

ADMINISTRATIVE PANEL DECISION

Sodexo v. Bob Sakayama, TNG/Earthling, Inc.
Case No. D2022-4814

1. The Parties

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

The Respondent is Bob Sakayama, TNG/Earthling, Inc., United States of America.

2. The Domain Name and Registrar

The disputed domain name <sodexocommunity.com> (the “Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 15, 2022. On December 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 15, 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 (See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 15, 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 19, 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 December 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2023. The Respondent did not submit a formal response. The Respondent informally emailed the Center on December 21, 2022. Accordingly, the Center notified the Respondent of the Commencement of Panel Appointment Process on January 11, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on January 16, 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 French company. Founded in 1966, it is one of the largest companies in the world specializing in foodservice and facilities management with 422,000 employees serving daily 100 million consumers in 64 countries. The Complainant's consolidated revenues in 2022 reached 21.1 billion euros.

From 1966 to 2008, the Complainant promoted its business under the mark and trade name SODEXHO, which in 2008 was simplified to SODEXO. The Complainant owns registered trademark rights for the SODEXO word mark and for various combined word and logo marks that incorporate the mark SODEXO in many countries. See for example European trademark registered on February 1, 2010 registered under No. 008346462. These trademarks are referred to as the SODEXO trademark in this decision.

The Complainant owns <sodexo.com> and various other domain names corresponding to or including the term SODEXO and promotes its activities via websites linked to such domain names.

The Disputed Domain Name was registered by the Respondent on May 18, 2017 after its previous owner allowed its registration to lapse. It now resolves to a website (the "Respondent's Website") which contains a copy of archived material from around 2011 which describes itself as follows "In 2010 / 2011 SodexoCommunity.com was a meeting place for employees, customers, and community members to learn and share their experiences about Sodexo's new initiatives, community involvement, and great stories about our people". This is followed by several pages of text dating from 2011 or so which describe individual employees' positive experiences working for the Complainant. Following receipt of the Complaint the Respondent has added a prominent disclaimer to the Respondent's Website which states "if you have inadvertently ended up here while doing a search for Sodexo, go to their current website at <https://us.sodexo.com/home.html>".

5. Parties' Contentions

A. Complainant

The Complainant case can be summarized as follows

The Disputed Domain Name is identical to or confusingly similar to the Complainant's trademark SODEXO, which is entirely incorporated in the Disputed Domain Name with the addition of the generic or descriptive dictionary word "community".

The Respondent has no rights nor legitimate interests in the Disputed Domain Name as he has no rights in SODEXO as corporate name, trade name, shop sign, mark or domain name that would be prior to the Complainant's rights on SODEXO.

The Respondent was not commonly known by the Disputed Domain Name prior to the adoption and use by the Complainant of the corporate name, business name and mark SODEXO / SODEXHO. Moreover, 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.

The Complainant's trademark SODEXO is purely fanciful and well-known worldwide as previous UDRP decisions already recognized. The unauthorized registration of the Disputed Domain Name by the Respondent and its use linking it to a website which gives the impression it is an official Sodexo website constitute bad faith registration and use.

B. Respondent

The Panel will exercise its discretion and treat the Respondent's email of December 21, 2022 to the Center as its Response. It reads as follows:

"We very recently became aware that there is a dispute regarding our ownership of the domain sodexocommunity.com, which is one of many expired domains that we legally purchased and restored using publicly available information from archive.org. There is no intent to defraud or infringe upon any rights held by any party. To make this more clear we added, "If you have inadvertently ended up here while doing a search for Sodexo, go to their current website at: <https://us.sodexo.com/home.html>" to avoid any hint that we are attempting to mislead.

The only reason we were able to purchase this domain is that the previous owner failed to renew it on time and allowed it to expire. Your strong arm tactics to recover it are distasteful and unnecessary.

Since our domain purchases are intended as investments, we are happy to entertain an offer to purchase this domain from us".

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

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

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of the SODEXO trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable within the disputed domain name, the disputed domain name is considered to be confusingly similar to the mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

It is also established that the addition of a term (such as here "community") to a disputed domain name would not prevent a finding of confusing similarity between the domain name and the mark ([WIPO Overview 3.0](#) at section 1.8).

