

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd. v. Pham Van Sieng  
Case No. D2022-0031

### **1. The Parties**

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

The Respondent is Pham Van Sieng, Viet Nam.

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

The disputed domain names <sellcanva.com>, and <maucanva.com> (the “Disputed Domain Names”) are registered with Mat Bao Corporation (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in Vietnamese with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2022. On January 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On January 6, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the Disputed Domain Names. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amended Complaint in English on January 27, 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 February 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 2, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on March 7, 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, Canva Pty Ltd, 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, through an "easy-to-use" online platform. According to the Complainant, it has been valued at USD 6 billion as of June 2020, and currently has some 30 million active users per month with customers in 190 countries.

The Complainant uses its main site "www.canva.com" to offer its services, as a basic package, for free, besides offering a paid version named "Canva Pro" with more features and design capabilities.

The Complainant's trademarks CANVA have been registered for design-related goods/services in Classes 9 and 42 in a variety of countries under a number of trademark registrations, including, but not limited to, the Australian trademark No. 1483138 (registered on September 9, 2013), United States registration No. 4316655 (registered on April 9, 2013), and International trademark registration No. 1204604 (registered October 1, 2013).

The Disputed Domain Names <sellcanva.com> and <maucanva.com> were registered on June 14, 2021 and June 18, 2021, respectively. As of the date of this Decision, the Disputed Domain Name <sellcanva.com> resolves to a web shop selling cell phone accessories under a third party's trademark, while the Disputed Domain Name <maucanva.com> resolves to a website with a notification "Welcome to WordPress. This is your first post. Edit or delete it, then start writing!". However, the Dispute Domain Names used to resolve to websites, which provided many graphic design templates under the Complainant's trademarks CANVA.

The Complainant sent a cease and desist letter to the Respondent on July 6, 2021, requesting for a transfer of the Disputed Domain Name <sellcanva.com>. The Respondent has, after that, changed the contents of the website under this Disputed Domain Name but did not respond to the cease and desist letter.

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

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

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Names are confusingly similar to the trademark in which the Complainant has rights.

First, the Complainant submits that the Complainant is the registered owner of trademark registrations for CANVA in many jurisdictions. Further, the Complainant contends that its trademarks CANVA have obtained goodwill and recognition around the world.

Second, the Complainant asserts that the Disputed Domain Names are confusingly similar to the trademarks CANVA owned by the Complainant since the Disputed Domain Names incorporate the Complainant's trademarks CANVA in its entirety, and the addition of the descriptive terms "sell" and "mau" (Vietnamese for "my") is insufficient to avoid confusing similarity.

Finally, the Complainant argues that the generic Top-Level Domain ("gTLD") ".com" is disregarded under the first element as it is a standard registration requirement.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

First, the Complainant contends that there is no evidence that the Respondent holds any registered or unregistered right to the term "canva". Moreover, the Respondent has not received any license from the Complainant to use the Disputed Domain Names featuring the CANVA trademarks.

Second, the Complainant argues that there is no evidence that the Respondent has used or is using the Disputed Domain Names in connection with a *bona fide* offering of goods or services since their registration, namely:

- The Disputed Domain Name <sellcanva.com> used to host a website that offered services directly identical to those of the Complainant under their CANVA trademarks. This is the Respondent's blatant attempt to create a false impression of association with the Complainant's services and has the potential to cause genuine confusion in unsuspecting Internet users. As such, this does not confer a genuine good faith use.
- The Respondent's removal of contents from the website under the Disputed Domain Name <sellcanva.com> subsequent to receipt of the Complainant's cease and desist letter is evidence to show the Respondent's awareness that they were not using the Disputed Domain Names in connection with a *bona fide* offering of goods or services.
- The Disputed Domain Name <maucanva.com> currently hosts an undeveloped WordPress blog page and thus, such use does not confer rights or legitimate interests in a domain name as previous UDRP panels have considered the non-use of a domain name to be "not a *bona fide* offering of goods or services".

Third, the Complainant contends that the Respondent is not known nor has it ever been known as "CANVA", namely:

- The Respondent's registration of the Disputed Domain Names is to take advantage of the goodwill and valuable reputation of the CANVA trademarks as the Respondent has no connection or affiliation with the Complainant and has not received any license or consent to use the mark in any way.
- There is no evidence that the Respondent, at the time of registration, was commonly known by the Disputed Domain Names.

