

**IL-DRP PANEL**

**FOR THE INTERNET SOCIETY OF ISRAEL**

In the matter of the Domain <Deliveroo.co.il>

between

***RooFoods Ltd***

1Cousin Lane  
London EC4R 3TE  
United Kingdom

Represented by Adv. Jonathan Agmon

Email: [jonathan@ip-law.legal](mailto:jonathan@ip-law.legal)

(The "Petitioner")

and

**Hadar Cohen**

XXXXX

Email: [xxxxxxx](mailto:xxxxxxx)

(The "Respondent" or "Holder")

**DECISION**

**I. Procedure**

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "deliveroo.co.il" be reallocated to the Petitioner.

A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the IL-DRP Rules, in order to address the Petitioner's above request ([http://www.isoc.org.il/domains/ildrp\\_rules.html](http://www.isoc.org.il/domains/ildrp_rules.html)) (hereinafter – "the Rules").

2. Notification of the pending Petition, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent on October 10<sup>th</sup>, 2018, to the Respondent's email address as recorded in the ISOC Domain Name Registry. In accordance with section 9.3 of the Rules, the Respondent was allotted 15 days, concluding on October 25<sup>th</sup>, 2018, to submit a Statement of Response or any other relevant information to the Panel.
3. The Respondent replied on October 17<sup>th</sup> by email, requesting an extension of 60 days which he deemed necessary in order to prepare an adequate Response, and also briefly addressed aspects of the Complaint. The Petitioner responded to said request. Both letters will be acknowledged as part of the communications included in this proceeding.
4. The Panel found that there were no unusual circumstances to justify such an extension, and in alliance with the guidelines as set forth in Section 10 of the Rules, aimed at providing "speedy resolution" of the Dispute, the Panel granted a 10 day extension for submission of the Statement of Response, until Nov 4<sup>th</sup>.
5. No Statement was submitted on behalf of the Respondent until said deadline, other than aforementioned email communication.
6. On Nov 12<sup>th</sup>, an attorney on behalf of the Respondent approached the Panel by phone, requesting to address the Petition. Panelist explained the limits of the authority of the Panel, and referred the attorney to the relevant procedures as set forth in the IL-DRP Rules.

## ***II. Factual Background***

1. The Petitioner is "RooFoods Ltd", a company incorporated in the UK. It is an international technology-based business that offers app-based food delivery services.

2. The Respondent is Mr. Hadar Cohen, a private individual with alleged background as a business consultant in the fields of cellular, finance, restaurants, etc..
3. The Respondent registered the Disputed Domain on January 14th, 2016.
4. The Domain is currently inactive.

### ***III. The Parties' Claims***

#### **A. The Petitioner**

1. The Petitioner is a British Company by the Name of RooFoods Ltd., which started its activity locally in London in 2012 in the food delivery business, and has since claimed to have grown internationally.
2. The Petitioner claims to have a strong Internet presence, which is applicable in Israel. (active Twitter account since 2012, active Facebook page, and many local websites). In addition, the company has expanded internationally and currently provides its services in 140 cities, in 12 countries.
3. The Complainant is the owner of numerous DELIVEROO Trademarks, which have been registered internationally, including UK (2012, 2016), EU (2014), Australia (2016), Hong Kong (2016), etc. A Trademark in Israel has been registered since 2017.
4. The Complainant is the owner of several Domain Names including the name Deliveroo, including <deliveroo.com>; <deliveroo.be>; <deliveroo.de>; <deliveroo.hk>; <deliveroo.ie>; <deliveroo.it>; <deliveroo.es>; <deliveroo.co.uk>; and others.
5. The Complainant presented a series of media references describing Deliveroo and its service, including various online articles starting as early as 2015, including an article in an Israeli Online Magazine about fast-growing Startups, published in June 2015.

