

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company v. Ataev Murad Case No. D2022-0470

1. The Parties

The Complainant is Publix Asset Management Company, United States of America (“United States”), represented by Thomas & LoCicero PL, United States.

The Respondent is Ataev Murad, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <publix-weekly.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2022. On February 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 12, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2022. On March 21, 2022, the Complainant submitted a supplemental filing. The Respondent did not submit any response.

On March 21, 2022, the Complainant submitted a Supplemental Filing, requesting that the Center proceed with panel appointment. Accordingly, the Center notified the Respondent’s default on March 31, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on April 8, 2022. 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 corporation organized and existing under the laws of Florida, United States and is a subsidiary and licensor of trademarks to Publix Super Markets, Inc. The Complainant's group of companies was founded in 1930 and today owns and operates 1,297 retail stores, where retail sales in 2020 totalled USD 44.9 billion, employs more than 197,000 people, and asserts that it is the largest employee-owned business in the United States.

The Complainant is the owner of various United States registered trademarks for the mark PUBLIX, in a variety of classes of goods and services. For example, the Complaint owns United States Registered Trademark No. 1339762 for the word mark PUBLIX registered on June 4, 1985 in respect of retail grocery store services in Class 42, claiming a first use in commerce dating back to December 31, 1930.

The Complainant is the owner of the domain names <publix.com>, which was registered on January 31, 1995, and <publix.org>, which was registered on December 10, 1997. The domain name <publix.com> resolves to a website describing the Complainant's goods and services. In addition, the Complainant uses the URL "www.publix.com/savings/weekly-ad" to display a copy of an advertising circular that is distributed weekly. The domain name <publix.org> resolves to a website containing resources for the Complainant's employees whereby they may login to their personal employee account.

The disputed domain name was registered on September 18, 2019. Little is known about the Respondent, which has not participated in the administrative proceeding. The disputed domain name is associated with a website which features the Complainant's PUBLIX trademark, the Complainant's circular green lowercase "p" logo, and the Complainant's typical website look and feel. It invites Internet users to check the balance on the Complainant's gift cards and to download files from another website, and requests the Complainant's employees to log into their personal employee account via a dedicated login facility. Comments from website users suggest that the features may not be working, while indicating that such users had been confused into believing that the website was an official site of the Complainant. Furthermore, since the Complaint was filed, the content on the website has been updated and there is evidence that it is hosted and potentially controlled from Canada rather than from the Respondent's address as listed in the Whois record for the disputed domain name.

On August 5, 2021, the Complainant wrote to the Respondent to request a transfer of the disputed domain name but the Respondent did not reply to this inquiry.

5. Parties' Contentions

A. Complainant

Identical or confusingly similar

The disputed domain name is confusingly similar to the Complainant's registered PUBLIX mark because it consists of the entire mark with the addition of a dash and the generic term "weekly" with the generic Top-Level Domain ".com". The Respondent has simply added a generic term to the Complainant's mark, which does not negate the confusing similarity between the mark and the disputed domain name. The inclusion of the term "-weekly" in the disputed domain name does not prevent confusing similarity. Said term conveys the frequency of the Complainant's advertising circular. It is not a distinguishing element. The similarities in

content between the website at the Complainant's own domain name and the disputed domain name support a finding of confusing similarity as the likelihood of confusion is great.

Rights or legitimate interests

The Respondent has no rights to any trademark incorporating the Complainant's mark or to the disputed domain name. The Respondent is not licensed or authorized to use said mark and the Complainant has neither consented nor acquiesced to the Respondent's use of said mark. To the Complainant's knowledge, the Respondent has not been commonly known by the disputed domain name. There is no similarity between the disputed domain name and any contact name in its registration data. The Respondent is using the disputed domain name in an infringing manner. The website associated with the disputed domain name suggests that owners of the Complainant's gift cards can check their balances through the Respondent's website. The comments on said website show that users are unable to do so. Said website also suggests that the Complainant's employees may login and access their personal employee accounts. Comments on said website indicate that some of the Complainant's employees have been confused by this. The Respondent does all this via the disputed domain name which is confusingly similar to the Complainant's PUBLIX mark and to the Complainant's domain names, leading persons who encounter the disputed domain name to believe that it is associated with or endorsed by the Complainant, which is not the case.

