

ADMINISTRATIVE PANEL DECISION

Sodexo v. Dany Karsten, Dany Karsten

Case No. D2024-0610

1. The Parties

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

The Respondent is Dany Karsten, Dany Karsten, France.

2. The Domain Name and Registrar

The disputed domain name <sodexo-group.store> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2024. On February 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 9, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 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 13, 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 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 6, 2024.

The Center appointed Marie-Emmanuelle Haas as the sole panelist in this matter on March 21, 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

Founded in 1966, the Complainant, the French company Sodexo (prior called Sodexho Alliance) is one of the largest companies in the world specialized in food services and facilities management, with 430,000 employees serving daily 80 million consumers in 45 countries.

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

The Complainant's Fiscal 2023 Integrated Report is enclosed as Annex 4 to the Complaint.

The Complainant is listed as one of "The world's Most Admired Companies" by FORTUNE magazine.

From 1966 to 2008, the Complainant promoted its business under the SODEXHO mark and trade name. In 2008, SODEXHO simplified the spelling of its mark and name to SODEXO and changed its logo.

The mark SODEXO is used in connection with food and facility management services.

The Complainant is the owner of the following registered trademarks:

- French word and device SODEXO trademark, registered on July 16, 2007, registered under No. 3513766, renewed in 2017, in international classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45;
- French SODEXO trademark registered on November 3, 2020, registered under No. 4697571, in international classes 7, 29, 30, 32, 33 and 35;
- European Union SODEXO trademark filed on June 8, 2009, registered on February 1, 2010, under No. 008346462, renewed in 2019, in international classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45;
- European Union word and device SODEXO trademark filed on July 16, 2007, registered on June 27, 2008, under No. 006104657, renewed in 2017, in international classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45;
- International word and device SODEXO trademark No. 964615 filed and registered on January 8, 2008, under priority of the French trademark registration No. 3513766 of July 16, 2007, renewed in 2018, 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, Iran (Islamic Republic of), Iceland, Israel, Japan, Kyrgyzstan, Democratic People's Republic of Korea, Republic of Korea, Kazakhstan, Lesotho, Morocco, Monaco, Republic of Moldova, Montenegro, Mongolia, Namibia, Norway, Serbia, Russian Federation, Singapore, Türkiye, Ukraine, United States of America, Uzbekistan and Viet Nam; and
- SODEXO, international trademark No. 1240316 filed and registered on October 23, 2014, in international classes 9, 16, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45, protected in the following countries: Iran (Islamic Republic of), Mozambique and United Kingdom.

The Complainant operates the domain name <sodexo.com>.

The disputed domain name <sodexo-group.store> was registered on February 7, 2024. It does not resolve to a website with any active content.

The Complainant contends that it has recently faced several attacks, and strongly fears the fraudulent use of the disputed domain name, namely to perpetrate an email scam that would be sent to its clients requesting payment of false invoices on fake Sodexo bank accounts or to order products for the Complainant's clients in considerable amounts by impersonating the Complainant's employees.

The Respondent provided an address in France when registering the disputed domain name, which is obviously false, since the city of La Rochelle is not in Alpes-Maritimes.

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.

Identical or Confusingly Similar

Notably, the Complainant contends that the disputed domain name incorporates the SODEXO mark in its entirety with the addition of the element "group".

The addition of the generic word "group" clearly refers to an affiliation with SODEXO.

The expression "SODEXO group" therefore refers to a Sodexo's official website.

The addition of the word "group" in the disputed domain name is inoperative to distinguish it from the Complainant's mark as in the disputed domain name, the SODEXO mark is dominant and keeps its individuality and attractive character.

It is widely admitted that the addition of a generic or descriptive term to a mark will not alter the fact that the disputed domain name is confusingly similar to the mark in question.

Given the identical reproduction of the SODEXO mark, the public will believe that the disputed domain name comes from the Sodexo group or is linked to the Complainant. The risk of confusion or association is further increased as the Complainant is composed of numerous entities forming the Sodexo group.

Absence of rights or legitimate interests

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.

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.

Bad faith registration and use

Given the well-known character and reputation of the SODEXO / SODEXHO mark, the Respondent knew its existence when he registered the disputed domain name, so that he perfectly knew that he had no rights or legitimate interests in the disputed domain name and that he cannot lawfully use it.

