

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Tsunehiro Sato
Case No. D2022-0442

1. The Parties

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

The Respondent is Tsunehiro Sato, Japan.

2. The Domain Name and Registrar

The disputed domain name <e-iqos.com> 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 February 9, 2022. On February 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 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 February 10, 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 February 11, 2022.

On February 10, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On February 11, 2022, the Complainant confirmed its 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 February 16, 2022. In accordance

with the Rules, paragraph 5, the due date for Response was March 8, 2022. The Respondent did not submit any formal response. The Center received the Respondent's communications by email on March 7, 2022, April 4, 2022, and April 6, 2022. The proceeding was suspended on March 9, 2022, and was reinstated on March 24, 2022, at the Complainant's request.

The Center appointed Haig Oghigian as the sole panelist in this matter on April 6, 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 disputed domain name was created on July 8, 2016. The disputed domain name resolves to a website that refers to and includes hyperlinks featuring the Complainant's trademarked goods, which redirect Internet users to third party online shops allegedly selling and offering the Complainant's IQOS System, as well as competing third party products of other commercial origin.

The Complainant Philip Morris Products S.A. is a company which is part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI"). PMI is a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries

In the course of transforming its business from combustible cigarettes to Reduced Risk Products (or "RRPs", which the Complainant defines as products that present, are likely to present, or have the potential to present less risk of harm to smokers who switch to those products versus continued smoking), the Complainant has developed a number of RRP products. One of these RRP products developed and sold by PMI is a tobacco heating system called IQOS. According to the Complainant 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 nicotine-containing aerosol (collectively referred to as the "IQOS System").

The Complainant has, amongst others, the following trademark registrations (the "Trademarks"):

- Japanese Registration IQOS (word) No. 5727311 registered on December 19, 2014;
- Japanese Registration IQOS (word) No. 5770614 registered on June 12, 2015;
- Japanese Registration IQOS (word) No. 6100975 registered on November 22, 2018;
- Japanese Registration (device) No. 5766517 registered May 22, 2015; and
- International Registration IQOS (device) No. 1338099 registered on November 22, 2016, designating several jurisdictions, *inter alia*, Japan.

5. Parties' Contentions

A. Complainant

The following information has been taken from the Complaint.

The disputed domain name is linked to an online shop at "www.eiqos.com" (the "Website"). More particularly, the Website refers and/or includes hyperlinks, which redirect Internet users to third party online shops allegedly selling and offering the Complainant's IQOS System, as well as competing third party products of other commercial origin.

According to the Complainant, the Website is clearly purporting to be an official online retailer of the Complainant's IQOS System in Japan by using the Complainant's IQOS trademark in the disputed domain name together with the non-distinctive and descriptive addition, "e-" (which is arguably an abbreviation for "electronic").

Further, the Complainant is of the view that the Website (nor the third party websites which the Website refers and/or include hyperlinks which redirects the user / relevant consumer to) 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.

The Complainant further stated that the provider of the Website is using the Complainant's IQOS trademark in its name in circumstances where the provider of the Website is not known to the Complainant, nor is it authorized to use the Complainant's IQOS trademarks

Therefore, the Complainant argues that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that it was registered and is being used in bad faith

B. Respondent

The Respondent did not reply to the Complainant's contentions. It did declare however the following by email on March 7, 2022, to the Center in English and Japanese: "My intention in response to your petition is not to file a dispute at all. I have no problem with the deletion of all web content posted on the subject domain (e-iqos.com). There is also no problem with abandoning (transferring/canceling) the subject domain."

6. Discussion and Findings

6.1. Preliminary Issue: Language of Proceeding

The Registrar confirmed that the language of the Registration Agreement of the disputed domain name is Japanese. The Complainant sets forth a number of arguments as to why the proceeding should be held in English, including that the disputed domain name itself features Latin characters and the Website also featured English text. The Respondent did not comment on the Complainant's request.

The Respondent sent an email communication to the Center on March 7, 2022, in English and Japanese, which shows that the Respondent is fluent in English.

In accordance with paragraph 11(a) of the Rules, the Panel determines that the language of the proceeding should be English.

6.2. Substantive Issues

A. Identical or Confusingly Similar

The disputed domain name fully incorporates the IQOS Trademark. It is now trite law that a domain name that wholly incorporates a registered trademark is enough to conclude that there is a confusing similarity. This conclusion must remain unchanged even if other terms are added to the domain name.

