

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Cliff Smith / Maurice G Summers  
Case No. D2023-1121

### **1. The Parties**

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

The Respondent is Cliff Smith / Maurice G Summers, United States of America ("United States").

### **2. The Domain Names and Registrar**

The disputed domain names <canvadesigncoupon.online>, <canvadesigndeal.online>, <canvadesigndeals.com>, <canvadesigndeals.website>, <canvadesignoffer.com>, <canvadesignoffer.online>, <canvadesignoffers.email>, <canvadesignoffers.online>, <canvadesigns.agency>, <canvadesignsdeals.com>, <canvadesigns.email>, <canvadesign.site>, <canvadesigns.online>, <canvadesigns.site>, <canvadesigns.website>, <canvalogocoupon.com>, <canvalogocoupon.online>, <canvalogocoupon.site>, <canvalogocoupons.online>, <canvalogocoupon.website>, <canvalogodeal.com>, <canvalogodeal.online>, <canvalogodeals.click>, <canvalogodeals.com>, <canvalogodeal.site>, <canvalogodesign.online>, <canvalogodesigns.com>, <canvalogodesign.website>, <canvalogo.online>, <canvalogos.com>, and <canvalogos.site> ("Domain Names") are registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 14, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the domain names that were the subject of the initial Complaint. On March 14, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the domain names that were the subject of the initial Complaint which differed from the named Respondent (Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 2023, 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 adding 22 domain names to the Complaint on March 16, 2023. On March 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional domain names. On March 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the additional domain names which differed from the named

Respondent and contact information in the Complaint and the amended Complaint. The Complainant filed a second amended Complaint on March 23, 2023.

The Center verified that the Complaint together with the amended Complaints 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 March 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 18, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on April 21, 2023. 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 Australian company, established in 2012, that offers an online graphic design platform from its website at "www.canva.com" and through various other platforms, such as through iPad and Android apps. As of 2023, the Complainant has over 100 million active users per month with customers across 190 countries. Its website at "www.canva.com" receives an average of more than 360 million visits per month.

The Complainant is the owner of trademark registrations for a trademark consisting of the word "Canva" (the "CANVA Mark") in various jurisdictions, the earliest of which is an Australian trademark registered from March 29, 2012 (registration number 1483138) for goods in the computer aided design field in class 9.

Each of the Domain Names was registered between March 15 and April 6, 2022. The majority of the Domain Names ("Inactive Domain Names") are inactive or inaccessible and there is no evidence that they have been used for any purpose since registration. The domain names <canvalogodesigns.com>, <canvadesignsdeals.com>, <canvadesigndeals.com>, <canvalogodeals.com>, <canvadesignoffer.com>, <canvalogocoupon.com>, <canvalogodeal.com>, and <canvalogos.com> ("Active Domain Names") presently resolve to pay-per-click websites but prior to the commencement of the proceeding redirected visitors to a competitor of the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant makes the following contentions:

- (i) the Domain Names are identical or confusingly similar to the Complainant's CANVA Mark;
- (ii) the Respondent has no rights nor any legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

The Complainant is the owner of the CANVA Mark, having registered the CANVA Mark in numerous jurisdictions, including Australia and the United States. Each of Domain Names reproduces the CANVA Mark in its entirety, and then includes descriptive or generic terms and a generic Top-Level Domain ("gTLD"), none of which distinguish any of the Domain Names from the CANVA Mark.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Names. The Respondent is not commonly known as the Domain Names, nor does the Respondent have any authorization from the Complainant to register the Domain Names. The Respondent is not making a legitimate noncommercial fair use of the Domain Names nor are the Domain Names used to promote a *bona fide* offering of goods and services. Rather the Respondent is using the Active Domain Names to redirect visitors to a competitor of the Complainant, such use not being *bona fide*. The Inactive Domain Names are likely being held pending similar use.

The Domain Names were registered and are being used in bad faith. By using the Active Domain Names to redirect visitors to a website operated by a competitor of the Complainant (and in the case of the Inactive Domain Names passively hold them pending similar use), the Respondent is clearly aware of the CANVA Mark and are using it to deceive consumers as to their affiliation with the Complainant for commercial gain. Such conduct amounts to registration and use of the Domain Names in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Matter: Consolidation of Respondents**

The named registrant of the domain names <canvalogodeals.click> and <canvadesigncoupon.online> ("Summers Domain Names") (Maurice G Summers) is a different individual to the named registrant of the other Domain Names. UDRP proceedings are normally brought against a single respondent. However, paragraph 10(e) of the Rules states that in certain circumstances a panel may consolidate multiple domain name disputes. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2, states:

"Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

UDRP Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behaviour, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

Based on the information before it, the Panel is prepared to allow the consolidation of the proceedings against the named registrants on the basis that the Domain Names are under common control. The Summers Domain Names were registered with the same Registrar, using the same privacy services, and during the same one-month time period as the remaining domain names. They contain the same pattern of composition. Finally, the disclosed Whois records for both the named registrants contain numerous mismatched, inconsistent, and fake details (e.g., addresses and phone numbers corresponding to different

States than disclosed) which strongly suggest that that there is a single entity who has registered the Domain Names and is using multiple pseudonyms and fake addresses.