6. The Petitioner submitted copies of letters the Holder had sent to the Petitioner in 2016, after having purchased the Domain, in which he clearly stated that he is familiar with the Petitioner's business and it is very similar to what he would like to create in Israel.
7. The Petitioner submitted a series of email communications in 2018 between the parties. The first of which was a Cease and Desist letter sent to the Holder, prior to submission of Petition, requesting transfer of the Domain.

## **B. The Respondent**

The Respondent, Mr. Hadar Cohen, failed to submit a Letter of Response to the Complaint.

On Oct 17<sup>th</sup> he sent a short reply email, in which he requested an extension for submission of a Response, and in which he proposed to transfer the Domain to the petitioner, which he claimed to have bought when there was no legal impediment or TM preventing him from doing so, in return for the amount of 25,000 British Pounds.

## ***IV. Discussion***

1. The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain Names, in accordance with the Rules for Allocation of Domain Names under the .IL country code. By registering a Domain, any Holder agrees to abide by these Rules.
2. Let it be emphasized that the IL-DRP proceedings are meant to be concise, specific, straight-forward cases, as an easily accessible alternative procedure. The IL-DRP sets forth clear guideline recommendations as to how the Procedure should be conducted, aimed at providing expedited resolution to Domain Name disputes, as

described in the preamble to the Rules. The procedure is not intended to substitute court review in cases where there are contractual disputes or complex business contentions between the parties, which will require lengthy processes of evidence and cross examination.

3. Historically, the framework within which the Israeli II-DRP rules were established, similar to the WIPO Uniform Domain Name Dispute Resolution Policy, was aimed at mitigating and preventing all instances of "cybersquatting", which according to ICANN is: "bad faith registration of another's trademark in a domain name."<sup>1</sup>
4. As phrased in *WIPO Administrative Panel Crough and McNeil v. Stein*, case no, *D2005-1201* and applicable to the IL-DRP rationale as well:

"The Policy was adopted to deal as is with the problem of cybersquatting, the registration of domain names consisting of, including, or confusingly similar to marks belonging to another for the purpose of profiting from the goodwill associated with said marks."

5. In order for a case to be brought before an II-DRP Panel, the Petitioner must show prima facie indications that certain grounds exist. The following must all be fulfilled:
  - 3.1. the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant; and
  - 3.2. the Complainant has rights in the Name; and
  - 3.3. the Holder has no rights in the Name; and
  - 3.4. the application for allocation of the Domain Name was made or the Domain Name was used in bad faith.
6. Keeping all of the above in mind, the Panel will proceed to review existence of the grounds for the request, based on the II-DRP guidelines, and in consideration of the purpose and relevance of the facts at hand to the rationale of II-DRP proceedings.

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<sup>1</sup> <https://www.icann.org/resources/pages/cybersquatting-2013-05-03-en>

#### A. Name is Same or Confusingly Similar

The first requirement in the Rules is that "the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant".

The Disputed Domain consists of the term "deliveroo" and of the suffix "co.il".

It has been previously ruled that the suffix "co.il" is to be disregarded for the purpose of determining similarity of a Domain to a Registered Mark, since it is a common suffix indicating that the domain is registered as a commercial Israeli website (see for example ISOC II-DRP case in the matter of <Crayola.co.il>).

Hence the question arises, whether or not the term "deliveroo" which is the essence of the Domain name, is the same or confusingly similar to any marks owned by the Complainant.

The Petitioner demonstrated ownership of several international Trademarks of the term DELIVEROO, which are identical to the Disputed Domain, as expressed under the Petitioner's claims above.

The Petitioner has also registered several other international Domains consisting of the Name "Deliveroo", as demonstrated above.

The Petitioner has also presented broad media and press coverage, online internationally as well as locally in Israel, referring to "Deliveroo" as its Company name.

In light of the above, it is evident that the Domain name is identical to the Name of the Complainant, and the first requirement is thus fulfilled.

## B. Complainant has Rights in the Name

The II-DRP rules require fulfillment of all grounds specified in Section 3 of the Rules. This Section requires prima facie proof that the Complainant has rights in the Name.

