

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company v. Eric Thomas
Case No. D2022-4143

1. The Parties

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

The Respondent is Eric Thomas, United States.

2. The Domain Name and Registrar

The disputed domain name <publixcorporate.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 3, 2022, 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. The Center sent an email communication to the Complainant on November 8, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 9, 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, and the proceedings commenced on November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2022.

The Center appointed Ezgi Baklacı Gülkökar as the sole panelist in this matter on December 27, 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 Publix Asset Management Company is a corporation organized and existing under the laws of Florida, in the United States. It is a subsidiary of, and a licensor of trademarks to, Publix Super Markets, Inc. which owns and operates 1,308 retail stores. Publix Super Markets, Inc. is an employee-owned grocery chain in the United States.

The Complainant owns numerous trademarks registered in the US, consisting of or including the terms PUBLIX. *Inter alia*, Complainant owns the following registrations: PUBLIX (US reg. no. 2,739,635) registered on July 22, 2003, PUBLIX (US reg. no. 3,359,127) registered on December 25, 2007, PUBLIX (US reg. no. 3,774,699) PUBLIX (US reg. no. 3,774,700) and PUBLIX (US reg. no. 3,774,764) registered on April 13, 2010.

In addition, the Complainant is the owner of the domain names <publix.com> registered on January 31, 1995, and <publix.org> registered on December 10, 1997. The websites provide information about products available, grocery shopping, discounts, recipes, etc. The Complainant also uses the web address <corporate.publix.com> to display information about Publix, including information about working for and with Publix.

The disputed domain name was registered on June 7, 2022. As of the date of this Decision, the disputed domain name is resolving to an inactive website. However, the disputed domain name has been used to send fraudulent emails impersonating the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy is satisfied in the present case, as follows:

Identical or confusingly similar

The Complainant argues that the disputed domain name <publixcorporate.com> is confusingly similar to the Complainant's registered PUBLIX mark because it consists of its trademark with the term "corporate" and the generic Top-Level Domain ("gTLD") ".com."

Rights or legitimate interests

The Complainant argues that the Respondent is not licensed or authorized to use the Complainant's trademark. Therefore, the Respondent has no rights to any trademark consisting of or incorporating the Complainant's mark, or to the disputed domain name <publixcorporate.com>.

Further, the Complainant contends that the Respondent has not been commonly known by or associated with the disputed domain name. The disputed domain name has been used to send fraudulent emails purportedly from the Complainant. The Complainant also contends that in an attempt to conceal the fraud, the disputed domain name displayed the website at the Complainant's domain name <publix.com>. However, once the Complainant discovered the fraud, it submitted an abuse report to the Registrar, who subsequently removed the webpage displayed at the disputed domain name.

The disputed domain name was registered and used in bad faith

The Complainant claims that the Respondent's main aim in registering and maintaining the disputed domain name is to impersonate the Complainant for the purposes of email-based fraud.

Further, the disputed domain name currently is no longer linked to an active website, and the fact that the Respondent continues to hold the disputed domain name is a clear sign of bad faith.

In summary, the Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (ii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name <publixcorporate.com> consists of the registered trademark PUBLIX and the term "corporate". The Panel finds that the disputed domain name is confusingly similar to the registered trademark PUBLIX (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

The element "corporate" in the disputed domain does not prevent the finding of confusingly similarity as the Complainant's trademark PUBLIX remains clearly recognizable ([WIPO Overview 3.0](#), section 1.8).

Moreover, the gTLD ".com" is disregarded in the confusing similarity test, as it does not form part of the comparison as it is a standard registration requirement for technical reasons ([WIPO Overview 3.0](#), section 1.11).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and that the first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. While the overall burden of proof in UDRP proceedings is on the complainant, previous UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of proving a negative, *i.e.*, 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. 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).

The Panel notes that there is no evidence showing that the Respondent holds any rights in the term "publix". The Panel also notes that there is no evidence showing that the Respondent is authorized or licensed to use the Complainant's trademark PUBLIX.

Instead, the disputed domain name <publixcorporate.com> has been used to send fraudulent emails by impersonating the Complainant. The Complainant's allegations also includes evidence of a newspaper extract about an arrest made of the person purportedly impersonating the Complainant.

The evidence submitted by the Complainant indicates that the disputed domain is being used for fraudulent solicitations while representing the sender as being the Complainant ([WIPO Overview 3.0](#), section 2.13.1). See also *Beiersdorf AG v. PrivacyGuardian.org / Edward Peter Inc.*, WIPO Case No. [D2019-0149](#) (domain name used in attempted fraudulent email scheme designed to be deceptive and confusing, and an impersonation of the complainant by the respondent, cannot amount to *bona fide* offering of goods and services or a legitimate noncommercial or fair use).

The use of the disputed domain cannot amount to a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Therefore, the Panel finds that the Respondent does not have rights or any legitimate interests in the disputed domain name within the meaning of Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that a complainant must demonstrate that the disputed 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 trademark ([WIPO Overview 3.0](#), section 3.1).

The Panel finds that at the time the disputed domain name was registered the Respondent more likely than not was aware of the trademark PUBLIX as the Complainant's trademark registrations significantly predate the registration date of the disputed domain name. The Respondent knew or should have known about the Complainant's rights, and such information can be reached by a quick online search (see *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

Further, previous UDRP panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g. to solicit payment of fraudulent invoices by the complainant's actual or prospective customers ([WIPO Overview 3.0](#), section 3.4). The Panel finds that the Respondent's impersonation of the Complainant by use of the trademark PUBLIX in the disputed domain name to send fraudulent emails constitutes bad faith.

Further, the Complainant contends that the disputed domain name previously displayed the website at the Complainant's domain name <publix.com>, which was subsequently removed after the Complainant submitted an abuse report to the Registrar. The Panel finds that this is further evidence of bad faith.

Based on the available record, the Panel finds that the Complainant has succeeded in proving the requirement of paragraph 4(a)(iii) that the disputed domain name was registered and used in bad faith by the Respondent.

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, <publixcorporate.com> be transferred to the Complainant.

/Ezgi Baklacı Gülkökar/

Ezgi Baklacı Gülkökar

Sole Panelist

Date: January 10, 2023