

## **ADMINISTRATIVE PANEL DECISION**

Sodexo v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues,  
Fundacion Comercio Electronico  
Case No. D2022-0087

### **1. The Parties**

The Complainant is Sodexo, France, represented by Areopage, France.

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America (“United States”) / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

### **2. The Domain Name and Registrar**

The disputed domain name <portalsodexo.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2022. On the same date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 18, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 19, 2022, 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 January 21, 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 Respondent of the Complaint, and the proceedings commenced on January 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 18, 2022.

The Center appointed Michael A.R. Bernasconi as the sole panelist in this matter on February 23, 2022. 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**

Founded in 1966, the Complainant is a French company and, with around 420,000 employees serving 100 million consumers in 64 countries, is one of the world's largest enterprises specializing in food services and facilities management.

The Complainant holds a number of registered trademarks for the words SODEXO and SODEXHO in multiple jurisdictions around the world ("Complainant's Marks"), including the International Trademark Registration Numbers 964615 and 1195702. The International Trademark Registration Number 964615 was first registered on January 8, 2008, and renewed in 2018, in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45. The International Trademark Registration Number 1195702 was registered on October 10, 2013 in classes 9, 16, 35, 36, 37, 38, 39, 41, 42, 43, 44, and 45.

The Domain Name was registered on December 10, 2021. The website accessible under the Domain Name offers advertisement and referral links linked to a variety of third-party websites.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant makes the following contentions:

- (i) the Domain Name is identical or confusingly similar to the Complainant's Marks;
- (ii) the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The Complainant maintains that it is a widely established company all around the world with trademarks, *inter alia*, in the United States. The strong reputation of the Complainant has been repeatedly recognized by UDRP panels in a number of referenced cases. The Domain Name is confusingly similar to the SODEXO and SODEXHO trademarks since it incorporates the SODEXO mark in its entirety with the addition of the element "portal-" and the generic Top-Level-Domain ("gTLD") ".com". These elements are not sufficient to distinguish the Domain Name from the Complainant's Marks as the SODEXO mark is dominant and keeps its individuality and attractive character. In conclusion, the public is led to believe that the Domain Name is linked to the Complainant.

There are no rights or legitimate interests held by the Respondent in respect to the Domain Name. The Complainant has not granted any license or authorization for the Respondent, who is not associated or affiliated to the Complainant, to use the Complainant's Marks or to register the Domain Name.

The Domain Name was registered and is used in bad faith. As the word "sodexo" is purely fanciful, nobody could legitimately choose this word or any variation thereof, unless seeking to create an association with the Complainant's Marks and services. Due to the well-known character of the SODEXO mark, the Respondent was aware that it had no rights or legitimate interests in the Domain Name and that it cannot be lawfully used by someone other than the Complainant. Actual knowledge of the Complainant's Marks may in itself be considered as an inference of bad faith. The Respondent registered the Domain Name with the objective to

create confusion with Complainant's Marks in order to divert or mislead third parties and achieve illegitimate profit.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the Complainant's contentions would not by itself mean that the Complainant is deemed to have prevailed; a Respondent's default is not necessarily an admission that the Complainant's claims are true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Thus, although Respondent has failed to provide the Center with its response to the Complaint, the burden to prove that the three elements of paragraph 4(a) of the Policy are fulfilled by a preponderance of the evidence, remains with the Complainant.

### **A. Domain Name is identical or confusingly similar**

To prove this element the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark. Ownership of a trademark registration is generally sufficient evidence to prove that the Complainant has the requisite rights in a mark as foreseen under paragraph 4(a)(i) of the Policy (see section 1.2.1 of the [WIPO Overview 3.0](#)).

The Complainant provided evidence of its ownership of the Complainant's Marks, having registrations for the presently relevant SODEXO mark as a trademark in the United States, as well as other jurisdictions.

Apart from the ".com" gTLD, a necessary technical requirement of the Domain Name, and the additional element "portal", the Domain Name is confusingly similar to the SODEXO mark given that it entirely incorporates the SODEXO mark and solely adds the term "portal". The addition of terms does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

In order to satisfy the prerequisite under paragraph 4(a)(ii) of the Policy, a complainant must show that a respondent possesses no rights or legitimate interests in a disputed domain name. Once a complainant establishes the lack of rights or legitimate interests of a respondent on a *prima facie* basis, it remains for the respondent to prove its rights or legitimate interests in the domain name. If a respondent fails to satisfy this burden of production, a complainant is deemed to have fulfilled the requirement of paragraph 4(a)(ii) of the Policy (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel accepts, as elaborated by the Complainant, that the Respondent is not associated or affiliated with the Complainant in any way, and therefore there is no relationship between the Complainant and the Respondent which would justify and entitle the Respondent to use the Domain Name. Furthermore, the Respondent has not been authorized by the Complainant to register or use the SODEXO mark. Hence, the Panel is of the view that a *prima facie* case has been established by the Complainant. Consequently, the burden of production shifts to the Respondent who must provide evidence of rights or legitimate interests in the Domain Name.

The Respondent had the opportunity to submit a reply to Complainant's contentions in order to prove its rights or legitimate interests in the Domain Name. In the absence of such response, the Panel finds that there is no specific evidence that demonstrates Respondent's rights or legitimate interests in the Domain Name pursuant to paragraph 4(c) of the Policy. The Panel concurs with the Complainant in stating that the pay-per-click links at issue do not represent a *bona fide* offering, since such links compete with or capitalize on the reputation and goodwill of the Complainant's Marks, or otherwise mislead and confuse Internet users.

The Respondent therefore has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The requirement under paragraph 4(a)(iii) is further specified under paragraph 4(b) of the Policy. Pursuant to paragraph 4(b) of the Policy, the following circumstances shall in particular form evidence of a registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or has 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 trade or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or

(ii) the Respondent has 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 the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

In view of the Complainant's reputation, the Panel concurs with the Complainant in establishing that the Complainant is a very well-known entity, and the Respondent must have been well-aware of the Complainant's SODEXO marks at the time of acquiring the Domain Name. The Complainant promoted its business operations under the name "Sodexho" from 1966 until 2008. From 2008, the Complainant promoted its operations under the simplified SODEXO mark. In conjunction with the Complainant's global reach, it is more than apparent that the Domain Name aims at creating a confusion with the Complainant's Marks.

In particular, the Respondent uses the reputation of the Complainant's Marks to attract Internet users and offers unrelated advertisement links to achieve commercial gain. Respondent provided no response to the contention of the Complainant that the Domain Name was only registered with the intention to create a likelihood of confusion with the Complainant's Marks. There is also no apparent explanation for such registration.

As established in previous UDRP decisions, the awareness of a third party's trademark while registering a domain name is an indication of bad faith (e.g. *LEGO Juris A/S v. Reiner Stotte*, WIPO Case No. [D2010-0494](#); *Caixa D'Estalvis / Pensions de Barcelona ("La Caixa") v. Eric Adam*, WIPO Case No. [D2006-0464](#)). Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Accordingly, in consideration of the above-elaborated circumstances and absence of any response from the Respondent, the Panel finds that the Respondent's conduct in registering the Domain Name while being aware of the Complainant's rights and directing the confusingly similar Domain Name to pay-per-click links amounts to a registration and use in bad faith within the meaning of paragraph 4(a)(iii).

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(a) of the Policy and 15 of the Rules, the Panel orders that the disputed Domain Name <portalsodexo.com> be transferred to the Complainant.

*Michael A.R. Bernasconi*  
**Michael A.R. Bernasconi**  
Sole Panelist  
Date: March 9, 2022