

ADMINISTRATIVE PANEL DECISION

Sodexo v. Oformi Midamesi

Case No. D2022-3844

1. The Parties

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

The Respondent is Oformi Midamesi, Côte d'Ivoire.

2. The Domain Name and Registrar

The disputed domain name <buyb2b-sodexo.com> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 13, 2022. On October 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 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 17, 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 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 21, 2022.

The Center appointed C. K. Kwong as the sole panelist in this matter on November 30, 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, SODEXO (a French company) is the owner of numerous trademarks consisting of or comprising the word “SODEXO”. These registrations include:

1. International Trademark Registration No. 964615 for the mark SODEXO and device filed on January 8, 2008 claiming a priority date of July 16, 2007 based on its corresponding French trademark registration in respect of goods and services under International Classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45 with protection extended to, *inter alia*, Iceland.
2. International Trademark Registration No. 1240316 for the word mark “SODEXO” filed on October 23, 2014 in respect of goods and services under International Classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

The evidence produced by the Complainant shows its first registration for the mark “SODEXO” well before the first registration of the disputed domain name <buyb2b-sodexo.com> on October 4, 2022.

The disputed domain name resolves to a website which is inactive.

Other than the particulars shown in the printout of the database searches conducted by the Complainant on the Whois Database (as provided in Annex 1 to the Amended Complainant) and the inactive link as shown on the screen capture provided on page 12 of the Amended Complaint and the information disclosed in Annex 13 of the Amended Complaint, there is no evidence concerning the background of the Respondent and its businesses or activities.

The Complainant uses the domain names <sodexo.com>, <uk.sodexo.com>, <sodexoprestige.co.uk>, <sodexo.fr>, <sodexoca.com>, <sodexousa.com>, <cn.sodexo.com>, to operate websites for offering and promoting their goods and services bearing the SODEXO trademark or with reference to the SODEXO trademark.

5. Parties' Contentions

A. Complainant

The Complainant has made the following contentions.

The Complainant, SODEXO (a French company) was established in 1966. It is specialized in food services and facilities management, with 412,000 employees serving 100 million consumers in 56 countries on a daily basis. The Complainant's consolidated revenue reached EUR17.4 billion in 2021, with 39% of its revenue from North America, 42% from Europe and 19% from Asia-pacific, Latin America, Middle East and Africa.

The SODEXO trademark is continuously and extensively used and registered worldwide including the trademarks SODEXO and SODEXO with device as set out in Section 4 above. It operates numerous websites to which its domain names, including <sodexo.com>, resolve to promote one-site services, benefits and rewards services, personal and home services which are intended to improve the quality of daily life.

SODEXO mark has a strong reputation and is widely known all over the world, as recognized in various WIPO UDRP decisions.

The main element in the disputed domain name is the word “SODEXO” which is identical to the Complainant's mark. Additions of the English word “Buy” and the abbreviation “b2b” which means business to business, are unable to distinguish the disputed domain name from the Complainant's SODEXO trademark. The expression “buy b2b” will mislead the public to believe that the disputed domain name comes from the Complainant or is linked to it in so far as the Complainant, provides many b2b services.

The disputed domain name has been used in an attempt to defraud the Complainant's client as shown in the exchange of emails which are produced as Annex 13 to the Amended Complaint. The name of a former employee of the Complainant was used in an email using the email address of "[email address]@buyb2b-sodexo.com" which is based on or embodies the disputed domain name. That email was sent to the Complainant's client purporting to place an order for 600 laptops when in fact the Complainant had not. Furthermore, the identity of the same employee was falsely used in various occasions as discussed in the following WIPO UDRP cases:

(a) *Sodexo v. Withheld for Privacy Purposes, Privacy service Provided by Withheld for Privacy ehf/Name Redacted*, WIPO Case No. [D2021-2041](#) <b2b-sodexo.com>

(b) *Sodexo v. Privacy Service Provided by Withheld for Privacy ehf/Name Redacted*, WIPO Case No. [D2022-1436](#) <fr-sodexo.com>

(c) *Sodexo v. Privacy Service Provided by Withheld for Privacy ehf/Name Redacted*, WIPO Case No. [D2022-1702](#) <achat-sodexo.com>

The Complainant fears that the Respondent will repeat in perpetrating recurrent attempts to defraud the Complainant's clients and other third parties, using the disputed domain name in email scams.

The Respondent has no right in and is not commonly known by the disputed domain name. The Respondent is unknown to the Complainant. It has no affiliation, association, sponsorship or connection with the Complainant. The Complainant has not authorized, licensed or otherwise permitted the Respondent to register and use the disputed domain name.

SODEXO is a fancy word which nobody could legitimate choose to use whether alone or in combination with other elements or in forms of variation without an intention to create an impression of connection with the Complainant or its trademark SODEXO.

Given the reputation and well-known status of the Complainant's mark SODEXO, the Respondent should know of the Complainant's SODEXO mark at the time of registration of the disputed domain name, with knowledge that it has no right or legitimate interest in the disputed domain name.

The Respondent is using the disputed domain name as a tool to falsely impersonate the Complainant to mislead third parties in its attempt to obtain commercial gain.

B. Respondent

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

6. Discussion and Findings

A. The naming of party and notice of proceedings

The Whois Lookup search results provided in Annex 1 to the Amended Complaint showed the name/Admin name/Tech name of the original registrant as Withheld for Privacy ehf of Iceland.

The answers provided by the Registrar to the Center on October 14, 2022 in response to the Center's request for Registrar Verification disclosed the identity of the current Registrant of the disputed domain name as Oformi Midamesi of Côte d'Ivoire.

