

## **ADMINISTRATIVE PANEL DECISION**

Sodexo v. Privacy Protection / chen, ciso  
Case No. D2022-3161

### **1. The Parties**

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

The Respondent is Privacy Protection, United States of America / chen, ciso, Israel.

### **2. The Domain Name and Registrar**

The disputed domain name <cibussodexo.bio> is registered with Sav.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 26, 2022. On August 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 26, 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 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 August 31, 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 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2022. The Respondent sent informal communications to the Center on September 6, 2022, and on September 9, 2022, offering to settle the dispute. The Respondent did not submit any formal response. The Center informed the Complainant of the two informal communications from the Respondent. The Complainant did not submit a request for suspension. Accordingly, the Center notified the parties that it would proceed to panel appointment on September 27, 2022.

The Center appointed Stefan Naumann as the sole panelist in this matter on October 3, 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 well-known French company specialized in food services and facilities management, that owns and operates numerous companies globally, including in Israel. The Complainant's subsidiary in Israel owns the domain name <cibus-sodexo.co.il>.

The Complainant owns European Union trademarks SODEXO (no. 006104657 and no. 008346462) filed respectively on July 16, 2007, and June 8, 2009, and International trademarks SODEXO (no. 964615 and no. 1240316) registered respectively on January 8, 2008, and October 23, 2014, for products and services in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45. The International trademarks designate 36 countries and the European Union, including numerous Middle Eastern and North African countries including Israel. The evidence submitted by the Complainant fully establishes that these rights are in effect and owned by the Complainant or its subsidiaries.

The disputed domain name was registered on April 9, 2022. The Complainant indicates and provides evidence that the disputed domain name directs to an inactive website.

The Respondent, initially a privacy protection service provider, was disclosed as an individual, with an address in Israel.

In cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed. Depending on the facts and circumstances of a particular case, *e.g.*, where a timely disclosure is made and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))), paragraph 4.4.5).

In the present case, disclosure of the underlying registrant occurred, and the record contains no indication of a relationship between the privacy protection service and the underlying registrant beyond the provision of privacy or proxy registration services. The underlying registrant sent the Center two informal communications offering to settle the dispute.

The Panel finds it appropriate that the case should proceed against the underlying registrant as the Respondent.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that its SODEXO marks are well known, that the disputed domain name is confusingly similar to the Complainant's trademarks, that the Respondent has no permission from the Complainant to use the Complainant's trademarks or apply for a domain name with the Complainant's trademarks, that the Respondent is not commonly known by and does not have a right or legitimate interest with respect to the disputed domain name in connection with a *bona fide* offer of goods and services, and that the Respondent registered and is using the disputed domain name in bad faith. The Complainant argues that although the disputed domain name leads to an inactive website, it fears a possible fraudulent use of the disputed domain name to perpetrate email scams.

## B. Respondent

The Respondent did not reply to the Complainant's contentions. The Respondent did send emails to the Center indicating "I have no problems to settle the dispute" and "Im [sic] willing to settle for 500\$".

## 6. Discussion and Findings

In order to succeed in its claim, the Complainant must demonstrate that all three elements listed in paragraph 4(a) of the Policy have been satisfied:

(i) the disputed domain name must be identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent must have no rights or legitimate interests with respect to the disputed domain name; and

(iii) the disputed domain name must have been registered and used in bad faith.

Paragraph 15(a) of the Rules provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Furthermore, paragraphs 10(b) and 10(d) of the Rules provide that a panel shall ensure that the parties are treated with equality and shall determine the admissibility, relevance, materiality, and weight of the evidence.

Paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, the Rules, a panel shall draw such inferences therefrom as it considers appropriate.

In the present matter the Respondent did not formally reply to the Complainant's contentions.

While the Respondent's failure to respond does not automatically result in a decision in favor of the Complainant, the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see [WIPO Overview 3.0](#), paragraph 4.3).

At the outset, the Panel first considers whether the Respondent's offer to settle moots the need to address the foregoing provisions.

A line of cases has addressed the issue of respondents' unilateral consent to transfer of contested domain names.

Paragraph 4.10 of [WIPO Overview 3.0](#) considers whether a UDRP panel can decide a case based on a respondent's consent to transfer of a contested domain name:

"Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the "standard settlement process" described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis).

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. Scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights.”

In *The Cartoon Network LP, LLLP v. Mike Morgan*, WIPO Case No. [D2005-1132](#), the panel observed that:

“A number of Panel decisions have considered the proper course where a respondent has unilaterally consented to transfer a disputed domain name to a complainant. There have been at least three courses proposed:

(i) to grant the relief requested by the Complainant on the basis of the Respondent's consent without reviewing the facts supporting the claim (see *Williams-Sonoma, Inc. v. EZ-Port*, WIPO Case No. [D2000-0207](#); *Slumberland France v. Chadia Acohuri*, WIPO Case No. [D2000-0195](#)); (ii) to find that consent to transfer means that the three elements of paragraph 4(a) are deemed to be satisfied, and so transfer should be ordered on this basis (*Qosina Corporation v. Qosmedix Group*, WIPO Case No. [D2003-0620](#); *Desotec N.V. v. Jacobi Carbons AB*, WIPO Case No. [D2000-1398](#)); and (iii) to proceed to consider whether on the evidence the three elements of paragraph 4(a) are satisfied because the Respondent's offer to transfer is not an admission of the Complainant's right (*Koninklijke Philips Electronics N.V. v. Manageware*, WIPO Case No. [D2001-0796](#)) or because there is some reason to doubt the genuineness of the Respondent's consent (*Société Française du Radiotéléphone-SFR v. Karen*, WIPO Case No. [D2004-0386](#); *Eurobet UK Limited v. Grand Slam Co*, WIPO Case No. [D2003-0745](#)).”

