

ADMINISTRATIVE PANEL DECISION

GrabTaxi Holdings Pte. Ltd. v. Nguyen Thai Phuc
Case No. D2023-1439

1. The Parties

The Complainant is GrabTaxi Holdings Pte. Ltd., Singapore, represented by BMVN International LLC, Viet Nam.

The Respondent is Nguyen Thai Phuc, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <dichvugrabbinhduong.com> is registered with P.A. Viet Nam Company Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 4, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 2023, 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.

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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 4, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on May 16, 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 was incorporated in 2013. It is the intellectual property holding entity of the technology group Grab Holdings Limited that offers software platforms and mobile applications. The group operates in more than 480 cities in Singapore, Malaysia, Viet Nam, Indonesia, Thailand, the Philippines, Myanmar, and Cambodia. One of its offerings is the mobile application “Grab”, first launched in 2012, which connects consumers with drivers and merchants, and offers transportation (ride bookings, ride-hailing, ridesharing), logistics, food delivery, courier services, online shopping, home cleaning and repair services, financial services such as e-payments and enterprise services. The Grab application was launched in Viet Nam in 2014.

The Complainant is the owner of the following trademark registrations for the sign “GRAB” (the “GRAB trademark”):

- the International trademark GRAB with registration No. 1483224, registered on April 4, 2019 for goods and services in International Classes 16, 18, 20, 25, 41 and 43; and
- the International trademark GRAB with registration No. 1512478, registered on November 12, 2019 for goods and services in International Classes 16, 18, 20, 25, 41, 43 and 45;

The Complainant is also the owner of the domain name <grab.com>, registered on November 2, 1996, which resolves to its official website.

The disputed domain name was registered on November 22, 2021. At the time of filing of the Complaint, it resolved to a Vietnamese language website featuring the Complainant’s GRAB trademark and logo and offering transportation and related services.

5. Parties’ Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its well-known GRAB trademark, which it incorporates as its dominant element with the addition of the elements “dichvu”, which is a Vietnamese word for “service”, and “binh duong”, which is the name of the Binh Duong province in Viet Nam. According to the Complainant, the addition of these elements to the GRAB trademark does not suffice to prevent the confusing similarity between the disputed domain name and this trademark, and given that the Complainant also provides its services in the Binh Duong province, the confusing similarity between the disputed domain name and the GRAB trademark is increased and may suggest that the disputed domain name resolves to the official website of a subsidiary of the Complainant in that specific location.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name, which was registered after the registration of the Complainant’s GRAB trademark. The Complainant notes that the GRAB trademark is not a term commonly used in the English language for the Complainant’s services, and that after over 10 years of extensive use, it has acquired significant recognition in many countries worldwide and especially in Viet Nam. The Complainant submits that the Parties have no connection and that the Respondent has not been authorized by the Complainant to use the GRAB trademark in any manner and has not acquired any relevant trademark rights. The Complainant states that the Respondent is not commonly known by the disputed domain name and that it is impossible to conceive of any circumstances in which the Respondent would use the disputed domain name, except in a deliberate attempt to take advantage of the GRAB trademark for commercial gain.

The Complainant points out that the website at the disputed domain name does not disclose the lack of relationship between the Parties and the lack of an authorization for the Respondent to use the GRAB trademark, but prominently features this trademark in connection with transportation services.

The Complainant concludes that such deliberate use with the intention to create an undue association between the Complainant and the Respondent shows that the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services, but attempts to use the GRAB trademark and the disputed domain name to attract consumers to its website for commercial gain by appropriating the fame and reputation of the Complainant and its GRAB trademark.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It submits that although the word “grab” has a dictionary meaning in English, it has been legally registered and used by the Complainant and its licensees for goods or services that are not related to this dictionary meaning. According to the Complainant, as a result of this use the GRAB trademark is associated by the public with the Complainant’s mobile application and platform that connect consumers with drivers and merchants for services such as transportation, logistics, and food delivery. The disputed domain name wholly incorporates the GRAB trademark and was registered by the Respondent after this trademark became widely known to consumers and the relevant trade, so according to the Complainant, the Respondent must have had prior knowledge of the trademark when registering the disputed domain name.

