

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company v. Коваленко Роман/Kovalenko Roman Case No. D2022-4604

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 Коваленко Роман/Kovalenko Roman, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <publixads.com> (the “Domain Name”) is registered with Hosting Ukraine LLC (ua.ukraine) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2022. On December 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 5, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Privacy Protection, Hosting Ukraine LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

The Registrar also indicated that the language of the registration agreement is Russian. On December 5, 2022, the Center sent an email communication to the Parties in both Russian and English inviting the Complainant to submit satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English; or submit the Complaint translated into Russian; or submit a request for English to be the language of the administrative proceedings. On December 7, 2022, the Complainant filed a request for English to be the language of the proceedings. The Respondent did not comment on the language of the proceedings.

The Complainant filed an amended Complaint on December 8, 2022.

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 in both English and Russian, and the proceedings commenced on December 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 23, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on January 31, 2023. 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. Further Procedural Considerations

Under paragraph 10 (b) and 10 (c) of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent’s mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 (b) and 10 (c) of the Rules, whether the proceeding should continue.

The Panel noted that the courier was not able to deliver the Written notice to the Respondent’s address in Ukraine, but the Complaint together with the amended to the Complaint were delivered to the Respondent’s email address, as provided by the Registrar.

It is moreover noted that, for reasons, which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondent registered and has used the Domain Name in bad faith and with the intention of unfairly targeting the Complainant’s goodwill in its trademark.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

5. Factual Background

The Complainant is a subsidiary of Publix Super Markets, Inc. (“Publix”) which is an employee-owned American supermarket chain. Publix was founded in 1930. Currently, it operates 1,308 retail stores and employs more than 230,000 people.

The Complainant is the owner of several PUBLIX trademark registrations, including:

- the United States Trademark Registration PUBLIX No. 2739635 registered on July 22, 2003;
- the United States Trademark Registration PUBLIX No. 3359127 registered on December 25, 2007; and
- the United States Trademark Registration PUBLIX No. 3774699 registered on April 13, 2010.

The Complainant is also the owner of domain names incorporating its PUBLIX trademark, including <publix.com>.

The Domain Name was registered on May 24, 2022.

On November 7, 2022, the Complainant sent to the Respondent a cease-and-desist letter, demanding the Respondent stop using and transfer the Domain Name to the Complainant. The Respondent did not respond to this letter.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to a website displaying Publix weekly promotional publications, offering Publix employees to login to their alleged personal employee accounts, as well as inviting the owners of Publix gifts cards to the check the balances of their cards (the "Website").

6. Parties' Contentions

A. Complainant

The Complainant requests that the Domain Name be transferred to the Complainant. According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is identical or confusingly similar to the PUBLIX trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant contends that the Domain Name was registered and is being used in bad faith.

B. Respondent

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

7. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (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 the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A. Language of the Proceeding

The language of the Registration Agreement for the Domain Name is Russian. Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement,

the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#)).

The Complainant has submitted a request that the language of the proceeding be English. The Complainant argues that English is the language of the Domain Name and the content of the Website. Moreover, the Complainant notes that the Website mimics the Complainant's official website, which is in English. Furthermore, the Complainant indicates that the Respondent's email address is associated with other English-language websites. Finally, the Complainant contends that it is unable to communicate in Russian. Requiring the Complainant to submit documents in Russian would lead to delay and translation expenses on the part of the Complainant.

The Panel agrees that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment on the language of the proceeding, even though it was notified in English and Russian regarding the language of the proceeding.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid PUBLIX trademark registrations, which precede the registration of the Domain Name. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term "ads" in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant's PUBLIX trademark. UDRP panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms, whether descriptive, geographical, pejorative, meaningless, or otherwise, would not prevent a finding of confusing similarity under the first element. See section 1.8, [WIPO Overview 3.0](#).

The Top-Level Domain ("TLD") ".com" in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant's PUBLIX trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it is 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant's PUBLIX trademark registrations predate the registration of the Domain Name. There is no evidence in the record that the Complainant has licensed or otherwise permitted the Respondent to use the PUBLIX trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it does not result from the evidence in the record that the Respondent makes use of the Domain Name in connection with a *bona fide* offering of goods or services, or it makes a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain. On the contrary, the Domain Name resolves to the Website displaying Publix weekly promotional publications, offering Publix employees to log in to their alleged personal employee accounts, as well as offering the owners of Publix gifts cards to allegedly check the balances of these cards. It appears that Internet users attempting to log in to those services would have to provide their personal data and potentially sensitive information. The comments on the Website show, however, that the Internet users are unable to log in. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

The third requirement the Complainant must prove is that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or

- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the PUBLIX trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Domain Name. This finding is supported by the content of the Website displaying the PUBLIX trademark, listing the Complainant's official address and copying the Complainant's official marketing materials. Moreover, it has been proven to the Panel's satisfaction that the Complainant's PUBLIX trademark is well known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of services and products under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's PUBLIX trademark.

Moreover, the Domain Name is used in bad faith by the Respondent to attract Internet users to the Website displaying Publix weekly promotional publications and featuring log in fields for the Publix employees, as well as for the owners of Publix gifts cards to allegedly check the balances of these cards. It appears that in order to login in to those services, the Internet user would have to provide personal data and potentially sensitive information. By reproducing the Complainant's PUBLIX trademark in the Domain Name, as well as displaying the Complainant's official marketing materials on the Website, the Respondent intends to profit from the confusion created with Internet users, as it suggests association with the Complainant. In consequence, the Panel finds that the evidence in the record demonstrates that the Respondent uses the Domain Name deliberately in order to take advantage of the Complainant's reputation and to give credibility to its services.

Furthermore, the Respondent's use of a privacy service that concealed registrant information is a further evidence of bad faith.

Finally, on November 7, 2022 the Complainant sent to the Respondent a cease-and-desist letter, demanding the Respondent stop using and transfer the Domain Name to the Complainant. The Respondent did not respond to this letter. The Respondent's failure to respond to this correspondence is further evidence of bad faith.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements under paragraph 4(a)(iii) of the Policy.

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <publixads.com>, be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: February 14, 2023