

ADMINISTRATIVE PANEL DECISION

GrabTaxi Holdings Pte. Ltd. v. Grapiviet Media JSC
Case No. D2023-1080

1. The Parties

The Complainant is GrabTaxi Holdings Pte. Ltd., Singapore, represented by Ravindran Associates LLP, Singapore.

The Respondent is Grapiviet Media JSC, Viet Nam, represented by YouMe Vietnam, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <grapviet.com> is registered with Mat Bao Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 10, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 11, 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 Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint.

The Center sent an email communication in English and Spanish to the parties on March 13, 2023, regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain name is English and Vietnamese. The Complainant submitted a request for English to be the language of the proceeding on March 16, 2023. The Respondent submitted a request for Vietnamese to be the language of the proceeding on March 17, 2023.

Also, the Center sent an email communication to the Complainant on March 13, 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 amendment to the Complaint on March 17, 2023.

The Center verified that the Complaint together with the amendment to 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. The Response was filed with the Center on April 20, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 1, 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 headquartered in Singapore but operates at least across Southeast Asia. According to the Complaint, the Complainant (or presumably a predecessor) first began operations in 2012, began operating in Singapore in 2013 and opened in Viet Nam in 2014. When the Complaint was filed, the Complainant says it offers its services under the GRAB trademark across 480 cities across Viet Nam, Cambodia, Indonesia, Malaysia, Myanmar, the Philippines, Singapore, and Thailand.

It describes its principal business as providing ride-hailing services. Its services also extend to ordering and delivery of food, groceries, and parcels and provision of insurance and wealth management services.

These and other services are accessed through the Complainant's "Grab" app which, the Complainant says, is used by millions of customers each day. The Complainant's information indicates it has more than five million registered driver partners, more than two million merchant partners and two million plus "GrabKios" agents.

The Complainant has numerous social media accounts under its "Grab" brand on Instagram, Facebook, Twitter, YouTube, and LinkedIn. Its main Facebook page, for example, has 7,439,295 followers; its official YouTube page has over 285,000 subscribers; its main LinkedIn page, 730,185 followers and its Viet Nam Instagram account, which is one of 8 Instagram accounts, has over 28,000 followers.

The Complaint includes evidence that the Complainant is the owner of numerous registered trademarks for GRAB including:

- (a) Registered Trademark No. 40201608864P-01 from May 31, 2016, in Singapore in respect of services in International Classes 38 and 39 including in class 39 providing information about transportation services and booking services via a website, packing and storage of goods, passenger transport; pick-up and delivery of parcels and providing such services via mobile telecommunications services and devices; and
- (b) Registered Trademark No 4-0318225-000 which was registered in Viet Nam with effect from April 16, 2016, in respect of a range of goods and services in International Classes 9, 38, and 39.

The Complaint includes evidence of numerous other registrations in both countries, and also in other Southeast Asian countries for GRAB and some GRAB-formative marks such as GRABFOOD, GRABGIFTS, GRABINSURE, GRABKITCHEN, and so on.

The Respondent was incorporated in Viet Nam on May 17, 2018.

From the Whols record, the disputed domain name was registered on April 23, 2018.

The disputed domain name resolves to a webpage with links to download mobile phone applications from the Google Play and Apple App stores which appear to offer ride hailing and taxi services in Viet Nam. According to the Response, the Respondent has been providing laundry, communication, car booking, and ticketing services for customers in Viet Nam since 2018.

The Respondent has applied to register its trademark, GRAPVIET, in Viet Nam, application No. 4-2018-23406, which was filed on July 16, 2018, but is still pending. According to the Complainant, the Vietnam Intellectual Property Research Institute ("VIPRI") has found the Respondent's trademark application confusingly similar to the Complainant's own prior registrations in three Assessments: No. NH255-20YC/KLGD, No. NH896-21YC/KLGD, and No. NH897-21YC/KLGD.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint 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.

A. Language of the Proceeding

The Complainant has requested that the language of the proceeding be English. It says it is based in Singapore where English is the official language and, as the Internet operates globally, English is the *lingua franca* of global business. It also says it would be severely prejudiced if it were required to translate the Complaint into Vietnamese.

The Respondent disputes that request.

Paragraph 11 of the Rules provides that the language of the proceeding is the language of the registration agreement unless the parties agree otherwise or there is some other good reason to the contrary. See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.

