

ADMINISTRATIVE PANEL DECISION

Sodexo v. Emmie Heaney, boyd uk
Case No. D2022-0648

1. The Parties

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

The Respondent is Emmie Heaney, boyd uk, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <sodexho-it.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 24, 2022. On February 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 25, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 25, 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 March 2, 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 March 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 28, 2022.

The Center appointed Oleksiy Stolyarenko as the sole panelist in this matter on April 1, 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

The Complainant, a French company founded in 1966, specializes in food services and facilities management. It has 420,000 employees serving 100 million consumers in 64 countries including the United States. In 2020, its consolidated revenues reached EUR 19.3 billion with 43% of revenue attributed to the North America. In 2008, the Complainant who had until then operated under the name Sodexho Alliance, decided to simplify the spelling of Sodexho to Sodexo.

The Complainant has registered a number of SODEXO and SODEXHO trademarks worldwide, including in the United States, for a broad range of goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45 related to the activities of the Complainant. Some of the SODEXO and SODEXHO trademark registrations are indicated below:

- International Registration for SODEXO and design No. 964615 registered on January 1, 2008 for the goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45 designating *inter alia* the United States;
- International Registration for SODEXHO and design No. 689106 registered on January 28, 1998 for the services in classes 16, 36, 37, 39, 41, 42;
- European Union ("EU") Trademark for SODEXO No. 00610465 dated June 8, 2009, for the goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

The Complainant, also owns numerous domain names corresponding to and/or containing SODEXO and SODEXHO trademark. The Complainant promotes its activities among others under the following domain names: <sodexho.fr>, <sodexho.com>, <sodexo.com>, <uk.sodexo.com>, <sodexoprestige.co.uk>, <sodexo.fr>, <sodexoca.com>, <sodexousa.com>. The domain name <sodexho.com> was registered by the Complainant back on October 22, 1995 and domain name <sodexo.com> on October 8, 1998.

The Respondent appears to be an individual located in the United States. According to the WhoIs, the disputed domain name was registered in the name of the Respondent on December 27, 2021. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has strong rights in SODEXO and SODEXHO trademarks by virtue of its longstanding use and registration of the marks in a number of jurisdictions around the world. Also, the Complainant indicates that its activities and initiatives receive attention of the media worldwide. Previous UDRP panels found that SODEXHO and SODEXO marks are well known.

The Complainant argues that the disputed domain name is identical or confusingly similar to the Complainant's SODEXHO and SODEXO marks as it incorporates the Complainant's registered SODEXHO trademark entirely. The word "it" according to the Complainant refers to the shorthand for "Italy", a country where the Complainant is commercially active. The addition of the word "it" to the disputed domain name is not sufficient to distinguish it from the Complainant's marks.

The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not authorized the Respondent to use the SODEXHO and SODEXO marks in the disputed domain name.

The Respondent is not commonly known by the disputed domain name.

The Respondent was fully aware of the Complainant's reputation and the Complainant's trademark rights on the SODEXHO and SODEXO marks when the Respondent registered the disputed domain name.

The disputed domain name was registered in bad faith by the Respondent for the purpose of creating confusion with Complainant's marks to divert or mislead third parties for the Respondent's illegitimate profit.

Therefore, the disputed domain name has been registered by the Respondent in an unfair manner and in bad faith. It is also inconceivable that the Respondent had any good faith intentions at the point of registering the disputed domain name.

The Complainant seeks a decision that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has proved its rights in the SODEXHO and SODEXO marks through international registrations dating back to 1998 designating numerous countries worldwide including the United States, and also through EU and national trademark registrations registered in various countries of the world.

Therefore, the Panel considers that the Complainant has satisfied the threshold requirement of having relevant trademark rights.

The disputed domain name is comprised of the words "sodexho", "it" separated by hyphen and combined with the generic Top-Level Domain ("gTLD") ".com".

Thus, the Panel finds that the disputed domain name incorporates the Complainant's SODEXHO trademark entirely.

Furthermore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's the SODEXHO and SODEXO trademarks.

The Panel notes that addition of the word "it" and hyphen to the disputed domain does not prevent the Complainant's trademark from being recognizable in the disputed domain name.

The gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)). Therefore, the Panel disregards the TLD for the purposes of this comparison.

The Panel finds that according to a side-by-side comparison, the disputed domain name reproduces the Complainant's SODEXHO trademark and, thus, that the Complainant's trademark is recognizable within the disputed domain name.

