

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company, Publix Super Markets, Inc. v.
peterpalmerdude Peter
Case No. D2024-3414

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 LLC, United States.

The Respondent is peterpalmerdude Peter, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <publixsol.xyz> is registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 21, 2024. On August 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 22, 2024, 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 August 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 14, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on September 20, 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 Complainant Publix Asset Management Company was founded in 1930 in the United States and provides services in connection with retail grocery stores, currently being a Fortune 500 company with more than 1,350 stores and more than 250,000 employees. The Complainant Publix Super Markets, Inc. owns and manages the trademarks that are licensed to the first Complainant. Being part of the same group of companies, they will be collectively referred to as the "Complainant".

The Complainant holds at least 65 United States trademark registrations for or incorporating PUBLIX, such as the following:

- United States trademark registration number 1339762 for PUBLIX (word), registered on June 4, 1985, for services in International class 42; and
- United States trademark registration number 1373131 for P PUBLIX (stylized), registered on November 26, 1985, for services in International class 42.

The Complainant's official website is available under the domain name <publix.com> and was registered on January 1, 1995.

The disputed domain name was registered on March 30, 2024, and, at the time of filing of the Complaint, it resolved to a website displaying the Complainant's trademarks, including the stylized mark P PUBLIX (even displaying the ® / "registered trademark" symbol) and the green color (similar to the Complainant's official website). Further, on the website under the disputed domain name was posted a link that says "buy".

When the Panel visited the website under the disputed domain name, it resolved to an error page.

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 its trademark is strong, fanciful and well-known in its industry and to the general public through longevity and national scope; the disputed domain name is confusingly similar to its trademark PUBLIX; the Respondent's use of the disputed domain name is likely to cause deception, mistakes, and confusion among consumers – and has caused actual confusion since, for example on April 10, 2024, a person called the Complainant asking to buy cryptocurrency, as presented on the website under the disputed domain name because, when accessing the "buy" link available on the website under the disputed domain name, the Internet user was diverted to a third party website, believed to belong to the Respondent or its affiliate, which sells goods and services related to token-generation; the Respondent has no rights or legitimate interests in the disputed domain name; the disputed domain name has been registered in bad faith, almost a century after the first use of the Complainant's mark and over twenty-five years after Complainant's registration of its official domain name; the disputed domain name was used by the Respondent as a "bait and switch", luring consumers with famous mark and then offering blockchain and cryptocurrency services that have no connection with the PUBLIX mark whatsoever.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

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

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 easily 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.

While the addition of other terms, here "sol", may bear on assessment of the second and third elements, the Panel finds the addition of such term 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

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 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.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain name in connection with a website containing the Complainant's trademark, displaying Complainant's logo and color scheme, and diverting Internet users to a third party's website, without providing any disclaimer or statement disclosing its (lack of) relationship with the Complainant.

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 disputed domain name was registered in bad faith, with knowledge of the Complainant and its trademark particularly because the disputed domain name incorporates the Complainant's famous trademark registered for about forty years and used in commerce for almost a century, and with the Complainant's official domain name registered for more than twenty-nine years. Further, the use of the disputed domain name enhances such finding.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

According to the evidence in the Complaint, the disputed domain name was used in relation to a website displaying the Complainant's trademarks and diverting Internet users to a third party's website.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name is similar to the Complainant's reputable trademark, and domain name, and the website operated under the disputed domain name displays the Complainant's trademark, logo and color scheme available on Complainant's official website, indeed in this Panel's view, the Respondent has intended to attract unsuspecting Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain.

The Respondent has not participated in the present proceeding and apparently provided inaccurate/incomplete contact information in the WhoIs, which prevented the delivery of the Center's Written Notice. Such facts, together with all the other elements in this case, support, in the eyes of this Panel, a finding of bad faith behavior.

Lastly, it should also be noted that the absence of content on the disputed domain name does not prevent a finding of bad faith under the Policy, considering the circumstances of the case. [WIPO Overview 3.0](#), section 3.3.

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 <publxsol.xyz> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: October 4, 2024