

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Md Nurun Nabie
Case No. D2024-0679

1. The Parties

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

The Respondent is Md Nurun Nabie, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <iqosheetsmart.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2024. On February 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 16, 2024, 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 February 19, 2024.

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 February 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 31, 2024. The Respondent sent an email communication to the Center on February 23, 2024. Further to the Complainant’s request, the Center suspended the proceedings on February 27, 2024, and reinstituted the proceedings on March 15, 2024. On April 2, 2024, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Mihaela Maravela as the sole panelist in this matter on April 12, 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

According to information in the Complaint, the Complainant is a member of the group of companies affiliated to Philip Morris International Inc., being a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries. One of the products the Complainant developed is a tobacco heating system called IQOS, which is a controlled heating device into which specially designed tobacco sticks under the brand names HEETS, HEATSTICKS or TEREA are inserted and heated to generate a flavourful nicotine-containing aerosol. The IQOS system is available in key cities in around 71 markets across the world, and approximately 19.1 million consumers use the IQOS system worldwide.

The Complainant is the holder of a number of trademarks for IQOS or HEETS, including the International trademark HEETS (word/device) No. 1328679, registered on July 20, 2016, designating goods and services in international classes 9, 11 and 34, the International trademark HEETS (word) No. 1326410, registered on July 19, 2016, designating goods and services in international classes 9, 11 and 34, the International trademark IQOS (word) No. 1218246, registered on July 10, 2014, designating goods and services in classes 9, 11 and 34, or the International trademark IQOS (device) No. 1338099, registered on November 22, 2016, designating services in class 35.

The disputed domain name was registered on December 29, 2023, and at the date of the Complaint resolved to a website allegedly selling and offering the Complainant's IQOS products, as well as competing third party products of other commercial origin. At the date of the Decision, the disputed domain name resolves to a website represented by a sample WordPress page, still displaying the Complainant's IQOS and HEETS trademarks.

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 the IQOS and HEETS trademarks of the Complainant are used in the disputed domain name together with the non-distinctive and descriptive word "mart", therefore the first element is met.

As regards the second element, the Complainant submits that it has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its IQOS and HEETS trademarks (or a domain name which will be associated with these trademarks). Further, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The website at the disputed domain name is prominently using the Complainant's registered IQOS and HEETS trademarks, as well as an adaptation of the Complainant's official product image. The Respondent is not only offering the IQOS products but also third-party competing tobacco products (and other products) of other commercial origin. The Complainant submits that this in itself is sufficient to exclude a legitimate interest in the form of a bona fide offering of goods. Moreover, the website at the disputed domain name is further using a number of the Complainant's official product images and marketing materials without the Complainant's authorization.

In addition, the Complainant argues that the website at the disputed domain name does not show any details regarding the provider of the website, leaving the Internet user under the false impression that the online

shop provided under the website, is that of the Complainant or that it is connected to that of the Complainant or one of its official distributors, which it is not. On the privacy page of the website at the disputed domain name there is a disclaimer stating “No Affiliation Disclaimer: The website states that it is not officially affiliated with Philip Morris International (PMI) or IQOS.” The Complainant argues that such disclaimer is not presented in a clear and sufficiently prominent manner and makes no mention of who owns the IQOS and HEETS trademarks and the relationship (or lack thereof) between the provider of the website at the disputed domain name and these trademarks.

With respect to the third element, the Complainant submits that the terms HEETS or IQOS are purely imaginative terms and unique to the Complainant and that the Respondent started offering the Complainant's IQOS products immediately after registering the disputed domain name, therefore, the Respondent knew of the Complainant's IQOS and HEETS trademarks when registering the disputed domain name. The Respondent is not only using the Complainant's IQOS and HEETS trademarks for the purposes of offering for sale the IQOS products, but also for purposes of offering for sale third-party products of other commercial origin. Such abusive use of the Complainant's IQOS and HEETS trademarks for purposes of promoting competing products is a clear-cut trademark infringement and constitutes clear evidence of the Respondent's bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. In the informal communication of February 23, 2024, the Respondent stated: “Hello. I will change my domain name as soon as possible. Thank for informing me”.

6. Discussion and Findings

No formal response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.2.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (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.

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 3.0](#), section 1.7.

