

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company and Publix Super Markets, Inc. v. Tyler Kobylinski

Case No. D2023-4743

1. The Parties

The Complainants are Publix Asset Management Company and Publix Super Markets, Inc., United States of America (“United States”), represented by Holland & Knight, LLP, United States.

The Respondent is Tyler Kobylinski, United States.

2. The Domain Name and Registrar

The disputed domain name <injuredatpublix.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 16, 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 and contact information in the Complaint (Registration Private, Domains By Proxy, LLC). The Center sent an email communication to the Complainants on November 20, 2023, providing the registrant and contact information disclosed by the Registrar and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on November 20, 2023.

The Center verified that the Complaint together with the amendment to 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 November 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 18, 2023. The Respondent sent an email communication to the Center on November 28, 2023.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on January 10, 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 Complainants are corporations established under the law of the State of Florida, United States and headquartered in Lakeland, Florida. Publix Super Markets, Inc. (“the first Complainant”), an employee-owned Fortune 500 company, was founded in 1930. It operates a large chain of supermarkets in the Southeastern United States, with more than 1,350 stores and more than 250,000 employees. Its affiliate Publix Asset Management Company (“the second Complainant”), the other Complainant in this proceeding, owns and manages PUBLIX and PUBLIX-formative trademarks that are licensed to the first Complainant for use in its business. The Panel finds, therefore, that both have an interest in these marks and are proper Parties to this proceeding. The first Complainant has been advertising and providing retail grocery and related services for more than 90 years under the PUBLIX mark, and it has operated a website at “www.publix.com” since January 1995.

The second Complainant owns at least 65 current United States federal trademark registrations for PUBLIX and PUBLIX-formative marks as word marks or stylized logos. These include, for example, United States Registration Number 1339762 for PUBLIX as a standard character mark in international class 42 for retail grocery store services, registered in June 4, 1985.

The Registrar reports that the disputed domain name was created on September 3, 2023, and was registered in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Tyler Kobylinski, listing no organization and showing a postal address in Florida, United States and a contact email address in the domain name <appleid.com>.

The Respondent is evidently an attorney in Florida, and the disputed domain name redirects to a page with a photo of the Respondent and advertising his practice on the website of the law firm Morgan & Morgan, at “www.forthepeople.com/attorneys/tyler-r-kobylinski/”. A pop-up appears on the page offering 24/7 live chat with the “team” (displaying a photo of another lawyer at the firm) to start a “free consultation”. This page on the Morgan & Morgan website includes biographical and professional information about the Respondent and highlights the Respondent’s “featured wins” in five auto accident or “slip and fall” cases in 2022 and 2023, none of which appear to involve the Complainants.

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 confusingly similar to its PUBLIX trademark, which is wholly reproduced within the disputed domain name. The Respondent has no permission to use this mark, and the Respondent is not known by a corresponding name. The Complainant argues that the Respondent is not making use of the disputed domain name in connection with a bona fide offering of goods or services, unlike a nominative fair use in connection with a lawyer advertising claims solely against a particular defendant, for example. The Complainant cites *Instagram, LLC v. Brian Breiter, Law Offices of Brian Breiter*, WIPO Case No. [D2022-2149](#). There, the panel ordered the transfer of a domain name incorporating the complainant’s mark where the law firm respondent used the domain name for a site advertising the firm’s general practice, not solely for a site concerning claims against the complainant. The case for transfer is even stronger here, the Complainant asserts, as the Respondent does not even mention the first Complainant on the website associated with the disputed domain name. Hence, it

is not a use in connection with a bona fide commercial service offering. And it is not a noncommercial fair use, as the website advertises the Respondent's professional services.

The Complainant contends as well that the Respondent's registration and use of the disputed domain name was in bad faith. The PUBLIX mark is well-known and long-established, especially in the region where the Respondent is located. The Complainant asserts that the Respondent registered the disputed domain name incorporating the distinctive mark in its entirety and creating a likelihood of confusion with the Complainant, attracting Internet users to the Respondent's own web page for commercial gain.

B. Respondent

After receiving notice of the Complaint through the Registrar, the Respondent sent an email to the Center asking simply, "How can I help?"

The Center replied with further information about the Complaint but received no other communications from the Respondent. The Respondent, who is an attorney, did not submit a Response or otherwise reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

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

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

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, "injured at") 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 first Policy element. [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 have 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 Respondent does not appear to be known by a corresponding name and has used the disputed domain name only to redirect to his page on his law firm’s website, which advertises his legal practice but does not mention actual or potential claims against the Complainant. Thus, a perusal of the associated website reveals no legitimate interest in the disputed domain name, and the Respondent has not offered one.

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 notes that the second Complainant’s PUBLIX mark is long-established and well-known, particularly in Florida, United States, where the Respondent is located. It is not a dictionary term and is used to brand hundreds of grocery stores in Florida. The mark is incorporated in its entirety in the disputed domain name, which adds the words “injured at”, as might be expected for an attorney who handles “slip and fall” personal injury lawsuits at shopping malls and other public places, according to his web page. The Panel concludes that the Respondent had the Complainant and its mark in contemplation in registering the disputed domain name.

However, as discussed above in connection with the second element, the Respondent did not make what might arguably be defended as a nominative fair use of the disputed domain name by limiting its use to a site dedicated to claims against the Complainant or concerns about safety at the Complainant’s stores. Instead, the Respondent took unfair advantage of the Complainant’s trademark by registering a confusingly similar domain name simply to redirect to the Respondent’s own web page, advertising his legal services in all capacities, and with no mention of the Complainant. Such exploitation of the fame and goodwill of the Complainant’s trademark for commercial gain amounts to bad faith registration and use.

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 <injuredatpublix.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: January 24, 2024.