

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Whois Privacy, Private by Design, LLC / Matthew Merchant,
Merchant Law Group
Case No. D2022-2365

1. The Parties

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

The Respondent is Whois Privacy, Private by Design, LLC, United States of America (“United States”) / Matthew Merchant, Merchant Law Group, Canada.

2. The Domain Name and Registrar

The disputed domain name <cnva.com> is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 29, 2022. On June 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 1, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 5, 2022, 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 July 7, 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 1, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on August 10, 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

Complainant is an online graphic design platform founded in Australia in 2012. Complainant owns valid and subsisting registrations for the CANVA trademark in numerous countries, including the trademark for CANVA (Reg. No. 4,316,655) in the United States, with the earliest priority dating back to January 4, 2012.

Respondent registered the disputed domain name on October 29, 2021. At the time this Complaint was filed, the disputed domain name redirects to <lott60.com> which resolves to a placeholder webpage with a "THIS SITE IS BRAND NEW PLEASE CHECK BACK AGAIN SOON" message. The disputed domain name previously resolved to a parking page provided by the Registrar.

5. Parties' Contentions

A. Complainant

Complainant asserts ownership of the CANVA trademark and has adduced evidence of trademark registrations in the United States and other countries around the world, with earliest priority in the United States dating back to January 4, 2012. The disputed domain name is confusingly similar to Complainant's CANVA trademark, according to Complainant, because it replaces the first letter "a" in Complainant's CANVA trademark with the letter "z", which is directly beneath the letter "a" on a standard keyboard.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any registered or unregistered trademark rights by Respondent; the lack of any license or authorization between Complainant and Respondent; Respondent's passive holding of the disputed domain name; and the lack of any evidence that Respondent is known by the distinctive term "canva".

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the eight years by which Complainant's earliest trademark registration predates Respondent's registration of the disputed domain name; the prominence of Complainant on average Internet search engine or public trademark database queries for the term "canva"; Respondent's failure to reply to Complainant's cease and desist correspondence; Respondent's intentional typosquatting on Complainant's CANVA trademark through substitution of the letter "a" for the letter "z"; Respondent's passive holding of the disputed domain name; Respondent's configuration of the disputed domain name with MX records, suggesting Respondent is engaged in an email phishing scheme; and circumstantial evidence of additional domain names owned by Respondent that also forward to <lott60.com> and typosquat on third party trademarks like GOOGLE and AMAZON.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, *e.g.* where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the CANVA trademark has been registered in the United States and other jurisdictions with priority dating back to January 4, 2012. Thus, the Panel finds that Complainant's rights in the CANVA trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's CANVA trademark. In this Complaint, the disputed domain name is confusingly similar to Complainant's CANVA trademark because, disregarding the .com generic Top-Level Domain ("gTLD") and with the exception of a single letter (as discussed below), the trademark is effectively contained in its entirety within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test 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 domain name ... [I]n 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..."). In regard to gTLDs, such as .com in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

Furthermore, it is well established that domain names which consist of common, obvious or intentional misspellings of trademarks are considered to be confusingly similar for the purposes of the first element of the Policy. WIPO Overview, section 1.9 ("Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters ... (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersions of other terms or numbers"). See *e.g. Edmunds.com, Inc. v. Digi Real Estate Foundation*, WIPO Case No. [D2006-1043](#) ("This is clearly a 'typosquatting' case where the disputed domain name is a slight misspelling of a registered trademark to divert internet traffic ... In fact, the domain name comprises the Complainant's trademark ... with a single misspelling of an element of the mark: a double consonant 's' at the end."). See *e.g. General Electric Company v. mr domains (Marcelo Ratafia)* Case No. [D2000-0594](#) ("In the Panel's opinion 'www-' used in this context is a generic term which does nothing to reduce the potential for confusion, and therefore the panel is of the opinion that the Domain

Names are for all intents and purposes identical to the registered trademark.”) In this Complaint, the Panel concurs with Complainant that Respondent has intentionally substituted the letter “z” for the first letter “a” in Complainant’s CANVA trademark, due to the close proximity of those letters on a standard keyboard, in the hopes of garnering typographical traffic from Internet users seeking to reach Complainant’s official “www.canva.com” website.

In view of Complainant’s registration for the CANVA trademark, and Respondent’s clear attempt at typosquatting on the CANVA trademark, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. WIPO Overview, section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name as Matthew Merchant, Merchant Law Group (even assuming for the purposes of the second element of the Policy that name is not false or fictitious as discussed in detail below), is not commonly known by the disputed domain name or Complainant’s CANVA trademark.

Moreover, it is well established that passively holding a domain name in and of itself does not constitute a *bona fide* offering of goods or services. *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#).

In view of the absence of any evidence supporting any rights or legitimate interests in the disputed domain name, Respondent’s attempts to misdirect Internet users with a typographical domain name variation on Complainant’s CANVA trademark, and Respondent’s passive holding of the disputed domain name, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The act of “typosquatting” or registering a domain name that is a common misspelling of a mark in which a party has rights has often been recognized as evidence of bad faith registration *per se*. WIPO Overview, section 3.2.1 (“Particular circumstances UDRP panels take into account in assessing whether the respondent’s registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely known mark ...”). See also *Paragon Gifts, Inc. v. Domain.Contact*, WIPO Case No. [D2004-0107](#) (citing *National Association of Professional Baseball Leagues, d/b/a Minor League Baseball v. Zuccarini*, WIPO Case No. [D2002-1011](#)); *ESPN, Inc. v. XC2*, WIPO Case No. [D2005-0444](#) (finding that the practice of “typosquatting”, of itself, is evidence of the bad faith registration of a domain name). The Panel concurs with this approach. It is evident that Respondent registered and used the typographical disputed domain name to intentionally attract, for commercial gain, Internet users in a manner that confuses and misleads Internet users. Thus, the Panel infers Respondent’s bad faith based on the fact that the Respondent is either attempting to perpetrate an email phishing scheme (as discussed below) or trying to gain profit from mistakes such as typographical errors made by Internet users, when inputting the letter “z” instead of the first letter “a” for Complainant’s <canva.com> domain name and official website URL into a web browser.

