

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Whois Secure/ Whois Privacy Protection Foundation,
Hosting Concepts BV d/b/a Registrar.eu
Case No. D2022-2226

1. The Parties

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

The Respondent is Whois Secure, United States of America / Whois Privacy Protection Foundation, Hosting Concepts BV d/b/a Registrar.eu, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <canva49.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2022. On June 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 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 June 24, 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 June 24, 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 July 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2022.

The Center appointed Anne-Virginie La Spada as the sole panelist in this matter on August 15, 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. The Complainant offers its basic package of services for free, and it offers a paid version with additional functionalities under the name Canva Pro. The Complainant offers free of charge a specialized version of Canva Pro (under the name “Canva for Education”) to teachers who meet certain eligibility requirements.

The Complainant is the owner of the following trademark registrations for CANVA:

- United States Trademark registration No. 4316655, registered on April 9, 2013, in Class 42;
- International Trademark registration No. 1204604, registered on October 1, 2013 in Class 9.

The Complainant is also the owner of the domain name <canva.com>.

The disputed domain name was registered on March 26, 2022.

At the time of filing of the Complaint, the disputed domain name resolved to a website displaying prominently the Complainant’s trademark and logo and purporting to offer for sale log-in credentials to “lifetime” subscriptions of the Complainant’s service Canva Pro. The website included a mention that the subscription would give access to the “Education” version of the Complainant’s Canva Pro service (reserved to teachers), leading to a suspicion that the Respondent fraudulently obtained the log-in credentials offered on its website.

The Respondent included in its website a disclaimer stating: “We are a reseller of Canva Pro subscription. We are not a Canva’s official third-party.”

The Respondent appears to have been involved in three other UDRP proceedings initiated by the Complainant for the same or similar facts.

5. Parties’ Contentions

A. Complainant

According to the Complainant, the disputed domain name is confusingly similar to its CANVA registered trademark as it captures the entirety of its trademark with the mere adjunction of the number “49”.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name for the following reasons: (i) the Respondent is not commonly known by the disputed domain name; (ii) the Respondent is not affiliated nor authorized by the Complainant in any way; specifically no license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks, or apply for registration of the disputed domain name; (iii) the Respondent is making a commercial use of the disputed domain name by selling fraudulently obtained log-in credentials to the Complainant’s services, which does not amount to a *bona fide* offering of goods and services.

Finally, the Complainant contends that the Respondent has used and registered the disputed domain name in bad faith. Considering the fact that the disputed domain name resolves to a website offering for sale online subscriptions for the Complainant’s platform, and that the Complainant’s official logo is used prominently throughout the website, the Complainant contends that the Respondent was aware of the

existence of the Complainant and of its trademark when it registered the disputed domain name. According to the Complainant, the Respondent has intentionally misappropriated the Complainant's trademark as a way of redirecting internet users to the disputed domain name's website for commercial gain, which amounts to use in bad faith. Finally, the Complainant contends that the Respondent's involvement in a number of UDRP cases shows that the Respondent is engaged in a pattern of bad-faith conduct.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, a complainant must assert and prove each of the following:

- (i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name registered by the respondent has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name incorporates entirely the Complainant's trademark CANVA, with the adjunction of the number "49".

The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to a domain name where the relevant trademark is recognizable within the disputed domain name is considered by UDRP panels to be confusingly similar to the relevant mark for purposes of the first element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8).

In the present case, the trademark CANVA is clearly recognizable in the disputed domain name. The mere addition of the number "49" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

UDRP panels accept that a generic Top Level Domain ("gTLD"), such as ".com", may be disregarded when assessing whether a domain name is identical or confusing similar to a trademark (see [WIPO Overview 3.0](#), section 1.11).

The Panel finds accordingly that the Complainant has successfully established the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the information submitted by the Complainant, the Respondent does not appear to have rights or legitimate interests in respect of the disputed domain name, nor has the Complainant granted to the Respondent any authorization to use the disputed domain name. Moreover, there is no evidence indicating that the Respondent is commonly known by the disputed domain name.

