

ADMINISTRATIVE PANEL DECISION

SODEXO v. Domain Privacy, Domain Name Privacy Inc.
Case No. D2024-0402

1. The Parties

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

The Respondent is Domain Privacy, Domain Name Privacy Inc., Cyprus.

2. The Domain Name and Registrar

The disputed domain name <ext1sodexo.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 29, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 30, 2024, 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 0170039145) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 2024, 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 February 6, 2024.

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 February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 6, 2024.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on March 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 food services and facilities management company established in France in 1966.

Having used from 1966 to 2008 the trade name and trademark SODEXHO, it decided to adopt the simplified version of SODEXO in 2008, currently owing, amongst several others, the following trademark registrations Annexes 5 to 12 to the Amended Complaint):

- International trademark registration No. 689106 for SODEXHO and device, registered on January 28, 1998, subsequently renewed, in classes 16, 36, 37, 39, 41 and 42;
- International trademark registration No. 964615 for SODEXO and device, registered on January 8, 2008, successively renewed, in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45; and
- International trademark registration No. 1240316 for SODEXO, registered on October 23, 2014, in classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

Prior UDRP panel decisions have recognized that the Complainant's SODEXO trademark has acquired a substantial reputation and is well known. See, e.g., *Sodexo v. Registration Private, Domains By Proxy, LLC/ Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1580](#).

The disputed domain name was registered on January 26, 2024, and presently resolves to a parked webpage displaying pay-per-click ("PPC") links to competitors of the Complainant. In the past, as per the evidence submitted by the Complainant, the disputed domain name redirected to a webpage which hosted malicious software.

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 it employs 430,000 people, serving 80,000,000 customers in 45 countries, having had revenues of EUR 22.6 billion in 2023 and being listed as one of the "World's most admired companies" by Fortune magazine. Having its SODEXO (previously SODEXHO) trademark achieved a well-known status, as recognized by several past UDRP panels, the Complainant further states that its trademark is largely used in connection with facility management services, benefits and rewards services as well as personal and home services.

Under the Complainant's view the disputed domain name incorporates the Complainant's SODEXO trademark in its entirety, with the addition of the elements "ext" and "1", being the element "ext" generally used in email addresses to indicate that the sender is external to the company and therefore the disputed domain name will likely be perceived as linked to the Complainant.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

- (i) the Respondent has no rights on SODEXO as a corporate name, trade name, trademark or domain name that would predate the Complainant's rights over SODEXO;

- (ii) the Respondent is not commonly known by the disputed domain name; and
- (iii) 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.

As to the registration and use of the disputed domain name in bad faith the Complainant states that the Complainant's trademark is well known and enjoys a great reputation, so that the Respondent was not able to ignore it when registering the disputed domain name and thus it being obvious that the Respondent is intentionally attempting to take advantage of the well-known character of the Complainant's SODEXO/SODEXHO trademark in order to try to attract Internet users to the disputed domain name or to mislead third parties for an illegitimate profit. In addition to that the Complainant argues that the use of the disputed domain in connection with a webpage hosting malicious content demonstrates the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

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 ["ext" and "1"] 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, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a prima facie case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a prime facie case against the Respondent that the Respondent has not been commonly known by the disputed domain name, and there is no connection or affiliation between the Complainant and the Respondent. Also, the Complainant indeed states it has not authorized, licensed or otherwise permitted the Respondent to register the disputed domain name and to use it.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible legitimate connection between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or from a webpage relating to the disputed domain name, corroborate the Panel’s finding of the absence of rights or legitimate interests. In addition, the Panel finds that the composition of the disputed domain name carries a risk of implied affiliation.

Moreover, the past use of the disputed domain name in connection with a webpage spreading malware and the present use in connection with PPC links to competitors of the Complainant cannot be characterized as legitimate non-commercial use or bona fide use of the disputed domain name. In that sense, Panels have held that the use of a domain name for illegal activity (distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

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 this case, the current use of the disputed domain name in connection with a parked website that displays links or PPC advertisements characterizes the Respondent's intent of commercial gain by misleadingly diverting the Complainant's consumers or merely earning revenues from the links that solely exist in view of the association with the Complainant's well-known trademark. Such use, in this Panel's view, constitutes an attempt to profit from the fame and goodwill associated with the Complainant's trademark, thus unfairly capitalizing on the SODEXO trademark by creating a likelihood of confusion among Internet users who are likely to believe that the disputed domain name is either connected, endorsed or authorized by the Complainant.

As to the past use of the disputed domain name in connection with the distribution of malware, Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The choice to retain a privacy protection service to conceal the Respondent's true identity further reinforces the indication of the Respondent's bad faith in the broader context of this case.

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 <ext1sodexo.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: April 1, 2024