

ADMINISTRATIVE PANEL DECISION

Sodexo v. JoseTres
Case No. D2023-1450

1. The Parties

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

The Respondent is JoseTres, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <sodexomim.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 2023, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2023 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 April 12, 2023.

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 April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on May 17, 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, a French company founded in 1966, specializes in food services and facilities management. It has 422,000 employees serving 100 million consumers in 53 countries including the United States. In 2022, its consolidated revenues reached EUR 21.1 billion with 44% of revenue attributed to the North America.

The Complainant has registered a number of SODEXO trademarks worldwide, including but not limited in the United States, where the Respondent resides, for instance:

- 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;
- European Union (“EU”) Trademark for SODEXO No. 008346462 registered on February 1, 2010 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 trademark, one of which is <sodexo.com> registered 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 April 1, 2023. At the moment of issuance of this decision, the disputed domain name does not resolve to an active website. However, according to the Complaint, the disputed domain name used to resolve to a website protected by a password and with an image of catering services on the background.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy have been satisfied. In particular, the Complainant asserts that:

(1) it is widely established and among others in the United States where the Respondent is located. The Complainant has strong rights in SODEXO trademark by virtue of its longstanding use and registration of the marks in a number of jurisdictions around the world. Previous UDRP panels found that SODEXO marks are well known. The disputed domain name is identical or confusingly similar to the Complainant’s SODEXO marks as it incorporates the Complainant’s registered SODEXO trademark entirely adding the letters “mim”. The letters “mim” are inoperative to distinguish it from the Complainant’s marks as in the disputed domain name, the SODEXO mark is dominant and keeps its individuality and attractive character;

(2) the Respondent has no rights or legitimate interests in the disputed domain name, as well as no rights in “Sodexo” as corporate name, trade name, shop sign, mark or domain name that would be prior to the Complainant’s rights in SODEXO. The Respondent was not commonly known by the disputed domain name. The Respondent does not have any affiliation, association, sponsorship or connection with the Complainant and has not been authorized, licensed or otherwise permitted by the Complainant or by any subsidiary or affiliated company to register the disputed domain name and to use it;

(3) the disputed domain name was registered in bad faith by the Respondent for the purpose of creating confusion with the Complainant's marks to divert or mislead third parties for the Respondent's illegitimate profit. The Respondent tries to make consumers believe that the disputed domain name connects to the Complainant's official website, by copying the Complainant's logo in its web page.

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

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the complainant has rights.

The Complainant has proved its rights in the SODEXO marks through trademark registrations 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.

With the Complainant's rights in SODEXO trademark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The disputed domain name is comprised of the words "sodexo" and "mim" combined with the generic Top-Level Domain ("gTLD") ".com". Thus, the Panel finds that the disputed domain name incorporates the Complainant's SODEXO trademark entirely.

Furthermore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's SODEXO trademarks. The Panel notes that addition of the word "mim" to the disputed domain name does not prevent the Complainant's trademark from being recognizable in the disputed domain name. Prior UDRP panels have recognized that confusing similarity is established for purposes of the Policy where the disputed domain name incorporates the complainant's trademark in its entirety. See [WIPO Overview 3.0](#), section 1.7.

The gTLDs, such as ".com" in this case, may be disregarded for purposes of comparison under the first element, as it is viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1.

For all of the above-mentioned reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark SODEXO and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

The Panel finds that because the disputed domain name is confusingly similar to the Complainant's 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 SODEXO trademarks in the disputed domain name, as well as not in any way affiliated with the Complainant. Furthermore, the evidence in the case file shows that the Respondent is not commonly known by the disputed domain name.

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 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).

With the evidence on file, it is undoubtedly established that the Respondent has no rights or legitimate interests in respect to the disputed domain name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third UDRP element, the Complainant is required to prove that the disputed domain name was registered and is being used in bad faith.

As the Panel established above, the Complainant's SODEXO trademarks were used in commerce well before the registration of the disputed domain name. 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 furthermore finds with a high degree of certainty that the Respondent knew of the Complainant's 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.

Moreover, according to the evidence in the case file it is clear to the Panel that the disputed domain name was related to a web page protected with a password, where the first page was composed of a picture of a restaurant and the Complainant's logo and an image of restaurant or catering services in the background, which only increases a risk of implied affiliation to the Complainant and its business. Therefore, the Panel believes that it is obvious that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the trademark SODEXO and very likely for the purpose of creating confusion with the Complainant's mark to divert or mislead third parties for the Respondent's illegitimate profit.

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.

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 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.

For the reasons set out above, the Panel concludes that the disputed domain name was registered and is being used in bad faith, within the meaning of 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 <sodexomim.com> be transferred to the Complainant.

/Ganna Prokhorova/
Ganna Prokhorova
Sole Panelist
Date: May 31, 2023