

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. zid Hachi

Case No. D2023-1777

1. The Parties

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

The Respondent is zid Hachi, Algeria.

2. The Domain Name and Registrar

The disputed domain name <canvalifetime.pro> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 21, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 1, 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 May 3, 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 May 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 1, 2023.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on June 8, 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 online graphic design platform founded in 2012, which offers to the users thousands of images and templates to choose from when creating graphic designs.

The Complainant's offerings relate to many uses and contexts (e.g., for presentations, social media posts, and a range of print products).

The Complainant was valued at USD 40 billion in September 2021 and currently has more than 100 million active users per month (MAUs) with customers across 190 countries.

The Complainant offers services from its main website, "www.canva.com". Third-party Internet traffic statistics indicate that the Complainant's main website received an average of almost 400 million visits per month between January and March 2023. The Complainant's online platform is available in approximately 100 languages.

The Complainant markets its offerings to users based in various jurisdictions through the use of region-specific sites

The Complainant has rights over the CANVA mark for which it holds several mark registrations, such as International Registration No. 1,204,604 in class 9, registered on October 1, 2013, International Registration No. 1,429,641 in class 9, 40, and 42 registered on March 16, 2018.

The Complainant is also the holder of numerous exact-match domain names, under both generic Top-Level Domain ("gTLD") and country code Top-Level Domain ("ccTLD") extensions.

The Complainant is also very present on social media, with millions of followers and subscribers. The Complainant uses the CANVA mark to promote its services under this name, in particular on:

- Facebook: "https://www.facebook.com/canva/"
- Instagram: "https://www.instagram.com/canva/"
- Twitter: "https://twitter.com/canva"
- Pinterest: "https://www.pinterest.co.uk/canva/"

The disputed domain name was registered on September 1, 2021. Before the filing of the Complaint, the disputed domain name resolved to a site which, while brandishing an adapted version of the Complainant's CANVA logo, purported to sell lifetime access to the Complainant's "Canva Pro" offering, claiming to be a "marketing partner of Canva". On the day of the submission of the Complaint, the disputed domain name resolved to the inactive website.

5. Parties' Contentions

A. Complainant

By the Complaint, the Complainant contends:

- It holds a number of registered trademarks for the "canva" term, which cover multiple jurisdictions.
- It relies on the goodwill and recognition that it has attained under the CANVA brand, which has become a distinctive identifier of its offerings.
- It has been a complainant in numerous prior domain name disputes which resulted in the transfer of the domain names.

- The disputed domain name satisfies the identity/confusing similarity requirement of the first element it incorporates the Complainant's distinguished CANVA mark in full. This mark is only preceded by the term 'lifetime'.
- The Panel should disregard the ".pro" extension in the disputed domain name.
- The Respondent lacks rights or legitimate interests in the disputed domain name.
- The Respondent has not registered any trademarks for terms "canva", and "canvalifetime" or anything similar.
- There is no evidence that the Respondent holds unregistered rights in any such term.
- The Respondent has not been licensed by the Complainant to use disputed domain names that feature its CANVA trademark.
- The Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services.
- The disputed domain name has been used to resolve to a site which, while brandishing an adapted version of the Complainant's CANVA logo, purported to sell lifetime access to the Complainant's "Canva Pro" offering. The disputed domain name site claimed to be a "marketing partner of Canva", which is not the case; the Respondent is not associated with the Complainant and has not been authorised to use the CANVA mark commercially.
- The Respondent is not known, nor has ever been known, by the CANVA mark, "canvalifetime" term or anything similar.
- The Respondent is not connected to or affiliated with the Complainant and has not received license or consent to use the CANVA mark in any way, as supported by the evidence elucidated above, 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's prior use of the disputed domain name, by brandishing the Complainant's CANVA mark and purporting to sell lifetime access to its "Canva Pro" offering, was evidently calculated to derive revenue by creating the false impression that the resolving site was authorised by, or otherwise associated with, the Complainant.
- The Respondent did not take steps to mitigate the perceived association between the disputed domain name site and the Complainant's official offerings, and, on the contrary, capitalised on the likelihood of Internet user confusion by claiming to be a "marketing partner of Canva".
- The very nature of the disputed domain name's composition carries a risk of implied affiliation and cannot constitute fair use.
- The Respondent has both registered and is using the disputed domain name in bad faith, in accordance with paragraph 4(a)(iii).
- The Complainant's earliest CANVA trademark predates the registration of the disputed domain name by more than nine years, time in which the Complainant has also accrued substantial goodwill and international recognition in its CANVA mark.
- The Complainant's representatives sent a cease and desist letter to the Respondent in December 2022, which it did not receive a response to this correspondence. The Respondent therefore had the opportunity to explain its registration of the disputed domain name but chose not to do so.

- The Respondent has used the disputed domain name in bad faith prior to notice of the Complaint as 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 capitalise on the Complainant's CANVA offerings through its use of the disputed domain name containing the Complainant's CANVA mark.
- To present a site which features an adapted version of the Complainant's CANVA logo and, in connection with such, purports to sell lifetime access to the Complainant's "Canva Pro" offering.
- The Respondent's use of the CANVA mark, both in the disputed domain name and resolving site, creates the misleading and false impression that the disputed domain name's site is authorised, endorsed or otherwise associated with the Complainant. Panels have repeatedly found the same and similar conduct to constitute bad faith use within the meaning of the Policy
- The Respondent fails to disclaim its lack of connection with the Complainant, and therefore the risk of Internet user confusion.
- The disputed domain name's site specifically claimed to be a "marketing partner of Canva", which is further evidence of the Respondent's attempt to create Internet user confusion between its site and the Complainant's "Canva Pro" offerings.
- The Complainant lastly notes that the site is not active.
- It is implausible, particularly given the disputed domain name's composition, that the Respondent could put the disputed domain name to any good faith use.
- In view of the foregoing, the Complainant requests that the Panel makes a finding of bad faith registration and use under Paragraph 4(a)(iii) of the Policy.

