

ADMINISTRATIVE PANEL DECISION

Sodexo v. Privacy service provided by Withheld for Privacy ehf /
benoit Fournier, ASSYTEM ENGINEERING
Case No. D2022-3101

1. The Parties

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / benoit Fournier, ASSYSTEM ENGINEERING, France.

2. The Domain Name and Registrar

The disputed domain name <distribution-sodexo.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 22, 2022. On August 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 23, 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 August 24, 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 August 26, 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 September 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2022.

The Center appointed Nathalie Dreyfus as the sole panelist in this matter on October 6, 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

Complainant is Sodexo, a French company founded in 1966, specialized in food services and facilities management.

SODEXO provides a wide range of services under its trade name and mark SODEXO (prior SODEXHO) through an offer of on-site services, benefit and reward services, as well as personal and home services.

Complainant demonstrates its ownership over many trademarks consisting in or including the word “sodexo” in France and abroad, among which:

- International semi-figurative trademark No. 964615 SODEXO dated of January 8, 2008, duly renewed, for goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;
- International word trademark No. 1240316 SODEXO dated of October 23, 2014, for goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;
- European Union semi-figurative trademark No. 006104657 SODEXO dated of June 27, 2008, duly renewed, for goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;
- European Union word trademark No. 008346462 SODEXO dated of February 1, 2010, duly renewed, for goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;
- French semi-figurative trademark No. 3513766 SODEXO dated of July 16, 2007, duly renewed, for goods and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45.

Complainant demonstrates its ownership over many trademarks consisting in or including the word “sodexho” internationally, among which:

- International semi-figurative trademark No. 689106 SODEXHO dated of January 28, 1998, duly renewed, for goods and services in classes 16, 36, 37, 39, 41, 42;
- International semi-figurative trademark No. 694302 SODEXHO dated of June 22, 1998, duly renewed, for goods in class 9.

The SODEXO and/ or SODEXHO trademarks have been recognized as well-known in various prior Panel decisions, and notably in the following cases:

- *Sodexo v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1580](#);
- *Sodexo v. Contact Privacy Inc. Customer 1247189803 / NorAm Accounts Receivable*, WIPO Case No. [D2020-1683](#);
- *Sodexo v. Super Privacy Service LTD c/o Dynadot / Zhichao*, WIPO Case No. [D2020-1762](#);
- *Sodexo v. Zhichao Yang (杨智超)*, WIPO Case No. [D2020-2286](#);
- *Sodexo v. Ashutosh Dwivedi, Food & Beverages*, WIPO Case No. [D2020-2686](#);
- *Sodexo v. 李金梁 (Li Jin Liang)*, WIPO Case No. [D2020-3064](#);
- *Sodexo v. Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-3085](#);
- *Sodexo v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-0472](#);
- *Sodexo v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-0485](#);
- *Sodexo v. Daniela Ortiz*, WIPO Case No. [D2021-0628](#);
- *Sodexo v. bin quan wang, wang bin quan*, WIPO Case No. [D2021-0629](#);
- *Sodexo v. Yang Zhichao (杨智超)*, WIPO Case No. [D2021-0902](#);
- *Sodexo v. Lloyd Group*, WIPO Case No. [D2021-1214](#);

- *Sodexo v. Cheval Blanc*, WIPO Case No. [D2022-1588](#);
- *Sodexo v. Contact Privacy Inc. Customer*, WIPO Case No. [D2022-1399](#);
- *Sodexo v. Host Master, Transure Enterprise Ltd*, WIPO Case No. [D2022-1140](#).

The domain name <distribution-sodexo.com> (hereinafter referred as the “Disputed Domain Name”) has been registered on June 19, 2022, and does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

First and foremost, Complainant alleges that the Disputed Domain Name is identical or confusingly similar to the SODEXO and SODEXHO trademarks of which he is the owner:

To support this claim, Complainant refers in the first place to its remarkable position on the global market through independent sources and through its internal corporate documents, including its fiscal 2021 Integrated Report and Group Presentation.

Complainant also argues it is the registrant of domain names reproducing its trademarks.

Complainant further asserts that its SODEXO and SODEXHO trademarks have already been considered as well-known in previous UDRP cases.

Complainant then underlines that the Disputed Domain Name incorporates entirely its SODEXO trademark in addition to the generic element “distribution”, which intentionally refers to Complainant’s “distribution department” and makes the Dispute Domain Name look like its official website.