Finally, the Complainant submits that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names, namely:

- The Respondent has used the Disputed Domain Name <sellcanva.com> to redirect Internet users to a website which offered services in connection to the Complainant with the intention to generate monetary revenue as a result of customer confusion. This cannot be a legitimate noncommercial or fair use under the Policy.
- The Respondent's subsequent removal of the contents hosted on the Disputed Domain Name <sellcanva.com> further illustrates the Respondent's lack of rights or legitimate interests and its primary intention to trade off the Complainant's rights and reputation.
- The non-use of the Disputed Domain Name <maucanva.com> is not a legitimate noncommercial or fair use.

(iii) The Disputed Domain Names were registered and are being used in bad faith.

First, the Complainant submits that its earliest CANVA trademark registration predates the creation date of the Disputed Domain Names by at least 9 years and it has accrued substantial goodwill and recognition since 2012.

Second, the Complainant argues that the Respondent has clearly registered the Disputed Domain Names to target the Complainant's brand intentionally since the Respondent was already aware of the Complainant through its use of the Disputed Domain Name <sellcanva.com>.

In addition, the Complainant submits that the Respondent's lack of reply to the Complainant's cease and desist letter and the Respondent's removal of the website's contents under the Disputed Domain Name <sellcanva.com> as a result of the received letter infer bad faith behavior.

Third, the Complainant contends that the Respondent has registered the Disputed Domain Names in order to prevent the Complainant from reflecting its mark in a corresponding domain name since the Respondent has intentionally targeted the Complainant in the registration of the Disputed Domain Names.

Forth, the Complainant argues that the Respondent has registered the Disputed Domain Names primarily for the purpose of disrupting the Complainant's business since the website under the Disputed Domain Name <sellcanva.com> used to offer services identical to those of the Complainant and by this manner, redirecting users from the Complainant's websites to the Respondent's website.

Finally, the Complainant contends that the Respondent has clearly registered the Disputed Domain Names to unfairly capitalize on the goodwill and reputation of the Complainant's mark, namely:

- The Respondent's use of the Disputed Domain Name <sellcanva.com> to host a website offering services identical to those of the Complainant and the subsequently removal upon receipt of the Complainant's letter shows the Respondent's intention to obtain commercial benefits by creating the confusion among the Internet users that this Disputed Domain Name is in some way connected to, affiliated with, or sponsored by the Complainant.

- The passive use of Disputed Domain Name <maucanva.com> does not preclude a finding of bad faith on the part of the Respondent since the Respondent has already shown its bad faith in the Disputed Domain Name <sellcanva.com> and there is no evidence of any actual or contemplated good faith use of the Disputed Domain Names.

With the said arguments, the Complainant requests that the Disputed Domain Names be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Procedural Issues**

#### **(I) Language of the Proceeding**

The initial Complaint was filed in Vietnamese, with arguments for the proceeding to be held in English. The Registrar confirmed that the language of the Registration Agreement was Vietnamese. On January 27, 2022, the Complainant submitted to the Center an amended Complaint in English containing its request and supporting evidence for the language of the proceeding to be English.

As the amended Complaint was filed in English and the Complainant requested that language of the proceedings to be English, the Center, in its notification dated January 28, 2022, informed the Respondent of the Complainant's request, and invited the Respondent, in case of opposition against such request, to submit a substantiated objection as to why the proceedings should not be conducted in English by February 2, 2022. The Respondent did not submit any comment on this language matter.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances

of the administrative proceeding.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to;

(i) the fact that the Complainant, an Australian entity, does not appear to be able to communicate in Vietnamese and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;

(ii) the English language is quite popular in Viet Nam, where the Respondent resides, especially in the trading context; the Disputed Domain Names and their associated websites contain English content; the Respondent has changed the website under the Disputed Domain Name <sellcanva.com> after receipt of the Complainant's cease and desist letter written in English. These suggest that the Respondent has knowledge of the English language and is able to communicate in English;

(iii) the Respondent did not object for English to be the language of the proceeding and did not submit a response in either English or Vietnamese.

Therefore, for the purpose of easy comprehension of the Complainant (ultimately, the party solely taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

## (II) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#), and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

## **B. Identical or Confusingly Similar**

The Complainant is required to establish the following: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Names are identical or confusingly similar to its trademark.

First, the Panel finds that the Complainant has clearly evidenced that it has registered trademark rights to CANVA, well before the Disputed Domain Names were registered.