B. Respondent

Although properly summoned, the Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

This Panel finds the contentions of the Complainant in relationship to the holding of the mark CANVA registrations accurate and documented and considers that the Complainant is holder of the said mark.

In regards of the identity/confusing similarity requirement of the first element related to the disputed domain name, this Panel finds that it incorporates the Complainant's distinguished CANVA mark in full followed by the term "lifetime" and the said requirement is therefore fulfilled.

It is a long established UDRP practice (see section 1.7 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \("WIPO Overview 3.0"\)](#)) according to which the test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name, which is the case in these proceedings. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the [WIPO Overview 3.0](#)).

Accordingly, this Panel finds that the Complainant's trademark is recognizable in the disputed domain name

which makes the disputed domain name confusingly similar to the trademark and the first element under of paragraph 4(a) of the Policy is accordingly established.

B. Rights or Legitimate Interests

According to UDRP practice, in relation to the second element of the Policy, the Complainant has to show that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that *prima facie* showing, the burden of production shifts to the Respondent, according to the section 2.1 of the [WIPO Overview 3.0](#).

In these proceedings, this Panel finds that the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and such showing has not been rebutted by the Respondent, as it did not reply to the Complainant's contentions.

From the documented submissions of the Complainant, it appears that the Respondent:

- has not registered any trademarks for the terms "canva", and "canvalifetime" or anything similar,
- there is no evidence that the Respondent holds unregistered rights in any such term,
- the Respondent has not been licensed by the Complainant to use domain names that feature its CANVA trademark.
- the Respondent has not used, nor prepared to use of the disputed domain name in connection with a *bona fide* offering of goods or services.
- the disputed domain name has been used to resolve to a site which, while brandishing an adapted version of the Complainant's CANVA logo, purported to sell lifetime access to the Complainant's "Canva Pro" offering, claiming to be a "marketing partner of Canva", which is not the case.
- the Respondent is not associated with the Complainant and has not been authorised to use the CANVA mark commercially,
- the Respondent is not known, nor has ever been known, by the CANVA mark, "canvalifetime" term or anything similar,
- the Respondent is not connected to or affiliated with the Complainant and has not received license or consent to use the CANVA mark in any way.
- After the Complainant's representatives sent a cease and desist letter to the Respondent in December 2022, which it did not receive a response to, the website to which the disputed domain name was inactivated.

Accordingly, the Panel finds that 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. Therefore, the second element under of paragraph 4(a) of the Policy is accordingly established.

C. Registered and Used in Bad Faith

Several circumstances had been submitted by the Complainant in regards of the bad faith registration and use of the disputed domain name in bad faith, in accordance with Paragraph 4(a)(iii), as follows:

- The Complainant's earliest CANVA trademark predates the registration of the disputed domain name by more than nine years, time in which the Complainant has also accrued substantial goodwill and international recognition in its CANVA mark.

- The Complainant's representatives sent a cease and desist letter to the Respondent in December 2022, which it did not receive a response to. The Respondent therefore had the opportunity to explain its registration of the disputed domain name but chose not to do so.
- The Respondent has used the disputed domain name in bad faith prior to notice of the Complaint as 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 capitalise on the Complainant's CANVA offerings through its use of the disputed domain name containing the Complainant's CANVA mark.
- The Respondent's use of the CANVA mark, both in the disputed domain name and resolving site, has been misleading and creating false impression that the disputed domain name's site is authorised, endorsed or otherwise associated with the Complainant. Panels have repeatedly found the same and similar conduct to constitute bad faith use within the meaning of the Policy.
- There is no disclaimer in relationship to its lack of connection with the Complainant.
- The disputed domain name's site specifically claimed to be a "marketing partner of Canva", which is further evidence of the Respondent's attempt to create Internet-user confusion between its site and the Complainant's CANVA offerings.
- The disputed domain name is currently inactive.

Thus the overall submissions and documented evidence of the Complainant in the file together with the conduct of inactivating the disputed domain name after the cease and desist letter had been sent, indicates that the Respondent's registration of the disputed domain name was deliberate for its confusing association with, and with the intention to commercially benefit from the reputation and goodwill of, the Complainant's marks, which denotes bad faith.

Further, the Panel finds that through its use of the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's CANVA mark. The fact that the disputed domain name is currently inactive does not alter the Panel's findings (see section 3.3 of the [WIPO Overview 3.0](#)).

Moreover, in this Panel's view, the lack of response is also strong indicative that the Respondent lacks arguments and evidence to support its holding of the disputed domain name.

Therefore the element under of paragraph 4(a) of the Policy is properly established.

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, <canvalifetime.pro> be transferred to the Complainant.

/Dr. Beatrice Onica. Jarka/

Dr. Beatrice Onica. Jarka

Sole Panelist

Date: June 22, 2023