Complainant emphasizes that the adjunction of the word “distribution” fails to distinguish the Disputed Domain Name from Complainant’s trademarks. Furthermore, Complainant argues that the addition of this generic or descriptive term to its trademark does not neutralize the confusing similarity of the Disputed Domain Name to Complainant’s trademarks, by referring to previous UDRP decisions, amongst which:

- *Terex Corporation v. Texas International Property Associates - NA NA*, WIPO Case No. [D2008-0733](#);
- *Billabong International Limited, GSM (Operations) Pty Ltd, GSM (Trademarks) Pty Ltd, GSM (Europe) Pty Ltd, GSM (NZ Operations) Ltd v. Mookie Lei*, WIPO Case No. [D2008-0101](#);
- *Revlon Consumer Products Corporation v. Laurent D. Morel*, WIPO Case No. [D2002-0215](#);
- *Viacom International Inc. v. Erwin Tan*, WIPO Case No. [D2001-1440](#);
- *Nokia Corporation v. Nokiagirls.com a.k.a. IBCC*, WIPO Case No. [D2000-0102](#);
- *eAuto L.L.C. v. Net Me Up*, WIPO Case No. [D2000-0104](#).

Thus, the Disputed Domain Name may then refer to SODEXO’s official website. Moreover, Complainant claims that the word “sodexo” is the predominant part of the concerned domain name and is clearly perceived by consumers.

As a result, Complainant asserts that the Disputed Domain Name is identical or confusingly similar to its trademarks.

Secondly, Complainant claims that Respondent has no rights or legitimate interests in this Disputed Domain Name:

Complainant considers that Respondent was not commonly known by the Disputed Domain Name prior to the adoption and use by Complainant of the corporate name, business name and trademarks SODEXO and/or SODEXHO.

Complainant adds that Respondent was not authorized or granted a license to register the Disputed Domain Name and that there was no relationship of any kind between Complainant and Respondent.

Finally, Complainant asserts that Respondent registered and uses the Disputed Domain Name in bad faith:

1. Bad faith registration

Complainant underlines that the trademark SODEXO is purely fanciful. Therefore, Complainant concludes that choosing this word or any variation thereof means seeking to create an association with its activities and trademarks SODEXO.

Relying on the well-known character of its SODEXO and SODEXHO trademarks, Complainant argues that Respondent could not have ignored Complainant's rights at the time of registration.

Complainant also refers to previous UDRP decisions that already recognized that actual knowledge of Complainant's trademarks and activities at the time of the registration of the Disputed Domain Name may be considered an inference of bad faith, among which:

- *Sodexo v. Shahzan - PrivacyProtect.org*, WIPO Case No. [D2013-1308](#);
- *Accor, So Luxury HMC v. Youness Itsmail*, WIPO Case No. [D2015-0287](#);
- *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#) (cf. *Expedia, Inc. v. European Travel Network*, WIPO Case No. [D2000-0137](#));
- *Sony Kabushiki Kaisha also trading as Sony Corporation v. Inja, Kil*, WIPO Case No. [D2000-1409](#).

As a result, Complainant concludes that the Disputed Domain Name has been registered in bad faith.

2. Use in bad faith

Complainant argues that even if the Disputed Domain Name, which has been recently created, does not presently have any active content, a passive holding of a domain name does not prevent a finding of bad faith, quoting:

- *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and
- *Novo Nordisk A/S v. CDMS Invest*, WIPO Case No. [D2012-0676](#).

Complainant further asserts that previous panels have, among others, taken into consideration elements which are the strong reputation and well-known character of Complainant's trademarks, the lack of evidence provided by Respondent of any good faith use with regard to the Disputed Domain Name and the identity of the Disputed Domain Name with Complainant's name and trademark intended to divert or mislead potential web users from Complainant's website they are actually trying to visit. Complainant claims these circumstances may apply to the present case.

Finally, Complainant considers that bad faith use may also result from the threat of an abusive use of the Disputed Domain Name by Respondent, as it was the case in *Conair Corp. v. Pan Pin, Hong Kong Shunda International Co. Limited*, WIPO Case No. [D2014-1564](#).

Complainant concludes that the Disputed Domain Name is used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

According to Policy 4(a), there are three conditions that Complainant must satisfy in order to obtain a decision that the Disputed Domain Name registered by Respondent be cancelled or transferred to Complainant:

- (i) the Disputed Domain Name is identical or confusingly similar to the Complainant's trademark or service mark; and
- (ii) the Disputed Domain Name was registered by Respondent without any rights or legitimate interests in the Disputed Domain Name; and
- (iii) the Disputed Domain Name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has registered many SODEXO trademarks in France and abroad, such as those listed in the Factual Background above.

