

ADMINISTRATIVE PANEL DECISION

Sodexo v. Domain Administrator, Fundacion Privacy Services LTD
Case No. D2022-3588

1. The Parties

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

The Respondent is Domain Administrator, Fundacion Privacy Services LTD, Panama.

2. The Domain Name and Registrar

The disputed domain name <indeedsodexo.com> is registered with Media Elite Holdings Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 28, 2022. On September 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 4, 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 October 6, 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 October 7, 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 October 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 7, 2022.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on November 14, 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 is a French company founded in 1966, active in over 50 countries in the sector of foodservices and facilities management. The Complainant claims to be one of the largest employers worldwide, with 421 000 employees serving daily 100 million consumers for a total consolidated revenue of EUR 17,4 billion (fiscal year 2021). The Complainant contends that, as a result of this activity, its “sodexo” and (earlier) “sodex’ho” brands have been continuously and extensively used and registered worldwide.

Amongst others, the Complainant owns several active semi-figurative and verbal SODEXO trademarks, including:

- French semi-figurative trademark No. 073513766 registered on July 16, 2007 in classes 9, 16, 35-45;
- International semi-figurative SODEXO trademark No. 964615, filed on January 8, 2008 under priority of the aforementioned French semi-figurative trademark n° 073513766;
- European Union verbal Trade Mark No. 008346462 registered on February 1, 2010 in classes 9, 16, 35-45; and
- International verbal SODEXO trademark No. 1240316, filed on October 23, 2014 under priority of the aforementioned European Union verbal Trade Mark No. 008346462.

The Complainant also operates the domain name <sodexo.com>, registered on October 9, 1998.

The disputed domain name was registered by Respondent on September 6, 2022. At the time of filing the Complaint, the disputed domain name was inactive.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its SODEXO well-known trademarks, as the disputed domain name fully incorporates the trademark. Additionally, the association with the adverb “indeed” does not suffice to distinguish the disputed domain name from the Complainant’s trademarks.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name registered after its trademarks, as the Respondent has not acquired trademark rights in the term “sodexo”, is not commonly known by the disputed domain name and has not been authorized, licensed or otherwise permitted by the Complainant to use or registered the term “sodexo”.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith as the Respondent must have known of the existence of the Complainant’s trademarks given their well-known reputation and character. As a result, the Respondent must have registered and used the disputed domain name for the purpose of creating confusion with the Complainant’s trademarks to divert or mislead third parties for the Respondent’s illegitimate profit. The Complainant further argues that the doctrine of passive holding does not prevent a finding of bad faith. Finally, the Complainant argues that bad faith use may also be inferred from the threat of an abusive use of the disputed domain name, as supported by the involvement of the Respondent in 141 WIPO UDRP proceedings.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must demonstrate that the disputed domain name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

On the basis of the evidence presented, it is established that the Complainant owns several SODEXO verbal and semi-figurative trademarks.

In the assessment of the identity or confusing similarity between the disputed domain name and the trademarks of the Complainant, figurative elements of the trademarks shall be disregarded, except where they constitute the dominant element of the trademark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.10; *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp*, WIPO Case No. [D2001-0031](#); *Dreamstar Cash S.L. c Brad Klarkson*, WIPO Case No. [D2007-1943](#)). The semi-figurative SODEXO trademarks of the Complainant have a dominant verbal element "sodexo" and thus constitute relevant trademarks for the purposes of this assessment.

The disputed domain name reproduces the Complainant's SODEXO verbal trademarks (and the verbal elements of the SODEXO semi-figurative trademarks), albeit with the addition of the term "indeed". Previous UDRP panels have consistently held that, in circumstances where the disputed domain name incorporates the entirety of a trademark or its dominant feature is recognizable, the disputed domain name will be considered confusingly similar to the trademark ([WIPO Overview 3.0](#), section 1.7; *Fondation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber*, WIPO Case No. [D2003-0251](#); and *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*, WIPO Case No. [D2017-0156](#)).

