

ADMINISTRATIVE PANEL DECISION

Grabtaxi holdings pte. Ltd v. Cuong Vu
Case No. D2023-1930

1. The Parties

The Complainant is Grabtaxi holdings pte. Ltd, Singapore, represented by BMVN International LLC, Viet Nam.

The Respondent is Cuong Vu, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <taxigrabdongnai.com> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 28, 2023. On April 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 28, 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 / See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 2, 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 May 4, 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 May 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 5, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on June 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 is a company incorporated in Singapore in 2013, and is the intellectual property holding entity of a corporate group that offers software platforms and mobile applications for ride-hailing and ride sharing, among others, together with a mobile application named “Grab” (the “app”). The group operates in more than 480 cities across Singapore, Malaysia, Viet Nam, Indonesia, Thailand, the Philippines, Myanmar, and Cambodia. The Complainant’s app connects millions of consumers with drivers and merchants and launched in June 2012, expanding to Viet Nam in the first half of 2014. On March 26, 2018, the Complainant announced the acquisition of Uber’s operations in Southeast Asia, including Viet Nam. Uber’s ridesharing and food delivery business in the region has been integrated into the Complainant’s platform. On August 8, 2022, the Complainant announced that it had hit a milestone of 10 billion rides and deliveries.

The Complainant has received multiple international, national and regional awards in respect of its business, including being ranked the Top Transportation Company and Second Overall on Fast Company’s Most Innovative Companies List for 2019. In Viet Nam specifically, the Complainant won PC World Viet Nam’s Best ICT Products Award 2017 - Mobile App category.

The Complainant is the owner of the GRAB trademark in a wide variety of countries. In Viet Nam, where the Respondent is based, the Complainant owns (among others) International Registered Trademark Number 1213411 for the mark GRABTAXI, designated in respect of several territories including Viet Nam, registered on May 20, 2014 in Class 39, and Viet Nam Registered Trademark Number 40318225000 for the mark GRAB, registered on April 16, 2019 in Classes 9, 38 and 39.

The disputed domain name was registered on July 8, 2022. Little is known of the Respondent other than that it has provided an address in Biên Hòa, Đồng Nai, Viet Nam to the Registrar. The website associated with the disputed domain name is used to offer transportation services including a shuttle service and taxis. These are the same type of services offered by the Complainant. The content on the said website indicates that the word element “dongnai” in the disputed domain name represents the geographic location Đồng Nai in Viet Nam.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The disputed domain name consists of four elements, “taxi”, “grab”, “dongnai”, and “.com”. It incorporates the entirety of the Complainant’s distinctive arbitrary GRAB trademark as its dominant element. The “taxi” element should be deemed descriptive of transportation booking services and does not distinguish the disputed domain name from the Complainant’s mark. The “dongnai” element is a geographical location in Viet Nam, Đồng Nai Province, and such geographical term does not suffice to prevent the confusing similarity. The applicable Top Level Domain (“TLD”) in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Rights and legitimate interests

The consensus is that the burden of proof is shifted on to the Respondent to come forward with evidence of

a right to or a legitimate interest in the disputed domain name, once the Complainant has made a *prima facie* case showing that the Respondent lacks rights or legitimate interests.

The disputed domain name was registered long after the Complainant's trademarks, which have acquired significant recognition after over ten years of extensive use, especially in Viet Nam. The GRAB mark is not a term commonly used in the English language for the Complainant's services. The Complainant and the Respondent have no prior official connection, and the Respondent has not been authorized by the Complainant to use its mark within the context of the disputed domain name. The Respondent is not contracted by or otherwise affiliated with the Complainant, and the Complainant has never licensed or authorized the Respondent to use the GRAB trademarks in any manner. There is no evidence that the Respondent has become commonly known by reference to the disputed domain name, and 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 Complainant's trademark for commercial gain. There is no record showing that the Respondent has established a right or legitimate interest in any domain name, trademark or trade name similar to the Complainant's GRAB mark. Given the strong reputation of the Complainant's GRAB trademark, it is plain that the Respondent did not register the disputed domain name for any legitimate purpose but rather to use this to appropriate the Complainant's fame and reputation for its own profit.

Registered and used in bad faith

The Respondent's choice of domain name was not a coincidence, but rather an act of bad faith. Although the Complainant's mark has a common meaning in English, it has been registered lawfully and used for unrelated goods or services by the Complainant. It has been perceived by the public as distinctive and associated with the Complainant's app. The disputed domain name wholly and purposefully incorporates the Complainant's mark and was registered long after said mark became widely known to consumers. Given the high level of fame enjoyed by said mark, the Respondent must have had prior knowledge of it before it registered the disputed domain name. Such awareness is evidence of bad faith registration.

The Respondent has used the disputed domain name in bad faith for commercial gain to profit from the resulting consumer confusion. The Respondent has been offering the exact same services, including ride bookings and taxi services, as those the Complainant has provided to customers worldwide, yet the Respondent has no authorization from the Complainant to do so. The use of the word "grab" in the disputed domain name is an attempt to attract Internet users to the Respondent's website for commercial gain. After seeing "grab" as a dominant element of the disputed domain name, a consumer will be confused as to the disputed domain name's association with or sponsorship by the Complainant. This is sufficient to demonstrate bad faith.

