

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Lucas Henrique Gomes; Marcelo Openheimer da Silva;
Lucas Lins Costa; Anderson Simao, ANDERSON SIMAO TEIXEIRA
68161530653; Joao Oliveira, KGL; Elias Rocha de Souza;
CLOVIS JUNIOR; and Isabela Fanti
Case No. D2023-3547

1. The Parties

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

The Respondents are Lucas Henrique Gomes; Marcelo Openheimer da Silva; Lucas Lins Costa; Anderson Simao, ANDERSON SIMAO TEIXEIRA 68161530653; Joao Oliveira, KGL; Elias Rocha de Souza; CLOVIS JUNIOR; and Isabela Fanti, all located in Brazil.

2. The Domain Names and Registrars

The disputed domain names <artedocanva.com>, <marketingcanva.com>, and <powercanvapremium.com> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com.

The disputed domain names <canvapro.tech>, <canvatemplates.online>, <canvavitalicio.online>, <packcanva.shop>, and <powercanvapro.online> are registered with HOSTINGER operations, UAB.

PDR Ltd. d/b/a PublicDomainRegistry.com and HOSTINGER operations, UAB are hereinafter referred to as the “Registrars”.

The disputed domain names are hereafter collectively referred to as the “Domain Names” and individually as the “Domain Name”, followed by the disputed domain name involved.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 22, 2023. On August 25, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the Domain Names. On August 26 and August 28, 2023, respectively, the Registrars transmitted by emails to the Center their verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) et al.) and contact information in the Complaint.

The Center sent an email communication to the Complainant on August 31, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed the first amended Complaint on September 5, 2023. In response to the Center's change request regarding one of the Registrars' location, the Complainant filed a second amended Complaint on September 6, 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 Respondents of the Complaint, and the proceedings commenced on September 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 28, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on October 10, 2023.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on October 16, 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.

A. Consolidation Request and Procedural Orders

The Complaint relates to eight different domain names, registered in the name of different individuals, and the Complainant requested consolidation of the eight disputes. On November 1, 2023, the Center at the request of the Panel notified Procedural Order No. 1 in which the Complainant was invited to submit additional evidence in relation to its request for consolidation of the disputes and the Respondents were invited to respond to such evidence, if any. On November 3, 2023, the Complainant expressed its wish to proceed with the Complaint and the consolidation request for the Domain Names <canvatemplates.online>, <marketingcanva.com>, and <artedocanva.com>, and requested withdrawal of the proceeding with respect to the other five Domain Names. In addition, the Complainant submitted an Amended Complaint and additional evidence relating to the Domain Names <canvatemplates.online>, <marketingcanva.com>, and <artedocanva.com>. By email of November 5, 2023, the Respondent Lucas Lins Costa notified the Center that he was willing to transfer the Domain Name <artedocanva.com>. No response was received by the Center from the other Respondents. By email of November 9, 2023, the Center informed the Complainant of the transfer offer from the Respondent Lucas Lins Costa and that, if the Complainant wished to explore settlement options, the Complainant should submit a request for suspension. By email of November 10, 2023, the Complainant submitted the suspension request in relation to the Domain Name <artedocanva.com>. By Procedural Order No. 2 of November 17, 2023, the Center invited the Respondents of the five Domain Names <powercanvapremium.com>, <canvapro.tech>, <canvavitalicio.online>, <packcanva.shop>, and <powercanvapro.online> to comment by November 22, 2023, on the Complainant's request for termination of their respective disputes. No response was received. By Procedural Order No. 3 of November 24, 2023, the disputes with respect to the five Domain Names mentioned were terminated and the proceeding for the Domain Names <canvatemplates.online>, <marketingcanva.com>, and <artedocanva.com> was suspended pursuant to paragraph 17(b) of the Rules, for purposes of settlement discussions concerning the Domain Name <artedocanva.com>. On November 29, 2023, the Complainant informed the Center that a settlement had been reached and that the Respondent Lucas Lins Costa was preparing the transfer of the Domain Name <artedocanva.com>. On November 30, 2023, Procedural Order No. 4 was issued in which the Center was ordered to reinstate the current proceeding for the remaining Domain Names <canvatemplates.online> and <marketingcanva.com>, after receiving the confirmation from the Complainant that the settlement relating to the Domain Name <artedocanva.com> has been implemented in accordance with paragraph 17(a)(vi) of the Rules.

