

ADMINISTRATIVE PANEL DECISION

Publix Asset Management Company v. Pavlichenko Aleksandr Case No. D2022-0143

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 Pavlichenko Aleksandr, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <publix-ads.com> is registered with RU-CENTER-MSK (Regional Network Information Center, JSC dba RU-CENTER) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 14, 2022. On January 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 18, 2022, 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. On January 20, 2022, the Center sent a message to the Parties in English and Russian in respect of the language of the proceeding. On January 21, 2022, the Complainant requested that the proceeding be held in English. The Respondent did not submit any comments on the language of the proceeding.

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 in English and in Russian the Respondent of the Complaint, and the proceedings commenced on February 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 7, 2022. On May 13, 2022, the Complainant filed a request to the Center to expedite the appointment of a Panel.

The Center appointed Assen Alexiev as the sole panelist in this matter on May 18, 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 is a subsidiary and a licensor of trademarks to Publics Supermarkets, Inc. - the largest employee-owned business in the United States, founded in 1930, which owns and operates 1,229 retail stores, where retail sales in 2020 totaled USD 44.9 billion, and employs more than 197,000 people.

The Complainant is the owner of a number of trademark registrations for the sign "PUBLIX" (the "PUBLIX trademark"), including the United States trademark PUBLIX with registration No. 1339762, registered on June 4, 1985 for services in International Class 42, claiming first use in commerce on December 31, 1930.

The Complainant is also the owner of the domain names <publix.com>, registered on January 31, 1995, and <publix.org>, registered on December 10, 1997, which it uses for its official websites.

The disputed domain name was registered on July 12, 2021. It resolves to a website that offers Publix employees and clients to "log in" to the Complainant's online services, and offers to owners of Publix gifts cards to check the balances of their cards.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its PUBLIX trademark, because it consists of the entire trademark with the addition of a dash and the term "ads", which does not negate the confusing similarity between the trademark and the disputed domain name.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because the Respondent is not licensed or authorized to use the PUBLIX trademark and has no relationship with the Complainant. The Complainant submits that the disputed domain name was registered in 2021, many years after the PUBLIX trademark was first used in commerce in the United States, and many years after the registration of the Complainant's <publix.com> domain name. The Complainant states that the Respondent has not been commonly known by or associated with the disputed domain name and has not related trademark rights. According to the Complainant, the Respondent is using, or is allowing others to use, the disputed domain name in an infringing manner. The website at the disputed domain name suggests that Publix gift card owners are able to check their remaining card balances through the Respondent's website, but the comments on the website show that users are unable to do so. Similarly, the Respondent's website at the disputed domain name suggests that Publix employees are able to log in and access their personal employee accounts, but the comments on that website indicate that Publix employees have been unable to log in. The Complainant notes that the Respondent is doing this through a domain name that is confusingly similar to the Complainant's PUBLIX trademark and to the Complainant's <publix.com> and <publix.org> domain names, so persons who encounter the disputed domain name are likely to wrongly believe that it is associated with or endorsed by the Complainant. Therefore, according to the Complainant, the use of the disputed domain name by the Respondent does not constitute a *bona fide* use or a legitimate noncommercial or fair use of the disputed domain name, but is used to target the Complainant and trade off the goodwill of the PUBLIX trademark, and may represent a platform for an illicit scheme to misappropriate visitor personal data.

The Complainant refers to the decision in *Publix Asset Management Company v. Privacy Protection Service - whoisproxy.ru / Oleksandr Haidash*, WIPO Case No. [D2021-2132](#), regarding the domain name <publix-ad.com>, and notes that the website at the disputed domain name displays the same "comments" verbatim

from pages on the <publix-ad.com> domain name, inclusive of publication dates. According to the Complainant, this explains why there are comments on the disputed domain name “Gift Card Balance” page that date back to July 19, 2020 – 12 months before the disputed domain name was registered, and why there are comments on the “Employee Login” page of the disputed domain name that date back to June 6, 2020.

According to the Complainant, the similarities between the two cases provide support for the same findings as those made in the proceeding regarding the <publix-ad.com> domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the Respondent’s goal in registering and maintaining the disputed domain name was to misappropriate the Complainant’s trademark and to divert Internet users away from the websites of the Complainant at <publix.com> and <publix.org>, and such diversion disrupts the Complainant’s relationships with customers and other persons seeking information concerning the Complainant. The Complainant also points out that the Respondent has used the disputed domain name to display content with no disclaimer alerting visitors to the lack of a relationship with the Complainant.

