

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Super Privacy Service LTD c/o Dynadot / kieu Duc
Case No. D2022-2935

1. The Parties

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

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America / kieu Duc, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <canvaagency.net> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 9, 2022. On August 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10, 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 August 11, 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 August 12, 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 August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2022.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on September 28, 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 CANVA trademark is used by the Complainant in connection with a graphic design platform. The Complainant owns a number of registrations for the trademark CANVA such as United States of America trademark registration No. 4,316,655 registered on April 9, 2013, and International trademark registration No. 1204604 registered on October 1, 2013.

The disputed domain name was registered on November 25, 2021, and resolves to a webpage that offers services similar to those offered by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark CANVA. The Complainant owns numerous registrations for the trademark CANVA. It has also achieved goodwill and recognition. The disputed domain name reproduces the trademark CANVA in full adding to it the term "agency", which does not prevent a finding of confusing similarity. In fact, given the nature of the Complainant's activity, the use of the term "agency" might create further confusion. The generic Top-Level Domain ("gTLD") ".net" should be ignored when assessing confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not registered the trademark CANVA nor received a license from the Complainant to use it. The Complainant submits that there is no use or preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services. The disputed domain name resolves to a website, which purports to offer services under the pretense that the Complainant themselves offer the services. It also brandishes the logo of the Complainant. The Respondent is not authorized by the Complainant to use its trademark and is not connected to the Complainant. The Complainant submits that the Respondent is not known by the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The Respondent is trying to mislead Internet users as to its affiliation with the Complainant and trade off its reputation for commercial gain.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant's trademark registration predates the creation of the disputed domain name by at least nine years and can easily be found through online search engines. There was no response by the Respondent to the cease and desist letter sent by the Complainant. The Complainant contends that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as the disputed domain name predominantly contains the trademark of the Complainant and the addition of the term "agency" adds further confusion. This is exacerbated by the placement of the Complainant's logo on the website of the Respondent.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the trademark CANVA. The Panel is satisfied that the Complainant has established its ownership of the trademark CANVA. The disputed domain name comprises the Complainant's trademark CANVA in its entirety. The generic term "agency" does not prevent the fact that the disputed domain name is confusingly similar to the Complainant's trademark.

The gTLD, “.net” should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

A complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The disputed domain name resolves to a website through which services similar to those offered by the Complainant are being offered. Prior UDRP panels have held that a respondent is not using a domain name for a *bona fide* offering of goods or services if it uses the domain name for competing products. The use of the Complainant’s trademark which has a reputation for offering the type of products being offered by the Respondent is not fair as the Respondent’s website does not include a disclaimer that it is not connected with the Complainant, and it gives the impression of being the Complainant’s website or affiliated to it particularly that the Complainant’s logo is placed at the top left corner of the Respondent’s website. See *CareSource v. Domain Administrator*, See *PrivacyGuardian.org/FAG*, WIPO Case No. [D2018-2411](#).

Furthermore, the absence of a response by the Respondent allows the Panel to draw inferences, and under the circumstances, the absence of response leaves the Complainant’s *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name unrebutted.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

The Complainant has been using the trademark CANVA for more than nine years when the Respondent created the disputed domain name. The disputed domain name resolves to a website, which offers services similar to those offered by the Complainant. As such, the disputed domain name has been registered in order to attract Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation or endorsement. It has been found by prior UDRP panels that such use of a domain name constitutes bad faith, see *Gilead Sciences, Inc. v. Adewale Tokosi*, WIPO Case No. [D2021-0961](#).

Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the 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, <canvaagency.net>, be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: October 7, 2022