

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. Arnon Panyathip, BU Innovation co.,Ltd.
Case No. D2022-3271

1. The Parties

The complainant is Canva Pty Ltd, Australia, represented by SafeNames Ltd., United Kingdom (the “Complainant”).

The respondent is Arnon Panyathip, BU Innovation co.,Ltd., Thailand (the “Respondent”).

2. The Domain Name and Registrar

The disputed domain name <canvaasia.com> (the “Domain Name”) is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com in Japan (the “Registrar”).

3. Procedural History

On September 2, 2022, the Complainant filed its complaint in English (the “Complaint”) with the WIPO Arbitration and Mediation Center (the “Center”). On September 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 5, 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.

On September 5, 2022, the Center transmitted an email communication to the parties in English and Japanese regarding the language of the proceeding. On September 5, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the 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”).

On September 12, 2022, in accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced. In accordance with the Rules, paragraph 5, the due date for Response was October 2, 2022. The Respondent did not submit any response. On September 28, 2022, the Center received an email from the Respondent

confirming that they received the Complaint, and noted that the registration of the Domain Name was made for the Respondent's customer and that the Respondent closed the Domain Name as it is not related to their business in any way. On September 28, 2022, the Center informed the Respondent that they could forward the notification of the Complaint, the Complaint and its corresponding annexes to the Respondent's customer if they considered that it may have an interest in the proceeding. On October 3, 2022, the Center informed the Parties that it would proceed to panel appointment.

On October 11, 2022, the Center appointed Haig Oghigian as the sole panelist in this matter. 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.

The Respondent is Arnon Panyathip, BU Innovation co. Ltd.

Since 2012, the Complainant has held a number of registered trademarks worldwide for the CANVA term. The numerous trademark registrations include the following (the "Trademark"):

Origin	Registration Number	Registration Date	Class(es) covered
Australia	1483138	March 29, 2012	9
United States of America	4316655	April 9, 2013	42
International	1204604	October 1, 2013	9
International	1429641	March 16, 2018	9, 40, 42
Brazil	914660462	April 30, 2019	9
United States of America	6114099	July 28, 2020	9, 42

The Complainant also holds exact-match domain names under both generic Top-Level Domain and country code Top-Level Domain extensions, including the following:

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

Since 2012, the Complainant has utilized the CANVA term as part of its brand logo.

The Domain Name is <canvaasia.com>. The Domain Name was registered on October 21, 2021. The Domain name resolves to a website which advertises the sale of a commercial package in connection with the Complainant's CANVA offerings.

The Registrar confirmed that according to Whois, the Domain Name is registered with Arnon Panyathi, BU Innovation co., Ltd. in Thailand and that the Domain Name expires on October 21, 2022. The Registrar confirmed that a lock of the Domain Name was applied and that such lock status will remain in place through the remaining pendency of the proceeding.

5. Parties' Contentions

A. Complainant

The following information has been taken from the Complaint and the attached Annexes.

The Complainant submits that the dispute is properly within the scope of the Policy and that this Panel has the jurisdiction to decide the dispute because the registration agreement, pursuant to which the Domain Name that is the subject of the Complaint is registered, incorporates the Policy.

The Complainant offers an online platform that provides its customers with thousands of images and templates to choose from when creating graphic designs. The Complainant's CANVA offerings relate to many uses and contexts (e.g., for presentations, social media posts, and a range of print products). As of June 2020, the Complainant has been valued at USD 6 billion and currently has more than 60 million active users per month with customers in 190 countries.

The Complainant offers services from its main website, "www.canva.com". Web traffic statistics indicate it received an average of more than 300 million visits per month between May and July, 2022.

The Complainant offers its services, as a basic package, for free. The Complainant also offers a paid version named "Canva Pro" which, used by millions of individuals across the globe, has many more features and design capabilities.

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 country-specific sites (e.g., "https://www.canva.com/th_th/" for Thailand).

In 2014, the Complainant launched its app for the iPad in 2014. The Complainant's app is now available on mobile phone devices.

The Complainant's business has grown through the acquisitions of Zeetings, Pexels and Pixabay. The Complainant also offers a "design school", which provides tutorials, courses and events. The "design school" helps businesses and graphic designers perfect their work, with courses such as "Print Advertising", "Typography & Layout" and "Creating a logo" offered. The Complainant also maintains blogs and learning resources on design, marketing, branding and photography.