Finally, the Panel notes that none of the named registrants have denied any association with the other or objected to the consolidation of the proceedings requested by the Complainant. The Panel finds that, on the balance of probabilities, the Domain Names are subject to common control and that the consolidation would be fair and equitable to all the Parties. As such, for the purposes of the decision, the Panel will refer to the named registrants of the Domain Names as a single Respondent.

## **6.2. Substantive Matters**

### **A. Identical or Confusingly Similar**

To prove this element the Complainant must have trade or service mark rights and each Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the CANVA Mark, having registrations for CANVA as a trademark in Australia as well as in various other jurisdictions.

Disregarding the gTLD as a necessary element of a domain name, each of the Domain Names is confusingly similar to the CANVA Mark as each domain name reproduces the CANVA mark along with one or more words. Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the [WIPO Overview 3.0](#).

The Panel finds that each of the Domain Names is identical or confusingly similar to the CANVA Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain names. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain names.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Names or to seek the registration of any domain name incorporating the CANVA Mark or a mark similar to the CANVA Mark. There is no evidence that the Respondent is commonly known by any of the Domain Names or any similar name. There is no evidence

that the Respondent has used or made demonstrable preparations to use the Domain Names in connection with a legitimate noncommercial use. Indeed, the Inactive Domain Names do not resolve and on the evidence before the Panel have never resolved to active websites.

The present use of the Active Domain Names for what appears to be parking pages with pay-per-click links including advertisements related to the Complainant's services does not amount to use for a *bona fide* offering of goods and services. The prior use of the Active Domain Names (being domain names confusingly similar to Complainant's mark) to redirect users to a website offered by a competitor of the Complainant also does not, by itself, show a *bona fide* offering of goods and services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names. The Respondent has had the opportunity to put on evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Names under the Policy. In the absence of such a response the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

For the purposes of paragraph 4(a)(iii), 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 trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its 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 trade mark 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 of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainant and its reputation in the CANVA Mark at the time the Domain Names were registered. The Domain Names consist of the CANVA Mark and various words describing the services offered by the Complainant (e.g., "design(s)", "logo(s)"). The Respondent has provided no explanation, and none is immediately obvious, of why an entity would register 31 domain names incorporating the CANVA Mark and direct a portion of the Domain Names to a website operated by a direct competitor of the Complainant unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its CANVA Mark. The registration of the Domain Names in awareness of the CANVA Mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith. Moreover, given the pattern of bad faith registration at issue, the Panel finds that the Respondent has registered the Domain Names in order to prevent the Complainant from reflecting its CANVA Mark in corresponding domain names, pursuant to paragraph 4(b)(ii).

The Respondent registered the Domain Names for the purposes of redirecting visitors to a website operated by a competitor of the Complainant, likely for commercial gain. It then used the Active Domain Names for

websites containing pay-per-click links, some of which purport to offer products and services in direct competition with the Complainants. In these circumstances where the Respondent has offered no plausible explanation for the registration of the Domain Names, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant and the Complainant's CANVA Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or locations. As such, the Panel finds that the Active Domain Names are being used in bad faith.

The Panel finds that the passive holding of the Inactive Domain Names does not prevent a finding of use in bad faith (see section 3.3 of [WIPO Overview 3.0](#)). The Panel is prepared to infer that the Inactive Domain Names are most likely being passively held for future use in the same manner as the Active Domain Names, namely for websites (or to redirect to websites) that will misleadingly take advantage of an association with the Complainant for commercial gain.

Accordingly, the Panel finds that the Respondent has registered and used the Domain Names in bad faith under 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 Domain Names, <canvadesigncoupon.online>, <canvadesigndeal.online>, <canvadesigndeals.com>, <canvadesigndeals.website>, <canvadesignoffer.com>, <canvadesignoffer.online>, <canvadesignoffers.email>, <canvadesignoffers.online>, <canvadesigns.agency>, <canvadesignsdeals.com>, <canvadesigns.email>, <canvadesign.site>, <canvadesigns.online>, <canvadesigns.site>, <canvadesigns.website>, <canvalogocoupon.com>, <canvalogocoupon.online>, <canvalogocoupon.site>, <canvalogocoupons.online>, <canvalogocoupon.website>, <canvalogodeal.com>, <canvalogodeal.online>, <canvalogodeals.click>, <canvalogodeals.com>, <canvalogodeal.site>, <canvalogodesign.online>, <canvalogodesigns.com>, <canvalogodesign.website>, <canvalogo.online>, <canvalogos.com>, and <canvalogos.site>, be transferred to the Complainant.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: April 27, 2023