

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. MD Rubel
Case No. D2022-3663

1. The Parties

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

The Respondent is MD Rubel, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <iqosdubaishop.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 4, 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 October 7, 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 October 7, 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 October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 1, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on November 4, 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 in this administrative proceeding is Philip Morris Products S.A. a Swiss company established under the laws of Switzerland and a subsidiary of Philip Morris International, Inc.

The Complainant is a company which is part of the group of companies affiliated to Philip Morris International Inc.

The Complainant is a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries and has unequalled trademark portfolio contains brands like MARLBORO (outside of the United States of America and Canada), selling cigarette brand since 1972.

The Complainant is also known for innovating across its trademark portfolio. In the course of transforming its business from combustible cigarettes to Reduced Risk Products the Complainant has developed a number of reduce risk products. One of these RRP developed and sold by the Complainant is a tobacco heating system called IQOS. IQOS is a precisely controlled heating device into which specially designed tobacco sticks under the brand names "HEETS", "HeatSticks" or "TEREA" are inserted and heated to generate a flavorful nicotine-containing aerosol (collectively referred to as the "IQOS System").

According to the Complainant, there are 5 versions of the IQOS heating device currently available: the IQOS 2.4/IQOS 2.4+ pocket charger and holder, IQOS 3 pocket charger and holder, IQOS 3 Multi device, IQOS 3 DUO/DUOS and IQOS ILUMA. The IQOS System was first launched by PMI in Nagoya, Japan in 2014 and has obtained an extraordinary 20% share of the market in Japan.

Today the IQOS System is available in key cities in around 71 markets across the world. As a result of an investment of over USD 9 billion into the science and research of developing smoke-free products and extensive international sales (in accordance with local laws), the IQOS System has achieved considerable international success and reputation, and approximately 19.1 million relevant consumers using the IQOS System worldwide. In the present moment, the IQOS System has been almost exclusively distributed through the Complainant's official IQOS stores and websites and selected authorized distributors and retailers.

For its new innovative smoke-free products, the Complainant owns a large portfolio of well-known trademarks. The Complainant enclosed to its Complaint enough evidence of the trademark registrations in the United Arab Emirates ("UAE"), among them the following:

- UAE Registration IQOS (word) No. 211139 registered on March 16, 2016;
- UAE Registration IQOS (word/stylized) No. 257763 registered on April 22, 2018;
- UAE Registration IQOS (word/stylized) No. 305079 registered June 27, 2019;
- UAE Registration HEETS (word) No. 256864 registered on December 25, 2017; and
- UAE Registration (word/device) No. 256867 registered on December 25, 2017.

The disputed domain name was registered on August 19, 2022. According to evidence submitted by the Complainant, the disputed domain name has resolved to a website at "www.iqosdubaishop.com" which includes "IQOS DUBAI STORE". At the moment of this decision the website is inactive.

The Complainant has its official website at "www.iqos.com"

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its trademark IQOS. Due to the fact that the trademark is included in its entirety with the addition of the words "dubaishop". Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established its trademark rights in the IQOS trademark. The test that a panel must carry out in order to establish if a domain name is confusingly similar to a trademark involves the comparison between the trademark and the domain name.

Regarding whether the disputed domain name is identical or confusingly similar to the IQOS trademark, this Panel observes that the disputed domain name is comprised of: (a) the Complainant's trademark IQOS; (b) with the addition of the words "dubaishop" (c) followed by the generic Top-Level Domain ("gTLD") ".com".

The dominant part of the disputed domain name comprises the Complainant's trademark IQOS in its entirety. It is well established that where a domain name incorporates a complainant's trademark in its entirety, the domain name will be normally considered confusingly similar to that mark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

The disputed domain name also comprises the trademark and the words "dubaishop". 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 [WIPO Overview 3.0](#), section 1.8.

The addition of the gTLD ".com" is a technical requirement and therefore is irrelevant to determine the confusing similarity between the trademark and the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following: (i) before any notice to it of the dispute, the respondent's 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; or (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

Even though the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#) that a Complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant allegations and evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with arguments or evidence proving its rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not commonly known by the disputed domain name or the trademark IQOS. The Respondent has not been authorized by the Complainant to register or use the trademark IQOS in any way including the disputed domain name. At the moment of this decision the website is inactive.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case was established by the Complainant and has not been refuted by the Respondent.

