

ADMINISTRATIVE PANEL DECISION

SODEXO v. Peter C Foy, “Sodexo”

Case No. D2022-3643

1. The Parties

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

The Respondent is Peter C Foy, “Sodexo”, United States of America.

2. The Domain Name and Registrar

The disputed domain names <sodexo.network> and <sodexo.solutions> are registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2022. On October 3, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended 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 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. On October 21, 2022, the proceeding was suspended, and reinstated on October 27, 2022. The new response due date was November 5, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on November 7, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on December 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

The Complainant, a French company founded in 1966, previously called SODEXHO ALLIANCE, is one of the largest companies in the world specialized in foodservices and facilities management, with 412 000 employees serving 100 million consumers in 56 countries.

The Complainant provides a wide range of services under its trademark SODEXO (previously SODEXHO) through an offer of on-site services, benefit and reward services, as well as personal and home services.

The Complainant is well-known in the food services and facilities management market, also the Complainant owns and operates numerous companies globally.

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) SODEXHO brands have been continuously and extensively used and registered worldwide.

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

- SODEXO and design, International trademark registration no. 964615, filed on January 8, 2008 under priority of the French trademark registration no. 073513766 of July 16, 2007, renewed in 2018, in International Classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, and 44, and designating numerous jurisdictions;

- SODEXO, International trademark registration no. 1240316 filed on October 23, 2014, registered on February 2, 2021, in International Classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45, and designating numerous jurisdictions;

- SODEXO, European Union Trade Mark registration filed on June 8, 2009, registered on February 1, 2010 under no. 008346462, renewed in 2019 in International Classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;

- SODEXO and design, European Union Trade Mark registration filed on July 16, 2007, registered on June 27, 2008 under no. 006104657, renewed in 2017, in International Classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;

- SODEXHO and design, International trademark registration no. 689106 filed on January 28, 1998 based on the French trademark registration no. 96654774 of December 10, 1996, renewed in 2018, in International Classes 16, 36, 37, 39, 41, and 42, and designating numerous jurisdictions;

- SODEXHO and design, International trademark registration no. 694302 filed on June 22, 1998 under priority of the French trademark registration no. 98714920 of January 27, 1998, renewed in 2018, in International Class 9, and designating numerous jurisdictions.

The evidence submitted by the Complainant fully establishes that these rights are in effect and owned by the Complainant or its subsidiaries.

The trademark SODEXO is used in connection with the following activities intended to improve the quality of daily life as shown in the Complainant's website: "www.sodexo.com/home/services.html".

The Complainant also owns numerous domain names corresponding to and/or containing SODEXO or SODEXHO trademarks, including: <sodexo.com>, <uk.sodexo.com>, <sodexoprestige.co.uk>, <sodexo.fr>, <sodexoca.com>, <sodexousa.com>, <cn.sodexo.com>, <sodexho.fr>, and <sodexho.com>.

The disputed domain name <sodexo.solutions> was created on September 9, 2022 does not resolve to an active website but rather to an Internet browser malicious website warning page. This page is written in French and alerts on the connection to a malicious website. The connection is avoided due to the fact that to the antivirus software installed on the computer. The paragraph can be translated as follows: "The Web site you are about to open is deceptive. Malicious individuals at work on the <sodexo.solutions> website could trick you into performing dangerous actions, such as installing software or disclosing personal information (e.g., passwords, phone numbers or credit card numbers)."

The disputed domain name <sodexo.network> was created on September 9, 2022 and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant argues that both of the disputed domain names are confusingly similar to its trademarks SODEXO. Due to the fact that both disputed domain names include the trademarks SODEXO in its entirety, with the only difference of the generic Top-Level Domains ("gTLDs") ".network" and ".solutions". Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain names, and, finally, that the Respondent registered and is using the disputed domain names in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The test that the Panel must carry out for both disputed domain names in order to establish if they are identical or confusingly similar involves a comparison between a trademark in which the Complainant has rights and the disputed domain names.

The Panel is satisfied that the Complainant has established its trademark rights in the SODEXO trademark in many jurisdictions.

Regarding whether the disputed domain names are identical or confusingly similar to the SODEXO trademark, this Panel observes that both disputed domain names compromise the trademark SODEXO in the following form: (a) the Complainant's trademark SODEXO it is entirely in both disputed domain names; (b) followed by the gTLDs ".network" and ".solutions".

In conclusion, the disputed domain names include the trademarks SODEXO in its entirety with the only difference of the gTLDs.

It is well established that where a domain name incorporates a complainant's trademark in its entirety, the domain name will be normally considered identical or confusingly similar to that trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The addition of the gTLDs ".network" and ".solutions" is viewed as a standard registration requirement and therefore may be disregarded when determining the confusing similarity between the trademarks and the disputed domain names. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.2. The practice of disregarding the gTLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new gTLDs"); the ordinary meaning ascribed to a particular gTLD would not necessarily impact assessment of the first element.

In this case, when disregarding the gTLDs, both disputed domain names are identical to the Complainant's SODEXO trademark. Therefore, the Panel finds that the disputed domain names are identical to the Complainant's trademark for the purposes of the first element.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

(i) before any notice to it 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 has been commonly known by the domain name, even if it 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.

