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'grabprinting.com' decision: UDRP panels will want snapshot of circumstances at time when domain name was registered

International - [Hogan Lovells](#)

- **Grabtaxi, the owner of numerous trademarks containing the term 'grab', sought the transfer of 'grabprinting.com' under the UDRP**
- **The panel found that the respondent appeared to have been operating a legitimate business for around three years**
- **The respondent had also provided a credible explanation for its adoption of the domain name in good faith**

In [Grabtaxi Holdings Pte Ltd v Lim](#) (WIPO Case D2019-1585), a single-member panel has denied the transfer of a domain name under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) because the complainant had failed to prove the respondent's lack of rights or legitimate interests. The panel found that the respondent appeared to have been operating a legitimate business for around three years and had provided a credible explanation for his choice of the domain name.

Background

The complainant was Grabtaxi Holdings Pte Ltd, a technology company based in Singapore offering a software platform and mobile application for ride hailing, ride sharing, food delivery, logistics services and digital payment. The respondent was Sam Lim, the sole proprietor of an online printing company in Singapore. The domain name 'grabprinting.com' was registered in August 2015.

UDRP requirements

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

- the disputed domain name is identical, or confusingly similar, to a name, trademark or service mark in which the complainant has rights;
- the respondent has no rights or legitimate interests in respect of the domain name; and
- the domain name has been registered and subsequently used in bad faith.

Decision

Identity/similarity

As far as the first limb was concerned, the complainant claimed that the domain name was identical to its trademarks both pre-dating and post-dating the registration date of the domain name. Such trademarks were considered by the complainant as a family of trademarks that used the term 'grab', either alone or as a prefix. The complainant considered that the other terms added were intended to be descriptive. According

to the complainant, the domain name reproduced the same pattern as it used the term 'grab' followed by the suffix 'printing'.

The panel found that the domain name was confusingly similar to the trademarks in which the complainant had rights.

Rights/legitimate interests

With regard to the second limb, the complainant argued that the respondent was not commonly known by the domain name, and that his business registration had expired in April 2019. The complainant stated that the use of the domain name by the respondent could not constitute legitimate or fair use of the domain name, as the incorporation of the term 'grab' was unrelated to the service provided by the respondent and the domain name was purposely used to mislead consumers into believing that there was a connection between the parties by diverting them to the respondent's website.

As a preliminary matter, the panel noted that there were a number of objective factors which it had taken into account to assist in its finding that this case did not have the "general indicia" of typical cybersquatting cases. In relation to whether the respondent was using the domain name in connection with a *bona fide* offering of goods or services, the panel carefully studied the evidence submitted by the complainant and noted that the latter had not addressed the fact that, when the domain name was registered in 2015, it did not yet own registered rights for GRAB on its own and it would appear that it had not yet extended its services outside of taxi and transportation. In other words, the date that the domain name was registered was prior to the establishment of the complainant's so-called "brand architecture". The panel noted that the respondent had clearly been operating a genuine established printing business for at least three years with a very different logo to the complainant's trademarks.

The panel also found that the respondent's explanation that he chose the name Grabprinting because it suggested that the customer could quickly order printing at any time was credible. The fact that the respondent might have been aware of the existence of the complainant's taxi services at the time that the domain name was registered did not mean that his services were not *bona fide*, especially since the term 'grab' was in common usage, as pointed out by the respondent. Furthermore, the complainant's trademarks did not cover printing services. The panel was therefore satisfied that the respondent was using the domain name in relation to a *bona fide* offering of goods or services.

In relation to whether the respondent was commonly known by the domain name, the panel found that:

- the respondent's services were easily found on Google;
- the respondent had registered the term 'Grabprinting' as his business name in June 2016; and
- even though the business registration expired in April 2019, he continued to trade under this name.

The panel was therefore satisfied that the respondent was commonly known by the domain name.

After considering all the evidence submitted by both parties, the panel found that the complainant had failed to meet its burden on the second element regarding the respondent's lack of rights and legitimate interests.

Bad faith

The panel also concluded that the domain name was not registered or used in bad faith. The respondent had provided a credible explanation for its adoption of the domain name in good faith. Concerning bad faith use, the panel noted that the complainant had not provided any evidence to show that there had been any confusion between the parties.

As a result, the transfer was denied.

Comment

This decision is a reminder that panels will pay close attention to the situation at the time that domain names are registered. In this case, the complainant had yet to develop its family of marks when the respondent registered the domain name and thus it was a reasonable choice at the time, all things considered. It is quite common for complainants to supply an abundance of evidence about their rights and reputation at the time that the complaint is filed, but it is worth noting that this is not necessarily pertinent as the panel will want to obtain a snapshot of the surrounding circumstances at the time when a disputed domain name was registered.

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