

ADMINISTRATIVE PANEL DECISION

RooFoods Ltd v. Ronny Tones
Case No. D2024-1437

1. The Parties

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

The Respondent is Ronny Tones, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dispenseroo.org> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2024. On April 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 2024, 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 (Unknown, REDACTED FOR PRIVACY, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 10, 2024, 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 April 10, 2024.

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 April 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2024. The Respondent did not submit a response by the due date. Accordingly, the Center notified the Respondent’s default on May 3, 2024. On May 4, 2024, the Center received a brief email from one of the email addresses to which all communications to the Respondent had been sent, the contents of which are set out in section 5.B below.

The Center appointed Andrew F. Christie as the sole panelist in this matter on May 14, 2024. 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 England and Wales on August 3, 2012. It operates an app-based and website-based on-demand food delivery service under the DELIVEROO brand, in 10 markets (and over 800 towns and cities) spanning the United Kingdom, Europe, the Middle East, and Asia. Launched in 2013, the Complainant's business has grown rapidly into a successful global business, with global sales of GBP 2.03 billion in the year ending December 31, 2022.

The Complainant owns an extensive portfolio of trademark registrations for the word trademark DELIVEROO, including United Kingdom Trademark No. 3150368 (filed February 18, 2016; registered May 13, 2016) and European Union Trademark No. 15750763 (filed August 16, 2016; registered January 10, 2017).

The disputed domain name was registered on December 18, 2023. The Complainant has provided screenshots, said to have been taken on March 28, 2024, showing the disputed domain name resolved to a website offering for sale the "Best Weed Products Online". The website makes clear that "weed" refers to cannabis. Under the heading "Our Story", it is stated: "We are a collective of cannabis smokers aiming to fix the stigma surrounding cannabis and its positive effects." As at the date of this decision, the disputed domain name resolves to a website that appears to be the same as the one shown in the screenshots.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant contends that the disputed domain name is confusingly similar to a trademark in which it has rights on the following grounds, among others. The Complainant's DELIVEROO brand is very well protected and extremely well-known around the world. The Complainant's registered trademarks confer upon the Complainant the exclusive right to ensure that third parties do not use the trade mark DELIVEROO, anything incorporating DELIVEROO, or any similar marks in relation to goods and services covered by the Registered Marks or similar goods and services. Furthermore, given the Complainant's reputation and its extensive sales in multiple jurisdictions, the Complainant owns substantial unregistered rights in the "Deliveroo" name. At the second level the disputed domain name consists of the word "dispenseroo", which is similar to its trade mark DELIVEROO because both: (i) comprise words of similar length; (ii) begin with the same letter and end with the same four letters; and (iii) contain a word meaning to provide (i.e., dispense and deliver) followed by the distinctive "roo" suffix.

The Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name on the following grounds, among others. The Respondent is in no way related to, or authorised by, the Complainant. The Complainant has not granted the Respondent any licence to use its registered trademarks (or any similar mark). The Respondent's website advertises the sale of a variety of cannabis products and is targeted specifically at United Kingdom consumers. In particular, the goods are priced in British pounds and the website specifically states, by way of example: "We want Dispenseroo to be much more than the UK's biggest dispensary..."; "We currently only ship to the United Kingdom excluding the Channel Islands"; and "When we set out in our mission we made the joke that we want Dispenseroo to

be the biggest and most customer friendly dispensary of recreational Marijuana in the UK; but that is our mission.”

Cannabis is a “controlled drug” for the purposes of the United Kingdom’s *Misuse of Drugs Act 1971*, and under section 4(1) of that Act it is not lawful for a person to supply or offer to supply a controlled drug to another in the United Kingdom. Contravention of this section is a criminal offence under section 4(3). Given the illegal nature of the Respondent’s activities, there can be no argument that the disputed domain name is being used in connection with a bona fide offering of goods or services, or that 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 tarnish the DELIVEROO mark.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith on the following grounds, among others. By the date of registration of the disputed domain name, the Complainant was widely known as DELIVEROO (particularly in the United Kingdom, the market that the Respondent’s website is targeted at). The disputed domain name was registered by the Respondent without the authority of the Complainant. As at the date of registration of the disputed domain name, it is inconceivable that the Respondent was not aware of the Complainant or its rights. The disputed domain name has clearly been registered and is being used to intentionally 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 the Respondent’s website or of the products or services advertised on the Respondent’s website.

B. Respondent

The Respondent did not formally reply to the Complainant’s contentions. However, on May 4, 2024 (after the Center’s notification of the Respondent’s failure to respond), the Center received a brief email from one of the email addresses to which all communications to the Respondent had been sent, stating: “Hi all Please bear in mind that i would not like this domain to go down as i have not faulted anyone. Dispensroo (sic) and Deliveroo are completely 2 different things and you should not let this happen to my domain Thanks”.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. It is the owner numerous trademark registrations for the word trademark DELIVEROO.

The Complainant’s trademark consists of the conflation of two terms, where the first term (“deliver”) is descriptive of the services provided by the Complainant under the trademark (i.e., delivery) and the second term is allusive to a quick form of delivery (i.e., via a kangaroo – of which “roo” is a shortening). The distinctiveness of the Complainant’s trademark largely derives from the utilization of the allusion.

The Panel considers that the disputed domain name is confusingly similar to the Complainant’s trademark, for the following reasons: (i) it consists of a string of similar length to the trademark (11 characters, compared with nine characters); (ii) it begins with the same letter (“d”) and end with the same four letters (“eroo”) as the trademark; (iii) it begins with a word of similar meaning to the first word of the trademark (both “dispense” and “deliver” mean to provide); and (iv) it ends in the distinctive allusion (“roo”).

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain name was registered more than seven years after the Complainant first registered its trademark, that the disputed domain name incorporates a similar descriptive element and the same distinctive element as the Complainant’s trademark, and that the Respondent has used the disputed domain name to resolve to a website which impliedly acknowledges the existence of the Complainant and its trademark, when it states: “We want to make Dispenseree (sic) as revolutionary as the food delivery service we take inspiration from”. Given these circumstances, it is clear the Respondent registered the disputed domain name with knowledge of, and to take unfair advantage of, the Complainant’s trademark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds 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 trademark as to the source, sponsorship, affiliation, or endorsement of its website.

The Panel finds that the Complainant has established the third element 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 <dispenseroo.org> be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: May 28, 2024