

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Tadayuki Homma  
Case No. D2022-0045

### **1. The Parties**

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

The Respondent is Tadayuki Homma, Japan.

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

The disputed domain names <iqoslabo.com> and <iqosnote.com> are registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 6, 2022. On January 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 7, 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 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 in English on January 10, 2022.

On January 7, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 10, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on January 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 3, 2022.

The Center appointed Masato Dogauchi as the sole panelist in this matter on February 10, 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**

Whereas the Respondent has not submitted any formal response, the following information from the Complaint is found to be the factual background of this case.

The Complainant is a company which is part of the group of companies affiliated to Philip Morris International Inc., which is one of the largest international tobacco and smoke-free products company with products sold in approximately 180 countries. The Complainant has been transforming its business from combustible cigarettes to reduced risk products, One of such new product is a tobacco heating system called "IQOS". The IQOS system was first launched in 2014. As a result of an investment of over USD 8.1 billion into the development of smoke-free products and extensive international sales, the IQOS system has acquired approximately 19.1 million consumers worldwide.

The Complainant owns a large portfolio of IQOS trade marks such as follows:

- Japanese Registration No. 5727311, IQOS (word), registered on December 19, 2014; and
- International Registration No. 1338099, IQOS (figurative), registered on November 22, 2016, designating various jurisdictions including Japan.

The disputed domain name <iqoslabo.com> was registered on November 22, 2016, and the disputed domain name <iqosnote.com> was registered on July 23, 2017.

On the websites associated with the disputed domain names, there are buttons linking to third party online shops selling the Complainant's IQOS system, as well as competing products.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions are divided into three parts as follows:

First, the Complainant asserts that the disputed domain names are confusingly similar to its trade mark, since the disputed domain names include the Complainant's IQOS trade marks the trade mark. The addition of merely generic or descriptive wording to a trademark in a domain name should normally be insufficient in itself to avoid a finding of confusing similarity. Accordingly, the addition of non-distinctive words "labo" and "note" to the Complainant's IQOS trade marks respectively should be disregarded in this context. Further, on the basis of well-established authority, the generic Top-Level Domain ("gTLD"), in this case ".com", should be disregarded in assessing confusing similarity.

Second, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names. According to prior UDRP decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the Respondent. The Complainant confirms that the Complainant has not

licensed or otherwise permitted the Respondent to use its IQOS trade mark or to register the disputed domain names incorporating its IQOS trade mark. The Respondent has not used the disputed domain names in connection with the *bona fide* offering of goods or services. Instead, the fact that the websites associated with the disputed domain names linked to third party online shops selling the Complainant's IQOS system shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the Complainant's IQOS trade mark.

Third, the Complainant asserts that the disputed domain names have been registered and are being used in bad faith. Because the term IQOS is purely an imaginative term and unique to the Complainant and the term is not commonly used, it is therefore beyond the realm of reasonable coincidence that the Respondent chose the disputed domain names without the intention of invoking a misleading association with the Complainant. By reproducing the Complainant's IQOS trade mark in the disputed domain names and the titles of the websites associated with the disputed domain names, the Respondent is clearly suggesting to any Internet user visiting the websites that the Complainant is the source of the websites, which it is not.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Issue: Language of Proceedings**

In respect of the language to be used in the administrative proceeding, in accordance with the Rules, paragraph 11(a), the language of the administrative proceeding shall be, in principle, the language of the registration agreement. However, the same provision allows the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In the present case, the Registrar has confirmed that the language of the Registration Agreement is Japanese.

The Panel determines that the language of this proceeding shall be English rather than Japanese on the following grounds:

- the Complainant requested to that effect;
- the Respondent surely has become aware of this case filed by the Complainant and did not reply to the notification in both English and Japanese by the Center that the Respondent was invited to indicate its objection, if any, to the Complainant's request for the language by the specified due date; and
- the disputed domain names are in Latin script and not in Japanese script;
- the websites resolving from the disputed domain name display copyright notices in the English language; and,
- the use of Japanese language would produce undue burden on the Complainant in consideration of the absence of a Response from the Respondent.

### **6.2. Substantive Matters**

In accordance with the Rules, paragraph 15(a), a panel shall decide a case on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. Since the Respondent has not made any substantive arguments in this case, the following decision is rendered on the basis of the Complainant's contentions and other evidence submitted by the Complainant.

In accordance with the Policy, paragraph 4(a), in order to qualify for a remedy, the Complainant must prove each of the following:

- (i) the disputed domain names are identical or confusingly similar to a trade mark 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.

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

The Panel finds that the Complainant has the right in the IQOS trade mark.

The disputed domain names include the Complainant's IQOS trade mark. Such inclusions are by themselves enough to have the disputed domain names confusing similar to the Complainant's IQOS trade mark. Addition of the terms "labo" and "note" in the disputed domain names respectively do not prevent a finding of confusing similarity. Further, as well-established in prior UDRP decisions, the gTLD ".com" contained in the disputed domain names respectively is typically irrelevant in the determination of the confusing similarity.

Therefore, the Panel finds that the disputed domain names are confusingly similar to the trade mark in which the Complainant has rights. The above requirement provided for in paragraph 4(a)(i) of the Policy is accordingly satisfied.

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

There is no evidence at all that shows the Respondent is commonly known by the name "iqoslabo" or "iqosnote". The Respondent is not affiliated with the Complainant or authorized or licensed to use the Complainant's IQOS trade mark. Use of the disputed domain names to offer goods of the Complainant and its competitors without any explanation regarding the (lack of) relationship with the Complainant constitutes neither a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use.

Since the Respondent did not reply to the Complainant's contentions in this proceeding, the Panel finds on the available record that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The above requirement provided for in paragraph 4(a)(ii) of the Policy is accordingly satisfied.

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

The Complainant is one of the companies within a large tobacco and smoke-free products company group and its IQOS trade mark is famous worldwide. Therefore, it is highly unlikely that the Respondent would not have known of the Complainant's right in the trade mark at the time of registration of the disputed domain names. Nothing in the disputed domain names bear any reasonable relevance to the Respondent. In consideration of the uniqueness of the mark IQOS, there can be found no reasonable possibility of fortuity in the Respondent's innocent registration of the disputed domain names. The use of the disputed domain names also points to the Respondent's knowledge of the Complainant and its trade marks. Therefore it is found that the Respondent registered the disputed domain names in bad faith.

With regard to the requirement that the Respondent is using the disputed domain names in bad faith, the fact that the websites associated with the disputed domain names linked to third party online shops selling the Complainant's IQOS system and competing products without any explanation of the (lack of) relationship with the Complainant shows the Respondent's use of the disputed domain names in bad faith. In these circumstances it is clear the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's IQOS trade marks.

Since the Respondent did not reply to the Complaint in this proceeding, the Panel finds that the disputed domain names have been registered in bad faith and are being used in bad faith. The above requirement provided for in paragraph 4(a)(iii) of the Policy is accordingly satisfied.

In conclusion, all three cumulative requirements as provided for in paragraph 4(a) of the Policy are determined to be satisfied.

## **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, <iqoslabo.com> and <iqosnote.com>, be transferred to the Complainant.

*/Masato Dogauchi/*

**Masato Dogauchi**

Sole Panelist

Date: February 24, 2022