The Complainant accordingly filed an Amended Complaint to identify and replace the former registrant with Oformi Midamesi on October 17, 2022 following the said verification particulars provided by the Registrar.

On October 31, 2022, the Center forwarded the Notification of Complaint and Commencement of Administrative Proceedings to the contact details of the Respondent, including those found in the Amended Complaint, Whois, and Registrar Verification. The said notification was sent by post/courier and email as per the contact particulars so provided with copies to the Registrar.

In the circumstances, the Panel finds that the proper Parties to these proceedings have been named and notified. As long as the Complainant or the Center as the case may be communicated with the Respondent using the contact information which the Respondent have chosen to provide to the Registrar as reflected in the above contact details, their respective notice obligations will be discharged and the Respondent is bound accordingly.

The Panel is satisfied that the Center has discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint and that the failure of the Respondent to furnish a reply is not due to any omission or inadequate communication by the Center.

B. The Three Elements

In rendering its decision, the Panel must adjudicate the dispute in accordance with paragraph 15(a) of the Rules which provides that, “the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 14(b) of the Rules further provides that, “[i]f a Party, in the absence of exceptional circumstances, does not comply with any provisions of, or requirement under, these Rules or any requests from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate”. Paragraph 5(e) of the Rules further provides that, “if a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint”.

The failure of the Respondent to respond does not automatically result in a favourable decision for the Complainant, which is specifically required under paragraph 4(a) of the Policy to establish each of the three elements as provided therein. See *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) and *Berlitz Investment Corp. v. Stefan Tincuiescu*, WIPO Case No. [D2003-0465](#).

The said three elements are considered below.

1. Identical or Confusingly Similar

On the evidence available, the Panel has no hesitation in finding that the Complainant has rights in the trademark SODEXO by reason of the trademark registrations recited in Section 4 above.

Furthermore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark SODEXO.

The dominant or principal component of the disputed domain name is the Complainant's SODEXO trademark. Despite additions of the indistinctive expressions “BuyB2B” as prefixes and followed by the generic Top-Level Domain (“gTLD”) “.com”, the Complainant's SODEXO mark remains clearly recognizable in the disputed domain name.

It is well-established practice to disregard the gTLD part of a domain name, such as “.com”, when assessing whether a domain name is identical or confusingly similar to the mark in issue. *Société Anonyme des Eaux Minérales d'Evian and Societe des Eaux de Volvic v. Beroca Holdings B.V.I. Limited*, WIPO Case No. [D2008-0416](#).

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy is established.

2. Rights or Legitimate Interests

The Complainant needs to establish a *prima facie* case showing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). Once such *prima facie* case is made, the burden will shift to the Respondent to prove that it has rights or legitimate interests in the disputed domain name.

The Complainant has confirmed that it has not authorized, licensed, or permitted the Respondent to use the mark SODEXO.

There is no explanation on the record as to why it was necessary for the Respondent to adopt the term “sodexo” in the disputed domain name. In fact, the evidence in Annex 13 shows an attempted fraud by impersonating the Complainant and its former employee.

There is no evidence before the Panel to suggest that the Respondent is commonly known as <buyb2b-sodexo.com>.

There is also no evidence available to demonstrate any legitimate noncommercial or fair use of the disputed domain name by the Respondent. The Complainant has put forward a very strong *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Accordingly, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name.

3. Registered and Used in Bad Faith

The Complainant has filed for registration of its SODEXO trademark since at least 2008 as claimed in the aforesaid International Trademark Registration and has been using it long before the registration of the disputed domain name by the Respondent.

The Complainant has made a serious allegation that there was an attempt by someone using the name of its retired employee having an email address of “[email address]@buyb2b-sodexo.com” for correspondence and invoice as described in Annex 13 to the Amended Complaint. There is a strong case for the named Respondent to come forward to defend the case. Notwithstanding that, the named Respondent has not come forward with any defense on its choice of embodying the word “sodexo” as part of the disputed domain name and adopting the word “sodexo”, which entirely incorporates the Complainant’s word mark SODEXO as registered and used by the Complainant in their official website under various domain names including <sodexo.com>.

It is also noted that the Registrar and the original registrant of the disputed domain name are the same as the registrar and registrant of the three disputed domain names which embodied the Complainant’s trademark SODEXO, namely, (1) <b2b-sodexo.com> in WIPO Case No. [D2021-2014](#), (2) <fr-sodexo.com> in WIPO Case No. [D2022-1436](#) and (2) <achat-sodexo.com> in WIPO Case No. [D2022-1702](#), under which the respective Administrative Panels ordered the transfers of those domain names to the Complainant.

The incorporation of the rather unique distinctive invented word “sodexo” as part of the disputed domain name without any explanation under the above circumstances and the prior substantial use of the Complainant’s SODEXO mark lead to the conclusion that the Respondent must have been aware of the existence of the Complainant and its trademark SODEXO at the time of the registration of the disputed domain name.

Although the disputed domain name resolves to an inactive website, as discussed in [WIPO Overview 3.0](#), section 3.3, it does not prevent a finding of bad faith. Furthermore, the disputed domain name has also been used in the context as described above as shown in Annex 13 to the Amended Complaint.

The Panel finds that the circumstances under paragraph 4(b)(iii) and (iv) of the Policy have been established. Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith under 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 <buyb2b-sodexo.com> be transferred to the Complainant.

/C. K. Kwong/

C. K. Kwong

Sole Panelist

Date: December 23, 2022