

ADMINISTRATIVE PANEL DECISION

Canva Pty Ltd v. william jon
Case No. D2023-2727

1. The Parties

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

The Respondent is william jon, India.

2. The Domain Name and Registrar

The disputed domain name <canvapro.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 26, 2023. On June 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 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 July 4, 2023.

The Center verified that the Complaint together with 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 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 16, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on August 18, 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 is an online graphic design platform founded in 2012. The Complainant's platform, which is available in approximately 100 languages, provides thousands of images and templates to create graphic designs. The Complainant has more than 100 million active users per month, with customers across 190 countries. The Complainant offers its services through its main website, at "www.canva.com", and through region-specific sites. The "www.canva.com" website received an average of more than 450 million visits per month between March and May 2023. The Complainant has a strong social media presence, with millions of followers on the most important social networks. The Complainant offers its services, as a basic package, for free. The Complainant also offers a paid version named "Canva Pro", with has more features and design capabilities.

The Complainant is the owner of, *inter alia*, the following trademarks:

TRADEMARK	ORIGIN	REGISTRATION NO.	REGISTRATION DATE	CLASSES
CANVA	Australia	1483138	29/03/2012	9
CANVA	United States of America	4316655	09/04/2013	42
CANVA	International	1204604	01/10/2013	9
CANVA	International	1429641	16/03/2018	9, 40, 42
CANVA	Brazil	914660462	30/04/2019	9
	United States of America	6114099	28/07/2020	9, 42
	International	1689790	21/03/2022	9, 40, 42, 45

The Respondent registered the disputed domain name on January 10, 2023. The disputed domain name initially resolved to a webpage offering for sale "Canva Pro" annual subscriptions at a discounted price. In order to purchase a "Canva Pro" subscription, users had to fill in sensitive information, including their bank details.

On January 25, 2023, the Complainant sent a cease and desist letter to the privacy service registrant of the disputed domain name, pointing out the Complainant's earlier rights and requesting the transfer of the disputed domain name. The Respondent did not reply to the Complainant's letter and at the time of the filing of the Complaint, the disputed domain name resolved to a website offering coupons for retail stores and redirecting users to retail websites when they attempted to redeem such vouchers.

5. Parties' Contentions

A. Complainant

The Complainant maintains that the disputed domain name is confusingly similar to its trademark CANVA as it fully reproduces this trademark, which is clearly recognizable within the disputed domain name, while the addition of the term "pro" cannot prevent a finding of confusing similarity under the first UDRP element.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name, for a number of reasons. First, the Respondent has no registered trademarks for the term "canva". There is also no evidence that the Respondent holds any unregistered right to this term. The Respondent is not a Complainant's licensee, nor has the Complainant ever granted an authorization to the Respondent to make use of the CANVA trademark in any manner, including as part of a domain name. There is no connection or affiliation between the Respondent and the Complainant and the Respondent is not known as CANVA or "canvapro".

The disputed domain name was initially used to impersonate the Complainant and to request Internet users to fill in sensitive information, including their bank details, in order to purchase purported "Canva Pro" subscriptions at a heavily discounted price. At the time of the filing of the Complaint, the disputed domain name resolved to a website offering coupons for retail stores, and redirecting users to retail websites when they attempted to redeem such vouchers. Both these uses do not amount to a *bona fide* offering of goods or services or to a legitimate, noncommercial or fair use, since the Respondent is implying an in-existent affiliation with or endorsement by the Complainant and is illegitimately capitalizing on the Complainant's mark to its own advantage.

Lastly, the Complainant maintains that the disputed domain name was registered and is being used in bad faith. The Complainant accrued substantial goodwill and recognition since its establishment in 2012. Anyone can find the Complainant's trademarks on the relevant public databases through simple Internet searches. A search on Google for the term "canva" lists the Complainant's mark and services as the first result. The previous use of the disputed domain name, attempting to impersonate the Complainant, clearly explains that the Respondent's intention at the time of the registration of the disputed domain name was that of targeting the Complainant's mark. Therefore, the Respondent has registered the disputed domain name in bad faith.

With respect to use in bad faith, the Complainant maintains that the Respondent has intentionally attempted to attract, for commercial gain, Internet users, by creating a likelihood of confusion with the Complainant's CANVA mark. The Complainant's previous use to sell "Canva Pro" subscriptions by implying an affiliation with the Complainant is evidence of use in bad faith. The Respondent's website does not contain a disclaimer clarifying that the Respondent has no relation to, nor affiliation with, the Complainant. The Respondent's current use of the disputed domain name, displaying unrelated content and redirecting users to third-party's retail websites, does not prevent a finding of bad faith use, since the disputed domain name incorporates the Complainant's CANVA mark with the word "pro", which on its face, suggests a connection with the Complainant or its CANVA products or services. The Respondent is therefore using the disputed domain name to intentionally attract Internet users to its website for personal gain.

