

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Privacy service provided by Withheld for Privacy ehf / Thi Tuong Vi Nguyen
Case No. D2022-1454

1. The Parties

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

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Thi Tuong Vi Nguyen, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <studycanva.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 25, 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 Complainant on April 27, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 27, 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 Respondent of the Complaint, and the proceedings commenced on April 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 20, 2022.

The Center appointed Nathalie Dreyfus as the sole panelist in this matter on May 26, 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

Complainant is “Canva Pty Ltd”, an online graphic design platform founded in 2012 in Australia.

Complainant owns trademark rights in the “CANVA” sign, notably through the following trademark registrations (“Registered Trademarks”):

- United States trademark CANVA No. 4316655, dated April 4, 2013, registered for services in class 42;
- Australian trademark CANVA No. 1483138, dated September 9, 2013, registered for goods in class 9;
- International trademark CANVA No. 1204604, dated October 10, 2013, registered for goods in class 9.

Complainant also argues that it uses the CANVA trademark as part of their brand logo.

Respondent owns the disputed domain name, which was registered on July 22, 2021 with Namecheap Inc, and resolves to a Pay- Per-Click (PPC) webpage containing links related to other products and services, including some in competition with Complainant.

Respondent has no relationship with Complainant.

5. Parties’ Contentions

A. Complainant

Complainant argues that the disputed domain name is confusingly similar to its registered CANVA trademark.

Complainant asserts that the disputed domain name replicates the distinctive CANVA trademark in its entirety, with the addition of the word “study”. Complainant further submits that previous UDRP panels have recognized the value of the CANVA trademark and its association with Complainant.

Complainant also argues that Respondent lacks a right or a legitimate interest in respect to the disputed domain name. Complainant underlines that Respondent is not commonly known by the distinctive term “canva”, nor is offering any goods or service by the term “canva”.

Furthermore, Complainant claims that Respondent does not have any trademark rights to the term “canva” or any other term used in the disputed domain name. Complainant states that it has never given any authorization or permission whatsoever to Respondent to register or to use the disputed domain name.

Complainant submits that the evidence shows that Respondent is not making a legitimate noncommercial or fair use of the disputed domain name but is generating monetary income through misleadingly diverting online users with the disputed domain name.

Finally, Complainant claims that Respondent registered and is using the disputed domain name in bad faith. Complainant’s earliest trademark predates the registration of the disputed domain name by nine years. Complainant argues that its representatives sent a cease and desist letter to Respondent, to which Respondent replied. Respondent refused to amicably transfer the domain name to Complainant when this last refused to pay a compensation.

Complainant also argues that the disputed domain name resolves to a PPC webpage containing links related to other products and services, including some in competition with Complainant.

Complainant asserts that such use constitutes a clear attempt to generate a commercial gain, particularly by misleading online users with the disputed domain name and subsequently redirecting these online users to third-party websites.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Pursuant to paragraph 4(a) of the Policy, Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

- (i) the disputed domain name registered by Respondent is identical or confusingly similar to a trademark or a service mark in which Complainant has rights;
- (ii) 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.

The *onus* of proving these elements is on Complainant.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, Complainant must prove that the disputed domain name is identical or confusingly similar to the registered trademarks in which Complainant has rights.

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)", section 1.2.1). In this regard, Complainant has submitted evidence proving its rights in the CANVA mark. The Panel finds that Complainant's rights in the said trademarks have thus been established pursuant to the first element of the Policy.

The disputed domain name replicates the CANVA trademark in its entirety, with the addition of the word "study". As Complainant claims, it has been established in previous decisions that where the relevant trademark is recognizable within the limits of a disputed domain name, the addition of other terms (whether descriptive, geographical, meaningless or otherwise) does not prevent a finding of confusing similarity.

The extension ".com" is not to be taken into consideration when examining the identity or similarity between Complainant's Registered Trademarks and the disputed domain name, as it is viewed as a standard registration requirement (see section 1.11 of the [WIPO Overview 3.0](#)). Indeed, the mere adjunction of a generic Top-Level Domain ("gTLD") such as ".com" is irrelevant as it is well established that the gTLD is insufficient to avoid a finding of confusing similarity (*Facebook, Inc v. S. Demir Cilingir*, WIPO Case No. [D2018-2746](#)).