Passively holding a domain name does not prevent a finding of bad faith. WIPO Overview, section 3.3. This includes domain names that do not resolve to any website content as well as domain names that are parked with a “coming soon” message or other similar content like “Please Check Back Again Soon”. Where a domain name is being passively held, as alleged in this case, bad faith registration and use exists based upon: (i) the degree of distinctiveness or reputation of the complainant’s mark; (ii) the failure of the respondent to submit any response or offer any credible evidence of rights or legitimate interests; (iii) the respondent’s concealing its identity or use of false contact details; and (iv) the implausibility of any good faith use which the domain name may be put. See *Id. Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (“A remedy can be obtained under the Policy only if those circumstances show that the Respondent’s passive holding amounts to acting in bad faith.”) To that end, the Panel acknowledges the multitude of prior panel determinations under the Policy cited by Complainant concluding that Complainant’s CANVA trademark is “well-established, distinctive, and fanciful.” See e.g. *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#); *Canva Pty Ltd v. Dang Nguyen, Dũng, Dung Nguyen*, WIPO Case No. [D2021-3519](#). Moreover, Respondent has failed to provide any response or offer any evidence whatsoever, and (as discussed below) the registration data provided by Respondent appears as though it may be false or fictitious. Furthermore, Respondent’s intentional typosquatting on Complainant’s CANVA trademark makes any good faith use implausible.

In addition, the Panel further concludes that failure by Respondent to answer Complainant’s cease and desist letter “suggests that Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith.” See *America Online, Inc. v. Antonio R. Diaz*, WIPO Case No. [D2000-1460](#) (internal citations omitted). See also *Spyros Michopoulos S.A. v. John Toliias, ToJo Enterprises*, WIPO Case No. [D2008-1003](#). Indeed, the failure of Respondent to answer this Complaint or take any part in the present proceedings, in the view of the Panel, is another indication of bad faith on the part of Respondent. See *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

Prior WIPO panel determinations agree, the use of false registration data in connection with a disputed domain name further supports a finding of bad faith registration and use. See e.g. *Action Instruments, Inc. v. Technology Associates*, WIPO Case No. [D2003-0024](#) (Providing false contact information violates paragraph 2 of the Policy, which requires a registrant to represent that the statements it “made in [its] Registration Agreement are complete and accurate.” Maintaining that false contact information in the WHOIS records (which can easily be updated at any time) after registration constitutes bad faith use of the domain name because it prevents a putative complainant from identifying the registrant and investigating the legitimacy of the registration.”); *Royal Bank of Scotland Group v. Stealth Commerce*, WIPO Case No. [D2002-0155](#); *Home Director, Inc. v. HomeDirector*, WIPO Case No. [D2000-0111](#). In this case, limited factual research into matters of public record by the Panel has raised concerns that the registration data provided by Respondent is likely to be false or fictitious. Indeed, while an individual named “Matthew Merchant” does appear to exist and does appear to have been employed by a company called “Merchant Law Group” in Canada, the Panel

could not locate any evidence to corroborate whether (as the registration data suggests) this person has ever used an “@hotmail.com” email address or that they were employed at that company when the disputed domain name was registered on October 29, 2021. In other words, the Respondent may be an entirely different person, or may have provided false contact information from a previous employer.

Finally, the Panel considers configuration of an email server on the disputed domain name as additional evidence that the disputed domain name has been registered and used in bad faith. With the exception of a single letter, the disputed domain name contains in its entirety Complainant’s CANVA trademark, and the record is devoid of any evidence to suggest that Respondent has any legitimate interest in sending emails from the disputed domain name. Conversely, Complainant has made a plausible argument that Respondent’s proactive configuration of an email server, creates a risk that Respondent is engaged in a phishing scheme, thereby using an email address associated with Complainant to try to steal valuable sensitive, financial or other confidential information from Complainant’s clients or employees. Prior WIPO panel determinations have recognized the same risk, and considered it as additional evidence of bad faith. See e.g. *Accor SA v. Domain Admin, C/O ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org / Yogesh Bhardwaj*, WIPO Case No. [D2017-1225](#); *Carrefour S.A. v. WhoisGuard, Inc / Gaudet Jose*, Case No. [DCO2018-0041](#) (“The Panel concurs with the Complainant that the connection of the disputed domain name with an email server configuration enhances a likelihood of confusion and presents a risk that the Respondent is engaged in a phishing scheme.”).

In view of Respondent’s typosquatting on Complainant’s CANVA trademark, Respondent’s passive holding of the disputed domain name, Respondent’s failure to respond to Complainant’s cease and desist correspondence or this Complaint, Respondent’s use of ostensibly false or fictitious registration data, and Complainant’s credible argument that Respondent’s website merely phishes for sensitive financial data, the Panel concludes that Complainant has established the third element 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, <cznva.com>, be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: September 2, 2022