It is very clearly evident from the information presented above, that the Petitioner had international rights in the name, at the time of filing the claim.

These rights include:

- Various International Registered Trademarks under the name DELIVEROO;
- DELIVEROO is a coined word without any common meaning, thus giving it distinctive meaning in the context of use by the Petitioner;
- Extensive use and media coverage, identifying DELIVEROO as a Trade name strongly associated with the Petitioner, in the field of food delivery.

The Petitioner registered the Name DELIVEROO in the UK as early as 2012, which is prior to Domain registration. Additional Trademarks were also registered, as well as Domain names, all prior to registration. The existence of a locally registered Trademark in Israel is immaterial to the general finding that the Petitioner has rights in the name.

It has already been concluded by WIPO Arbitration Panels that:

"It has been a consensus view among UDRP panels that if the complainant owns a registered trademark, then it generally satisfies the threshold requirement of having trademark rights". *Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy Nikolaevich*, WIPO Case No. [D2016-0205](#), <horten-canada.com>

Since Israeli II-DRP guidelines are very similar to those established by WIPO Uniform Domain Name Dispute Resolution Policy, local guidance is often taken from WIPO Panel decisions.

In addition, even the Respondent's own behavior enforces the existence of the Petitioner's Rights in the name. In a letter sent from the Respondent to the Petitioner on Aug 18<sup>th</sup>, 2018 (as submitted in the Annex to the Petition, and uncontended by the Holder), the Respondent states clearly that "Two years ago, when I purchased the Domain, I sent an email to the CEO of the Company, Mr. Shu, and proposed a plan to establish a Deliveroo branch in Israel". This email clearly demonstrates that even the Holder, upon registration of the Domain, recognized the proper owner of rights in the Domain.

Finally, these Complainants Rights had already been clearly ascertained by various WIPO Panels regarding additional instances of competing Domain name registration. As stated by the WIPO Arbitration Panel in *Roofoods Limited v. Jai Shan* WIPO Case No. D2017-1440 and *Roofoods Limited v. Wang Liqun*, Case No. D2017-1761, regarding the Domain <deliveroo.asia>: "It is undisputed that Complainant has rights over the DELIVEROO trademark."

Therefore it is concluded that the Petitioner provided at least the required Prima Facie case in favor of ownership of its rights in the Name.

#### C. Respondent has no Rights in Name

Above analysis indicates that the first two of four required grounds for Petition have been fulfilled. The Third claim requires that the Respondent have No Rights in the Name.

The Respondent, Mr. Hadar Cohen, appears to be (according to public profile info submitted by the Petitioner) a consultant in various industries, including the food delivery business.

The Respondent did not provide a Statement of Response in this case, and as such, made no claim to any Rights in the name.

The Complainant specifies that it was not familiar with the Holder prior to registration of the Domain, and had no relationship with him whatsoever.

The website under the Domain does not refer to an active web page, and seems to have never been activated (as also re-inforced by a review on the Internet Archive at <https://web.archive.org>, which provides no recorded activity for the Domain).

Therefore, Panel concludes that the third requirement under the Rules is clearly fulfilled, and the Respondent has indicated no rights or interest vested in the Name.

#### D. Registration or Use in Bad Faith

Section 3.4 requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". The Rule requires that either the registration or the use be in bad faith, it appears that in this case, there are multiple acts on behalf of the respondent which are indicative of bad faith both in registration and in use, as follows:

##### Bad Faith in Registration of the Domain:

- Previous knowledge of the Name –
  - WIPO Panels have repeatedly concluded that a finding of bad faith can be made when a Respondent "knew or should have known of the registration and use of the trademark prior to registering the domain" (ie WIPO Case No. D2005-0524 Maori Television Service v. Damien Sampat )
  - In this case, the Respondent registered the Domain on January 14<sup>th</sup>, 2016. Shortly after (according to unrefuted evidence submitted by the Petitioner), the Respondent sent an email to the Petitioner on February 2<sup>nd</sup> 2016, stating that he had researched the field of food delivery and came across the Petitioner's activity.
  - This clearly indicates that the Respondent was familiar with the Petitioner's activity during or near the time when he registered the

Domain. This is also reinforced by the fact that deliveroo: is a term coined by the Petitioner, and therefore unlikely to have been incidentally made up by the Respondent without prior knowledge of its existence.