It is also well established that the Top-Level Domain ("TLD"), in this case ".com", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#) at section 1.11.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

The Panel finds the SODEXO trademark is, on the evidence before the Panel, a term in which the Complainant has developed a significant reputation. It is also a term which has no meaning other than in relation to the Complainant.

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, 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 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.

The Respondent in effect says (i) applies. The Panel accepts the Respondent's statement that it is in business selling domain names. The Panel considers that the offering for sale of a domain name which comprises a generic or descriptive term, with no intent to target a complainant, may establish a legitimate interest. The Panel agrees with the approach taken to this issue in *X6D Limited v. Telepathy, Inc.*, WIPO Case No. [D2010-1519](#) where the panel stated as follows:

"Due to the commercial value of descriptive or generic domain names it has become a business model to register and sell such domain names to the highest potential bidder. Such a practice – including the sale of the domain name – has been found to constitute use of the domain name concerned in connection with a bona fide offering of goods or services provided that the registration of the domain name was not undertaken with intent to profit from or otherwise abuse a complainant's trademark rights." [emphasis added]

The difficulty here for the Respondent is that the Disputed Domain Name clearly does target the Complainant and is not merely a generic or descriptive term. Its value lies in the fact that it contains the Complainant's SODEXO trademark which has no meaning save in relation to the Complainant. The Panel considers that the re-registration of a lapsed domain name with an intent to resell that domain name does not confer a legitimate interest where the domain name is likely to be of value because it includes a specific trademark. That is the case here.

Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 your documented out-of-pocket costs directly related to the

domain name; or

- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Respondent has not explained the detail of how it acquired the Disputed Domain Name or what enquiries it made at that time. In the absence of any such explanation the Panel will assume that it is more likely than not that the Respondent properly considered what it was acquiring and must as a result have been aware that the term "Sodexo" related to the Complainant, given that term has no other meaning. The fact that the Respondent subsequently linked the Disputed Domain Name to a website containing archived material relating to the Complainant confirms the Respondent's knowledge.

The re-registration of lapsed domain names is a common practice. If the domain name is generic or descriptive or has many possible meanings then such a registration, if made without intent to target a trademark owner, is likely to be unobjectionable. The position is, however, different if the domain name at issue is clearly referable to a particular trademark and/or its owner. In this regard, see *Theodoor Gilissen Bankiers N.V. v. AbdulBasit Malaani*, WIPO Case No. [D2013-1229](#) where the Panel stated "...the Respondent committed bad faith registration and use when it intentionally registered the disputed domain name, shortly after the original registration of which had lapsed, knowing that the disputed domain name includes the mark of the Complainant and is thus identical to that mark so as to cause confusion with it. Thus, the Respondent's conduct also reflects bad faith registration and use under the general bad faith provisions of paragraphs 4(a)(iii) and 4(b) of the Policy".

In the present circumstances, the Panel agrees with that approach and considers the Respondent acquired the Disputed Domain Name because of its connection with, and likely value to, the Complainant. In this regard the Panel also notes the Respondent's statement in its email to the Center (above) that "Since our domain purchases are intended as investments, we are happy to entertain an offer to purchase this domain from us" - which in the Panel's opinion confirms the Respondent's motivation.

The Panel does not consider that the disclaimer on the Respondent's Website alters this analysis (assuming in the Respondent's favour that it is the current version of the Respondent's Website, which is to be considered). The Panel accepts the disclaimer is prominent and makes clear the Respondent's Website is unconnected with the Complainant. In some factual circumstances, a website disclaimer may be relevant. In the present case, however, it seems to the Panel that the disclaimer is not relevant to the Respondent's intent with regard to the Disputed Domain Name, as analysed above. In this regard the Panel adopts the consensus view set out in paragraph 3.5 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("[WIPO Overview 2.0](#)"), which states as follows:

"What is the role of a disclaimer on the web page of a disputed domain name?"

Consensus view: The existence of a disclaimer cannot by itself cure bad faith, when bad faith has been established by other factors. A disclaimer can also show that the respondent had prior knowledge of the complainant's trademark. However a disclaimer, especially if it is sufficiently clear and prominent, may sometimes be found to support other factors indicating good faith or legitimate interest."

The Panel does not consider in the present case that there are other factors indicating good faith, rights or legitimate interests which are supported by the disclaimer.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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, <sodexocommunity.com> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: January 30, 2023