

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company v. Milen Radumilo
Case No. D2023-2874

1. The Parties

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

The Respondent is Milen Radumilo, Romania.

2. The Domain Name and Registrar

The disputed domain name <publixvaccine.com> is registered with GreenZoneDomains Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 5, 2023. On July 6 and 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 1, 2023, the Registrar transmitted by email to the Center its verification disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 2, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended to the Complaint. The Complainant filed an amended Complaint on August 3, 2023.

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 August 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 28, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on September 9, 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. Factual Background

The Complainant is a subsidiary of Publix Super Markets, Inc., which has been founded in 1930 and which owns and operates 1,345 retail stores, where retail sales in 2022 totaled USD 54.5 billion. Publix Group uses the web address “www.publix.com/vaccines” to display information about vaccinations available at Publix Pharmacies.

The Complainant is the registered owner of several trademarks in the USA and particularly invokes registered US trademark for PUBLIX (No. 3,359,127, registered on December 25, 2007, with first use in commerce on January 3, 2004, for services in class 35).

The disputed domain name has been registered on March 30, 2023. The language of the Registration Agreement is English.

It results from the undisputed evidence provided by the Complainant that the disputed domain name shows pay-per-click (PPC) links featuring commercial links to third-party websites, some of which advertise antivirus and marketing software.

On May 10, 2023, the Complainant sent a cease-and-desist letter to the Respondent and the Registrar asking to immediately lock the disputed domain name, prevent any use of it to host any website or to send or receive email messages, and terminate the registration. No reply to this letter has been received by the Complainant.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant points out that the disputed domain name is confusingly similar to the Complainant's registered PUBLIX trademark because it consists of the entire PUBLIX mark with the generic term “vaccine” and the generic Top-Level Domain “.com”.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Respondent has not been commonly known by or associated with the disputed domain name, and there is no similarity or association between the disputed domain name and the company name or contact name in the registration data. Moreover, the Respondent is not using the disputed domain name for a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of the disputed domain name. Instead, the latter currently resolves to various third-party PPC-pages, including advertisements for antivirus and marketing software.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. The Complainant submits that the Respondent has used the disputed domain name to resolve to PPC-advertising websites. Such use is evidence of bad faith. Furthermore, before filing this proceeding, the Complainant's counsel wrote to the Respondent concerning the infringing domain. However, Respondent did not reply. The evidence also shows that the Respondent has taken steps to hide his or her true identity by using a privacy service to avoid being notified of a UDRP proceeding, which panels have found supports an inference of bad faith. Finally, the Respondent has registered more than 150 domain names incorporating wellknown trademarks, and has, therefore, been recognized by multiple Panels to be a serial cybersquatter engaged in a pattern of conduct.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “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”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (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 Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to said mark.

The Complainant is the registered owner of several trademarks in the USA, in particular registered US trademark for PUBLIX No. 3,359,127.

Many UDRP panels have found that a domain name is confusingly similar to a complainant's trademark for purposes of the first element where the relevant trademark is recognizable within the domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 section of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))). This Panel shares the same view and notes that the disputed domain name identically contains the Complainant's registered trademark PUBLIX, which is placed at the beginning of the disputed domain name. The addition of the term “vaccine” does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name. The Panel is of the opinion that the trademark PUBLIX remains recognizable within the disputed domain name.

Finally, the generic Top-Level-Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1).

Hence, this Panel finds that the disputed domain name is identical or confusingly similar to the Complainant's trademark PUBLIX pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must further establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to a disputed domain name. In the Panel's view, based on the allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, it results from the evidence provided by the Complainant that the disputed domain name is currently connected to a parking page, featuring multiple PPC-links to commercial third-party websites, some of which advertise antivirus and marketing software. This Panel is of the opinion that such use does not represent a *bona fide* offering of goods or services and can therefore not constitute legitimate interests under paragraph 4(c)(i) of the Policy. In fact, previous UDRP panels have found that such pages with commercial links do not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see section 2.9 of the [WIPO Overview 3.0](#)). This is the case here, since the parking page is not connected to the trademark PUBLIX but contain links to commercial third-party websites.

Second, the Panel notes that there is no evidence in the record which could lead the Panel to conclude that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy. In addition, the Respondent does not appear to have any connection or affiliation with the Complainant.

Finally, use of the disputed domain name for a parking page, featuring multiple links to commercial websites excludes any noncommercial use in the sense of paragraph 4(c)(iii) of the Policy from the outset.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent failed to come forward with any allegations or evidence in this regard, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and are being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of a disputed domain name's registration and use in bad faith.

One of those circumstances are those specified in paragraph 4(b)(iv), *i.e.*, where the domain name is used to intentionally attempt to attract, for commercial gain, Internet users to your website 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 website or location or of a product or service on your website or location.

In the Panel's view, the Respondent has intentionally registered the disputed domain name which identically contain the Complainant's trademark PUBLIX plus an additional descriptive term. By the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant and its mark PUBLIX, which is identically included in the disputed domain name. These findings are reinforced by the fact that before he registered the disputed domain name, the Respondent had been involved in another UDRP proceedings involving the same trademarks (*Pet Plan Ltd v. William (chase) Bruder*, WIPO Case No. [D2020-1339](#)). The Complainant also proved that the Respondent is using the disputed domain name to lead to a parking page, with commercial PPC-links to commercial third-party websites. These facts confirm that the disputed domain name is used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith:

- (i) the fact that the disputed domain name identically includes the sign PUBLIX which has been used in commerce for more than nine decades;
- (ii) the Respondent originally masked his identity behind a privacy shield;
- (iii) the Respondent did not answer to the cease and desist letter sent by the Complainant before the present proceedings have been initiated;
- (iv) the Respondent did not provide any formal response with conceivable explanation for his behavior within these proceedings so that no legitimate use of the disputed domain name by the Respondent is conceivable for the Panel;
- (v) the fact that the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications; and
- (vi) the Respondent is engaged in a pattern of conduct since he did not only register the disputed domain name but has additionally recognized by multiple panels to be a serial cybersquatter (see *e.g.*, *Olaplex, Inc. v. Milen Radumilo*, WIPO Case No. [D2023-0928](#); *CITYA Immobilier v. Milen Radumilo*, WIPO Case No. [D2023-0634](#); *Laforêt France v. Milen Radumilo*, WIPO Case No. [D2023-0223](#); *Colibri SAS v. Milen Radumilo*, WIPO Case No. [D2022-1027](#)).

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <publixvaccine.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: September 22, 2023