The Complainant points out that the Respondent offers the exact same transportation services as those that the Complainant has been providing to customers worldwide, while the Respondent is not authorized by the Complainant to offer such services in the Vietnamese market or to use the Complainant’s trademarks in any manner. The Complainant contends that the Respondent is using the disputed domain name in bad faith for commercial gain and to profit from the resulting consumer confusion that the disputed domain name and the transportation services offered on it are connected with or endorsed by the Complainant.

B. Respondent

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

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

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

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”.

A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of the GRAB trademark and has thus established its rights in this trademark for the purposes of the Policy.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel

Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD of the disputed domain name.

As pointed out by the Complainant, the disputed domain name incorporates the GRAB trademark in combination with the elements “dichvu”, which is a Vietnamese word for “service”, and “binh duong”, which is the name of the Binh Duong province in Viet Nam. The GRAB trademark is recognizable within the disputed domain name. As discussed in section 1.8 of the [WIPO Overview 3.0](#), 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.

As further noted in section 1.15 of the [WIPO Overview 3.0](#), the content of the website associated with the domain name is usually disregarded by UDRP panels when assessing confusing similarity under the first element. In some instances, UDRP panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears *prima facie* that the respondent seeks to target a trademark through the disputed domain name. The Panel accepts this being the case here, as the website at the disputed domain name features the GRAB trademark and offers transportation services that coincide with the services offered by the Complainant under this trademark, and the Respondent does not provide any plausible explanation about its use of the disputed domain name. As further discussed below in this decision, the Panel’s conclusion is that the Respondent seeks to target the Complainant through the disputed domain name and the associated website.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the GRAB trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control 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 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. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it is not commonly known by the disputed domain name, is not related to the Complainant and has not been authorized to use the GRAB trademark. The Complainant notes that the Respondent is using the disputed domain name for a website that features the GRAB trademark and offers transportation services identical to the services offered by the Complainant.

The Respondent does not deny the Complainant’s contentions and does not allege having rights or legitimate interests in the disputed domain name. It does not provide any explanation about the registration and use of the disputed domain name.

As discussed in sections 2.5 and 2.5.1 of the [WIPO Overview 3.0](#), fundamentally, a respondent’s use of a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Certain geographic terms (e.g., <trademark-usa.com>, or <trademark.nyc>) are seen as tending to suggest sponsorship or endorsement by the trademark owner.

Here, the disputed domain name reproduces the GRAB trademark in combination with the Vietnamese word for “service” and the name of a province in Viet Nam. This combination may appear as denoting an official online location offering the Complainant’s services in this Vietnamese province, especially to Vietnamese Internet users. The disputed domain name thus effectively impersonates or suggests sponsorship or endorsement by the Complainant. The website at the disputed domain name does not include a disclaimer that the Respondent is not affiliated to the Complainant and has not been authorized by it to offer services protected under the GRAB trademark in Viet Nam. All this supports a conclusion that the Respondent was well aware of the goodwill of the Complainant’s GRAB trademark when it registered the disputed domain name, and that its registration and use target this trademark, in an attempt to benefit financially from the likelihood of confusion with the GRAB trademark by attracting Internet users looking for the services offered by the Complainant and offering them the same services in competition with the Complainant. The Panel does not regard such conduct as giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

On this basis, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(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 website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The disputed domain name is confusingly similar to the GRAB trademark in combination with the Vietnamese word for “service” and the name of a province in Viet Nam. This combination carries a risk of implied affiliation with the Complainant, especially to Vietnamese Internet users. The disputed domain name resolves to a website that features the GRAB trademark and offers the same transportation service as those offered by the Complainant. This is not denied by the Respondent, who does not provide any plausible explanation for the registration and use of the disputed domain name.

This combination of factors leads the Panel to the conclusion that the Respondent is well aware of the Complainant and its GRAB trademark, and attempts to impersonate it and mislead Internet users to believe that the disputed domain name and the transportation services offered on the associated website are affiliated to or endorsed by the Complainant, and thus take advantage of its reputation for financial gain. This supports a finding of bad faith under paragraph 4(b)(iv) of the Policy.

For these reasons, the Panel finds that the disputed domain name was registered and 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 <dichvugrabbinhduong.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: May 22, 2023