For all of the above-mentioned reasons, the disputed domain name is confusingly similar to the Registered Trademarks in which Complainant has rights, and therefore the condition of paragraph 4(a)(i) of the Policy is fulfilled.

B. Rights or Legitimate Interests

Under Policy paragraph 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect to the disputed domain name. The burden of production then shifts to Respondent to come forward with evidence of its rights or legitimate interests. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Complainant argues that, to the best of its knowledge, Respondent is not commonly known by the distinctive term “canva” and does not have any trademark rights to the term “canva” or any other terms used in the disputed domain name. In addition, Respondent did not receive any license from Complainant to use a domain name featuring the CANVA trademark.

The disputed domain name resolves to a Pay-Per-Click webpage containing links related to other products and services, including some in competition with Complainant. Previous panels have considered that such use cannot provide the registrant with a legitimate interest (*Paris Hilton v. Deepak Kumar*, WIPO Case No. [D2010-1364](#); *Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright*, WIPO Case No. [D2007-0267](#)).

Respondent is generating monetary income through misleadingly diverting online users with the disputed domain name. As Complainant claims, it is accepted under the Policy that the use of a Complainant’s trademark to divert to unrelated/competing websites does not confer good faith use.

Therefore, the Panel finds that Complainant has made a *prima facie* case showing Respondent’s lack of rights or legitimate interests in the disputed domain name. As Respondent has failed to respond, the latter fails to rebut the *prima facie* case established by Complainant.

Considering the above circumstances, the Panel finds, on the balance of probabilities, that Respondent has no rights or legitimate interests in respect to the disputed domain name and the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

To fulfill the third requirement of the Policy, Complainant must prove that the disputed domain name was registered and is used in bad faith.

First, Complainant argues that its earliest trademark registration predates the creation of the disputed domain name by nine years.

Complainant’s representatives sent a cease and desist letter to the Respondent on the September 2, 2021, to which Respondent replied. Respondent pursued compensation for the disputed domain name and refused to amicably transfer the disputed domain name to Complainant. Previous panels stated that this constitutes evidence of bad faith (*FXCM Global Services, LLC v. Privacy service provided by Withheld for Privacy ehf/ Mack John, wikina*, WIPO Case No. [D2021-2143](#)).

Complainant has proven that it has a strong reputation in the brand CANVA; the circumstances of this case indicate that Respondent is intentionally using the commercial value and goodwill of Complainant’s brand to attract and redirect Internet users to its own website.

Furthermore, Panel agrees that the CANVA trademark should be considered as well-known, as illustrated in the following cases:

- *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#);
- *Canva Pty Ltd v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2021-2395](#);
- *Canva Pty Ltd v. Contact Privacy Inc. Customer 12410081353 / Tanner*, WIPO Case No. [D2021-2387](#);
- *Canva Pty Ltd v. Radha Rani, Mahu*, WIPO Case No. [D2021-2303](#);

- *Canva Pty Ltd v. Domain Administrator*, WIPO Case No. [D2021-1977](#);
- *Canva Pty Ltd. v. Bruno Henrique Lima De Castro*, WIPO Case No. [D2021-2347](#).

Consistently, the Panel notes that the established well-known character of the CANVA trademark strengthens Complainant's claim.

As Complainant argues, the use of Pay-Per-Click links by Respondent on the disputed domain name constitutes a clear attempt to generate a commercial gain, particularly by misleading online users with the disputed domain name and subsequently redirecting these online users to third-party websites. Previous panels considered that this kind of practice constitutes bad faith (*Revlon Consumer Products Corporation v. Moniker Privacy Services / Janice Liburd*, WIPO Case No. [D2011-0315](#)).

Finally, the disputed domain name is similar to Complainant's prior rights in such a way as to lead to confusion for Internet users, which is an additional indication of bad faith use.

In light of the above, the Panel finds that the disputed domain name has been registered and is also being used in bad faith.

As a result, the Panel finds that Complainant has satisfied 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 <studycanva.com> be transferred to Complainant.

/Nathalie Dreyfus/

Nathalie Dreyfus

Sole Panelist

Date: June 9, 2022