

## **ADMINISTRATIVE PANEL DECISION**

Sodexo v. Sebastian Barra Alarcon, sindicatosodexo.com  
Case No. D2023-5194

### **1. The Parties**

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

The Respondent is Sebastian Barra Alarcon, sindicatosodexo.com, Chile.

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

The disputed domain name <sindicatosodexo.com> is registered with Squarespace Domains II LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 13, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 December 18, 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 in English on December 21, 2023.

On December 18, 2023, the Center informed the parties in Spanish and English, that the language of the registration agreement for the disputed domain name is Spanish. On December 18, 2023, the Complainant requested that English be the language of the proceeding. The Respondent did not submit any comment on the language of the proceeding.

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 January 10, 2024. In accordance with the Rules, paragraph

5, the due date for Response was January 30, 2024. On January 23, 2024, a Chilean law firm sent an email communication to the Center in Spanish requesting a copy of the Complaint. On the following day, the Center sent a reply by email in Spanish, asking that the law firm identify itself and its relationship (if any) with the Respondent, and provide sufficient information to justify its request. The law firm did not reply, and the Respondent did not submit any response by the due date. Accordingly, the Center notified the Commencement of Panel Appointment Process on January 31, 2024. On February 4, 2024, the Respondent sent an email communication to the Center in English.

The Center appointed Matthew Kennedy as the sole panelist in this matter on February 5, 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 provides food services and facility management services. Founded in 1966, it traded as SODEXHO until 2008 and has traded as SODEXO since then. It now serves 80 million consumers daily in 45 countries. It owns trademarks in multiple jurisdictions including the following:

- International trademark registration number 689106 for a figurative SODEXHO mark, registered on January 28, 1998, designating multiple jurisdictions, specifying goods and services in multiple classes;
- International trademark registration number 964615 for a figurative SODEXO mark, registered on January 8, 2008, designating multiple jurisdictions, specifying goods and services in multiple classes;
- Chilean trademark registrations numbers 814943 and 827178, both for a figurative SODEXO mark, registered on April 24, 2008, and September 11, 2008, respectively, specifying goods and services in multiple classes; and
- European Union trademark registration number 008346462 for SODEXO, registered on February 1, 2010, specifying goods and services in multiple classes.

The above trademark registrations are current. The Complainant has also registered the domain name <sodexo.com> that it uses in connection with a website where it provides information about itself and its services. The Complainant uses the subdomain <cl.sodexo.com> in connection with a website in Spanish where it provides information about its operations and services in Chile and employment opportunities.

The Respondent is an individual based in Chile. His registrant information includes the disputed domain name.

The disputed domain name was registered on December 9, 2023. It does not resolve to any active website; rather, it is passively held.

#### **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 the disputed domain name is identical or confusingly similar to its SODEXHO and SODEXO marks. The Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 or to use it. The disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

The Respondent apologized for the delay in deactivating the disputed domain name. He explained that the letter arrived, but the disputed domain name has been successfully deactivated. Otherwise, he did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Spanish. 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 and amended Complaint, as well as the Respondent's informal email communication, were all filed in English. The Complainant requested that the language of the proceeding be English because it cannot communicate in Spanish and translation of the Complaint would entail substantial expenses and delay the proceeding. The Respondent did not comment on 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.

### **6.2 Substantive Issues**

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

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

The burden of proof of each element is borne by the Complainant.

#### **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. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the SODEXO trademark. See [WIPO Overview 3.0](#), section 1.2.1. Given the Panel's findings below, it is not necessary to consider the Complainant's other marks. The entirety of the mark is reproduced within the disputed domain name. Although the disputed domain name adds the word "sindicato", meaning "labor union", as its initial element, the SODEXO mark remains

clearly recognizable within the disputed domain name. The only additional element is a generic Top-Level Domain (“gTLD”) extension (“.com”) which, as a standard requirement of domain name registration may be disregarded in the assessment of confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, and 1.11.

Therefore, 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. See [WIPO Overview 3.0](#), section 2.1.

In the present case, the disputed domain name is passively held. The Complainant submits that the Respondent has no 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 or to use it. These circumstances indicate that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services. The Registrar has verified that the Respondent’s name is Sebastian Barra Alarcon, which does not resemble the disputed domain name. Although he lists the disputed domain name in his registrant information, the Respondent has not alleged or provided evidence that he represents a Sodexo labor union or is otherwise commonly known by the disputed domain name. Further, passive holding of the disputed domain name does not constitute a legitimate noncommercial or fair use.

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.

Based on the record, the Panel finds the second element of the Policy has been established.

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

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the disputed domain name was registered in 2023, years after the registration of the Complainant’s SODEXO mark. The disputed domain name wholly incorporates the SODEXO mark, which is a coined term with no apparent meaning other than as a reference to the Complainant. The Complainant has operations in Chile, where the Respondent is based. The Respondent provides no explanation for his registration of the disputed domain name. In view of these circumstances, the Panel finds that the Respondent had the Complainant and its SODEXO mark in mind at the time when he registered the disputed domain name.

As regards use, the disputed domain name does not resolve to any active website. However, prior panels under the Policy have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and [WIPO Overview 3.0](#), section 3.3. In the present case, the SODEXO mark is highly distinctive and has acquired a strong reputation in the food services sector through longstanding and widespread use. The disputed domain name wholly incorporates the mark, combined with the word “sindicato” meaning “labor union”. The Respondent has not provided any evidence of an intended good faith use of the disputed domain name. The Respondent submitted that the disputed domain name has been deactivated. However, the Panel notes that the disputed domain name remains passively held. Having reviewed the available record, the Panel considers 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.

Therefore, 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 < синдикатосодехо.ком > be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: February 19, 2024