Previous UDRP panels have consistently held that the addition of a geographical term to a disputed domain name that incorporates a trademark in its entirety typically does not prevent the finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

For all the foregoing reasons, the Panel finds that the first element of paragraph 4(a) of the Policy has therefore been satisfied by the Complainant.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to establish that the respondent has no rights or legitimate interests in the domain name. Once the complainant establishes a *prima facie* case against the respondent under this ground, the burden of production shifts to the respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#). In this case, the Respondent did not rebut the Complainant's *prima facie* case regarding the lack of rights or legitimate interests.

However, the overall burden of proof remains with the Complainant. Paragraph 4(c) of the Policy provides circumstances that demonstrate the respondent's rights or legitimate interests to the disputed domain name, and that the complainant frequently address to show that the activities of the respondent does not fall under the *bona fide* offering of goods or services (paragraph 4(c)(i) of the Policy), that the respondent is not commonly known by the disputed domain name (paragraph 4(c)(ii) of the Policy) and that the respondent is not making a legitimate noncommercial or fair use of the disputed domain name (paragraph 4(c)(iii) of the Policy).

The Panel finds that because the disputed domain name is confusingly similar to the Complainant's SODEXHO and SODEXO trademarks, any use of such domain name by the Respondent carries a high risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

According to the Complainant, the Respondent is not an authorized or licensed to use the Complainant's SODEXHO and SODEXO trademarks in the disputed domain name, as well as not in any way affiliated with the Complainant.

The Panel also notes that the Respondent failed to come forward with any relevant evidence confirming use or demonstrable preparations to use of the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

Taking into account the reputation and long period of use of the Complainant's SODEXHO and SODEXO trademarks, and in the corresponding Complainant's domain name and website, and in the absence of evidence to the contrary, the Panel finds that the Respondent is not involved in a *bona fide* offering of goods or services (under paragraph 4(c)(i) of the Policy) and the Respondent's activities does not fall under a legitimate noncommercial use (under paragraph 4(c)(iii) of the Policy).

According to the Registrar's information, "Emmie Heaney" is the registrant of the disputed domain name. The Panel did not find any evidence that the Respondent is commonly known by the disputed domain name. The Panel concludes that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Complainant has satisfied the second element of the Policy, namely paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

As the Panel established above, the Complainant's SODEXHO and SODEXO trademarks were used in commerce well before the registration of the disputed domain name on December 27, 2021. The Complainant has used SODEXHO and SODEXO trademarks in various forms since 1966.

Previous UDRP panels have already recognized the wide reputation of the SODEXO trademark: “The Panel agrees with previous UDRP panels holding that the fanciful trademark SODEXO enjoys a wide reputation. Therefore, the Panel agrees with the fact that the Respondent would have known that the disputed domain name interferes with the Complainant’s well-known SODEXO trademark when registering the Disputed Domain Name”. See *Sodexo v. Registration Private, Domains By Proxy, LLC / Ilan Sigura*, WIPO Case No. [D2021-2898](#).

The Panel agrees and considers that the well-known character of the SODEXO trademark is established.

The Panel finds with a high degree of certainty that the Respondent knew of the Complainant’s SODEXHO and SODEXO trademarks when registering the disputed domain name. This conclusion is supported by the well-known character of the mark, the fact that the Complainant actively works in the United States and derives a significant proportion of revenue from there. Also, it is important to note that the Complainant’s marks by nature are fanciful designations, therefore, it is highly unlikely that the Respondent has registered the disputed domain name without knowing of activities of the Complainant.

Furthermore, the Respondent’s use of the geographical term “it” in the disputed domain name has a potential to mislead the Internet users that the disputed domain name is operated by the Complainant or the Complainant’s authorized agent or representative of the Complainant in Italy.

Furthermore, the Respondent failed to submit a response to disprove allegations of illegal activity or provide any evidence of a good-faith use or to show rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent’s intent for registering the disputed domain name, which reproduces the Complainant’s trademark along with the geographic term “it” has always been to capitalize on the goodwill of the Complainant’s trademark.

According to previous UDRP panel decisions, passive holding may indeed amount to bad faith use in certain circumstances. See section 3.3 of [WIPO Overview 3.0](#).

Furthermore, the Panel finds it implausible that the disputed domain name could be used by the Respondent in good faith considering that it is almost identical to the Complainant’s trademark. The Panel finds that the fact that the disputed domain name does not currently resolve to an active website does not prevent a finding of bad faith in these circumstances.

Therefore, based on the confirmed reputation, fame, long term and worldwide use of the Complainant’s SODEXHO and SODEXO trademarks, and in the absence of the response from the Respondent providing any explanation or evidence of actual or contemplated good-faith use, the Panel finds the Respondent registered and used the disputed domain name in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(iii) 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 <sodexho-it.com> be transferred to the Complainant.

/Oleksiy Stolyarenko/

Oleksiy Stolyarenko

Sole Panelist

Date: April 22, 2022