

## **ADMINISTRATIVE PANEL DECISION**

Sodexo v. Compass Adm, COMPASS GROUP

Case No. D2023-5169

### **1. The Parties**

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

The Respondent is Compass Adm, COMPASS GROUP, Brazil.

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

The disputed domain name <sodexoonsite.com> is registered with Squarespace Domains II LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 12, 2023. On December 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 13, 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 (Contact Privacy Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 15, 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 December 18, 2023.

On December 15, 2023, the Center informed the parties in Portuguese and English, that the language of the registration agreement for the disputed domain name is Portuguese. On December 15, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2024.

The Center appointed Gonçalo M. C. Da Cunha Ferreira as the sole panelist in this matter on January 18, 2024. 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 (previously named Sodexo Alliance) founded in 1966 and is specialized in food services and facilities management. The Complainant is one of the largest employers worldwide with 430,000 employees serving 80 million consumers in 45 countries. The Complainant is listed as one of "The world's Most Admired Companies" by Fortune Magazine.

For fiscal year 2023, consolidated revenues reached EUR 22,6 billion euros which represent by region: 46% North America, 36 % Europe, and 18 % for the rest of the world.

The Complainant owns, among others, the following registered marks for SODEXO:

- Brazilian trademark registration n° 829531874 in international class 9, registered on March 17, 2015.
- Brazilian trademark registration n° 829531866 in international class 16, registered on March 17, 2015.
- Brazilian trademark registration n° 829531815 in international class 35, registered on March 17, 2015.
- International trademark registration n° 964615 registered on January 8, 2008 under priority of the French trademark registration n° 073513766 of July 16, 2007, in international classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45 protected in the following countries: Armenia, Australia, Azerbaijan, Bosnia and Herzegovina, Bahrain, Belarus, Switzerland, China, Algeria, Egypt, European Union, Islamic republic of Iran, Iceland, Israel, Japan, Kyrgyzstan, Democratic People's Republic of Korea, Republic of Korea, Kazakhstan, Lesotho, Morocco, Monaco, Republic of Moldova, Montenegro, Mongolia, Republic of Namibia, Norway, Serbia, Russian Federation, Singapore, Türkiye, Ukraine, United States of America, Uzbekistan, and Viet Nam.
- European Union trademark registration n° 008346462, registered on February 1, 2010, in international classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

The SODEXO mark has been already recognized as well known, among others, in the following cases under the UDRP: see *Sodexo v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1580](#): "Further, the Complainant's business is truly international and of such a size and scope that it has developed a very substantial reputation and goodwill as has been recognized by previous UDRP panels."

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

The disputed domain name was registered on December 8, 2023, and resolves to an inactive page.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

1. the disputed domain name is identical or confusingly similar to the marks SODEXHO and SODEXO in which the Complainant has rights.
2. The Complainant is widely established and among others in Brazil where the Respondent is located:
3. due to the identical reproduction of the SODEXO mark, the public will believe that the disputed domain name comes from the Complainant or is linked to the Complainant in so far as it specifically provides on-site services.
4. despite the disputed domain name is currently inactive, the Complainant has recently faced several attacks, fears a possible fraudulent use of the disputed domain name notably to perpetrate email scam sent to its clients requesting payment of false invoices on fake bank accounts or to order products to Complainant's clients for considerable amounts by impersonating the Complainant's employees.
5. the Respondent has no rights or legitimate interests in respect of the disputed domain name.
6. the disputed domain name is registered in the name of "Compass Adm" from Compass Group that is one of the Complainant's competitors. However, the address provided ""corresponds to the address of the Complainant's Brazilian subsidiary, Sodexo Do Brasil Comercial S.A.:
7. the contact email address of the Respondent includes the Complainant's SODEXO mark with "recrutamentobr" and "@gmail.com" and that is an identity theft.
8. the Respondent has no rights nor legitimate interests in the disputed domain name as he has no rights on SODEXO as corporate name, trade name, shop sign, mark or domain name that would be prior to the Complainant's rights on SODEXO.
9. 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 and/or SODEXHO.
10. 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.
11. The disputed domain name was registered and is being used in bad faith.
12. the sign "sodexo" is purely fanciful, and nobody could legitimately choose this word or any variation thereof (especially associated to the expression "on site"), unless seeking to create an association with the Complainant's activities and marks SODEXO.
13. the Respondent not only knows the SODEXO mark but wants to benefit of its reputation. It is obvious that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the mark SODEXO 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.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Portuguese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is not able to communicate in Portuguese and therefore, if the Complainant should submit all documents in Portuguese the proceeding will be unduly delayed, and the Complainant would have to incur substantial expenses for translation. Moreover, the disputed domain name <sodexoonsite.com> is registered with the English expression "on site", rather than in Portuguese.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "onsite" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel finds that the Respondent not only knew of the SODEXO mark but wants to benefit of its reputation. It is clear for the Panel that the Respondent registered the disputed domain name with actual knowledge of the Complainant’s rights in the mark 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.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the (i) distinctiveness and reputation of the Complainant’s SODEXO trademark; (ii) the lack of a Response by the Respondent; (iii) the concealment of the Respondent’s identity through a privacy service; and (iv) the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, the Panel notes that the email address used for the registration of the disputed domain name includes the term “recrutamento” together with “br” and the SODEXO trademark, which in the circumstances of this case affirms a likely intention of bad faith towards the disputed domain name.

The Panel finds that the Complainant has established the third element 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 <sodexoonsite.com> be transferred to the Complainant.

*/Gonçalo M. C. Da Cunha Ferreira/*

**Gonçalo M. C. Da Cunha Ferreira**

Sole Panelist

Date: February 5, 2024