The Respondent does not appear to have operated any *bona fide* or legitimate business under the disputed domain name and is not making a noncommercial or fair use of the disputed domain name. Instead, the disputed domain name resolves to a website purporting to offer for sale allegedly unlimited subscriptions to a service of the Complainant. Such use further supports the apparent lack of rights or legitimate interests of

the Respondent in the disputed domain name. While the website hosted at the disputed domain name does include a disclaimer in some sections that identifies the alleged reseller nature of the website, the qualifying information is not prominently displayed and requires an Internet user's search throughout the website content (additionally, see below in relation to bad faith). Considering the composition of the disputed domain name, which consists of the Complainant's trademark in its entirety, the nature of the disputed domain name exacerbates the risk of implied affiliation and reinforces the finding that the Respondent sought to unfairly capitalize on the Complainant's reputation and trademark rights, which cannot constitute fair use (see [WIPO Overview 3.0](#), sections 2.5 and 2.8). Indeed, attracting Internet users to a website offering fraudulently obtained log-in credentials for the Complainant's platform can hardly be a legitimate or fair use.

Furthermore, UDRP panels consider that even where a domain name consists of a trademark plus an additional term (at the Second- or Top-Level), such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see [WIPO Overview 3.0](#), section 2.5.1).

Finally, the Respondent did not file a Response to the Complaint. The Panel may draw from the lack of a Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b).

In view of the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the Respondent's silence leaves such *prima facie* case un rebutted.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Complainant has satisfied the condition set out in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Given that the trademark CANVA of the Complainant is distinctive and has been widely used before the registration of the disputed domain name, and that the Respondent used the Complainant's logo on his website, the Panel accepts that the Respondent was aware of the existence of the Complainant and of its CANVA trademark at the time of the registration of the disputed domain name. Accordingly, the Panel finds that the disputed domain name was registered in bad faith.

Under paragraph 4(b)(iv) of the Policy, the use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 a website or location or of a product or service on the website or location, amounts to evidence of registration and use in bad faith.

The Respondent used the disputed domain name to resolve to a website offering for sale online subscriptions for the Complainant's platform. Such use was apt to create the false impression that the Respondent's website was operated or endorsed by the Complainant. Consequently, by using the disputed domain name in such manner, the Respondent intentionally attempted to attract, for the purposes of commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source and affiliation of its website. Such behavior constitutes use in bad faith under paragraph 4(b)(iv) of the Policy.

Furthermore, UDRP panels consider that where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In such cases, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused (see section 3.7 of the [WIPO Overview 3.0](#)). The short disclaimer on the Respondent's webpage merely confirms, in the Panel's opinion, the Respondent's knowledge and bad faith disregard of the Complainant's rights.

Finally, the Respondent appears to have been involved in three other UDRP proceedings initiated by the Complainant (see *Canva Pty Ltd v. Dang Nguyen*, WIPO Case No. [D2021-1169](#); *Canva Pty Ltd v. Dang Nguyen, Dũng, Dung Nguyen*, WIPO Case No. [D2021-3519](#); and *Canva Pty Ltd. v. Dung Nguyen*, WIPO Case No. [D2022-0357](#)). While in these three cases, the named respondent is different from the named Respondent in the present case, the domain names at issue resolved to websites with either the same appearance as the Respondent's website or to a website with a different design but identical wording. These circumstances make it appear likely that the same person is behind the privacy service named as Respondent in the present case. The fact that the Respondent has been involved in several previous cases under the UDRP against the Complainant shows a pattern of bad faith conduct within the meaning of paragraph 4(b)(ii) of the Policy (see section 3.1.2 of the [WIPO Overview 3.0](#): a pattern of bad faith conduct may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner).

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has satisfied the condition set forth in 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 <canva49.com> be transferred to the Complainant.

/Anne-Virginie La Spada/

Anne-Virginie La Spada

Sole Panelist

Date: August 29, 2022