Further to Procedural Order No. 4, the Panel by email of December 8, 2023, informed the Respondents that the Complainant confirmed to the Center on December 7, 2023 that the settlement for the Domain Name <artesdocanva.com> had been implemented, and ordered the Center to reinstitute the current proceeding for the remaining Domain Names <canvatemplates.online> and <marketingcanva.com> as of December 8, 2023 (hereafter the “Remaining Domain Names”).

4. Factual Background

The Complainant is an online graphic design platform founded in 2012. Users of the Complainant’s services have thousands of images and templates to choose from when creating graphic designs, 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 with customers across 190 countries. Third-party Internet traffic statistics indicate that the Complainant’s main website under “www.canva.com” received an average of more than 360 million visits per month between January and March 2023. The Complainant’s online platform is available in approximately 100 languages on region-specific sites.

The Complainant holds a number of registered trade marks for CANVA, including:

- Australia word trade mark CANVA, registered on March 29, 2012, under No. 1483138;
- United States of America word trade mark CANVA, registered on April 9, 2013, under No. 4316655;
- International word mark CANVA, registered on October 1, 2013, under No. 1204604; and
- United States of America device trade mark CANVA (in a blue circle), registered on July 28, 2020, under No. 6114099.

These trade marks are hereafter collectively referred to as the “Trade Marks” or individually as the CANVA word mark or the CANVA device mark.

The Domain Name <canvatemplates.online> has been registered on January 2, 2023, in the name of Isabela Fanti (“Respondent 1”); and the Domain Name <marketingcanva.com> has been registered on January 20, 2023, in the name of Lucas Henrique Gomes (“Respondent 2”).

The Complainant sent out a cease-and-desist notice to the Respondent 1 on March 6, 2023, to which no response was received.

5. Parties’ Contentions

A. Complainant

The Complainant requests consolidation of the disputes concerning the Remaining Domain Names since the registrants are either the same person or entity or are acting in concert. The arguments for this request are elaborated and discussed in section 6A below.

The Complainant has made the following submissions as to the grounds on which it demands transfer of the Remaining Domain Names. In view of its consolidation request, the Complainant refers to the “Respondent” (singular) which terminology has been taken over in this section of the decision.

The Domain Names are confusingly similar to the Trade Marks, in which the Complainant holds rights. The Remaining Domain Names encompass the CANVA word mark in its entirety with the addition of the terms “marketing” and “templates”, respectively. As the Complainant operates within the online marketing and

graphic design industries, such additions relate to the Complainant's offerings. As the CANVA word mark is recognizable in the Remaining Domain Names, the addition of these descriptive or generic terms does not prevent a finding of confusing similarity. The generic Top-Level Domains ("gTLDs") ".com" and ".online", which respectively form part of the Remaining Domain Names, should be disregarded as they are standard registration requirements.

The Respondent lacks a right or legitimate interest in the Remaining Domain Names in accordance with Paragraph 4(a)(ii) of the Policy, since (i) to the best of the Complainant's knowledge, the Respondent does not have any trade mark rights to the term "canva", nor any similar term; (ii) there is no evidence that the Respondent retains any unregistered trade marks to the term; and (iii) the Respondent has not received any license from the Complainant to use a domain name featuring the CANVA word mark. Furthermore, the Respondent has not used, nor prepared to use, the Remaining Domain Names in connection with a *bona fide* offering of goods or services, as they have all, at some point during their registrations, been used by the Respondent to advertise for sale products and services that directly compete with those offered by the Complainant. Specifically, the Respondent purports(ed) to offer "Canva" packages on the websites under the Remaining Domain Names granting its purchasers access to custom files that the websites imply were created using the Complainant's content and design platform. These services are in direct competition to the services offered by the Complainant and covered by the Trade Marks. In addition, the Remaining Domain Names' use to offer various template designs and bundle packages is an attempt by the Respondent to offer services identical to the Complainant's and such use, without authorization from the Complainant, brandishes the Trade Marks. It is clear from the composition of the Remaining Domain Names that the Respondent has capitalized on the goodwill of the CANVA word mark to attract Internet users to its own sites for the purpose of deriving commercial gain.