According to the Registrar, the language of the registration agreement in the present case is both English and Vietnamese.

The Panel is mindful that a respondent must have a fair opportunity to deal with a complaint made against them under the Policy. In registering the disputed domain name, the Respondent has agreed to jurisdiction under the Policy in accordance with its terms and those of the Rules, including of course paragraph 11 of the Rules.

In the present case, the Respondent has registered the disputed domain name with a Registrar under a registration agreement where both English and Vietnamese are the languages of the agreement. The Respondent's website is in Vietnamese and directed to customers in Viet Nam. However, the Respondent has also demonstrated through the Response (in Vietnamese) that it has fully understood the allegations being made against it in the Complaint.

In these circumstances, the Panel will proceed on the basis that both English and Vietnamese are the language of the proceeding.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous registered trademarks for GRAB in Viet Nam, Singapore, and many other countries.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark and the term "Viet" but with a "p" instead of "b". Accordingly, the Complainant relies on the phonetic similarity of "grap" to "grab" to establish confusing similarity.

The Respondent says "Grapviet" is an invented word. It is impermissible to split it up into two words as the Complainant has done and so the commonality of three letters out of eight is insufficient to mislead users.

As the Complainant points out, however, the "viet" element of the disputed domain name is very likely to be taken as a country or geographical descriptor. As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.8.

Furthermore, the phonetic similarity between "grap" and "grab" means that the Complainant's trademark is sufficiently recognisable within the disputed domain name for the purposes of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.9.

Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

C. Rights or Legitimate Interests

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

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The Respondent points out that the disputed domain name is derived from the Respondent's corporate name, which has been legally registered in Viet Nam. However, the Respondent was incorporated under that name several years after the Complainant began using its trademark in Viet Nam and, for that matter, across Southeast Asia. By the time of the Respondent's incorporation and adoption of the disputed domain name, the Complainant had received a number of international accolades such as being ranked in the top 10 of CNBC's Disruptor 50 list of private companies whose innovations are changing the world.

Further, the Respondent's business appears to compete directly with the Complainant's.

Given how well established the Complainant and its trademark were by the time the Respondent was incorporated and the disputed domain name was registered, therefore, the inference is clearly open that both the corporate name and the disputed domain name were adopted with knowledge of the Complainant's trademark and to trade on its reputation.

In these circumstances, the *onus* falls on the Respondent (or those behind it) to explain how it has been incorporated under a name which so closely resemble the Complainant's trademark and registered the disputed domain name for use in a field which so directly competes with the Complainant's services. No such explanation has been offered other than that the disputed domain name is an invented term consisting of eight letters and so is sufficiently different from the Complainant's trademark. For reasons explained in section 5C above, however, the Panel has found the disputed domain name is nonetheless confusingly similar to the Complainant's trademark.

The Respondent further says that Viet Nam recognizes registration of domain names on the basis of first to register and claims that registration of domain names is not subject to trademark law. Those arguments cannot be accepted, however, as the disputed domain name is registered subject to the Policy.

The Respondent also relies on its pending trademark application. Having regard to the Assessment Conclusions reached by VIPRI, however, that pending application is not sufficient to afford rights or legitimate interests in the disputed domain name in the circumstances of the present case.

The use of the disputed domain name in conflict with the Complainant's prior trademark rights, therefore, does not qualify as a good faith use for the purposes of paragraph 4(c)(i) of the Rules as it is likely to cause confusion with the Complainant's trademark and otherwise targets that trademark.

Accordingly, the Panel finds the Complainant established the second requirement under the Policy also.

D. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g. Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd.*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

For the reasons explained in section 5C above, it appears very likely that the Respondent (or those behind its incorporation) were well aware of the Complainant and its trademark when the Respondent was incorporated and the disputed domain name was registered.

Further, it seems very likely that the Respondent registered the disputed domain name to take advantage of its resemblance to the Complainant's trademark and so cause confusion with users and potential users of the parties' services. Accordingly, the Panel finds the Respondent registered the disputed domain name in bad faith.

Further still, as explained in section 5C above, the manner of use of the disputed domain name targets the Complainant's trademark and constitutes use in bad faith.

Accordingly, the established all three requirements under the Policy.

6. 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, <grapviet.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 15, 2023