The Complainant states that on June 1, 2021, it requested a transfer of the disputed domain name, but the Respondent did not reply.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural issue – Language of the proceeding

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain name is Russian. Under paragraph 11 of the Rules, 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 Complainant requests that the language of the proceeding be English. It submits that the Respondent understands English, because the disputed domain name contains English language words and displays an English language website.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainant’s request that the proceedings be held in English, and as noted by the Complainant, the website at the disputed domain name is in English.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English.

6.2 Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (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 respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”

The Respondent however did not submit a Response in this proceeding.

A. Identical or Confusingly Similar

The Complainant has provided evidence that he is the owner of various registrations of the PUBLIX trademark and has thus established his rights in this trademark for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The disputed domain name incorporates the PUBLIX trademark in its entirety with the addition of a hyphen and the word “ads”, and the trademark is easily recognizable in the disputed domain name, which is affirmed by the content on the associated website. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the [WIPO Overview 3.0](#).

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the PUBLIX trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Complainant has not authorized the Respondent to use the PUBLIX trademark, and that the Respondent is using the disputed domain name for an unauthorized by the Complainant website that is directed to its employees and clients and offers them access to the Complainant’s online services and possibly collects their personal data. Thus, 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 submitted a Response and has not alleged that it has rights or legitimate interests in the disputed domain name and has not disputed the Complainant's allegations in this proceeding. The evidence in the case file shows that the disputed domain name indeed resolves to a website that offers Publix employees and clients to "login" to the Complainant's online services, and offers to owners of Publix gifts cards the check the balances of their cards. It is unclear whether such access is indeed provided, but it appears that persons who attempt to use the services would have to provide certain personal data and potentially sensitive information.

In view of the above, the Panel is satisfied that it is more likely than not that the Respondent, being well aware of the goodwill of the Complainant's PUBLIX trademark, has registered the disputed domain name in an attempt to exploit the trademark's goodwill to attract Internet users to the Respondent's website which offers unauthorized access to the Complainant's online services and may collect personal data and sensitive information from unsuspecting users. To the Panel, such conduct does not appear to be legitimate nor giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

The Panel also notes that the website at the disputed domain name currently contains a disclaimer for the lack of relationship between the Parties, but the Panel does not consider that the presence of this disclaimer renders the Respondent's activities *bona fide* under the Policy. When Internet users have a chance to read the disclaimer they have already been attracted to the Respondent's website, under the mistaken impression that it is associated with the Complainant – which confusion is furthered by the appearance of a "copyright notice (in the form of "Copyright © 2022 «Publix» Weekly Ad"), and would be exposed to its unauthorized content.

In view of the above, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted 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."

As discussed above, the disputed domain name is confusingly similar to the PUBLIX trademark and has been used for a website that offers Publix employees and clients to "login" to the Complainant's online services, and offers to owners of Publix gifts cards the check the balances of their cards. It is unclear whether such access is indeed provided, but it appears that persons who attempt to use the services would have to provide certain personal data and potentially sensitive information. As discussed in the section on rights and legitimate interests above, the presence of a disclaimer and copyright notice on the Respondent's website does not render its activities *bona fide* under the Policy. As noted by the Complainant, the conduct

of the Respondent strongly resembles the conduct of the respondent in *Publix Asset Management Company v. Privacy Protection Service - whoisproxy.ru / Oleksandr Haidash*, WIPO Case No. [D2021-2132](#), regarding the domain name <publix-ad.com>, which displayed the same content and where the respective respondent was found to have acted in bad faith. In the lack of any contrary evidence, it seems likely that the two domain names have been controlled by the same person who has engaged in the same conduct.

Taking the above into account, the Panel accepts that it is more likely than not that the Respondent has registered and used the disputed domain name with knowledge of the Complainant and targeting the PUBLIX trademark in an attempt to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the PUBLIX trademark as to the affiliation or endorsement of its website and the services offered on it.

Therefore, the Panel finds that the disputed domain name has been registered and used in bad faith.

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 <publix-ads.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: July 14, 2022