Furthermore, the Respondent has not been authorized by the Complainant to commercially use the CANVA word mark (in a domain name, or otherwise) and it is not possible to conceive of any plausible good faith use that can be made from the Remaining Domain Names without contravening the Complainant's Terms of Use and, in particular, the provision: "You must not present a misleading endorsement or affiliation with Canva on a Canva Site, including (but not limited to), by attempting to register a domain name or subdomain name that includes the word "canva" or any other Canva brand or trade mark of Canva or its affiliates. Canva may include or require certain terms to be included on a CanvaSite at any time for any reason". The Respondent has not been granted an exception to the Complainant's Terms of Use, nor any other authorization to use the Trade Marks.

To the best of the Complainant's knowledge, the Respondent is not commonly known by the term "canva" nor any other terms within the Remaining Domain Names. Therefore, there is no plausible reason for the registration and use of the Remaining Domain Names, other than the motive of taking advantage of the goodwill and reputation attached to the CANVA word mark. Mere ownership of a domain name is not sufficient to show that a respondent has been commonly known by the domain name.

The use of the Remaining Domain Names to advertise products identical to the Complainant's offerings is not a legitimate, noncommercial, or fair use since the Respondent clearly intends to confuse Internet visitors as to the Remaining Domain Names' affiliation to the Complainant and lead them to inevitably land on the Respondent's own sites. Therefore, the Respondent is exploiting the Complainant's CANVA mark by creating increased traffic and generating profit from purchases made on the sites.

The Respondent both registered and is using the Remaining Domain Names in bad faith in accordance with Paragraph 4(a)(iii) of the Policy.

The Trade Marks predate the creation date of the Remaining Domain Names by more than 10 years and substantial goodwill has accrued since the Complainant's establishment in 2012, so that the CANVA name has become synonymous with online graphic design and templates. In addition, when searching "CANVA" on popular Internet search engines such as Google, the Complainant and its services, as well as the CANVA word mark, are listed as the first results. Moreover, any average Internet user has access to the registration information on the Trade Marks, as they can be found on public trade mark databases.

In addition, as the Remaining Domain Names replicate the CANVA word mark in its entirety with the addition of terms and gTLDs which describe the Complainant's offerings, the Remaining Domain Names are likely to mislead Internet visitors into thinking that they are linked with the Complainant's web-shop for their products and/or services. In this way, the Respondent attempts to attract Internet visitors seeking or expecting to reach the Complainant's offerings to the websites under the Remaining Domain Names in order to create increased traffic to these websites, and to generate profit from purchases made on those sites.

B. Respondents

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

6. Discussion and Findings

A. Request for consolidation

The Complaint concerns eight domain names registered in the name of natural persons with different names and addresses. The Complainant has requested to consolidate the disputes concerning the Domain Names, based on paragraph 3(c) of the Rules which reads: "The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder."

According to paragraph 10(e) of the Rules, a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

As set out in section 3 above, following Procedural Order No. 1, the Complainant filed an amended Complaint and additional evidence relating to the Domain Names <canvatemplates.online>, <marketingcanva.com>, and <artesdocanva.com> and requested withdrawal of the proceeding with respect to the other five Domain Names. Following Procedural Order No. 4, the Complainant confirmed the implementation of the settlement with respect to the Domain Name <artesdocanva.com> and requested consolidation of the disputes concerning the Domain Names <canvatemplates.online> and <marketingcanva.com>. Accordingly, the present case has been limited to the disputes concerning the Domain Names <canvatemplates.online> and <marketingcanva.com> (the Remaining Domain Names).

