

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Domain Admin, Whoisprotection.cc / dian hadi saputra, Dian Kratif

Case No. D2022-3273

1. The Parties

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

The Respondent is Domain Admin, Whoisprotection.cc, Malaysia / dian hadi saputra, Dian Kratif, Indonesia.

2. The Domain Name and Registrar

The disputed domain name <bongkardapurcanva.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 1, 2022. On September 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 2, 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 September 7, 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 September 8, 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 September 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 4, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on October 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 is an online graphic design platform founded in 2012, offering its services exclusively online from its main website available at <canva.com>. It is the owner, amongst others, of the following trademark registrations (Annex 12 to the Complaint):

- Australia Trademark Registration No. 1483138 for CANVA, filed on March 29, 2012, and registered on September 9, 2013, in class 9;
- United States Trademark Registration No. 4316655 for CANVA, registered on April 9, 2013, in class 42; and
- International Trademark Registration No. 1204604 for CANVA, registered on October 1, 2013, in class 9.

The disputed domain name <bongkardapurcanva.com> was registered on December 6, 2021, and, at times, resolves to a webpage that purports to sell the Complainant's templates, and at other times does not resolve to an active webpage. A previous version of the website that resolved from the disputed domain name also displayed the Complainant's logo in connection with the commercialization of the Complainant's templates (Annex 15 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant asserts to provide an online platform that is easy-to-use, intuitive and utilises a 'drag-and-drop' methodology which lead the Complainant's services to have achieved significant reputation and acclaim, having the Complainant been valued at USD 6 billion in June 2020. Currently counting with around 60 million active users per month from 190 different countries, the Complainant sustains that its CANVA trademark has become well known around the world.

The Complainant also offers a 'design school' which provides tutorials, courses and events and provides its platform in approximately 100 languages.

According to the Complainant, the disputed domain name is confusingly similar with the Complainant's trademark since the CANVA trademark is reproduced in its entirety with the addition of the Indonesian terms "bongkar" and "dapur" which is insufficient to add distinctiveness thereto.

Also according to the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the Respondent, to the best of the Complainant's knowledge, has not registered any trademarks for the term "CANVA", nor is there any evidence that the Respondent holds any unregistered right to the term "CANVA", "BONGKARDAPURCANVA" or anything similar;
- (ii) the Respondent has not received any license from the Complainant to use a domain name which features the "CANVA" trademark;

(iii) the Respondent is not commonly known by the disputed domain name, nor is there a connection or affiliation between the Complainant and the Respondent, also not having the Respondent received any license or consent to use the CANVA trademark in any way; and

(iv) the disputed domain name is not being used in connection with a *bona fide* offering of goods or services or with a legitimate noncommercial or fair use, given that the Respondent has used the disputed domain name to brandish the Complainant’s CANVA trademark and advertise the sale of a commercial offering in connection with such.

The Complainant contends that the disputed domain name was registered in bad faith given the well-known status of its CANVA trademark which has accrued substantial goodwill and recognition since the Complainant’s establishment in 2012. The Complainant further submits that a cease-and-desist letter was sent by the Complainant’s Representatives in February 2022 (Annex 19 to the Complaint), in order to put the Respondent on notice of the Complainant’s trademarks and rights and with a view to resolving the matter amicably. However, the Respondent did not reply to the cease-and-desist letter. In addition to that, the Complainant states that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s CANVA trademark, having used the disputed domain name to attract and divert Internet users to a site that brandished the CANVA trademark and logo and purports to sell a commercial offering in connection with such. Lastly, the Complainant contends that the Respondent has engaged in a pattern of bad faith conduct, given that the email address [...]@gmail.com also appears in connection with the other domain names <googleimage.party>, <googletranslate.party> and <toyota-malang.com> which refer to other third parties’ well-known trademarks (Annex 20 to the Complaint).

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed domain name 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the CANVA trademark, duly registered in several countries around the world (Annex 12 to the Complaint).

The disputed domain name reproduces the Complainant’s trademark in its entirety, with the addition of the Indonesian terms “bongkar” and “dapur”. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice 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 (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired 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.

The Respondent, in not responding to the Complainant, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent that the Respondent has not been commonly known by the disputed domain name and neither is there a connection or affiliation between the Complainant and the Respondent, also not having the Respondent received any license or consent to use the CANVA trademark in any way.

In addition to that, the offer of templates for sale in connection with the Complainant's logo does not characterize as evidence of 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.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of a trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other location, by creating a likelihood of confusion with the Complainants' 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 registration and use of the disputed domain name in bad faith can be found in the present case in view of the following circumstances:

(i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, not having submitted a response;

(ii) the Respondent has not replied to the cease-and-desist letter sent prior to this procedure;

(iii) other seemingly abusive domain name registrations by the same Respondent (Annex 20); and

(iv) the well-known status of the Complainant's trademark, the nature of the disputed domain name (reproducing the entirety of the Complainant's trademark), and the fact that the Respondent's website content gives Internet users the false impression that the resolving site is controlled, endorsed, or otherwise affiliated with the Complainant, when this is not the case.

The Panel finds the Respondent's intention to unduly profit from the value of the Complainant's trademark may be inferred from the overall circumstances of this case, which demonstrate the Respondent's registration and holding of the disputed domain name in bad faith.

For the reasons stated above, the Panel finds that the disputed domain name was registered and is being used in bad faith pursuant to 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 <bongkardapurcanva.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/
Wilson Pinheiro Jabur
Sole Panelist
Date: October 24, 2022