

ADMINISTRATIVE PANEL DECISION

**Philip Morris Products S.A. v. Contact Privacy Inc., Customer 0163300138,
Contact Privacy Inc., Customer 0163503231 / Lupo Abate, ExclusiveHeets
Case No. D2022-0240**

1. The Parties

The Complainant is Philip Morris Products S.A., Switzerland, represented by D.M. Kisch Inc., South Africa.

The Respondent is Contact Privacy Inc., Customer 0163300138, Contact Privacy Inc., Customer 0163300138, Canada / Lupo Abate, ExclusiveHeets, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names <exclusiveheets.com> and <123heets.com> are registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 25, 2022. On January 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 27, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 27, 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 January 28, 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 January 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on March 3, 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 Philip Morris Products S.A. is a company which is part of the group of companies affiliated to Philip Morris International Inc. and a tobacco and smoke-free products company. The Philip Morris Group also sells reduced risk products such as a tobacco heating system called IQOS. IQOS is a precisely controlled heating device into which specially designed tobacco sticks under the brand names “Heets” are inserted and heated to generate a flavourful nicotine-containing aerosol.

The disputed domain names have been registered on December 13, 2021 <exclusiveheets.com> and January 13, 2022 <123heets.com> respectively. The language of the registration agreements at the time of registration was English.

The Complaint is based amongst others on the International Registration HEETS (word) No. 1326410 registered on July 19, 2016 for goods in classes 9, 11, 34 and designating a large number of countries worldwide.

It results from the undisputed evidence provided by the Complainant that both disputed domain names resolve to the same web shop in the Italian language under the disputed domain name <123heets.com> allegedly selling and offering the Complainant’s IQOS System. In addition, this web shop prominently features at its head the HEETS trademark (preceded by the term “exclusive”) and uses a number of the Complainant’s official product images without the Complainant’s authorization.

5. Parties’ Contentions

A. Complainant

First, the Complainant alleges that when accessing the disputed domain name <exclusiveheets.com>, the user is redirected to the same Website for the disputed domain name <123heets.com>.

Second, the Complainant contends that the disputed domain names are confusingly similar to its earlier trademarks, they reproduce the HEETS trademark in its entirety, in addition to the nondistinctive and descriptive word “exclusive”; and non-distinctive number “123” respectively. The addition of such merely descriptive wording to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP.

Thirdly, the Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain names. In particular, the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its HEETS trademark. Furthermore, the Respondent’s behaviour shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademarks owned by the Complainant. It is a common principle that the use of a domain name cannot be “fair” if it suggests an affiliation with the trademark owner. Such an affiliation is suggested in the case at hand by the following facts: (i) the disputed domain names contain the HEETS trademark, (ii) the website, prominently presents the Complainant’s trademark HEETS at the top of the Website and without authorization and (iii) the Website further uses the Complainant’s official product images without authorization, while at the same time falsely claiming copyright in this material.

Fourthly, the Respondent’s registration and use of the disputed domain names constitutes – in the Complainant’s view – bad faith in particular, because by using the disputed domain names, the Respondent

intentionally attempted 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 or location or of a product or service on the Respondent's website or location. Since the disputed domain names are used for a website which is headed with the Complainant's trademark and which is concerned with selling the Complainant's products, the Respondent was well aware of the Complainant and its trademark.

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 names should be transferred or cancelled:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel is satisfied that the registrant of record for the disputed domain names 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 establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various trademark registrations in several jurisdictions consisting of the term "HEETS". Reference is made in particular to International Registration HEETS (word) No. 1326410 registered on July 19, 2016 for goods in classes 9, 11, 34 and designating a large number of countries worldwide.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark for purposes of the first element, where the relevant trademark is recognizable within the disputed 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 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 both disputed domain names contain the Complainant's registered trademark HEETS in full with the addition of the terms "exclusive" and "123", respectively. The additional terms "exclusive" and "123" do not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain names. Consequently, this Panel is of the opinion that the trademark HEETS remains recognizable within both the disputed domain names.

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

In the light of the above, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

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

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 the disputed domain names. In the Panel's view, based on the undisputed 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 names.

First, it results from the Complainant's uncontested evidence that both disputed domain names resolve to a website which prominently presents the Complainant's trademark HEETS at the top of the Website and without authorization. Furthermore, this website uses the Complainant's official product images without authorization, while at the same time falsely claiming copyright in this material. Finally, the disputed domain names identically contain the HEETS trademark. In this Panel's view, such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use rather capitalizes on the reputation and goodwill of the Complainant's trademarks and is therefore likely to mislead Internet users (*cf.* [WIPO Overview 3.0](#) at section 2.9). In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain names. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized the Respondent's use of the HEETS trademarks for registering the disputed domain names, which are confusingly similar.

Furthermore, the Panel notes that there is no evidence in the record or WhoIs information showing that the Respondent might be commonly known by the disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel is satisfied that the registered HEETS trademark is distinctive so that it is unlikely that the Respondent wanted to fairly use the disputed domain names consisting of this trademark with further non-distinctive elements. In addition, the disputed domain names are used for a commercial website, so a noncommercial use is excluded from the outset.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has therefore 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 names have 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 disputed domain names' registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain names, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of

a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

It results from the Complainant's documented allegations that the disputed domain names resolve to a website which prominently presents the Complainant's trademark HEETS at the top of the Website while the Complainant has not given any authorisation for such use and is not linked to the Respondent or this website. Furthermore, this website uses the Complainant's official product images without authorization, while at the same time falsely claiming copyright in this material. Finally, the disputed domain names identically contain the HEETS trademark. For the Panel, it is therefore evident that the Respondent positively knew the Complainant's trademarks and products. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain names included the Complainant's trademark entirely when it registered these domain names. Registration of a domain name which contains a third party's trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see e.g., *KOC Holding A.S. v. VistaPrint Technologies Ltd*, WIPO Case No. [D2015-1910](#); *The Chancellor, Masters and Scholars of the University of Oxford v. Oxford College for PhD Studies*, WIPO Case No. [D2015-0812](#); *The Chancellor, Masters and Scholars of the University of Oxford v. Almutasem Alshaikhissa*, WIPO Case No. [D2014-2100](#); and *Deutsche Lufthansa AG v. Mustermann Max, Muster AG*, WIPO Case No. [D2015-1320](#)).

The finding of bad faith registration and use is also supported by the following further circumstances resulting from the case at hand:

- (i) the Respondent's failure to submit a response,
- (ii) the Respondent's failure to provide any evidence of actual or contemplated good-faith use,
- (iii) the implausibility of any good faith use to which the disputed domain names may be put, and
- (iv) the Respondent concealing its identity behind a privacy shield.

In the light of the above the Panel finds that the disputed domain names have been registered and are 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 names, <exclusiveheets.com> and <123heets.com>, be transferred to the Complainant.

/Tobias Malte Müller/
Tobias Malte Müller
Sole Panelist
Date: March 17, 2022