

ADMINISTRATIVE PANEL DECISION

RooFoods Ltd v. Dispenseroo UK, and Alfie Davies, Capital Office
Case No. D2022-4479

1. The Parties

The Complainant is RooFoods Ltd, United Kingdom, represented by CMS Cameron McKenna Nabarro Olswang LLP, United Kingdom.

The Respondents are Dispenseroo UK, United Kingdom, and Alfie Davies, Capital Office, United Kingdom.

2. The Domain Names and Registrars

The disputed domain name <dispenseroo.com> (the “first disputed domain name”) is registered with eNom, LLC (the “First Registrar”).

The disputed domain name <dispenseroo.shop> (the “second disputed domain name”) is registered with Porkbun LLC (the “Second Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 23, 2022. On November 24, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On November 28 and 29, 2022, the Registrars transmitted by emails to the Center their verification responses, disclosing registrant and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to the Complainant on November 30, 2022, providing the registrant and contact information disclosed by the Registrars and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 5, 2022.

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 Respondents of the Complaint, and the proceedings commenced on December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Center received informal email

communications from the Respondents on December 4, and December 12, 2022. The Center informed the Parties of its commencement of Panel appointment on January 5, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on January 11, 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 formed in England and Wales in 2012 and, since 2013, has provided an on-demand food delivery service under the brand DELIVEROO. The Complainant partners with over 160,000 restaurants and over 100,000 delivery drivers worldwide and, in 2021, its global sales were in excess of GBP 1.8 million.

The Complainant owns many DELIVEROO trade marks including, by way of example, European Union Trade Mark number 01570763, in class 9, registered on January 10, 2017. The Complainant also owns and operates the domain name <deliveroo.co.uk>, which resolves to its principal website. The Complainant's DELIVEROO brand is typically presented in a lower case font in a specific shade of green.

The first disputed domain name was registered on May 26, 2022, and the second disputed domain name was registered on July 23, 2022. The second disputed domain name formerly resolved to a website at the first disputed domain name, which offered for sale a variety of cannabis-based products. The website was branded as "dispenseroo" in a very similar lower case font to that used by the Complainant for its mark, as displayed on the home page of its website, and using a similar shade of green. In what was evidently a reference to the Complainant, in the "Frequently Asked Questions" section of the Respondent's website, under the heading "Are we a scam?", the Respondent asserted that "We want to make Dispenseroo as revolutionary as the food delivery service we take inspiration from".

Both disputed domain names now resolve to a website at the domain name <dispenseree.com> (the "Respondent's website") which appears to have substantially the same content to the website at the first disputed domain name, save that the trading name has been changed from DISPENSEROO to DISPENSEREE. Additionally, two further domain names, namely <dispenseroo.co.uk> and <dispenseroo.uk>, resolve to the website at <dispenseree.com>. The current version of the Respondent's website explains that; "We also base our technical operations in jurisdictions where the sale of Marijuana is legal in both a recreational and medical perspective; allowing us to host our operations without interference from law enforcement in the UK" and that "Our deep-web website will be operating shortly for the customers who want an added layer of anonymity".¹

5. Procedural issue – Complaint filed against multiple Respondents

The Complainant says that the Respondents are the same entity and/or that both disputed domain names are under common control and that it is appropriate for its complaint in respect of each of them to be dealt with within the same proceedings under the Policy.

The Complainant's request for consolidation does not require detailed consideration by the Panel because, in an email to the Center dated December 4, 2022, elements of which are considered further below, the Respondent has asserted that both disputed domain names are owned by Dispenseroo Limited, a company incorporated in the United Kingdom. Accordingly, in these circumstances, it is procedurally efficient, as well

¹ As explained at section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), UDRP panels may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. The Panel has accordingly visited the websites to which each of the disputed domain names resolve to establish the use which is presently being made of them.

as fair and equitable to all Parties, for the Complainant's case in respect of both disputed domain names to be dealt with in a single Complaint; see *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#). The Panel therefore grants the Complainant's request for consolidation and the named Respondents are accordingly referred to below collectively as "the Respondent".²

6. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain names are identical or confusingly similar to a trade mark or service mark in which it has rights. The Complainant refers to its trade mark registrations for DELIVEROO, full details of one of these marks having been set out above, and says that the disputed domain names are of a similar length to its mark, each of them begins with the same letter and ends with the same four letters, including a distinctive "roo" suffix, and the first component of each comprises a word meaning "to provide". Moreover, it is evident from the content of the Respondent's website that the similarities between the disputed domain names and the Complainant's mark are intentional.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is in no way related to the Complainant or authorized by it to use its registered marks. The Respondent's website advertises the sale of a variety of cannabis products and is targeted specifically at United Kingdom consumers. Under the relevant United Kingdom legislation, namely the Misuse of Drugs Act 1971 and the Misuse of Drugs Regulations 2001, cannabis is considered a "controlled drug" and it is unlawful for a person to supply or offer to supply it to another person in the United Kingdom. Given the illegal nature of the Respondent's activities, it is clear that the disputed domain names are not being used in connection with a *bona fide* offering of goods and services, nor is the Respondent making a legitimate noncommercial or fair use of them. The use of a domain name for illegal activity can never confer rights or a legitimate interest on a respondent.

Lastly, the Complainant says that the disputed domain names were registered and are being used in bad faith. As at the date of registration of the disputed domain names, it is inconceivable that the Respondent was not aware of the Complainant and its rights in DELIVEROO. The disputed domain names have clearly been registered and are being used intentionally to attempt to attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The Respondent's logo deliberately uses a very similar font and colour to that of the Complainant and expressly acknowledges that it takes inspiration from the Complainant. The Respondent is using similar branding to that of the Complainant in order to add an element of credibility and legitimacy to its website, potentially with a view to distracting from the fundamentally illegal nature of its activities. Indeed, a third party website has commented that "[Dispenseroo] plays on the branding of food delivery giant Deliveroo". The Respondent is deliberately hoping that the disputed domain names will confuse Internet users into visiting its website in the hope and expectation that its website is authorized by, or connected with, the Complainant.

B. Respondent

The Respondent in its email to the Center dated December 4, 2022, which the Panel treats as its response to the Complaint, accepts it was aware of the Complainant and says that its trading style is a humorous reference to the Complainant's brand. The Complainant cannot have rights in the "roo" component of its mark as this is derived from the common word "kangaroo". The other components of the mark and the disputed domain names, namely "deliver" and "dispense" are different and used in different contexts. The parties also operate in different industries, the Respondent being part of a peaceful movement against

² Alfie Davies, Capital Office and Dispenseroo UK are, however, still at shown as a Respondent in the title to these proceedings in line with the information provided by the Registrar.

archaic laws in certain countries. Moreover, the font of the Respondent's mark is open-sourced and not owned by the Complainant.

The Respondent's logo changes periodically and any colour resemblances should be looked at a civil level in relation to the Respondent's guerilla marketing activities. The Respondent has now also acquired value in the term "dispenseroo".

The Complainant is engaging in reversed domain name hijacking in asserting expansive trade mark rights against the Respondent's peaceful holding of the disputed domain names. Furthermore, the Respondent's name is Dispenseroo Limited although the Respondent's stated address in the United Kingdom is a virtual address.

7. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain names are identical or confusingly similar to a trade mark 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided details of its registered trade marks for DELIVEROO, including the mark in respect of which full details are set out above, which thereby establish its rights in this term.

When considering whether the disputed domain names are identical or confusingly similar to the Complainant's DELIVEROO mark, the generic Top-Level Domains ".com" and ".shop" are disregarded as they are technical requirements of registration.

