

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Tomoyuki Yamaguchi  
Case No. D2022-0239

### **1. The Parties**

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

The Respondent is Tomoyuki Yamaguchi, Japan.

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

The disputed domain name <iqos-shuri.net> is 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 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 name. On January 26, 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 January 26, 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 26, 2022.

On January 26, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 26, 2022, the Complainant submitted a confirmation 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 February 1, 2022. In accordance with

the Rules, paragraph 5, the due date for Response was February 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 23, 2022.

The Center appointed Erica Aoki as the sole panelist in this matter on March 1, 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 is a company which is part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI"). PMI is an international tobacco and smoke-free products company, and is also known for innovating across its brand portfolio. In the course of transforming its business, PMI has developed a number of smoke-free products. One of such products developed and sold by PMI is a tobacco heating system called "IQOS".

For its new innovative smoke-free products the Complainant owns a large portfolio of well-known trademarks. Among them, but by no means limited to, trademark registration in Japan (Registration for IQOS (word) No. 5727311) registered on December 19, 2014.

The disputed domain name <iqos-shuri.net> was registered on July 27, 2016. The disputed domain name is linked to an online shop allegedly selling and offering repair and maintenance services for the Complainant's IQOS System, as well as competing third party products of other commercial origin, and is further using a number of the Complainant's official product images without the Complainant's authorization, while at the same time providing a copyright notice at the bottom of the website claiming copyright in the material presented on the website.

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

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

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

The Complainant developed and sell 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 flavourful nicotine-containing aerosol (collectively referred to as the "IQOS System"). There are five 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 the Complainant 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 66 markets across the world. As a result of an investment of over USD 8.1 billion into the science and research of developing smoke-free products and extensive international sales, the IQOS System has achieved considerable international success and reputation, and approximately 19.1 million relevant consumers using the IQOS System worldwide.

For its new innovative smoke-free products the Complainant owns a large portfolio of well-known trademarks.

The disputed domain name is linked to an online shop allegedly selling and offering repair and maintenance services for the Complainant's IQOS System, as well as competing third party products of other commercial origin.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Complainant is required to establish the requirements specified under paragraph 4(a) of the Policy:

(i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of which the Complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

### **A. Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Japanese. Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

However, as noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. General Energy a/k/a Edison GE GEEEEE.COM a/k/a Edison-GE and Edison Electric Corp.*, WIPO Case No. [D2006-0334](#)).

In deciding whether to allow the proceeding to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that Agreement, the Panel must have regard to all "the relevant circumstances" of the case. The factors that the Panel should take into consideration include *inter alia* whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without causing injustice to the Parties.

According to section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), prior UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include: (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names

registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

The Complainant has submitted a request that the language of the proceeding be English. The Complainant contends that in the present case, there is plenty of evidence showing that the Respondent can communicate in English, since the disputed domain name is in Latin script and not in Japanese script indicating that the website provided under the disputed domain name is directed to, at the very least, an English-speaking public. The Complainant also contends that the website under the disputed domain name includes a number of English words or phrases. The Complainant also contends that it is Swiss entity and has no knowledge of Japanese. The Complainant would have to retain specialized translation services in order to proceed in Japanese, which would impose an extra burden on the Complainant and unnecessarily delay the proceeding.

The Panel notes that the Center notified the Respondent in Japanese and English regarding the language of the proceeding and the Respondent was invited to present his objection to the proceeding being held in English and if the Center did not hear from the Respondent by the specified due date, the Center would proceed on the basis that the Respondent had no objection to the Complainant's request that English be the language of the proceeding. The Respondent had the opportunity to raise objections or make known his preference but did not do so. The Panel further notes that the Center notified the Respondent in Japanese and English of the Complaint, and the Respondent was informed that it could file a response either in Japanese or English, but the Respondent did not file any response.

Taking all these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

## **B. Identical or Confusingly Similar**

Based on the facts presented by the Complainant, this Panel finds that the disputed domain name identically adopts the Complainant's IQOS trademarks in which the Complainant has rights under the Policy, paragraph 4(a)(i). The Complainant has established its rights in IQOS through registration and use. The Panel finds that there is no doubt that the disputed domain name is confusingly similar to the Complainant's registered trademark, as the disputed domain name includes the Complainant's mark in full, with only the addition of the word "-shuri" to the IQOS mark, which does not prevent a finding of confusing similarity (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

## **C. Rights or Legitimate Interests**

The Panel finds the following on record in this proceeding under the Policy:

The Respondent is in default and thus has made no affirmative attempt to show any rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy indicates that a registrant may have a right or legitimate interest in a domain name if it uses the domain name in connection with a *bona fide* offering of goods or services prior to notice of the dispute. In this regard, the Respondent is in no way connected with the Complainant and has no authorization to use any of the Complainant's trademarks. The disputed domain name is linked to an online shop allegedly selling and offering repair and maintenance services for the Complainant's IQOS System, as well as competing third party products of other commercial origin, and is further using a number of the Complainant's official product images without the Complainant's authorization, while at the same time providing a copyright notice at the bottom of the website claiming copyright in the material presented on the website, and thereby strengthening the false impression of an affiliation with the Complainant.

There is no evidence on record that the Respondent is or was commonly known by the disputed domain name as an individual, business, or other organization.

There is no evidence on record that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Thus, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In addition, the nature of the disputed domain name, which composes the Complainant's IQOS trademark and the term "shuri" (meaning "repair" in English), carries a risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Panel therefore finds that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, under the Policy, paragraph 4(a)(ii).

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

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy and that the Respondent has used the disputed domain name intentionally to attempt to attract, for commercial gain, Internet users to the Respondent's 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 the Respondent's site or of a product or service offered on the Respondent's site.

The Complainant's trademark was registered before the registration of the disputed domain name and it is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's IQOS trademark when registering the disputed domain name.

Furthermore, the Complainant's IQOS trademark is distinctive and unique to the Complainant. It is therefore beyond the realm of coincidence that the Respondent chose the disputed domain name without the intention of invoking a misleading association with the Complainant.

The Panel finds that it is most likely that the Respondent was aware of the Complainant's rights in the IQOS trademark at the time the disputed domain name was registered, indicating that such registration was made in bad faith.

The disputed domain name is linked to an online shop allegedly selling and offering repair and maintenance services for the Complainant's IQOS System, as well as competing third party products of other commercial origin, and is further using a number of the Complainant's official product images without the Complainant's authorization, while at the same time providing a copyright notice at the bottom of the website claiming copyright in the material presented on the website, and thereby strengthening the false impression of an affiliation with the Complainant. Based on that evidence, the Panel finds that the Respondent has 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 other online location, and this constitutes evidence of bad faith under the Policy, paragraph 4(b)(iv).

Accordingly, and as also supported by the Panel's findings above under the second element of the Policy, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith under the Policy, paragraph 4(a)(iii).

## 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 <iqos-shuri.net> be transferred to the Complainant.

*/Erica Aoki/*

**Erica Aoki**

Sole Panelist

Date: March 15, 2022