Even though the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#) that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant allegations and evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent does come forward with arguments or evidence proving its rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not commonly known by the disputed domain names or the trademark SODEXO. The Respondent has not been authorized by the Complainant to register or use the trademark SODEXO in conjunction or separately in any way, including the disputed domain names. The website and the use of the disputed domain names does not show any *bona fide* offering of goods or services.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been refuted by the Respondent.

In the present case, the Panel has the view that the use of the disputed domain names to resolve to inactive websites does not constitute a *bona fide* offering goods or services or legitimate noncommercial or fair use by the Respondent within paragraphs 4(c)(i) and (iii) of the Policy.

Regarding paragraph 4(c)(ii) of the Policy, the Panel notes that there is no evidence that the Respondent has been commonly known by the term “sodexo” or the disputed domain names. While the Panel notes that the Respondent has listed “Sodexo” as the registrant organization for the registration of the disputed domain name, there is nothing in the record to suggest that the Respondent is actually commonly known by “sodexo” or the disputed domain names. Rather the circumstances of the case, including the composition and use of the disputed domain names and reputation of the Complainant, suggest that the Respondent has sought to impersonate or falsely suggest an affiliation with the Complainant – likely in connection to a fraudulent scheme.

In this case, the Panel finds that the Complainant has made out a *prima facie* case for both disputed domain names. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. Furthermore, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the SODEXO trademark. That the Complainant does not have any type of business relationship with the Respondent.

Moreover, the Panel finds that the identical nature of the disputed domain name carries a high risk of implied affiliation and that such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant, see [WIPO Overview 3.0](#), section 2.5.1.

Considering all of the above circumstances, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of both disputed domain names.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in both of the disputed domain names. In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

This Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith pursuant to paragraph 4(b) of the Policy. In order to prevail under the Policy, the Complainant must demonstrate that both disputed domain names have been registered and are being used in bad faith, accordingly it is a cumulative requirement.

The Panel is satisfied that the Respondent must have been aware of the Complainant’s trademark SODEXO when it registered the disputed domain names as both of the disputed domain names contain the Complainant’s widely known trademarks in its entirety.

Furthermore, the SODEXO trademark is unique to the Complainant. The terms SODEXHO or SODEXO (both Complainant’s trademarks) are not commonly used for food services. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the disputed domain names, without the intention of invoking a misleading association with the Complainant. A factor indicating bad faith, see [WIPO Overview 3.0](#), section 3.2.2 and the cases referenced therein.

Also, from all the available evidence, the disputed domain names were registered long after the Complainant attained registered rights in the Complainant’s trademarks. Previous UDRP panels have consistently found that registration of a domain name that is confusingly similar to a widely known trademark, as it is the present case in both disputed domain names, can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

The Panel accepts the Complainant’s submissions that the trademark SODEXO is a distinctive, creative term and that it is obvious that the Respondent registered the disputed domain names with the intention of referring to the Complainant’s trademarks and the associated services.

Furthermore, the disputed domain names, which has been recently created, do not presently resolve to active websites. In this regard, the Panel notes that passive holding of a domain name does not prevent a finding of bad faith. *Cf. Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Novo Nordisk A/S v. CDMS Invest*, WIPO Case No. [D2012-0676](#), in which the panels found that passive holding, under the totality of circumstances of the case, can indeed constitute a bad faith use under the Policy. In this regard, the [WIPO Overview 3.0](#), section 3.3 states:

“While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (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.”

Here, the Panel notes that the Complainant’s trademark is distinctive and well-known around the world, the Respondent has not submitted any response or provided any evidence of possible good faith use, the Respondent has apparently used false registration details to suggest an affiliation with the Complainant, and the Panel is unable to consider any plausible good faith use to which the identical disputed domain names may be put.

In summary, this Panel finds that the Respondent, by choosing to register and use of the disputed domain names, which are identical to the Complainant’s well-known trademark, in the absence of convincing evidence and rebuttal to the contrary from the Respondent, the choice of the disputed domain names and the conduct of the Respondent are indicative of registration and use of the disputed domain names in bad faith.

Moreover, factors in the case, such as the Internet browser malicious website warning page associated with the disputed domain name <sodexo.solutions> and false registration details, suggest the Respondent may have engaged or is preparing to engage in fraudulent activities impersonating the Complainant. For example, the disputed domain names may be actively used for email services, *i.e.* for sending emails, which could include the Complainant’s trademark or name for fraudulent purposes. Such use of the disputed domain name could only be observed as clear evidence of the Respondent’s bad faith, see, in particular, sections 3.1.4 and 3.4 of the [WIPO Overview 3.0](#). In any event, the identical disputed domain names represent an abusive threat hanging over the Complainant and, absent explanation from the Respondent, further support an inference of bad faith in this context.

The Panel therefore finds that both disputed domain names have been registered and are being used in bad faith. Therefore, the Panel sustain that the Complaint fulfils the third condition of paragraph 4(a) 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 names <sodexo.network> and <sodexo.solutions> be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: December 20, 2022