The Complainant further notes that the lack of reply of the Respondent to the Complainant's cease and desist letter also amounts to bad faith. Likewise, the Respondent's activation of email exchange ("MX") records for the disputed domain name emphasizes the high risk that unsuspected customers of the Complainant could receive emails from the disputed domain name and that the Respondent has likely engaged in or will engage at some point in phishing activities.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel agrees with the Complainant that the disputed domain name is confusingly similar to the Complainant's earlier mark CANVA. The disputed domain name fully includes this trademark followed by the word "pro" and the Top-Level Domain ("TLD") extension ".cam", which can be disregarded. The CANVA trademark is well recognizable within the disputed domain name, and the addition of the term "pro" cannot prevent a finding of confusing similarity. Under section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[w]here 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". Previous panels have recognized that the incorporation of a trademark in its entirety or in its dominant feature is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See also section 1.7 of the [WIPO Overview 3.0](#)".

In light of the above, the Panel is satisfied that the first condition under the Policy is met.

B. Rights or Legitimate Interests

While the overall burden of proof rests with the complainant, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the instant case, the Panel notes that the Complainant has no relation with the Respondent and that the Complainant did not authorize the Respondent to incorporate its CANVA trademark in the disputed domain name. The Respondent is not a licensee of the Complainant and does not appear to be commonly known by the disputed domain name. Already the disputed domain name by itself, which consists of the Complainant's trademark CANVA followed by the word "pro", which corresponds to the name of the advanced version of the Complainant's platform, impersonates or suggests sponsorship or endorsement by the Complainant. Moreover, the Respondent initial use of the disputed domain name to offer alleged "Canva Pro" subscriptions at a heavily discounted price is highly misleading. The Respondent's initial website displayed the Complainant's trademark and some appealing information to lure potential Complainant's customers into revealing their sensitive information, including their full name, telephone number, and postal and email addresses, as well as their credit card information to make their purchases.

After receiving the Complainant's cease and desist letter, the Respondent changed the content of the website related to the disputed domain name, by reproducing various well-known trademarks belonging to third parties, and coupons to obtain discounts on eligible items or other economic advantages from the connected outlet stores. When the Internet user tries to redeem these coupons, he/she lands on the web page of these outlet stores.

Both these uses cannot amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. The Respondent is clearly targeting the Complainant's CANVA trademark for its own profit or for any other kind of illegitimate advantage. Thus, the Respondent cannot obtain any rights or legitimate interests in the disputed domain name as a result of the uses described above.

For all these reasons, the Panel finds that the Respondent has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the burden of production shifts to the Respondent to provide convincing arguments and evidence supporting its rights or legitimate interests. However, the Respondent failed to meet this burden by choosing not to file its response.

The Panel is therefore satisfied that the second requirement under the Policy is met.

C. Registered and Used in Bad Faith

The disputed domain name incorporates the Complainant's trademark CANVA followed by the descriptive word "pro". Canva Pro is exactly the name of the advanced version of the Complainant's platform offering enhanced services to its subscribers. When the Complainant first detected the disputed domain name, a few days after its registration, the disputed domain name resolved to a webpage displaying the CANVA trademark in the same graphic of the Complainant's CANVA figurative trademark. Moreover, through the disputed domain name, the Respondent proposed to the Complainant's potential customers to subscribe to the Complainant's services at a very high rebate. It is therefore clear that at the time of the registration of the disputed domain name, the Respondent was well aware of the CANVA trademark and of the services offered by the Complainant under this mark. The registration of a domain name confusingly similar to a third party's trademark without rights or legitimate interests amounts to registration in bad faith.

As far as use in bad faith is concerned, at the time of the registration of the disputed domain name, and before the receipt of the Complainant's cease and desist letter, the Respondent was using the disputed domain name to falsely impersonate the Complainant, and to lure Internet users into revealing their sensitive information to subscribe to the Complainant's services at heavily discounted prices. Lately, the Respondent changed the use of the disputed domain name. The disputed domain name resolved to a website displaying third parties' renowned trademarks and coupons offering several types of discounts. When Internet users tried to redeem these coupons, they were redirected to the websites of the trademark owners. Both these uses amount to use in bad faith. The Respondent is clearly attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on such website. Moreover, the Respondent was using the disputed domain name for a phishing scam.

In addition, the Respondent failed to reply to the Complainant's cease and desist letter and activated MX records for the disputed domain name, which enables the Respondent to send fraudulent emails under a domain name incorporating the Complainant's trademark. Lastly, the Panel notes that the Respondent has availed itself of a privacy service in order to disclose its identity and prevent the Complainant's protection of its trademark rights, which is further indication of bad faith.

For all these reasons, the Panel is satisfied that the Complainant has duly established the third and last condition under the Policy, namely, that the disputed domain name has been registered 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 disputed domain name, <canvapro.cam>, be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: September 1, 2023