The Respondent's use of a privacy protection service further evidences bad faith intent as it precludes the Complainant from providing definitive evidence showing the Respondent's pattern of registering domain names that include well-known trademarks. This constitutes evidence of bad faith in and of itself, and because it has been paired with knowledge of the Complainant's strong rights and use of the disputed domain name for commercial gain.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (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 first element assessment under the Policy is usually determined by way of a two-stage process. First, the Complainant must demonstrate that it possesses UDRP-relevant rights in a trademark, whether registered or unregistered. Secondly, the disputed domain name is compared to such trademark, typically on a straightforward side-by-side basis, usually disregarding the Top-Level Domain, in order to assess identity or confusing similarity. If, on the basis of such comparison, the disputed domain name is alphanumerically identical to the Complainant's trademark, identity will generally be found, while if the Complainant's mark is otherwise recognizable in the disputed domain name, confusing similarity will usually be found.

In the present case, the Panel finds that the Complainant possesses UDRP-relevant rights in its GRAB and GRABTAXI registered trademarks as described in the factual background section above. Turning to the comparison exercise, the Panel notes that the disputed domain name incorporates the Complainant's GRAB and GRABTAXI trademarks in their entirety. The disputed domain name merely reverses the Complainant's GRABTAXI mark to make the term "taxigrab" and inserts at the end of this the geographic term "dongnai", which the Complainant notes refers to the geographic location Đồng Nai in Viet Nam. These additional words (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In all of these circumstances, the Panel finds that the disputed domain name is confusingly similar to both of the Complainant's said trademarks and accordingly that the Complainant has carried its burden with regard to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (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."

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has established the requisite *prima facie* case based on its submissions outlined above, together with the

evidence that it has produced indicating that the disputed domain name makes use of the Complainant's GRAB and GRABTAXI trademarks to offer competing services with those of the Complainant in a manner which is likely to be confusing to consumers as to the source of the Respondent's services.

In these circumstances, the burden of production shifts to the Respondent to come forward with evidence of any rights or legitimate interests which it might have in the disputed domain name. The Respondent, however, has not engaged with the administrative proceeding or taken the opportunity to refute the Complainant's allegations and evidence. There are no submissions or evidence on the present record which appear to support any claim that the Respondent might have made on this particular topic. The Panel has not identified and cannot conceive of any potential rights or legitimate interests that the Respondent might have put forward if it had participated in the proceeding. The disputed domain name and corresponding website appear to be designed to take unfair commercial advantage of the Complainant's rights in its GRAB and GRABTAXI trademarks. The Respondent is offering taxi services on the associated website that compete with the Complainant's services and its use of the Complainant's GRAB mark and/or a reversed variant of the Complainant's GRABTAXI mark suggests sponsorship or endorsement by the Complainant when no such sponsorship or endorsement exists. Accordingly, the Respondent's use of the disputed domain name and the associated website does not confer any rights or legitimate interests upon the Respondent in the circumstances of this case, whether in terms of paragraph 4(c)(i) of the Policy or in any other respect.

In all of these circumstances, the Panel determines that the Respondent has failed to rebut the Complainant's *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name, and accordingly the Panel finds that the Complainant has carried its burden in terms of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, 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 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.”

In the present case, the Panel is satisfied that the Complainant has evidenced substantial notoriety in respect of its GRAB and GRABTAXI trademarks. Such notoriety extends to the jurisdiction where the Respondent is based. The marks are of a longstanding nature. Specifically, the Complainant's GRABTAXI mark has been established for almost a decade. The Complainant's marks were registered well before the disputed domain name was registered. The Complainant has evidenced the fact that it has won awards internationally, including in the country where the Respondent is based. Due to its substantial activities there, it is reasonable for the Panel to infer that the Complainant's marks are prominent in the Respondent's locality.

In the above circumstances, it is inconceivable that the Respondent registered the disputed domain name without knowledge of the Complainant or its rights. The Respondent has incorporated the Complainant's trademark in the disputed domain name in the manner described above and has used it in connection with a website offering competing services to those of the Complainant. Such use implies sponsorship or endorsement by, or affiliation with, the Complainant where none exists. The Panel finds on the balance of probabilities that the disputed domain name was registered with intent to target the Complainant's rights and indeed has been used to take unfair commercial advantage of these. These circumstances are indicative of registration and use in bad faith. The Respondent has not participated in the administrative proceeding and therefore has not provided any submissions or evidence to counter those of the Complainant. The Panel has been unable to identify anything from the present record that would suggest that the disputed domain name might not have been registered in bad faith.

In light of the circumstances disclosed on the present record, the Panel concludes that the Respondent has intentionally attempted 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 in terms of paragraph 4(b)(iv) of the Policy.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has carried its burden in terms 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 <taxigrabdongnai.com> be transferred to the Complainant.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: June 30, 2023