In *John Bowers QC v. Tom Keogan*, WIPO Case No. [D2008-1720](#), the panel noted that:

“As the panel held in *The Cartoon Network LP, LLLP v. Mike Morgan*, WIPO Case No. [D2005-1132](#); “A genuine unilateral consent to transfer by the Respondent provides a basis for an immediate order for transfer without consideration of the paragraph 4(a) elements. Where the Complainant has sought transfer of a disputed domain name, and the Respondent consents to transfer, then pursuant to paragraph 10 of the Rules the Panel can proceed immediately to make an order for transfer. This is clearly the most expeditious course (see *Williams-Sonoma, Inc. v. EZ-Port*, WIPO Case No. [D2000-0207](#))”

This approach has been followed in a number of other decisions: See, for example, *Valero Energy Corporation, Valero Refining and Marketing Company v. RareNames, WebReg*, WIPO Case No. [D2006-1336](#); *Nutri/System, IHPC, Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-0864](#); and *KBC Group N.V. and KBC Bank N.V. v. Bank Dir, Bankgroup*, WIPO Case No. [D2008-0446](#).

There may be circumstances where it is appropriate to proceed to a consideration of the merits of the Complaint, for example where it is desirable to make a public finding of bad faith against a serial cybersquatter who has repeatedly sought to avoid such a finding by timely concession (see *Brownells, Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1211](#) and *Messe Frankfurt GmbH v. Texas International Property Associates*, WIPO Case No. [D2008-0375](#)). It is clear that the panel has a discretion to consider the merits where appropriate, even if the respondent has consented to the relief sought by the complainant.”

In the present matter, the Panel considers that the Respondent's offer to settle, including its offer “to settle for 500\$”, does not amount to or constitute an unequivocal unilateral consent to transfer the disputed domain name, and thus does not stand in the way of a reasoned adjudication of the matter.

With the foregoing provisions in mind, the Panel finds as follows:

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

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain.

The disputed domain name combines the SODEXO trademark with the term "cibus", and the generic Top-Level Domain ("gTLD") ".bio". The term "sodexo" is a coined mark (without a common or dictionary meaning). The addition of the term "cibus" and of the gTLD ".bio" does not affect the fact that the disputed domain name incorporates and reproduces the Complainant's SODEXO trademarks. In this context, the Complainant argues that the term "cibus" meaning "food" in Latin, and the gTLD ".bio" increase the confusing similarity since (i) the Complainant and the Complainant's SODEXO marks are known for food services, (ii) consumers would understand the meaning of "cibus", and (iii) the gTLD ".bio" reinforces or gives the impression of link with organic food or food services.

The Panel considers that it does not need to rely on these additional considerations for the purpose of assessing similarity in the present matter because:

- the disputed domain name is confusingly similar to the Complainant's trademarks since the SODEXO trademarks are clearly recognizable in the disputed domain name notwithstanding the addition of the term "cibus", and
- a gTLD may be disregarded in assessing whether a domain name is identical or confusingly similar to a trademark, although it may be relevant to a determination of the other elements of the UDRP.

The Panel is satisfied that the disputed domain name is confusingly similar to the Complainant's trademarks for the purposes of the Policy.

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

The disputed domain name carries a clear risk of implied affiliation since consumers would expect to land on a website of the Complainant when typing in the Complainant's trademark SODEXO with a term that may be understood (or not) as the Latin word for food, but that may perhaps more likely be associated with the Complainant's subsidiary's domain name <cibus-sodexo.co.il> by consumers in Israel and other countries in the region.

The Respondent has chosen not to formally reply to the Complaint.

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, and finds no indication in the evidence that the Respondent could claim rights or legitimate interests of his own in the term "Sodexo" or the combination of terms "cibussodexo". Since the Respondent has no permission from the Complainant and chose not to respond on the merits, its registration of the disputed domain name, based on the evidence provided by the Complainant, is without rights or legitimate interests.

The Panel finds that in the present case the Respondent does not have any rights or legitimate interests with respect to the disputed domain name.

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

The Complainant argues that the Respondent knew or could not have ignored the Complainant's well-known SODEXO trademarks, and that the registration of the disputed domain name allows a finding of bad faith registration and use under the passive holding doctrine or a doctrine of threat of abusive use.

