

## **ADMINISTRATIVE PANEL DECISION**

Publix Asset Management Company, Publix Super Markets, Inc. v.  
Kyle McClanahan  
Case No. D2024-2880

### **1. The Parties**

Complainants are Publix Asset Management Company and Publix Super Markets, Inc., United States of America (“United States” or “U.S.”), represented by Holland & Knight, LLP, United States.

Respondent is Kyle McClanahan, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <publixsolana.org> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 15, 2024. On July 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 16, 2024, 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 (Registration Private, Domains By Proxy, LLC; Perfect Privacy, LLC; Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on July 18, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. The original complaint was filed against three domain names believed to be owned or operated by the same individual or entity. On July 18, 2024, the Center informed Complainant that the domain names were registered to three different individuals or entities. Complainant filed an amended Complaint on September 3, 2024, to proceed solely against <publixsolana.org>.

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 Respondent of the Complaint, and the proceedings commenced on September 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 24, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on September 27, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on October 1, 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**

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Publix Super Markets, Inc., and its affiliate Publix Asset Management Company which owns and manages the trademarks licensed to Publix Super Markets, Inc. (collectively, "Complainant") since 1930 have provided retail grocery store services, pharmacy services, catering services, as well as food products, beverages, vitamins and supplements, hygiene items, and many more goods under the trademarks PUBLIX and PUBLIX-formative design marks (the "PUBLIX Marks"). Complainant asserts its PUBLIX Marks enjoy widespread recognition across the United States and are famous, having gained notoriety in the United States with continuous use since 1930. Publix has grown into a Fortune 500 company with more than 1,350 stores and more than 250,000 employees.

Complainant holds at least 65 current U.S. federal trademark registrations for the PUBLIX Mark and variations thereof in the United States used in connection with Complainant's retail grocery store, pharmacy, and catering services, as well as for a wide variety of, food products, beverages, vitamins and other goods, including:

1. U.S. Registration No. 1339762, PUBLIX, registered on June 4, 1985, for retail grocery store services in Class 42, and claiming a first use date of December 31, 1930.
2. U.S. Registration No. 1391014, PUBLIX, registered on April 22, 1986, for a range of food products in Class 30, and claiming a first use date of January 2, 1985.
3. U.S. Registration No. 1370458, PUBLIX, registered on November 12, 1985, for a range of beverage products in Class 32, and claiming a first use date of January 2, 1985.

Complainant has also registered domain names that incorporate the PUBLIX Mark, including <publix.com>, registered by Complainant on January 31, 1995, and used to access the official PUBLIX website (the "Official PUBLIX Mark Website") where Complainant promotes its grocery store services and food products sold in connection with the PUBLIX Marks.

The disputed domain name was created on April 8, 2024, and as of the date of the filing of the Complaint, resolved to a website landing page advertising blockchain and cryptocurrency-affiliated goods and services under the PUBLIX Mark and logo ("Respondent's Website"). The website also featured the term "solana", suggesting the website may be operated or sponsored by a blockchain company using Respondent's Website as a Solana token-generation website while trading off Complainants' established trademark rights, which has resulted in at least one instance of actual confusion when a customer called Complainant asking to buy cryptocurrency at its grocery store.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's trademark. Complainant contends it has well established registered and incontestable trademark rights in the PUBLIX Marks and the disputed domain name is confusingly similar because it incorporates the PUBLIX Mark in its entirety. The addition of the term "solana" in the disputed domain name does not prevent confusing similarity with Complainant's PUBLIX Mark under the Policy.

Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name because Respondent has no commercial relationship with Complainant or license to use the disputed domain name or PUBLIX Marks, is not commonly known by the disputed domain name or the PUBLIX Marks and Respondent currently uses the disputed domain name to redirect users to a website used for illegitimate purposes to impersonate Complainant and/or redirect users to Respondent's website for Respondent's commercial gain through its blockchain and cryptocurrency business.

Finally, Complainant contends that the disputed domain name was registered and is being used in bad faith based on the unauthorized use of Complainant's widely recognized and famous PUBLIX Marks in the disputed domain name in order to attract Internet users to Respondent's website by creating a likelihood of confusion with Complainant and its PUBLIX Marks as to the source, sponsorship, affiliation, or endorsement of Respondent's Solana token-generation Website. Further, Respondent has added "solana" to amplify this false association, and to fraudulently imply that Respondent and its cryptocurrency business is affiliated with Complainant and its retail grocery store services. Combining Respondent's configuration of its disputed domain name using the PUBLIX Mark in its entirety to imply affiliation with Complainant to pursue the illegitimate purposes for which the disputed domain name has been used as listed in Section 6 below is sufficient to show bad faith registration and use under the Policy.

### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will deal with each of these requirements in turn.

#### **A. Identical or Confusingly Similar**

To prove this element, Complainant must first establish that there is a trademark or service mark in which it has rights. Ownership of a nationally registered trademark constitutes prima facie evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. It is evident that Complainant possesses famous, widely recognized rights in the PUBLIX Marks. Complainant has been utilizing the PUBLIX Marks since 1930, promoting a broad spectrum of retail grocery store, pharmacy, catering and related services to distribute a wide array of food and consumer products. The PUBLIX Marks, in continuous use for decades, are protected by common law rights and statutory U.S. trademark registrations, thereby solidifying Complainant's exclusive rights. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting national trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has rights in the PUBLIX Marks. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the PUBLIX Marks established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's PUBLIX Marks. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7.

Prior UDRP panels have held the fact that a domain name which wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. [WIPO Overview 3.0](#), section 1.8 ("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 also, *BNP Paribas v. Ronan Laster*, WIPO Case No. [D2017-2167](#); *WhatsApp Inc. v. Moose Scheib*, WIPO Case No. [D2019-0541](#).

The disputed domain name incorporates Complainant's PUBLIX Mark in its entirety and adds the term "solana". Respondent's addition to Complainant's Mark of this term to form the disputed domain name would not prevent a finding of confusing similarity as noted in the UDRP precedents cited above. The addition of the generic Top-Level Domain ("gTLD") ".org" is irrelevant in determining whether the disputed domain name is confusingly similar. See, *Research in Motion Limited v. thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#); [WIPO Overview 3.0](#), section 1.11.1.

Based on the above, the Panel finds that the added term "solana" does not prevent a finding of confusing similarity between the disputed domain name and Complainant's PUBLIX Marks. Complainant's famous PUBLIX Mark remains fully recognizable as incorporated in its entirety into the disputed domain name. The similarity in domain names is consistent with previous UDRP decisions, where even slight deviations or additions to a well-known trademark have not been deemed sufficient to avoid confusing similarity. See, e.g., *Meta Platforms, Inc. et al. v. Abuz Hamal et al.*, WIPO Case No. [D2022-0212](#); and *Averitt Express, Inc. v. Domain Administrator, See PrivacyGuardian.org / NameSilo, LLC, Expired Domain*, WIPO Case No. [D2021-4258](#).

Accordingly, the Panel finds the disputed domain name is confusingly similar to the PUBLIX Marks in which Complainant has rights. Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Under the second element of the Policy, Complainant has to make out a prima facie case that the respondent does not have rights to or legitimate interests in the disputed domain name, and if successful the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the disputed domain name. If the respondent fails to come forward with such evidence, a complainant may be deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or legitimate interests.

The first example, under paragraph 4(c)(i), is where “before any notice to you of the dispute, your use of, or demonstrable 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”.

Here, the annexes to the Complaint show that the disputed domain name resolves to a website configured by Respondent to pass off its blockchain and cryptocurrency business as a Solana token-generation website sponsored or endorsed by Complainant through incorporating Complainant’s PUBLIX Mark into its disputed domain name. Complainant contends Respondent created such configuration to capitalize on Complainant’s established goodwill and brand recognition, as an apparent “bait and switch”, luring consumers with the famous PUBLIX Mark to Respondent’s Website but then offering Respondent’s blockchain and cryptocurrency services that have no connection with Complainant or its Mark whatsoever, to generate revenues from the sale of Respondent’s cryptocurrency products for Respondent’s commercial benefit. Complainant contends that Respondent furthers the false association with Complainant by displaying “\$PUBLIX SOLANA COMMUNITY” at the top of Respondent’s Website.