Registered and used in bad faith

The Respondent's goal in registering and using the disputed domain name is to divert Internet users away from the Complainant's legitimate websites. The facts demonstrate bad faith. The inclusion of the Complainant's mark in its entirety in the disputed domain name is indicative of bad faith, as does its use with no disclaimer of the lack of any relationship between the Parties. The Respondent has implicitly admitted bad faith by failing to respond to the Complainant's correspondence.

The Respondent's said website misappropriates the Complainant's trademark to attract, for commercial gain, Internet users to said and to divert, through confusion, Internet users away from the Complainant's official website. Such diversion disrupts the Complainant's relationships with its customers, potential customers, and anyone else seeking information concerning the Complainant.

Complainant's supplemental filing

The Respondent continues to use the disputed domain name to infringe upon the Complainant's rights. The website associated with the disputed domain name displays an infringing copy of the Complainant's advertising that was published in the week to March 21, 2022 (and is dated March 23, 2022). The Complainant first wrote to the Respondent in 2021 and sent a copy of the Complaint to it on February 10, 2022. The Center has duly notified the Complaint to the Respondent, and the Respondent has failed to file any Response in the administrative proceeding. Hosting data indicates that the website associated with the disputed domain name is hosted in Canada and any connection of the disputed domain name to Ukraine has not impacted its operation and use.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Preliminary Matters: Complainant's supplemental filing and notification of the Complaint

Paragraph 12 of the Rules provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case. In terms of paragraph 10 of the Rules, the panel shall determine the admissibility, materiality and weight of the evidence. Unless specifically requested by the panel, unsolicited supplemental filings are generally discouraged. Panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

In the present case, the Complainant has filed a supplemental filing in which it provides additional information indicating that the disputed domain name has continued to be used to display new material targeting the Complainant following the commencement of the administrative proceeding, and demonstrating that the associated website is hosted not in Ukraine, where the Whois records suggest that the Respondent may be based, but rather in Canada. It is equally possible that the website is controlled from Canada as well as being hosted there. The question of the location and control of the disputed domain name and corresponding website arises in the context of the present conflict in Ukraine whereby a respondent based in that country might have had difficulty in receiving notification of the Complaint or in formulating its Response.

The Panel is content to admit the Complainant's supplemental filing as, for the most part, it represents new material which would not have been available to the Complainant at the time when the Complaint was filed. This material demonstrates that the disputed domain name is still under active control. There is no suggestion before the Panel that notification of the Complaint did not reach the Respondent, and, for example, no notices of non-delivery were generated by the email notification to the Respondent's email address. Postal notification is reported to have arrived in the destination country on March 13, 2022 and to have reached its collection point on March 23, 2022. Importantly, the disputed domain name continues to be used actively to target the Complainant's mark with the publication of fresh content (as evidenced in the Complainant's supplemental filing and as further discussed below). It is not hosted in, and may not be controlled from, the location specified for the Respondent in the Whois record. Accordingly, as the Respondent is capable of continuing to control the disputed domain name and to generate fresh content at the associated website hosted in Canada, and as the Respondent has received notification of the Complaint in accordance with paragraph 2 of the Rules, the Panel considers that it would have been able to formulate and file a Response in the administrative proceeding had it wished to do so. The Panel will therefore proceed to a Decision.

B. Identical or Confusingly Similar

There are two parts to the inquiry under this element of the Policy. The Complainant must first demonstrate that it has UDRP-relevant rights in a trademark. Secondly, the disputed domain name is compared to such trademark, usually on a straightforward side-by-side basis which typically disregards the generic Top-Level Domain (in this case, ".com") with a view to determining whether the latter is recognizable in the former. If it is so recognizable, confusing similarity will generally be found, whereas if it is identical, identity will typically be found.

