form, which suffices to establish the intention of commercial gain.

In conclusion, the Panel determines that, for all of the above reasons, the disputed domain name has been registered and is being used in bad faith and, accordingly, that the Complainant has satisfied the requirement of 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 <canvaprint.xyz> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: May 24, 2022