Within the field of graphic design, the CANVA mark has achieved considerable acclaim. It is frequently featured in third-party lists collating the best online graphic design tools available.

The Complainant has established a social media presence, with millions of followers and subscribers using the CANVA Trademark to promote its services under its name:

- 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 Complainant alleges that the Domain Name is being used to resolve to a site that uses the Complainant's CANVA Trademark and logo and purports to offer a commercial package in connection with the Complainant's services.

In January 2022, the Complainant sent the Respondent a cease and desist letter. The Respondent did not respond.

The Complainant submits that the Domain Name is confusingly similar to the Trademark in which it has rights, the Respondent has no rights or legitimate interests in respect of the Domain Name, and both the registration and use of the Domain Name have been done in bad faith. The Complainant asks that the Domain Name be transferred to the Complainant.

B. Respondent

The Respondent did not reply substantively to the Complainant's contentions. The Respondent sent an informal email to the Center confirming that they received the Complaint, and asserting that the registration of the Domain Name was made for the Respondent's customer, and that the Respondent closed the Domain Name as it is not related to their business in any way.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The Registrar confirmed that the language of the Registration Agreement of the Domain Name is Japanese. The Complainant sets forth a number of arguments as to why the proceeding should be held in English, including that the Domain Name itself features Latin characters and resolves to a website containing some English text. The Respondent did not comment on the Complainant's request.

The Respondent sent an email communication to the Center on September 28, 2022 in English, which shows that the Respondent is fluent in English.

In accordance with paragraph 11(a) of the Rules, the Panel determines that the language of the proceeding should be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

Where a complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold of having trademark rights for the purposes of standing.

The Complainant holds a number of registered Trademarks for the CANVA term, which cover multiple jurisdictions. The Complainant relies on the goodwill and recognition that it has attained under the CANVA brand, which has become a distinctive identifier of its offerings.

The Panel is of the view that the Complainant has demonstrated to the Panel's satisfaction that it has the rights to the Trademark as per the registration of the Trademark and also of its commercial use.

The Domain Name incorporates the Complainant's Trademark. The Trademark is only followed by the geographical term "Asia". UDRP Panels have established that where the relevant trademark is recognizable, the addition of other terms within a domain name (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity. This principle has been consistently affirmed in respect of similarly constructed domain names (*Canva Pty Ltd v. Super Privacy Service LTD c/o Dynadot / tian tao*, WIPO Case No. [D2022-1019](#)).

The Panel agrees with the Complainant that the Domain Name is confusingly similar to its CANVA Trademark in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name for the purposes of paragraph 4(a)(ii) of the Policy. The burden of production therefore shifts to the Respondent to show that it has rights or legitimate interests in the Domain Name.

In accordance with paragraph 4(c) of the Policy, the Respondent, in order to demonstrate its rights or legitimate interests can, without limitation, refer to the following circumstances:

- (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.

No evidence was adduced by the Respondent to demonstrate any rights or legitimate interests in the Domain Name. The Respondent, having been duly notified of the Complaint and the present proceeding, has chosen not to reply substantively to the contentions of the Complainant.

It does not appear that the Respondent has registered any trademarks for “canva”, “canvaasia”, or anything similar. It does not appear that the Respondent holds any unregistered rights to any such term either. Moreover, the Complainant has confirmed that the Respondent has not been licensed by the Complainant to use domain names that feature its Trademark.

The Complainant first registered the Trademark in 2012. The Respondent registered the Domain Name in 2021. The Domain Name is resolving to an active website which advertises the sale of a commercial package in connection with the Complainant’s CANVA offerings, but the Respondent has not been authorised to commercially use the Trademark and its conduct contravenes the Complainant’s Terms of Use that state that one must not present a misleading endorsement or affiliation with Canva on a Canva site, including by attempting to register a domain name. The Respondent has not been granted an exception to the Complainant’s Terms of Use.

No evidence was adduced that would demonstrate that the Respondent has used any trademarks similar to the one used in the Domain Name nor that the Respondent has been authorized to register any domain names including the Trademark. It does not appear from the evidence that the Respondent is connected or affiliated with the Complainant. Mere ownership of a domain name does not confer rights or legitimate interests on a respondent (*National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. [D2000-0118](#)).

