

## **ADMINISTRATIVE PANEL DECISION**

### **Canva Pty Ltd v. Tais Araujo Santos, Afoite Digital Case No. D2023-1709**

#### **1. The Parties**

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

The Respondent is Tais Araujo Santos, Afoite Digital, Brazil.

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

The disputed domain name <canvackafoite.com> is registered with Wix.com Ltd. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 18, 2023. On April 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 20, 2023, 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 (Redacted for Privacy, Wix.com Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 20, 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 on April 21, 2023.

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 April 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2023.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on May 24, 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, Canva Pty Ltd, is an online graphic design platform founded in 2012 by Melanie Perkins, Cliff Obrecht and Cameron Adams. The Complainant's CANVA products are related to many uses and contexts (e.g., for presentations, social media posts, and a range of print products). The Complainant's online platform, available in approximately 100 languages, is easy-to-use, intuitive, and utilizes a "drag-and-drop" methodology. As a result, the Complainant's services have achieved significant reputation and acclaim.

The Complainant currently has more than 100 million active users per month with customers across 190 countries. The Complainant offers its services from its main website, "www.canva.com". Third party Internet traffic statistics indicate that the Complainant's main website received an average of more than 370 million visits per month between October and December 2022.

The CANVA brand is well known around the world. The Complainant's services are offered exclusively online, which make them inherently global. The Complainant uses region-specific sites to market its products or services.

The Complainant launched its app for the iPad in 2014. The Complainant's app is available on both the App Store and Google Play; it has been downloaded more than 100 million times on Google Play. The Complainant also maintains blogs and learning resources on design, marketing, branding, and photography.

Additionally, the Complainant's business has grown through the acquisitions of Zeetings, Pexels and Pixabay. Within the field of graphic design, the CANVA mark has achieved considerable recognition. It is frequently featured in third party lists collating the best online graphic design tools available.

The Complainant holds a number of registered trademarks for the CANVA term, some of which are exhibited below:

Trademark	Origin	Registration Number	Registration Date	Class(es)
CANVA	Australia	1483138	March 29, 2012	9
CANVA	United States of America	4316655	April 9, 2013	42
CANVA	International	1204604	October 1, 2013	9
CANVA	International	1429641	March 16, 2018	9, 40, 42
CANVA	Brazil	914660462	April 30, 2019	9

The Complainant is also the holder of numerous domain names that include their trademark CANVA, under generic Top-Level Domain ("gTLD") and country code Top-Level Domain ("ccTLD") extensions. Examples of these registrations presented in the table below:

Domain Name	Registration Date
<canva.biz>	March 19, 2012
<canva.club>	December 5, 2018
<canva.co.in>	January 7, 2013
<canva.fi>	December 16, 2017
<canva.us>	January 7, 2013
<canva.cn>	December 8, 2013

The disputed domain name <canvackafoite.com> was registered on the May 13, 2022, and it resolves to a site which purports to advertise the sale of a commercial package, including editable templates under the heading "CANVA PACK AFOITE".

## 5. Parties' Contentions

### A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its CANVA trademark. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, that the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name.

### B. Respondent

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that the Complainant has established that it has registered trademark rights in the CANVA trademark. As noted in [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \("WIPO Overview 3.0"\)](#), section 1.2.1: "Where the Complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case."

In order to establish the confusing similarity test, panels typically do a side-by-side comparison between the trademark and the domain name to establish if the complainant's trademark is recognizable within the domain name.

In this case, the disputed domain name incorporates the trademark CANVA in its entirety with the addition of the words "pack" and "afoite". As stated in [WIPO Overview 3.0](#), section 1.7: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Panels have also established that, where the relevant trademark is recognizable, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first UDRP element (see [WIPO Overview 3.0](#), section 1.8). The Complainant's CANVA mark remains clearly recognizable in the disputed domain name; the addition of "pack" and "afoite" does not prevent a finding of confusing similarity.

Further, the gTLD ".com" does not prevent a finding of confusing similarity. As stated by section 1.11.1 of the [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".

For the foregoing reasons, the Panel finds that the disputed domain name is confusingly similar to the trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) before any notice to you of the dispute, the respondent's 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) The Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) The respondent is 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.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not referred to or commonly known by the disputed domain name or any related trademark. The Complainant also claims that it has not authorized the Respondent to use the trademark in any way including use in a domain name and also that the Respondent has no rights to or legitimate interests in respect of the disputed domain name based on the Complainant's prior use of its trademark CANVA.

The Complainant argues that the Respondent is not affiliated or related to the Complainant in any way, or licensed or otherwise authorized to use the CANVA mark in connection with a website, a domain name or for any other purpose. The Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain, is not commonly known by the disputed domain name and has not acquired any trademark or service mark rights in that name or mark.