In the present case, the Panel finds that the Complainant has UDRP-relevant rights in its PUBLIX registered trademark described in the factual background section above. Comparing this mark to the disputed domain name, on the basis described above, it may be seen that the said mark is repeated in its entirety in the disputed domain name. The addition of the descriptive or qualifying term "-weekly" would not prevent a

finding of confusing similarity and, in particular, it cannot be overlooked that its inclusion in the disputed domain name seems calculated to appear to an Internet user as though it is a domain name which is being used for the Complainant's weekly promotional publication.

The Respondent has not participated in the administrative proceeding and has not commented on the issue of the identity or confusing similarity of the disputed domain name and the Complainant's PUBLIX trademark.

In all of the above circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"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 your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. Where the panel finds that a complainant has made out such a *prima facie* case, the burden of production shifts to the respondent to bring forward evidence of such rights or legitimate interests.

In the present case, the Complainant asserts that the Respondent has no authorization to use the Complainant's PUBLIX mark in the disputed domain name, is not commonly known by it and is using it in connection with an alleged gift card balance checker and portal for the Complainant's employees. Based on the screenshots provided with the Complaint, the website associated with the disputed domain name has the appearance of one of the Complainant's official websites. The Panel is satisfied that such website is calculated to cause confusion and to lead Internet users to believe that they are dealing with the Complainant when they are not. The Panel finds that the Complainant's submissions and corresponding evidence establish the requisite *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the burden of production shifts to the Respondent to bring forward submissions and any corresponding evidence of any such rights and legitimate interests.

The Respondent has not participated in the administrative proceeding and has not taken up the opportunity to point to any rights or legitimate interests which it may have asserted in the disputed domain name. In the absence of any account from the Respondent, the Panel notes that the evidence before it indicates that the disputed domain name is being used to impersonate the Complainant with a view to persuading consumers to provide details of the gift cards issued by the Complainant which they hold, and/or to persuade the Complainant's employees to divulge their login credentials for their personal employee accounts relating to the Complainant's systems. Neither of these activities could be considered to be a *bona fide* offering of

goods or services under paragraph 4(c)(i) of the Policy, and the Panel finds that paragraphs 4(c)(ii) and (iii) of the Policy equally do not apply in the circumstances of the present case.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name and accordingly that the Complainant has carried its burden in terms of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, 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 online 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 has found that the disputed domain name is confusingly similar to the Complainant’s PUBLIX mark, which is reproduced there in its entirety. The Complainant has presented evidence indicating that the website associated with such disputed domain name adopts and misuses the Complainant’s trademark and corporate identity with a view to persuading Internet users to enter numbers relating to gift cards issued by the Complainant and/or persuading the Complainant’s employees to enter their credentials for accessing their employee accounts with the Complainant. The website associated with the disputed domain name has cloned the Complainant’s branding and logos with a view to perpetuate confusion on the part of such gift card holders and/or employees. Furthermore, the addition in the disputed domain name of the term “-weekly” immediately following the Complainant’s mark appears calculated to reference the Complainant’s URL “www.publix.com/savings/weekly-ad” in a further attempt to provoke confusion on the part of Internet users who are looking for the online version of the Complainant’s weekly promotional advertisement. During the course of the present administrative proceeding, the website associated with the disputed domain name has continued to publish fresh up-to-date content which appears to the Panel to be intended to confuse Internet users into believing that it is affiliated to or endorsed by the Complainant.

All of these facts and circumstances indicate to the Panel that the disputed domain name was registered in the knowledge of the Complainant’s PUBLIX trademark and with intent to target it. They are consistent with a finding of bad faith registration and use in respect of the disputed domain name. These matters also call for an explanation from the Respondent, which is lacking in the present case. In the absence of such, the Panel cannot conceive of any good faith motivation that the Respondent might have put forward with regard to its registration and use of the disputed domain name.

Accordingly, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(iii) 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 <publix-weekly.com> be transferred to the Complainant.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: April 22, 2022