Prior UDRP panels have held that the use of a domain name to confuse and attract Internet users through misuse of a well-known trademark, and the provision of content which promotes goods and services impersonating or competitive to Complainant cannot be considered use in connection with a bona fide offering of goods or services under Paragraph 4(c)(i). See e.g., *The Clorox Company v. WhoisGuard Protected, WhoisGuard, Inc. / Enos Villanueva, Melissa Rosenberg, Yang Ming*, WIPO Case No. [D2021.0603](#) and *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Prior UDRP panels have also held that the use of a domain name for illegal activity involving impersonation and fraud (e.g., impersonation/passing off, phishing, unauthorized account access/hacking, or other types of fraud) can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#), section 2.13. See also, *Springer Nature Limited v. Registration Private, Domains By Proxy, LLC / Collections Springer Nature*, WIPO Case No. [D2020-0955](#).

Applying the foregoing decision to these facts this Panel finds the disputed domain name is not being used in connection with a bona fide offering of goods or services sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that Complainant operates grocery stores and has no connection to blockchain or cryptocurrency (the subject of Respondent's Website accessed through the disputed domain name). Complainant and Respondent, therefore, have no commercial relationship. Neither has Complainant granted Respondent any license or authorization to use the PUBLIX Marks for any purpose, including as a domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

Complainant also shows that Respondent is not commonly known by the disputed domain name because the original Respondent listed in the Whois record submitted with the initial Complaint displayed "Registration Private/Domains By Proxy, LLC of the United States". The Registrar identified the underlying registrant in its verification process, "Kyle McClanahan" of the United States, who has been substituted in the amended Complaint as Respondent. Neither the original nor the substitute bears any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a lack of rights or legitimate interests in the disputed domain name. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

Finally, given Complainant's illegitimate use of the disputed domain name to create confusion with the well-known PUBLIX Mark to pass itself off as Complainant for Respondent's commercial benefit, Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, and therefore cannot benefit from subsection Paragraph 4(c)(iii).

In light of the above, and with no Response or other submission in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, Complainant contends that its PUBLIX Marks are well-known in the industry and to the general public given their longevity of use and national scope, especially in the United States where Respondent is located. Complainant further contends that fact that the disputed domain name incorporates the PUBLIX Mark in its entirety, shows Respondent's actual knowledge of the PUBLIX Mark. The PUBLIX Marks have been in use for its retail grocery store, pharmacy, catering and related services and products for decades dating back to 1930 and registered in the U.S. for almost forty years before Respondent registered the disputed domain name. Complainant registered <publix.com> the domain name used to access its Official PUBLIX Mark Website in 1995. Prior UDRP panels have found that where, as here, it would be implausible to believe that Respondent selected and was using the disputed domain name for any other purpose than to target Complainant's mark and trade on Complainant's trademark rights and reputation, Respondent was disrupting Complainant's business by diverting business and prospective business away from Complainant and its

goods and services. Such activity in opposition to Complainant and disruptive to Complainant's business establishes a fact pattern that repeatedly has been held to constitute bad faith registration and use under paragraph 4(b)(iii) of the Policy. See *Galderma Holding S.A. v. Withheld for Privacy Purposes Privacy service provided by Withheld for Privacy ehf / Yves Aya*, WIPO Case No. [D2021-0981](#); see also *Philip Morris Products S.A. v. Rich Ardeia*, WIPO Case No. [D2020-0528](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises a complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain name. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#). Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Finally, as noted in 6B. above, Respondent has intentionally configured the disputed domain name to enhance confusing similarity to Complainant's PUBLIX Mark by adding the term "solana" to the PUBLIX Mark and using the PUBLIX Mark and logo on Respondent's Website to create a false association to direct or redirect consumers to Respondent's Website offering blockchain and cryptocurrency services. Prior UDRP Panels have found these facts demonstrate a clear indication that Respondent abused Complainant's PUBLIX Mark by incorporating it into the disputed domain name to create a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of Respondent's website to intentionally attract Internet users to its website for Respondent's own commercial gain and, therefore, registered and used the disputed domain name in bad faith in violation of paragraph 4(b)(iv) of the Policy. See, e.g., *AXA SA v. Yang Ji Feng*, WIPO Case No. [D2017-1299](#); *Royal Bank of Canada v. China Capital Investment Limited*, WIPO Case No. [D2017-1025](#); and *Travelscape, LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Irwin Periola*, WIPO Case No. [D2020-2741](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied 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 <publixsolana.org> be transferred to Complainant.

*/Scott R. Austin/*

**Scott R. Austin**

Sole Panelist

Date: October 18, 2024