The sign SODEXO is purely fanciful, and nobody could legitimately choose this word or any variation thereof, unless seeking to create an association with the Complainant's activities and mark SODEXO.

Previous decisions issued under the UDRP already recognize that actual knowledge of the complainants' trademarks and activities at the time of the registration of the disputed domain name may be considered an inference of bad faith:

The Respondent not only knew 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 SODEXO mark, probably for the purpose of creating confusion with the Complainant's mark to divert or mislead third parties for Respondent's illegitimate profit.

Even if the disputed domain name does not resolve to a website with active content, a passive holding of a domain name does not prevent a finding of bad faith. The Complainant relies on WIPO Case No. [D2000-0003](#), *Telstra Corporation Limited v. Nuclear Marshmallows*, in which the Panel found that passive holding, under the totality of circumstances of the case, can indeed constitute a bad faith use under the Policy. Panels have among others taken into consideration:

- the strong reputation and well-known character of the Complainant's mark;
- the lack of evidence provided by the Respondent of any good faith use with regard to the disputed domain name;
- the identity of the disputed domain name with the Complainant's name and mark intended to divert or mislead potential web users from the Complainant's website they are actually trying to visit.

These circumstances may apply to the present case.

Finally, it is also important to point that the Complainant believes that the Respondent is the same person as the registrant of the domain name <sodexogroupe.fr>, which has been the subject of a SYRELI (Système de Résolution des Litiges) decision transferring this domain name to the Complainant (decision No. FR-2023-03722), and of the domain names <sodexo-groupe.fr>, <sodexogroupes.fr> and <sodexo-sas.fr> which are currently the subject of pending SYRELI complaints (files No. FR-2024-03770, No. FR-2024-03780, and No. FR-2024-03787) with AFNIC (Association Française pour le Nomme Internet en Coopération). However, the Panel notes that it is not possible to verify this information.

The disclosed data of the registrant's .FR domain names provide an address similar to that of the Respondent in this case, which appears to be almost the same.

The same pattern is used for these addresses: the French city La Rochelle is written as one word, and is supposedly located in the Alpes-Maritimes, when in fact it is located in Charente-Maritime. The only differences are the number of the street.

Even if the name of the registrants differs, there is no doubt that the registrant is the same in all these cases.

The Complainant strongly fears a fraudulent use of the disputed domain name for phishing as the domain names <sodexogroupe.fr> and <sodexo-sas.fr> have already been used for phishing by usurping the identity of the Chief Executive Officer of Bellon SA, the family holding company of the Complainant, and a director of the Complainant.

In conclusion, the unauthorized registration of the disputed domain name by the Respondent and its passive holding, very likely in the aim of fraudulent uses, namely phishing, are for the purpose of commercial gain and then constitute bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

To prevail in the proceedings under the Policy, the Complainant must show that the three requirements set forth in paragraph 4(a) of the Policy are met. Those requirements are:

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

Likewise, under paragraph 4(c) of the Policy, the Respondent can demonstrate its rights and legitimate interests in the disputed domain name in its response to the Complaint by demonstrating, among others, the circumstances mentioned under this paragraph of the Policy.

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 Panel finds the mark is recognizable 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.

The Panel finds the addition of the term "group" 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

As set forth by paragraph 4(c) of the Policy, any of the following circumstances, in particular, but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to the Respondent of the dispute, its 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 (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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.

The Respondent has not been licensed or authorized to use the SODEXO mark or to register the disputed domain name.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by an Administrative Panel to be evidence of bad faith registration and use of a domain name. It provides that:

"For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(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."

In the present case, the Panel notes that, given the well-known character of the SODEXO mark, the Respondent, who is an individual located in France, cannot have ignored the existence and the reputation of this mark at the time it registered the disputed domain name. There is no doubt that the Respondent was targeting the Complainant.

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.

Providing a false address when registering the disputed domain name may be a way for the registrant to conceal its identity.

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, in breach of its registration agreement. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and 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.

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 <sodexo-group.store> be transferred to the Complainant.

/Marie-Emmanuelle Haas/
Marie-Emmanuelle Haas
Sole Panelist
Date: April 4, 2024