Therefore, the Panel considers that the trademarks rights of Complainant in the sign SODEXO are established.

Complainant underlines that the Disputed Domain Name reproduces its trademarks identically, albeit with the addition of the term "distribution". It is well established that where a trademark is recognizable within a domain name, the addition of a term or terms does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

As a result, the Panel considers that the Disputed Domain Name is confusingly similar to Complainant's trademarks.

Therefore, the Panel finds that Complainant has satisfied Policy 4(a)(i).

B. Rights or Legitimate Interests

Complainant underlines that Respondent was not authorized in any way to register the Disputed Domain Name and that there was no relationship of any kind between Complainant and Respondent.

Long-standing case law has considered these circumstances to be sufficient to make a *prima facie* case that Respondent lacks rights or interests in the Disputed Domain Name (See, *Linklaters LLP v. WhoisGuard Protected / Cindy Smith*, WIPO Case No. [D2019-0941](#), "The Panel accepts that the Respondent has no rights or legitimate interests in the Disputed Domain Name. There is no evidence that the Complainant has authorized or licensed the Respondent to use its LINKLATERS trademark and the Complainant has made out a *prima facie* case to that effect, which then places the burden on the Respondent, which it has failed to satisfy").

Respondent did not reply to Complainant's contentions.

Moreover, Complainant claims that Respondent was not commonly known by Disputed Domain Name. This is a long-standing criterion to assess whether Respondent has right or interest in the Disputed Domain Name. (Also see, *LEGO Juris A/S v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-0248](#), "Given that the Respondent was duly notified of the Complaint and has chosen not to rebut it on merits, the Panel draws an adverse inference against the Respondent with respect to the allegations made by the Complainant, from the silence 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. 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. Here, Respondent has not participated, thereby failing to rebut Complainant's above *prima facie* case.

In addition, the Disputed Domain Name consists of Complainant's well-known trademark SODEXO along with the added term "distribution" that is generally descriptive of Complainant's food-distribution services. Accordingly, the composition of the Disputed Domain Name is such to carry a risk of implied affiliation to Complainant that cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1. As such, the Panel agrees that Respondent does not have rights or legitimate interests in the Disputed Domain Name.

Therefore, the Panel finds that Complainant has satisfied Policy 4(a)(ii).

C. Registered and Used in Bad Faith

Complainant underlines that SODEXO is purely fanciful and therefore, choosing this word or any variation thereof would mean seeking to create an association with Complainant's activities and SODEXO trademarks. Additionally, relying on the well-known character of its SODEXO trademarks, Complainant argues that Respondent could not have ignored Complainant's rights at the time of registration.

Prior Panel decisions have already underlined that the fanciful trademark SODEXO enjoys a wide reputation (See, *Sodexo v. Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-3085](#), "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").

The Panel agrees and considers that the well-known character of the SODEXO trademarks is established and thus that bad faith registration is characterized. Furthermore, since Respondent is actually based in France where Complainant is established, it is implausible it did not have Complainant in mind at the time it registered the Disputed Domain Name. Prior panels have held that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Complainant recalls that the website is currently inactive and considers that such passive holding of the Disputed Domain Name by Respondent amounts to use in bad faith.

According to previous panel decisions, such passive holding may indeed amount to bad faith use in certain circumstances. (See [WIPO Overview 3.0](#), section 3.3, and the cases cited therein). Among the circumstances considered are (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. *Id.*

In the present case, and as underlined by Complainant, the SODEXO trademarks are well known, Respondent did not participate in these proceedings and as such there is no evidence of any actual or contemplated good-faith use, nor is there any plausible good-faith use to which the Disputed Domain Name may be put considering the notoriety of the SODEXO mark and its inherent association to Complainant. In these circumstances, passive holding of the Disputed Domain Name by Respondent does not prevent a finding of bad faith, in application of the criteria defined in section 3.3 of the [WIPO Overview 3.0](#).

The Panel thus finds that the Disputed Domain Name has been registered and is being used in bad faith in accordance with 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, <distribution-sodexo.com> be transferred to Complainant.

/Nathalie Dreyfus/

Nathalie Dreyfus

Sole Panelist

Date: October 26, 2022