There is no evidence that would show that the Respondent was acting in accordance of any rights or legitimate interests upon registration of the Domain Name.

There is also no evidence that would show that the Respondent had “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”, as per paragraph 4(c) of the Policy referred above.

The Respondent has clearly used the CANVA-contained Domain Name to attract and misleadingly divert Internet users to its own advertisement and sale of a commercial package that capitalizes on the Complainant’s reputable Trademark. The resolving site’s consistent presentation of the Trademark, logo and other copied visual content all serve to perpetuate the false impression that the Domain Name is controlled, endorsed or otherwise affiliated with the Complainant, when this is not the case.

It is clear that the Domain Name carries a high risk of implied affiliation and cannot constitute fair use. The Domain Name's composition creates initial interest confusion by giving Internet users the misleading impression that the resolving site content will pertain to the Complainant's globally-renowned offerings in Asia, and be controlled/otherwise endorsed by the Complainant. Previous UDRP panels have, in respect of similarly constructed domain names, made a finding with respect to the risk of implied affiliation (*Canva Pty Ltd v. Hiep Vu*, WIPO Case No. [D2022-0186](#)).

Therefore, the Panel concludes that the Respondent has neither rights nor legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that if the following circumstances in particular but without limitation, are present, they shall be evidence of the registration and use of a domain name in bad faith:

(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 web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Under the Policy, bad faith is understood to occur where a respondent has taken unfair advantage of or [has] otherwise abuse[d] a complainant's mark.

The Complainant's earliest Trademark predates the registration of the Domain Name by more than nine years. The Complainant has also accrued substantial goodwill and international recognition in its Trademark. The Complainant has been a complainant in numerous prior UDRP cases and panels have repeatedly affirmed the renown and distinctiveness of the CANVA mark (see, for example, *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#) in which this dispute's panel observed that the Complainant's mark is "well-established, distinctive, and fanciful").

The Respondent's use of the Domain Name to advertise a commercial package in connection with the Trademark reflects its intention to target users of the Complainant's services through its selection and registration of the Domain Name.

The simplest of Internet searches would have unequivocally brought the Complainant's established rights in the Trademark. The Respondent should have been aware of the Complainant's Trademark at the time of registration.

A simple trademark search or a web browser search for the Domain Name would have revealed the Complainant's rights in the Trademark. The Complainant has registered its Trademark since 2012. The Respondent should have been aware of the Complainant's Trademark at the time of registration in 2021. The Panel sees no reason for the Respondent to have registered the Domain Name. This also supports a

finding of bad faith.

The Complainant sent the Respondent a cease and desist letter, which the Respondent did not respond to. A non-response to a cease and desist letter can be considered an element of bad faith (*Sanofi v. Domain Administrator*, See *PrivacyGuardian.org / onlinestore, willam jhonson*, WIPO Case No. [D2019-2846](#)).

The Respondent had the opportunity to explain its registration of the Domain Name but chose not to do so.

The Respondent has sought to capitalize on the Complainant's CANVA offerings by, at the resolving site, repeatedly brandishing the CANVA name, logo and images associated with such. The Respondent uses these visual indicia to engage and direct Internet users to its own commercial offering. UDRP panels have consistently found bad faith within the meaning of paragraph 4(b)(iv) in cases involving similar unauthorized domain name use (*LEGO Juris A/S v. Domain Administrator*, See *PrivacyGuardian.org and Sun Chong*, WIPO Case No. [D2019-2263](#)).

The Domain Name's site does not attempt to disclaim its lack of association with the Complainant. On the contrary, its use of the CANVA Trademark and abovementioned indicia perpetuates the misleading and false impression that the Respondent is affiliated with or otherwise endorsed by the Complainant, when this is not the case. UDRP panels have consistently held that the lack of a disclaimer in circumstances where there is a likelihood of Internet-user confusion constitutes evidence of bad faith under the Policy (*KIKO S.p.A. v. Registration Private, Domains By Proxy, LLC / Blake Spencer*, WIPO Case No. [D2019-1301](#)).

For the reasons above, the Panel finds that both the registration and use of the Domain Name have been done 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 <canvaasia.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: October 25, 2022