The Panel agrees with the Complainant that the disputed domain name is confusingly similar to the IQOS Trademark. The Panel is also of the view that the Complainant has demonstrated to the Panel's satisfaction that it has the rights to the IQOS Trademark as per the registration of the IQOS Trademark and also of its commercial use.

The disputed domain name incorporates the Complainant's IQOS word trademark. The fact that the Domain Name differs from Complainant's trademark by the addition of the "e-" does not prevent a finding of the confusing similarity. Indeed, as held in section 1.8 and 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms or letters would not prevent a finding of confusing similarity under the first element.

It is well established that the applicable Top-Level Domain ("TLD") in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11).

Indeed, many prior decisions found that the addition of a TLD is merely instrumental to the use of Internet and shall thus be disregarded in the assessment of confusing similarity (see *Notch Up v. Lori Fulbright, Fulbright LTD*, WIPO Case No. [D2021-3220](#), *TBWA Worldwide, Inc. v. Karim Bendali*, WIPO Case No. [D2019-1932](#)).

In light of the above, it is apparent that the disputed domain name is confusingly similar to the registered trademark in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In accordance with paragraph 4(c) of the Policy, a respondent, in order to demonstrate its rights or legitimate interests can, without limitation, refer and to the following circumstances:

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial 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.

There is no evidence in this file that was adduced by the Respondent to demonstrate any rights or legitimate interests. The Respondent, having been duly notified of the Complaint and the present proceeding, has chosen not to reply to the contentions of the Complainant.

There is therefore no evidence that the Respondent was commonly known as "e-iqos.com". No evidence adduce in this file demonstrates that the Respondent has used any trademarks similar to the one use in the disputed domain name.

There is no evidence that would show that the Respondent was acting in accordance of any rights or legitimate interest upon registration of the disputed domain name.

There is also no evidence that would show that the Respondent had "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". (See paragraph 4(c)(i) of the Policy referred above)

The nature of the disputed domain name carries a risk of implied affiliation with the Complainant, seeing as the "e-" may signify "electronic" and is thus descriptive of the electronic-heating means of the Complainant's RRP's, of which the IQOS trademark is one. Moreover, the disputed domain name resolves to the Website with hyperlinks, which redirect Internet users to third party online shops allegedly selling and offering the Complainant's IQOS System, as well as competing third party products of other commercial origin. Such use does not constitute a *bona fide* offering of good or services nor a legitimate noncommercial or fair use,

without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark under paragraph 4(c)(iii) of the Policy.

Furthermore, while it is not clear if any products are actually sold at the disputed domain name, considering the redirection by means of hyperlinks to competing sites, the requirements set out in the *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) to establish a "bona fide offering of goods or services" are not met in this case.

Therefore, the Panel concludes that the Respondent has neither rights nor legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four examples of bad faith behavior. This list is not exhaustive.

Paragraph 4(b)(iv) of the Policy is the most relevant example for this case. The evidence adduced leads the Panel to conclude that 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 mark as to the source, sponsorship, affiliation, or endorsement" of the Respondent's website and its products. See paragraph 4(b)(iv) of the Policy.

As noted by the Panel above, the disputed domain name consists of the Complainant's well-known trademark in its entirety with the descriptive addition "e-". As such, the nature of the disputed domain name itself evidences bad faith registration and use. See *Charles Jordan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#), and [WIPO Overview 3.0](#), section 3.1.4.

The Panel also concludes that even if the Respondent ignored the rights of the Complainant in the IQOS trademarks, a simple trademark search or a web browser search would have revealed such rights. Thus, this also supports a finding of bad faith. See *BzzAgent, Inc. v. bzzaget.com c/o Nameview Inc. Whois IDentity Shield and Vertical Axis*, WIPO Case No. [D2010-1187](#).

Lastly, the disputed domain name features the Complainant's trademarks and goods, reinforcing the Panel's finding that Respondent was aware of the Complainant and its rights. Furthermore, the disputed domain name resolves to the Website with hyperlinks, which redirect Internet users to third party online shops allegedly selling and offering the Complainant's IQOS System, as well as competing third party products of other commercial origin. Therefore, the Panel holds that the disputed domain name was registered and is being used in bad faith.

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, <e-iqos.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: May 11, 2022