

## **ADMINISTRATIVE PANEL DECISION**

Canva Pty Ltd v. Dung Nguyen  
Case No. D2023-1780

### **1. The Parties**

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

The Respondent is Dung Nguyen, United States of America ("United States").

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

The disputed domain name <canva8.com> is registered with Realtime Register B.V. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 20, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 25, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 19, 2023.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on June 9, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant operates an online graphic design platform founded in 2012. The Complainant's offerings relate to many uses and contexts, e.g., for presentations, social media posts, and a range of print products. The Complainant was valued at USD 40 billion in September 2021 and currently has more than 100 million active users per month with customers across 190 countries.

The Complainant is the owner of several trademarks for CANVA ("CANVA trademark"), including:

- Australian Trademark Registration CANVA No. 1483138, registered on March 29, 2012;
- United States Trademark Registration CANVA No. 4316655, registered on April 9, 2013;
- International Trademark Registration CANVA No. 1204604, registered on October 1, 2013 for several jurisdictions, including China, European Union, Mexico and Russian Federation;
- International Trademark Registration CANVA No. 1429641, registered on March 16, 2018 for several jurisdictions, including India, Japan, Türkiye and United Arab Emirates;
- Brazil Trademark Registration CANVA No. 914660462, registered on April 30, 2019;
- United States Trademark Registration CANVA (combined) No. 6114099, registered on July 28, 2020; and
- International Trademark Registration CANVA (combined) No. 1689790, registered on March 21, 2022 for several jurisdictions, including Brazil, United Kingdom, Republic of Korea and New Zealand.

The Complainant is also owner of numerous domain names including the CANVA trademark, *inter alia* the domain names <canva.biz>, <canva.club>, <canva.co.in>, <canva.fi>, <canva.us> and <canva.cn>.

The disputed domain name was registered on September 2, 2022. The Complainant has provided evidence showing that the disputed domain name resolved to a website under which the CANVA trademark appears and which purports to offer lifetime access to the Complainant's "Canva Pro" offering. At the time of the decision, the disputed domain resolves to an inactive website.

#### 5. Parties' Contentions

##### A. Complainant

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the CANVA trademark. The disputed domain name includes the entire CANVA trademark, with only the addition of the number "8" and the generic Top-Level Domain ("gTLD") ".com". The Complainant's CANVA trademark remains distinguishable in the disputed domain name and the addition of the number "8" does not prevent a finding of confusing similarity.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. To the best of the Complainant's knowledge, the Respondent has not registered any trademarks for "canva", "canva8" or anything similar. The Complainant also cannot find evidence that the Respondent holds unregistered rights in any such term. Further, the Respondent is not connected to or affiliated with the Complainant and has not received license or consent to use the CANVA trademark in any way. The Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The disputed domain name has been used to resolve to a website which, while brandishing the CANVA trademark, purported to sell lifetime access to the Complainant's "Canva Pro" offering.

On the third element of the Policy, the Complainant asserts that the Respondent registered and used the disputed domain name in bad faith. The Complainant's earliest CANVA trademark predates the registration of the disputed domain name by more than 10 years. The Complainant has also accrued substantial goodwill and international recognition in its CANVA trademark. The Respondent's bad faith registration and use of the disputed domain name are established by the fact that the disputed domain redirected to a website, which contains the CANVA trademark and purported to sell lifetime access to the Complainant's "Canva Pro" offering. The Respondent's use of the CANVA trademark, both in the disputed domain name and resolving website, created the misleading and false impression that the website was authorised, endorsed or otherwise associated with the Complainant. Thus, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the CANVA trademark.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) 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 (see section 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the 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.

### **A. Identical or Confusingly Similar**

The Complainant, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

The Complainant is registered as the owner of several trademarks containing CANVA. Suitable evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the CANVA trademark.

The disputed domain name contains the CANVA trademark entirely with the addition of the number "8" as well as the gTLD ".com". Section 1.8 of [WIPO Overview 3.0](#) states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements." Further, section 1.11.1 of [WIPO Overview 3.0](#) states: "The applicable TLD in a domain name (*e.g.*, '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test". The gTLD ".com" will therefore be discounted in the Panel's consideration of confusing similarity.

The Panel finds that the relevant trademark CANVA within the disputed domain name is recognizable, so that the number “8” does not prevent a finding of confusing similarity.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The second element the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the second element of the Policy, section 2.1 of [WIPO Overview 3.0](#) states, “where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, 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”. In this case, the Respondent did not reply to the Complainant’s contentions.

According to the Complaint, the Complainant has not authorized the Respondent to use the CANVA trademark, the Respondent is not commonly known by the disputed domain name, and the Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain name was registered. Moreover, the Panel finds that the composition of the disputed domain name, adding the number “8” to the CANVA trademark, coupled with the use of the disputed domain name redirected to a website, under which the CANVA trademark appears prominently, and which purports to offer lifetime access to the Complainant’s “Canva Pro” offering, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant, as to the origin or affiliation of the website at the disputed domain name. The existence of a disclaimer on the website stating that the website operator is “a reseller of Canva Pro Subscription. We are not Canva’s official third-party.” is not sufficient to avoid a likelihood of confusion by unsuspecting Internet users.

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent. The Panel therefore finds that the Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

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

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrate that the Respondent registered and is using the disputed domain name in bad faith. Section 3.1 of [WIPO Overview 3.0](#) states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. Section 3.2.2 of the [WIPO Overview 3.0](#) reads: “Noting the near instantaneous and global reach of the Internet and search engines and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

Considering the reputation and public presence of the Complainant, it is unlikely that the Respondent had no knowledge of the CANVA trademark. The incorporation of the CANVA trademark within the disputed domain

name as well as the fact that the disputed domain redirected to a website, under which the CANVA trademark appears prominently, and which purports to offer lifetime access to the Complainant's "Canva Pro" offering, demonstrates the Respondent's actual awareness of and intent to target the Complainant. In light of the lack of any rights to or legitimate interests in the disputed domain name by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract Internet users to its website or affect the commercial activities of the Complainant by creating a likelihood of confusion with the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <canva8.com> be transferred to the Complainant.

*/Christian Gassauer-Fleissner/*

**Christian Gassauer-Fleissner**

Sole Panelist

Date: June 23, 2023