This finding of confusing similarity is not precluded by the addition of other terms ([WIPO Overview 3.0](#), section 1.8; *Intesa Sanpaolo S.p.A. v. Rampe Purda*, WIPO Case No. [D2010-1116](#); and *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. Mark Bolet*, WIPO Case No. [D2006-1245](#)).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's SODEXO trademarks and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, evidence of the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) may be established, in particular, by any of the following circumstances:

(i) prior to becoming aware of the dispute, the Respondent has used the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services, or made serious preparations to do so;

(ii) the Respondent is known by the disputed domain name in question, even without having acquired trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent to divert consumers for profit by creating confusion or to tarnish the trademark or service mark at issue.

Where the Complainant establishes *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production on this element is on the Respondent and it is up to the Respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain

name. If the Respondent does not provide such relevant evidence, the Complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

The Complainant establishes *prima facie* that the Respondent has no rights on SODEXO as a corporate name, trade name, trademark or domain name and that the Respondent has not been authorized, licensed or otherwise permitted by the Complainant to register or use said trademark or any corresponding domain name. The Complainant also establishes *prima facie* that the Respondent is not commonly known by the disputed domain name. In addition, given the inactivity of the disputed domain name, it appears that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not exercised its right to defend itself and has not asserted the existence of a legitimate use of the disputed domain name, so the Panel must conclude that the second condition of paragraph (4)(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides circumstances, in particular but without limitation, that shall be evidence of a disputed domain name being registered and in bad faith.

In addition to the circumstances provided in paragraph 4(b) of the Policy, the Panel may also consider special circumstances such as (i) the nature of the domain name (*e.g.*, a typo of a widely known mark, or a domain name incorporating the applicant's mark plus an additional term such as a descriptive or geographic term), (ii) a clear lack of rights or legitimate interests coupled with the absence of a credible explanation for the respondent's choice of domain name, or (iii) other *indicia* generally suggesting that the respondent has targeted the complainant in some way ([WIPO Overview 3.0](#), section 3.2.1).

On the basis of this provision, previous UDRP panels have already held on several occasions that the mere registration of a domain name that is identical or confusingly similar to a well-known or widely-known trademark by an unaffiliated entity may be sufficient to create a presumption of bad faith, as the respondent knew or should have known that its registration would be identical or confusingly similar to the complainant's trademark ([WIPO Overview 3.0](#), section 3.2.2).

The disputed domain name was registered on September 6, 2022, which is subsequent to the registration of the Complainant's SODEXO marks between 2007 and 2014. Previous UDRP panels have found that the Complainant's SODEXO trademarks are well-known (*see, e.g., Sodexo v Registration Private, Domains By Proxy, LLC / Caroline 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](#)). The Panel accepts that these elements create a presumption of bad faith on the part of the Respondent.

In addition, the website displayed at the disputed domain name is inactive. The Panel therefore considers that the Respondent has engaged in passive holding of the disputed domain name. In the presence of other relevant circumstances such as (i) the reputation of the Complainant's trademarks, (ii) the Respondent's lack of response, and (iii) the use of a privacy service, the Panel considers that these elements further reinforce a finding of bad faith ([WIPO Overview 3.0](#), section 3.3).

Further, the Complainant argues that the Respondent is frequently cited as respondent in UDRP Panel decisions, which order the transfer of the disputed domain name at issue. While the Panel cannot accept the argument following which this demonstrates a threat of abusive use of the disputed domain name by the Respondent, the Panel notes that it does support a finding of bad faith – due to the presence of a “Russian doll” scenario.

Indeed, the Panel notes that the registrant identity disclosed and cited as the Respondent appears to be yet

another privacy or proxy service ("Domain Administrator, Fundacion Privacy Services Ltd"). It is reasonable to infer that this behavior demonstrates an attempt to shield illegitimate conduct from UDRP proceedings, hence the Panel considers that this supports a finding of bad faith ([WIPO Overview 3.0](#), section 4.4.6).

For the reasons set out above, the Panel considers that the requirement of registration and use in bad faith of the disputed domain name set out in paragraph 4(a)(iii) of the Policy is satisfied.

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, <indeedsodexo.com> be transferred to the Complainant.

Benoit Van Asbroeck

Benoit Van Asbroeck

Sole Panelist

Date: November 28, 2022