Based on the following reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name:

(a) The Respondent has not rebutted and has not presented evidence in this case showing that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Therefore, the Respondent has not provided evidence of a legitimate use of the disputed domain name. There has been no evidence to show that the Complainant has licensed or otherwise permitted the Respondent to use the IQOS trademarks or to apply for or use any domain name incorporating the IQOS trademarks;

(b) There has been no evidence presented in this case to demonstrate that the Respondent has been commonly known by the disputed domain name. There has been no evidence included in the present case showing that the Respondent has any registered trademark rights with respect to the disputed domain name. The Respondent registered the disputed domain name in August 2022 long after the IQOS trademarks became internationally known. The disputed domain name is confusingly similar to the Complainant's IQOS trademarks;

(c) There has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name. According to the Complainant and the evidence presented in the Complaint, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Respondent's behavior 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. Due to the fact that the Respondent is not an authorized distributor or reseller of the IQOS System and in the website displayed in the disputed domain name is selling competing tobacco products and/or accessories of other commercial origin, consumers could be confused due to the fact that any Internet user when visiting a website under the disputed domain name will reasonably expect to find a website commercially linked to the Complainant, and this type of association could not be considered a legitimate noncommercial or fair use of the disputed domain name.

At the time of this decision, the disputed domain name is inactive.

In light of the above, the Complainant has complied with the second element of the Policy. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

This Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy. In order to prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith, accordingly it is a cumulative requirement.

The Panel accepts the Complainant's submissions that the trademark IQOS is distinctive and invented, and that it is obvious that the Respondent registered the disputed domain name with the intention of referring to the Complainant's trademark and the products associated. The Panel consents with the Complainant's argument that the Respondent knew of the Complainant's IQOS trademark when registering the disputed domain name. The term "iqos" is not commonly used to refer to tobacco products or electronic devices. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the disputed domain name without the intention of invoking a misleading association with the Complainant.

The Panel is satisfied that the Respondent must have been aware of the trademark IQOS when it registered the disputed domain name as the disputed domain name contains the trademark IQOS in its entirety, together with the words "dubaishop", both terms could be related to the Complainant's store in Dubai.

The Panel finds that the evidence in the case shows that the Respondent registered the disputed domain name in bad faith.

The Panel also finds that the use of the disputed domain name is in bad faith.

Section 3.1.4. of the [WIPO Overview 3.0](#) provides: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant's (or a competitor's) website, and (vi) absence of any conceivable good faith use.

In the present case, the Panel finds that the use of the disputed domain name is in bad faith as the website that was displayed by the Respondent before this decision reproduces the Complainant's trademark which creates a likelihood of confusion with the Complainant's products.

Even if the website at the disputed domain name at the present moment is inactive, it had previously reproduced the Complainant's registered trademark. Additionally, the title of the website was clearly suggesting to any Internet user visiting the website that the Complainant (or an affiliate dealer of the Complainant) is the source of the website, which is not. Also, the Respondent is not only using the Complainant's IQOS trademark for the purposes of offering for sale the IQOS system, but also for purposes of offering sale third party products of other commercial origin. Such use of the Complainant's IQOS trademark for purposes of promoting competing products is evidence of bad faith.

The Respondent changed the disputed domain content from an active website which used to display similar products to the products offered by the Complainant and under the IQOS trademark to an inactive website.

This Panel consider that this type of conduct also is evidence of bad faith.

The disputed domain name is currently inactive. In terms of inactive domain names, section 3.3 of the [WIPO Overview 3.0](#) provides: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.”

Section 3.3 of the WIPO overview 3.0 further states:

“While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

Taking into account all the circumstances of this case, the Panel concludes that the current inactive use of the disputed domain name by the Respondent is in bad faith, due to the fact that the trademark is renown.

In summary, the Respondent, by choosing to register and use the disputed domain name, which is confusingly similar to the Complainant’s well-known trademark, intended to disrupt the Complainant’s business. In the absence of convincing evidence and rebuttal to the contrary from the Respondent, the choice of the disputed domain name and the conduct of the Respondent are indicative of registration and use of the disputed domain name in bad faith.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith. Therefore, the Panel sustain that the Complaint fulfils the third condition of paragraph 4(a) 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 <iqosdubaishop.com> be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: November 18, 2022