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 disputed domain name incorporates the Complainant's trademarks IQOS and HEETS in their entirety, with the only difference that in the disputed domain name the word “mart” is added, which does not in the view of the Panel prevent the Complainant's trademarks from being recognizable within the disputed domain name.

Although the addition of other terms (here, “mart”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In addition, the Panel finds that the addition of the generic Top-Level Domain (“gTLD”) “.com” to the disputed domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

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.

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.

There is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. Rather, according to the un rebutted evidence provided by the Complainant, at the date of filing the Complaint, the website at the disputed domain name allegedly offered for sale the Complainant’s branded goods, reproducing the Complainant’s trademark and logo, as well as an adaptation of the Complainant’s product images, as well as competing third party products. While the genuine nature of the goods allegedly offered is unclear, it is not necessary for the Panel to reach such conclusion given the lack of a prominent and accurate disclaimer on the website at the disputed domain name as to their relationship with the trademark owner or the lack thereof, falsely suggests to Internet users that the website to which the disputed domain name resolves is owned by the Complainant or at least affiliated to the Complainant, contrary to the fact. (see the “Ok! data test” outlined in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)). The disclaimer in this case was not prominent and accurate, as it was only included in a privacy page and not in a visible location on the homepage, so its existence does not appear as likely to prevent the confusion of Internet users. The overall impression of the website to the Internet users was that the website is endorsed or at least somehow related with the Complainant. Also, given the composition of the disputed domain name, which incorporates the Complainant’s trademarks, the information provided in the disclaimer is not sufficient to clarify the relationship (or lack thereof) between the Respondent and the Complainant. This cannot amount in the Panel’s view to a bona fide offering of goods or services within the meaning of paragraphs 4(c)(i) of the Policy.

Subsequent to the filing of the Complaint, the content on the website at the disputed domain name was changed, and is currently represented by a sample WordPress page, with unrelated content but still displaying the Complainant’s IQOS and HEETS trademarks. Given also the nature of the disputed domain name, that includes the Complainant’s IQOS and HEETS trademarks in their entirety, and therefore carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship

or endorsement by the Complainant, neither such use nor the previous one confer in the Panel's view rights or legitimate interests to the Respondent. [WIPO Overview 3.0](#), section 2.5.1.

Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

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.

According to the unrebutted assertions of the Complainant, its trademarks were widely used in commerce well before the registration of the disputed domain name. The disputed domain name is confusingly similar with the Complainant's trademarks. At the time of the filing of the Complaint, the disputed domain name resolved to a website reproducing the Complainant's trademarks and purportedly offering for sale the Complainant's products with competing third party products. Under these circumstances, it is reasonable to infer that the Respondent has registered the disputed domain name with knowledge of the Complainant's trademarks, and to target those trademarks.

The disputed domain name is also being used in bad faith. The unauthorised impersonation of the Complainant and the alleged offering for sale of the Complainant's products, for which as per the unrebutted statements of the Complainant, the Respondent has no authorization, is clear indication of use for illegal activity. The website at the disputed domain name appeared to deliberately mislead Internet users that they are connected to, authorised by, or affiliated with the Complainant, as it displayed the Complainant's trademark, logo, and adaptation of the Complainant's product images, ostensibly offering the Complainant's products without any accurate and prominent disclaimer on the website regarding the relationship between the Respondent and the Complainant or lack thereof. A disclaimer was only included in the privacy page, which makes it quite difficult to notice and consider. As discussed in section 3.7 of the [WIPO Overview 3.0](#), the mere existence of a disclaimer cannot cure the finding of bad faith, when the overall circumstances of the case point in this direction. In these circumstances, the Panel concludes that the Respondent has intentionally attempted to attract, for commercial gain, by misleading Internet users into believing that the Respondent's website and the products offered for sale on them are those of or authorised or endorsed by the Complainant.

Panels have held that the use of a domain name for illegal activity, such as the sale of counterfeit goods or impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Moreover, the Respondent has not participated in these proceedings and has failed to rebut the Complainants' contentions or provide any evidence of actual or contemplated good faith use. Rather, the changes to the website at the disputed domain name after the receipt of the Complaint further supports the bad faith indicia. Furthermore, the Respondent availed of a privacy shield service to protect its identity. While the use of a privacy shield is not necessarily objectionable in itself, in the present case it contributes to the accumulation of elements pointing to bad faith registration and use.

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 <iqosheetsmart.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: April 20, 2024