- Purchase with purpose of selling the Name -
  - Section 4 of the Rules provides a general guideline of circumstance, which if present, may constitute bad faith. Among these is "circumstances indicating that the Holder has requested allocation or holds the Domain Name primarily for the **purpose of selling**, renting, or **otherwise transferring** the Domain Name allocation 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 documented out-of-pocket costs** directly related to the domain name; "
  - Immediately upon purchase of the Domain, the Respondent turned to the Petitioner and effectively suggested a business plan which will rely on the Deliveroo platform, using the Domain held by the Respondent. In a later communication, the Respondent clearly admitted that *"I am willing to release the URL as a commodity to your client if he has an offer to present"*.  
This clearly complies with the circumstance defined as Bad Faith in the rules mentioned above.
  - This gesture was amplified in the Respondents reply letter to this Panel, of Oct. 17<sup>th</sup>, in which the Holder clearly stated : *"I have no intention of denying him the use of the domain name and he can invite his client to purchase it from me for **25,000 GBP (Twenty-five thousand British Pound)**"*. Without doubt such an offer falls under the above definition of " **valuable consideration in excess of documented out-of-pocket costs** directly related to the domain name", which amounts to Bad Faith Registration.
  - The term "deliveroo" is not a generic or commonly used term, has no inherent meaning of its own and has no direct relevance to the Respondent himself or any activity conducted by him, and therefore the Respondent had no other reason in applying for registration of the Disputed Domain other than holding it as "Ransom" as a basis

for mandating cooperation with the Petitioner, as described above, or for the reason specified in section 4.1(b) of the Rules: "The Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor."

### **Bad Faith in Use of the Domain**

- Inactive Domain -

Bad faith can also be deducted through the holder's use, or lack of use, of the Domain. According to basic searches, the Domain has remained inactive since its registration. As stated by a Panel in WIPO *Case No. D2008-1393 Malayan Banking Berhad v. Beauty, Success & Truth International*: "Panels have consistently held that passive holding of domain names can, under certain circumstances, be considered bad faith use of the domain name. See *Telstra Corporation Limited v. Nuclear Marshmallows*", [WIPO Case No. D2000-0003](#) and *Polaroid Corporation v. Jay Strommen*, [WIPO Case No. D2005-1005](#)."

- Competing Domain

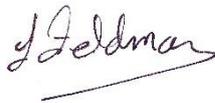
Panel also notes that shortly after registering the Domain, the same Respondent registered an additional Domain, <deliverapp.co.il>, which to date leads to a web site offering food delivery services, in a way that is in direct competition with the services offered by Deliveroo. Though the Respondent explained (as submitted by the Petitioner) that this is an inactive Demo site, the actual registration of two potentially competing Domains, strengthens the claim that the Holder registered the first in bad faith, while possibly setting up a business to compete with the Petitioner. This is compliant with section 4(1)(b) of the Rules, by which "the Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor; ", indicating use in bad faith.

The combination of all of the above is a sufficient indication of bad faith. Therefore the Panel concludes that the Respondent has acted in bad faith both in application for registration of the Domain, and in use thereof.

## ***V. Decision***

In light of all of the above, Panel finds that the Disputed Domain is the same and identical to many Well Known and Registered Marks of the Petitioner, the Petitioner has established substantial circumstances supporting its rights to the Disputed Domain, the Respondent presented no rights in the Domain, and the Respondent has acted in bad faith in registering and in holding the Domain.

Therefore, the Panel concludes that **the Disputed Domain shall be transferred and re-assigned to the Petitioner**, within 30 days of the date of this decision.



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Leehee Feldman , Adv.

Sole Panelist

Date: November 20<sup>th</sup>, 2018