

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Domain Admin, Domain Privacy Service FBO Registrant /
Lashawnta Armstrong, spiritually wealthy
Case No. D2022-1794

1. The Parties

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

The Respondent is Domain Admin, Domain Privacy Service FBO Registrant, United States of America (“United States”) / Lashawnta Armstrong, spiritually wealthy, United States.

2. The Domain Name and Registrar

The disputed domain name <canvamodapk.net> is registered with FastDomain, Inc. (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 19, 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 23, 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 23, 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 May 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 16, 2022. The Respondent did not submit any formal response, but sent email communications to the Center on May 27, and June 20, 2022 respectively. On June 1, 2022, a third party claiming that it was instructed to purchase the disputed domain name sent an email communication to the Center, offering to resolve the dispute and requesting a copy of the Complaint. On June 16, 2022, the Center requested this third party to clarify its relationship with the Respondent and the

Respondent could also clarify her relationship with this third party. No reply was received from this third party nor from the Respondent in this regard. On June 24, 2022, the Center also forwarded a copy of the Complaint to this third party, and informed the Parties of the Commencement of Panel Appointment Process.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on July 1, 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 it provides an online graphic design platform under the trademark CANVA. Users of the Complainant's services have thousands of images and templates to choose from when creating graphic designs. The Complainant has more than 60 million active users monthly with customers in 190 countries. The Complainant's service is available in approximately 100 languages. The Complainant has also established a strong social media presence and also offers an app for mobile devices giving access to the Complainant's services.

The Complainant is the proprietor of the trademark CANVA, registered *inter alia* in the United States under no. 4316655 as of April 9, 2013.

The disputed domain name was registered on September 26, 2021, and resolves to a website purporting to offer modified application software in connection with the Complainant's CANVA trademark.

5. Parties' Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant's trademark, which is included in the disputed domain name clearly and exactly and is only followed by the terms "mod" (short for "modification") and "apk" (a file format used by the Android operating system).

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not registered any trademarks relevant to the disputed domain name and the Complainant has not authorized the Respondent to use the Complainant's trademark. The Respondent is not known by the disputed domain name and there is no use or preparations to use the disputed domain name for a *bona fide* offering of goods or services.

The disputed domain name's composition of the Complainant's CANVA trademark with the terms "mod" and "apk" gives Internet users the false impression that the Respondent's website is licensed, or otherwise connected to the Complainant.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's CANVA trademark. The Respondent has used the disputed domain name purportedly to provide modified application software under the Complainant's CANVA trademark. The Respondent has cultivated this false impression of association by featuring the Complainant's distinctive CANVA logo and failing to disclaim her lack of connection to the Complainant. Rather than attempting to mitigate the prospect of misleading Internet users as to the source of the disputed domain name, the Respondent's conduct is clearly designed to capitalize on the likelihood of ensuing Internet-user confusion.

B. Respondent

Prior to the filing of the Complaint, the Respondent replied to the Complainant's cease-and-desist letter indicating that she purchased her services on "fiverr" from someone she was working with, and this person did all the work as well as picked the domain names, and had her register them, and she wanted to get this

resolved. However, when the Complainant asked for the authorization code for the disputed domain name, the Respondent did not reply.

The Respondent did not formally reply to the Complainant's contentions during the proceeding. On May 27, and June 20, the Respondent sent email communications to the Center indicating that she paid for these sites to be created and managed by others.

On June 1, 2022, a third party sent an email communication to the Center, indicating that "this site was set up through a third party [...] I was instructed to purchase this domain", "I paid money for this site to be created and was instructed through fiverr [...] to purchase the canva domain", "i was instructed on what site and the name to pick i thought i had rights to the domain", and "All I did was purchase a domain so the seller can complete their work on this domain that the seller picked out and instructed for me to purchase." This third party also offered to resolve the dispute.

6. Discussion and Findings

6.1. Procedural Issue – Identity of the Respondent

The Center received email communications from the Respondent and a third party as described above. The Center requested the Respondent and this third party to clarify their relationship with each other, however, neither the Respondent nor this third party replied to the Center's request.

Paragraph 1 of the Rules defines respondent as "the holder of a domain-name registration against which a complaint is initiated". The Registrar has confirmed that the Respondent is the registrant of the disputed domain name.

In view of the above, the Panel will rely on the confirmation by the Registrar that the Respondent is the registrant of the disputed domain name and will proceed on this basis. The Panel notes that in any case, even if the registrant of the disputed domain name is different from the Respondent, the substantive issues to be considered are essentially the same, and all references to the Respondent in this decision shall be construed to include the actual registrant of the disputed domain name.

6.2. Substantive issues

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to this trademark.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

Furthermore, "[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". See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain name is confusingly similar to the Complainant's trademark, which is clearly recognizable in the disputed domain name. The addition of the term "modapk", which may be understood by Internet users as "mod" and "apk", referring to "modified" and an Android application format ".apk", does not prevent a finding of confusing similarity with the Complainant's trademark. The Panel notes that the Respondent also appears to use these terms in this meaning on the website at the disputed domain name ("Canva Pro MOD APK").

This Panel finds that the disputed domain name is confusingly similar with the Complainant's trademark and hence the first element of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain name.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* case showing the absence of the respondent's rights or legitimate interests in a disputed domain name, the burden of production shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

Furthermore, because the Complainant's CANVA trademark is distinctive, fanciful and widely used, it is difficult to conceive any plausible legitimate noncommercial or fair use of the disputed domain name by the Respondent.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant's trademark. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Considering also the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain name. Therefore, the Panel finds that the second element of the Policy is fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

"(i) circumstances indicating that [the respondent has] registered or has 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) [the respondent has] 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) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent'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 respondent's] website or location or of a product or service on [the respondent's] website or location."

The Panel is of the opinion that the Complainant's trademark CANVA is distinctive, fanciful and widely used, which means that it is inconceivable that the Respondent would not have been aware of the Complainant's trademark when registering the disputed domain name. It is also difficult to conceive any plausible good faith use of the disputed domain name by the Respondent.

The Respondent uses the disputed domain name purportedly to provide modified application software under the Complainant's trademark. The Respondent is also using the Complainant's logo at the website thus clearly attempting to capitalize on the Complainant's trademark. Therefore, the disputed domain name has been registered and used to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark.

Therefore, the Panel finds that the third element of the Policy is fulfilled

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, <canvamodapk.net>, be transferred to the Complainant.

/Tuukka Airaksinen/

Tuukka Airaksinen

Sole Panelist

Date: July 15, 2022