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 (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2). Procedural efficiency would also underpin panel consideration of such a consolidation scenario. 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 behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

The Complainant has pointed at a number of circumstances which in its opinion demonstrate that the Remaining Domain Names are under the control of the same single individual or entity or, at least, reflective of a group of individuals acting in concert. These are discussed below.

First, the Complainant submits that the Remaining Domain Names share a similar lexical pattern, involving the CANVA mark plus a descriptive term that has connotations to the Complainant's commercial offerings (factor (vi) of the list referred to above).

It is correct that the Remaining Domain Names consist of the CANVA word mark and a descriptive terms, but there are also differences. The Remaining Domain Names are registered in different gTLDs (".com" and ".online", respectively) and the terms used are different ("marketing" and "templates", respectively), added in front of and behind the CANVA word mark respectively. In the Panel's opinion, there is not a readily discernable naming pattern in the way the Remaining Domain Names are made up which would point at the Remaining Domain Names being held by one and the same registrant or registrants acting in concert.

The Complainant for its request to consolidate the disputes further relies on similarities between the websites which are or were connected to the Remaining Domain Names (factor (iv) of the list referred to above).

In support of its arguments, the Complainant with submitted a print of screen shots for two pages of each of the websites connecting to the Remaining Domain Names, dated August 2, 2023 (the first page) and August 21, 2023 (the second page) respectively. With the Amended Complaint, the Complainant submitted screen shots of eight separate pages of the website under <marketingcanva.com>, dated November 3, 2023. In addition, a compilation of web pages ascribed to the website under <canvatemplates.online> was submitted. The first page thereof was dated November 1, 2023 with a time stamp, the other pages had neither a date nor a time stamp, suggesting that they were made on the same date. However, when checked by the Panel two days earlier, on October 30, 2023, the website under <canvatemplates.online> could not be found ("no connection to a server"). The Panel also on October 30, 2023 and again on December 5, 2023 consulted the Internet archive under "www.archive.org" and found that the captured pages for the Domain Name <canvatemplates.online> connected to a registrar's website stating: "This domain has been registered via IONOS and is not yet connected to a website."

In conclusion, the Panel's search did not yield evidence confirming the screen shots that the Complainant submitted as evidence of the contents of the website under <canvatemplates.online>. Taking into account as well that (i) the only dated screen shot of the website under <canvatemplates.online> submitted with the Amended Complaint carried a date of November 1, 2023, while the Panel's Internet search on October 30, 2023 (two days earlier) resulted in a message that the website could not be found; (ii) the other screen shots of the website under <canvatemplates.online> submitted with the Amended Complaint were not dated nor time stamped; and (iii) the Complainant did not clarify or explain the apparent omissions and inconsistencies in the evidence submitted, nor between the findings of the Panel and such evidence, the Panel in this case cannot base a positive consolidation decision on the screen shots submitted as evidence.

With respect to the Complainant's statement that the Remaining Domain Names (as disclosed by the Registrars) are associated with Brazilian-based addresses, with a common country code +55 (country code for Brazil), the Panel observes that the Remaining Domain Names are in the name of different individuals – Isabela Fanti and Lucas Henrique Gomes - each with a different address. Although the Complainant submits that the Respondent has used multiple aliases to register the Remaining Domain Names, the file does not contain information as to the verification of the identity of the registrants (factor (i) of the list mentioned above). As to the addresses (factor (ii) of the list), the Panel notes that the addresses of the Respondents are in two different states in Brazil, over 1200 km apart and that the DHL package from the Center containing the Complaint and related documentation was delivered to the address of the Respondent 1, which supports a preliminary conclusion that this address exists. In addition, the Center's email notifying the Respondents of the disputes was delivered to the personal email address of the Respondents, which therefore at first hand appear to be genuine.

Since, furthermore, the Complainant has not submitted evidence showing that the (email) addresses or the identity of the Respondents are false, the preliminary conclusion based on the above mentioned circumstances is that the evidence with respect to factors (i) (identity of registrants) and (ii) (address information) does not support a finding that the Respondents are in fact one person or entity or acting in concert with each other.