The Panel notes that the Respondent is domiciled in the Israel and finds that the Complainant's ubiquitous use of its SODEXO trademarks, and the use of the terms "cibus-sodexo" as domain name in Israel by the Complainant's local subsidiary, make it unlikely that the Respondent was or could have been unaware of the Complainant's SODEXO trademarks. These circumstances are sufficient to find bad faith registration.

Based on the evidence submitted by the Complainant, the Panel further finds that in the present matter the combination of the fanciful term "sodexo" with the word "cibus" (whether or not its Latin meaning would be understood) where the Respondent is domiciled in Israel and the Complainant's subsidiary in that country uses that specific combination for its domain name, constitute circumstances indicating that the Respondent's aim in registering the disputed domain name with the gTLD ".bio" was to profit from and exploit the Complainant's trademarks.

The record notably shows that:

- (i) the Respondent used a privacy protection service and is located in Israel,
- (ii) the Complainant's SODEXO trademarks have a reputation and are widely known, as evidenced by their use in numerous countries including in the Middle East and North Africa,
- (iii) the term "SODEXO" is a coined or fanciful mark that *prima facie* could not have been chosen because of a dictionary or common meaning, and
- (iv) the Respondent registered a domain name that fully incorporates the Complainant's trademarks and the Complainant's Israeli subsidiary's domain name, with a gTLD ".bio" that could or would be understood to refer to organic food when it is used in combination with the SODEXO trademarks.

In the present case, the Panel is thus persuaded that the overall circumstances of this case strongly suggest that the Respondent's registration of the disputed domain name was in bad faith.

As discussed in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), the relevant issue in determining whether passive holding constitutes bad faith use is whether under the circumstances of a case, it can be held that a respondent is acting in bad faith. In *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*, the panel noted that:

"[...] paragraph 4(b) recognizes that inaction (*e.g.* passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4(b) are 'without limitation' that is, paragraph 4(b) expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith."

"The question that then arises is what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behavior. A remedy can be obtained under the [Policy] only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith."

In the present matter, the record shows that:

- (i) the Complainant's SODEXO trademarks are well known, as evidenced by their substantial use;
- (ii) the disputed domain name reproduces the term "sodexo", which is not a common or dictionary word, and is confusingly similar to the Complainant's SODEXO trademarks; and

(iii) any website set up by the Respondent using the Complainant's SODEXO trademarks alone or in combination with another term would confuse and mislead Internet users, as does the disputed domain name leading to an inactive page at a gTLD ".bio".

These circumstances are sufficient to also find bad faith use based on the passive holding of the disputed domain name. The Panel thus does not need to reach the question of whether an abusive threat or threat of an abusive use could constitute valid grounds to find that a passive holding satisfies the bad faith use requirement.

In light of these specific circumstances, the Panel concludes that the Respondent's passive holding of the disputed domain name in the present matter also satisfies the bad faith use requirement of paragraph 4(a)(iii) of the Policy.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15 (e) of the Policy provides that if after considering the submissions a panel finds that a complaint was brought in bad faith, for example in an attempt at reverse domain name hijacking or was brought primarily to harass the domain name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

In *Jazeera Space Channel TV Station v. AJ Publishing aka Aljazeera Publishing*, WIPO Case No. D2005-0309, the majority of the three-member panel noted that the onus of proving that a complainant has acted in bad faith is on the respondent, and that mere lack of success of the complaint is not of itself sufficient to constitute reverse domain name hijacking. The majority in *Al Jazeera* noted that:

"Allegations of reverse domain name hijacking have been upheld in circumstances where a respondent's use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy (see *Goldline International, Inc v. Gold Line*, WIPO Case No. [D2000-1151](#)). See also *Deutsche Welle v. DiamondWare Limited*, WIPO Case No. [D2000-1202](#), where an allegation of reverse domain name hijacking was upheld in circumstances where the complainant knew that the respondent used the at-issue domain name as part of a bona fide business, and where the registration date of the at-issue domain name preceded the dates of the complainant's relevant trademark registrations."

In *Sydney Opera House Trust v. Trilynx Pty. Limited*, WIPO Case No. [D2000-1224](#), the panel found that to establish reverse domain name hijacking, the respondent must show knowledge on the part of the complainant of the respondent's right or legitimate interest in the disputed domain name and evidence of harassment or similar conduct by the complainant in the face of such knowledge.

The three-member panel in *Yell Limited v. Ultimate Search*, WIPO Case No. [D2005-0091](#), noted that whether a complainant should have appreciated at the outset that its complaint could not succeed will often be an important consideration for the purpose of assessing reverse domain name hijacking.

In the present matter, (i) the Complainant's trademarks are a fanciful or coined, and are older than the disputed domain name, and (ii) except for a hyphen, the disputed domain name reproduces the domain name of Complainant's subsidiary in the country of residence of the Respondent, so that Complainant could reasonably have considered that its claim could succeed on all three elements of paragraph 4 (a) of the Policy.

For the sake of completeness, the Panel therefore finds that the facts, evidence and possible inferences in the present matter do not support a finding of reverse domain name hijacking.

## 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 <cibussodexo.bio> be transferred to the Complainant.

*/Stefan Naumann/*

**Stefan Naumann**

Sole Panelist

Date: October 17, 2022