

## ADMINISTRATIVE PANEL DECISION

Sodexo v. Name Redacted

Case No. D2022-4501

### 1. The Parties

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

The Respondent is Name Redacted.<sup>1</sup>

### 2. The Domain Name and Registrar

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

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 24, 2022. On November 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 29, 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 December 3, 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”).

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<sup>1</sup> The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).




In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 3, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on January 14, 2023. 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 worldwide known French company specialized in foodservices and facilities management.

The Complainant underwent a change of name in 2008 from "Sodexho" to "Sodexo" and is the owner of several trademarks, in particular the following trademarks (the "SODEXO Trademarks"):

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

The Complainant has also registered several domain names containing the SODEXO Trademarks including the following domain names <sodexo.com>, <sodexoprestige.co.uk> and <sodexo.fr>.

The Disputed Domain Name was registered on November 22, 2022, and at the time of the Complaint, it revolved to a pay-per-click parking page containing links to the Complainant's competitors' websites. At the time of the decision, the Disputed Domain Name is inactive.

The Respondent is trying to pass off as an employee of the Complainant by using this employee's name to register the disputed domain name.

#### 5. Parties' Contentions

##### A. Complainant

First, the Complainant states that the Disputed Domain Name is confusingly similar to a trademark to which it has rights. The Complainant points out that it is the owner of several SODEXO Trademarks and domain names. The Complainant highlights that it is renowned worldwide for its services provided under the SODEXO Trademarks. The Complainant notes that the Disputed Domain Name is composed of the identical sign SODEXO associated with the descriptive French word "énergie" ("energy" in English). The Complainant states that it is widely known that the addition of a generic or descriptive term to a mark will not alter the fact

that the Disputed Domain Name is confusingly similar to its SODEXO Trademarks. For the Complainant, the mere addition of the descriptive term “energie” is inoperative to distinguish it from its SODEXO Trademarks since the word mark SODEXO is a fanciful term and is dominant in the Disputed Domain Name. Moreover, the Complainant explains that the risk of confusion or association of the Disputed Domain Name is stronger given that one of its main services is about energy and maintenance. Therefore, there is a high chance that the public will believe that the Disputed Domain Name is linked to the Complainant or its group. Finally, the Complainant states that the Disputed Domain Name leads to a parking page with links to the service of its competitors.

Then, the Complainant states that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant notes that the Respondent is obviously impersonating one of its employees. The Complainant explains that it has not registered the Disputed Domain Name and has not played any part in its registration and subsequent use. Moreover, the Respondent is not commonly known by the Disputed Domain Name nor has any affiliation, association, sponsorship, or connection with the Complainant. The Respondent has also never been authorized to use the SODEXO Trademarks.

Finally, the Complainant states that the Disputed Domain Name was registered and is being used in bad faith. The Complainant explains that the sign SODEXO in its SODEXO Trademarks is purely fanciful, and nobody could legitimately choose this word or any variation thereof, unless seeking to create an association with the Complainant's activities. The Complainant points out the fact that given the well-known character and reputation of its SODEXO Trademarks, the Respondent perfectly knew that it had no rights or legitimate interests in the Disputed Domain Name. For the Complainant, the actual knowledge of the Respondent of its SODEXO Trademarks can be considered an inference of bad faith. For the Complainant, the Respondent is using the Disputed Domain Name by exploiting the confusion with its well-known SODEXO Trademarks to attract Internet users and to incite them to click on third-party commercial links. The Complainant states that this is an intentional attempt to attract users for commercial gain. The Complainant also notes the fact that the Disputed Domain Name redirects to a parking page with pay-per-click sponsored links which is evidence of bad faith registration. Finally, the Complainant underlines the fact that the Respondent has impersonated one of its employees to register the Disputed Domain Name which is another element demonstrating that the Respondent has registered and is using the Disputed Domain Name in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the SODEXO Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the Disputed Domain Name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

The Panel finds that the Disputed Domain Name is composed of:

- the SODEXO Trademarks;
- the descriptive term "energie" which means "energy" in English;
- a hyphen; and
- the generic Top-Level Domain ("gTLD") ".com".

According to prior UDRP panel decisions, it is sufficient that the domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of a word to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#); *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. [D2002-0615](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that, in this case, the mere addition of the descriptive term "energie" to the distinctive and well-known mark SODEXO included in the Disputed Domain Name does not prevent a finding of confusing similarity between the latter and the SODEXO Trademarks.

Moreover, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Finally, the Panel holds that the Disputed Domain Name is confusingly similar to the SODEXO Trademarks, and that the Complainant has established the first element of paragraph 4(a) of the Policy.

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

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Complainant has not given any license or authorization of any kind to the Respondent to use the SODEXO Trademarks. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, the Respondent has impersonated one of the Complainant's employees to register the Disputed Domain Name. Moreover, the Disputed Domain Name, at the time of the Complaint, revolved to a parking page containing pay-per-click sponsored links to the Complainant's competitors.

Moreover, the composition of the Disputed Domain Name, which incorporates the Complainant's SODEXO Trademarks with an additional word referring to one of the Complainant's sector of activities, carries an implied risk of confusion and/or association with the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have any rights to or legitimate interests in the Disputed Domain Name.

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

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's 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.

First, the Panel considers that it is established of the Complainant's SODEXO Trademarks were registered and used well before the registration of the Disputed Domain Name and that the Complainant is well known by its trademarks. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it wholly reproduces the SODEXO Trademarks.

Moreover, the Panel finds that the Disputed Domain Name, at the time of the Complaint, revolved to a parking pay with sponsored pay-per-click links to the services of the Complainant's competitors.

Additionally, the Respondent has used, without any authorization whatsoever, the identity of one of the Complainant's employees when registering the Disputed Domain Name. This is evidence that the Respondent knew of the Complainant's activities and trademarks.

Further, UDRP panel have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a 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](#)).

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

The current non-use of the Disputed Domain Name does not change the Panel's finding of the Respondent's bad faith.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

## **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 <energie-sodexo.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: January 24, 2023