The Respondent has asserted that the Complainant's mark should be broken down into the components "deliver" and "roo" and that the "roo" element should be disregarded for the purpose of the comparison under the first element as it emanates from the word "kangaroo". Furthermore, the words "deliver" and "dispense" are different. There is no evidence to support the Respondent's contention that the "roo" component of the Complainant's mark is derived from the word "kangaroo" but, in any event, the Complainant's rights are in its entire mark (which the Panel notes is a fanciful, coined term), irrespective of its origin, and the comparison under the first element is between the entire mark and the disputed domain names. The mark and disputed domain names both have the "roo" component as the last three letters and the remaining elements, namely "deliver" and "dispense" respectively are conceptually very similar, each being associated with the provision of goods or services. Furthermore, they have visual similarity, each beginning with the letter "d" and being of roughly similar length. Lastly, it is evident from the claim on the Respondent's website that "We want to make Dispenseroo as revolutionary as the food delivery service we take inspiration from" not only that it had the Complainant's DELIVEROO mark in mind as the source of its choice of the disputed domain names but that it believed Internet users would appreciate that this claim referred to the Complainant's mark even though the mark itself was not actually mentioned. The fact that the Respondent may have intended the reference to the Complainant's brand to be humorous is immaterial for the purpose of assessing the first element.

For these reasons, the Panel finds that the disputed domain names are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, in summary, that a respondent may demonstrate that it has rights or legitimate interests in a domain name by demonstrating either that, before any notice to it of the dispute, it has been using or has made demonstrable preparations to use, the domain name in connection with a *bona fide* offering of goods or services or that it has been commonly known by the domain name or that it has been making a legitimate noncommercial or fair use of the domain name.

The Respondent has expressly stated on its website and in its informal response to the Complaint that the purpose of its website is intended to provide a means whereby Internet users located in the United Kingdom can purchase a variety of cannabis products. Regardless of this intent, the Panel notes that the Respondent's use cannot be *bona fide* where the Respondent has intentionally sought to trade off and take advantage of the Complainant's widely-known trademark, for its own commercial benefit.

Moreover, the Respondent's reply asserts, by implication, that it has rights or legitimate interests in the disputed domain names because it is commonly known by its limited company name, Dispenseroo Limited. However, the name of the Respondent has not been created independently of the Respondent's intention that the disputed domain names would call to mind, for many Internet users, the Complainant's DELIVEROO brand. Rather, it is a component part of the Respondent's scheme to create some form of association between its business and the Complainant in the minds of Internet users. It cannot in these circumstances be open to the Respondent to contend that it has a right or legitimate interest in the disputed domain names because of its chosen company name. See, by way of example; *Dun & Bradstreet International, Ltd. v. Duns Vietnam Company Limited / Nguyễn Huy Duy*, WIPO Case No. [D2022-3339](#). The Panel does not therefore find the second circumstance set out at paragraph 4(c) of the Policy to be applicable. The third circumstance is also inapplicable as the use to which the disputed domain names have been put is commercial in character.

The Panel accordingly finds that the Respondent has no rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

It is evident from both the content on the Respondent's website and its response to the Complaint that it registered the disputed domain names with an awareness of the Complainant's DELIVEROO mark, with the intention that Internet users would perceive a resonance between them and the Complainant's mark and in order to unfair advantage of such an association. Moreover, as explained in section 3.1.4 of the [WIPO Overview 3.0](#); "Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: [...] (ii) seeking to cause confusion [...] for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name [...]". The Panel therefore finds the Respondent's registration of the disputed domain names to have been in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a 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 its website. Many Internet users, on visiting the Respondent's website, are apt to appreciate that it is not operated by, or with the authority of, the Complainant. Nonetheless, it is the confusing similarity between the Complainant's mark and the disputed domain names that will have led such Internet users to visit the Respondent's website and it will thereby have gained the opportunity of seeking to secure sales of its cannabis products to them. Moreover, the fact that the Respondent has now redirected the disputed domain names to a different domain name, namely <dispenseree.com>, and that it has rebranded its website from "dispenseroo" to "dispenseree" makes no

material difference to the analysis because the Respondent is still using the disputed domain names in order to funnel Internet traffic to its new website and it is profiting from the confusion which is thereby being caused.

The Panel accordingly finds that the disputed domain names have been registered and are being used in bad faith.

8. 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 names, <dispenseroo.com> and <dispenseroo.shop>, be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: January 25, 2023