The Complainant further submits that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. It can therefore be concluded that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The evidence provided by the Complaint shows that the disputed domain name resolves to a site which purports to advertise the sale of a commercial package, including editable templates, in connection with the Complainant's CANVA mark under the heading "CANVA PACK AFOITE". Further, Internet users that click on "QUERO GARANTIR MEU CANVA PACK AGORA" and "QUERO MEU CANVA PACK" will be redirected to a third party merchant site (under) which facilitates the purchase of the product offered on the website at the disputed domain name. The Respondent's use of the disputed domain name to attract users to and advertise its own commercial offering of editable templates is not a conduct which constitutes a *bona fide* offering of goods or services. 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.

According to the Complaint and its evidence, the Respondent is not 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 CANVA mark. The Respondent has used the disputed domain name to attract and misleadingly divert Internet users to its own advertisement and sale of a commercial package that capitalizes on the renown of the Complainant's CANVA mark. The Respondent has not made a good faith attempt through the site at the disputed domain name to disclaim any perceived association with the Complainant. On the contrary, the site at the disputed domain name gives Internet users the false impression that it is endorsed, authorized, or otherwise connected to the Complainant.

The composition of the disputed domain name creates an initial confusion by giving users the misleading impression that the corresponding site is created, authorized, or endorsed by an entity related to the Complainant (e.g., editable CANVA templates).

In conclusion, according to this Panel, the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services nor making any legitimate noncommercial or fair use of the disputed domain name in the present case.

Therefore, 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. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests onto the Respondent.

For the foregoing reasons, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the requirements of paragraph 4(a)(ii) of the Policy therefore are fulfilled.

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

In order to prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith.

The Complainant's CANVA trademark is well known. The Complainant's trademarks have been continuously and extensively used for many years and have as a result acquired considerable reputation and goodwill worldwide. Accordingly, the Panel is satisfied that the Respondent must have been aware of the trademark CANVA when it registered the disputed domain name.

The Respondent has intentionally registered and is using the disputed domain name in bad faith. It is apparent from the composition of the disputed domain name that the Respondent chose to register the disputed domain name that is confusingly similar to the Complainant's trademark CANVA. The Panel finds that the Respondent more likely than not, was fully aware of the fact that the disputed domain name has incorporated a well-recognized and distinctive trademark in which the Respondent has no rights.

The registration of the disputed domain name took place by the Respondent on May 13, 2022, hence, more than 10 years after the CANVA trademark registration.

As this Panel stated before, the disputed domain name incorporates the Complainant's trademark CANVA and was registered almost 10 years after the Complainant started using its mark. Given the distinctiveness and well-established reputation of the Complainant's trademark, in all likelihood the Respondent could not ignore the Complainant's CANVA trademark at the time it registered the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith, with a deliberate intent to create an impression of an association with the Complainant. See [WIPO Overview 3.0](#), section 3.2.2.

Concerning the use of the disputed domain name, the evidence submitted by the Complainant shows that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's CANVA mark. The Respondent has sought to capitalize on the Complainant's CANVA mark through its use of the same in the disputed domain name to advertise its own offering of editable templates. The Respondent's use of the CANVA mark, both in the disputed domain name and in the name of its product, creates the false impression that the site at the disputed domain name is an authorized site, endorsed, or otherwise associated with the Complainant. See the *Canva Pty Ltd v. Jose de Souza Silva, ABC do Canva*, WIPO Case No. [D2022-1316](#).

Also, this Panel takes note that the Complainant further highlights that the Respondent fails to disclaim its lack of connection with the Complainant on the website at the disputed domain name, which therefore creates the risk of Internet user confusion. Other Panels have repeatedly found that such conduct, particularly in circumstances where there is a likelihood of Internet user confusion, constitutes evidence of bad faith under the Policy. See, for example, *KIKO S.p.A. v. Registration Private, Domains by Proxy, LLC / Blake Spencer*, WIPO Case No. [D2019-1301](#).

Further, the Complainant's representative sent a cease-and-desist letter to the Respondent in October 2022. The Complainant did not receive a response to this correspondence, and panels have repeatedly found that a respondent's failure to respond to the cease-and-desist letter may constitute additional evidence of its bad faith see, for example, *Sanofi v. Domain Administrator, See PrivacyGuardian.org / online store, willam Johnson*, WIPO Case No. [D2019-2846](#), in which the panel stated that the respondent's failure to respond to the cease and desist letter sent by the complainant "further reinforces the inference of bad faith registration and bad faith use".

All the above circumstances confirm the Respondent's bad faith in the disputed domain name under the Policy.

Therefore, the Panel finds that the disputed domain name was registered and is being used in bad faith under paragraph 4(b)(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 <canvackafoite.com> be transferred to the Complainant.

*/Ada L. Redondo Aguilera/*

**Ada L. Redondo Aguilera**

Sole Panelist

Date: June 7, 2023