Second, the Disputed Domain Names comprise the Complainant's CANVA trademarks, in which the Complainant has exclusive rights. The differences between the Disputed Domain Names and the trademarks CANVA are the addition of (i) the dictionary English word "sell" in respect of the Disputed Domain Name <sellcanva.com>, and (ii) the word "mau", which can be written with tone marks in Vietnamese as "mẫu", and accordingly, means "templates" or "form" in English, in respect of the Disputed Domain Name <maucanva.com>. However, it is well established that the addition of a descriptive or dictionary term to a trademark does not prevent confusing similarity. Thus, in the Panel's view, the addition of the said terms does nothing to prevent the trademarks CANVA from being recognizable in the Disputed Domain Names, nor to prevent confusing similarity, as it was found in previous UDRP decisions (see, e.g., *Price Costco*

*International, Inc. v. Huynh Van Duc*, WIPO Case No. [D2020-0321](#); *Philip Morris Products S.A. v. Ong Nguyen Ngoc Ha*, WIPO Case No. [D2019-2509](#); and *Facebook, Inc. v. Domain Admin Privacy Protect, LLC (PrivacyProtect.org) / Do Viet Dung*, WIPO Case No. [D2019-1121](#)).

Third, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD “.com” to the Disputed Domain Names does not constitute an element as to avoid confusing similarity for the purposes of the Policy (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. [D2012-2066](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant’s CANVA trademarks, and the first element of the Policy is established.

### C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Names for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(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 Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The Respondent did not refute the Complainant’s contentions.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating his rights or legitimate interests in the disputed domain name (see, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); and *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted providing arguments or evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant’s asserted facts that no license, permission, or authorization of any kind to use the Complainant’s trademarks CANVA has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to CANVA. Thus, the Panel finds that the Respondent has no rights in the trademarks CANVA.

In this particular case, the Panel finds that the Disputed Domain Names comprise the CANVA trademarks in its entirety, and it is evidenced by the Complainant that the websites under the Disputed Domain Names used to display the sign “Canva” which is identical to the Complainant’s CANVA trademarks. In addition, it is evidenced that these websites used to provide and offer for sale graphic design templates under the Complainant’s trademarks CANVA. Therefore, the Panel finds that by using the Disputed Domain Names in such a manner, the Respondent is attempting to ride on the reputation of the CANVA trademarks, and thus,

such use does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Names. Also, no evidence or argument supports that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names. In fact, it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Names that, the Respondent had full knowledge of the CANVA trademarks and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names, and the second element under paragraph 4(a)(ii) of the Policy is established.

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

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(i) circumstances indicating that you have registered or you have 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Names in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's bad faith registration and use of the Disputed Domain Names. In this regard, the Panel finds that the Complainant's CANVA trademarks have been registered in a variety of jurisdictions around the world. In addition, the Complainant's CANVA trademarks have been put in use for a long period of time and gained certain reputation in the sector of online graphic design. The Complainant's registration of the CANVA trademarks predates the registration of the Disputed Domain Names.

The Disputed Domain Names comprise the Complainant's CANVA trademarks in its entirety. Given the extensive use of the CANVA trademarks for graphic design by the Complainant, which occurs in numerous countries, it is very unlikely that the Respondent registered the Disputed Domain Names in a fortuity. Also, in consideration of the use of the Disputed Domain Names and the contents of the websites thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its CANVA trademarks when it registered the Disputed Domain Names. The Panel considers the registration of the Disputed Domain Names is an attempt by the Respondent as to take advantage of the Complainant's goodwill and the

reputation of the Complainant's CANVA trademarks.

It is well proven and evidenced by the Complainant that the websites under the Disputed Domain Names used to provide and offer for sale graphic design templates under the Complainant's CANVA trademarks. In addition to the adoption of the Complainant's CANVA trademarks as a uniquely distinctive part in the Disputed Domain Names, the Respondent has used, for a certain period of time, the Complainant's CANVA trademarks on the website under the Disputed Domain Names. The Panel takes the view that any Internet users seeking to use the Complainant's services at the Complainant's website may end up on the webpage set up by the Respondent. Thus, the Panel finds that, by using the Disputed Domain Names, 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 trademarks. The diversion of Internet traffic from the Complainant's site to the Respondent's site supports a finding of bad faith under paragraph 4(b)(iv) of the Policy.

Further, the Panel is of the view that the Respondent's removal of the website under the Disputed Domain Name <sellcanva.com> after receipt of the Complainant's cease and desist letter is somewhat indicative of bad faith on the part of the Respondent.

On the date of this Decision, the Panel finds that the Disputed Domain Name <sellcanva.com> resolves to a third party's website selling cell phone accessories and the Disputed Domain Name <maucanva.com> resolves to an undeveloped WordPress blog. However, this does not change the Panel's findings of bad faith in this case.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Names were registered and are being used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is 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 Names <sellcanva.com>, and <maucanva.com> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: March 21, 2022