The Panel further notes that, whereas registration on the same date may be an indication of concerted activity, in this case the Remaining Domain Names were registered on different dates, i.e., January 2 and 20, 2023 respectively. Likewise, the sharing of the same hosting provider may be a relevant circumstance indicating a concerted action, but in this case the Remaining Domain Names are registered with different hosting providers.

In the Amended Complaint, the Complainant has finally brought forward that the Respondents share the same mail exchange (“MX”) record provider, but that apparently concerned the Domain Names <marketingcanva.com> and <artedocanva.com> (which no longer is part of the proceeding) and not <canvatemplates.online>.

In the opinion of the Panel, all these circumstances taken together, and also considering fairness and equitability to both parties as well as procedural efficiency, in this case do not justify consolidation of the disputes concerning the Remaining Domain Names.

This finding does not preclude the Panel from proceeding with a decision in one of the cases, which the Panel will do for efficiency reasons. Nor does this decision preclude the Complainant from filing a new complaint with respect to any of the other Domain Names.

Below, the case with respect to the <marketingcanva.com> Domain Name, registered in the name of Lucas Henrique Gomes (the Respondent 2), will be discussed, as this Domain Name is connected to an active website, which contains all of the screens for which evidence was submitted by the Complainant.

B. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The <marketingcanva.com> Domain Name is confusingly similar to the Trade Marks as it incorporates the CANVA word mark in its entirety. The addition of the term “marketing” does not prevent a finding of confusing similarity between this Domain Name and the Trade Marks (see [WIPO Overview 3.0](#), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#); and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The gTLD “.com” is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11.1). Therefore, the Panel finds that the <marketingcanva.com> Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

C. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the second element a complainant has to prove is that a respondent lacks rights or legitimate interests in a domain name. This may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the domain name. If the Complainant succeeds in doing so, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element (See [WIPO Overview 3.0](#), section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent 2 has not received the Complainant’s consent to use the Trade Marks as part of the <marketingcanva.com> Domain Name, is not commonly known by the <marketingcanva.com> Domain Name and has not acquired trade mark rights in the <marketingcanva.com> Domain Name and is not an authorized reseller of the Complainant. The Respondent 2 uses the <marketingcanva.com> Domain Name for a website on which the Complainant’s CANVA word mark is used prominently, as well as photos of products purporting to be genuine products of the Complainant. The Respondent 2 thereby suggests a relationship with the Complainant which does not exist, while the website lacks a disclaimer to that effect.

Given these facts and circumstances, it is clear that there is no case of a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the <marketingcanva.com> Domain Name by the Respondent 2.

In view of the above, the Panel concludes that the Complainant has established that the Respondent 2 has no rights or legitimate interests in the <marketingcanva.com> Domain Name.

D. Registered and Used in Bad Faith

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the <marketingcanva.com> Domain Name, the Respondent 2 was or should have been aware of the Trade Marks, since:

- the Respondent 2's registration of the <marketingcanva.com> Domain Name occurred more than 10 years after the earliest registration of the CANVA word mark;
- the Respondent 2 uses the CANVA word mark prominently on the website; and
- a simple trade mark register search, or even an Internet search, prior to registration of the <marketingcanva.com> Domain Name in its name would have informed the Respondent 2 of the existence of the Trade Marks.

Furthermore, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the <marketingcanva.com> Domain Name:

- the probability that the Respondent 2 was aware or should have been aware of the Complainant's rights in the Trade Marks;
- the use of the <marketingcanva.com> Domain Name for a website prominently using the CANVA word mark, while offering products for sale purported to be from the Complainant;
- the lack of a response to the cease-and-desist notice; and
- the lack of a formal Response and of a response to the various Procedural Orders.

Therefore, the Panel concludes that the <marketingcanva.com> Domain Name has been registered and is being used in bad faith.

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 Name <marketingcanva.com> be transferred to the Complainant. However, the Complaint is denied as regards the Domain Name <canvatemplates.online>.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: December 14, 2023