

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Alec Morgan, GreenHost Case No. D2023-4282

1. The Parties

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

The Respondent is Alec Morgan, GreenHost, Denmark.

2. The Domain Name and Registrar

The disputed domain name <iqosmyqos.com> is registered with CSL Computer Service Langenbach GmbH dba Joker.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 16, 2023. On October 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 2023, 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 (GreenHost) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 2023, 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 November 3, 2023.

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 November 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 29, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on December 8, 2023. 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 are inserted and heated to generate a flavourful nicotine-containing aerosol.

The disputed domain name has been registered on January 29, 2023. The language of the registration agreements at the time of registration was both in English and German.

The Complaint is based, amongst others, on the following trademarks:

- International Registration IQOS (word) No. 1218246 registered on July 10, 2014 for goods in classes 9, 11, 34 and designating amongst others the European Union, where the Respondent is allegedly located;
- International Registration MyIQOS (word) No. 1569394 registered on August 27, 2020 for services in classes 35, 36, 41 and designating several countries;

The undisputed evidence provided by the Complainant shows that the disputed domain name resolves to a Persian-language web-shop that allegedly sells and offers the Complainant's tobacco products, as well as competing third party tobacco and other products of different commercial origin. In addition, this web web-shop prominently uses the Complainant's IQOS and HEETS trademarks and furthermore a number of the Complainant's official product images without the Complainant's authorization. It is therefore purporting to be an official online retailer, which it is, however, not.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- (1) the disputed domain name is confusingly similar to its earlier trademarks, since it reproduces the IQOS trademark in its entirety and combines it with an almost identical reproduction of the second trademark MyIQOS. Both marks remain recognizable within the disputed domain name;
- (2) the Respondent lacks any rights or legitimate interests in the disputed domain name. 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 IQOS/MyIQOS 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 name contains the IQOS trademark identically and the MyIQOS trademark almost identically, (ii) the website prominently presents the Complainant's trademark IQOS and HEETS 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;

(3) the Respondent's registration and use of the disputed domain name constitutes bad faith in particular, because by using the disputed domain name, 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 name is used for a website which is headed with the Complainant's trademark, shows the Complainant's official product photos and sells the Complainant's IQOS products along with competing third party products and accessories, 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 name should be transferred or cancelled:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the Registrant of record for the disputed domain name 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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark IQOS is reproduced within the disputed domain name. In addition, also another of the Complainant's trademarks, MyIQOS, is almost identically contained in the disputed domain name. While each case is judged on its own merits, Panels agree that 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 ([WIPO Overview 3.0](#), section 1.7.). In the Panel's view, at least the first trademark IQOS is entirely recognizable within the disputed domain name.

Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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

(1) First, it results from the Complainant’s uncontested evidence that the disputed domain name identically contains the IQOS trademark (and almost identically a second trademark MyIQOS) and resolves to a web-shop that allegedly sells and offers the Complainant’s tobacco products, as well as competing third party tobacco and other products of different commercial origin. In addition, this web web-shop prominently uses the Complainant’s IQOS and HEETS trademarks and furthermore a number of the Complainant’s official product images without the Complainant’s authorization. It is therefore purporting to be an official online retailer, which it is, however, not. In the 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 name. In particular, the Complainant’s uncontested allegations demonstrate that it has not authorized the Respondent’s use of the IQOS/MyIQOS trademarks for registering the disputed domain name, which are confusingly similar.

(2) 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 name in the sense of paragraph 4(c)(ii) of the Policy.

(3) 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 name, 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 IQOS/MyIQOS trademarks are distinctive so that it is unlikely that the Respondent wanted to fairly use the disputed domain name consisting of these trademarks identically or almost identically. In addition, the disputed domain name is used for a commercial website, so that a noncommercial use is excluded from the outset.

Having reviewed the available record, the Panel finds 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 rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent by using the disputed domain name, 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 name identically contains the IQOS trademark (and almost identically a second trademark MyIQOS) and resolves to a web-shop that allegedly sells and offers the Complainant's tobacco products, as well as and competing third party tobacco and other products of different commercial origin. In addition, this web web-shop prominently uses the Complainant's IQOS and HEETS trademarks and furthermore a number of the Complainant's official product images without the Complainant's authorization. It is therefore purporting to be an official online retailer, which it is, however, not. For the Panel, it is therefore evident that the Respondent positively knew of 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 name included the Complainant's trademark entirely when it registered the disputed domain name. 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. *Philip Morris Products S.A. v. Domains By Proxy, LLC / Cihan Bayrak, Elit*, WIPO Case No. [D2022-0235](#)).

The finding of bad faith registration and use is 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 name may be put, and
- (iv) the fact that the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <iqosfamily.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: December 22, 2023