

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Privacy Service provided by Withheld for Privacy ehf / Xinke Liu
Case No. D2022-0680

1. The Parties

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

The Respondent is Privacy Service provided by Withheld for Privacy ehf, Iceland / Xinke Liu, Australia.

2. The Domain Name and Registrar

The disputed domain name <heetsnow.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 28, 2022. On February 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 28, 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 March 1, 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 on March 3, 2022.

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 March 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 25, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on March 29, 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 part of the group of tobacco companies affiliated with Philip Morris International, Inc. ("PMI").

Amongst other things, the group produces tobacco products branded "Heets" or "HeatSticks", that are designed to be inserted into another of the Complainant's products, "IQOS", a heating device which the Complainant describes as a "Reduced Risk Product". There are approximately 19.1 million customers using the IQOS system worldwide.

The Complainant owns a number of registered trade marks for HEETS including International Registration No. 1326410 for HEETS, registered on July 19, 2016, in classes 9, 11, and 34.

The disputed domain name was registered on February 1, 2022.

The disputed domain name was used for a website headed "IQOSPOST" that offered the Complainant's products for sale including "IQOS Heatsticks" and used unauthorised copies of the Complainant's product images as well as deploying the Complainant's logo as its browser icon or "favicon". The website presented the address "Shinuju, Tokyo".

The following disclaimer appeared near the bottom of the website: "All product and company names are trademarks™ or registered® trademarks of their respective holders. Use of them does not imply any affiliation with or endorsement by them. We are reseller of these products. 'IQOS', 'Marlboro', and 'Heatsticks' are registered trademarks of PMI (Phillip Morris International Inc.) in the United States and/or other countries. heatshop is not endorsed nor affiliated with PMI (Phillip Morris International Inc.)."

In addition, the website included links to competing products such as "Relx".

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The disputed domain name is confusingly similar to the Complainant's trade mark as it reproduces the Complainant's trade mark in its entirety, in addition to the term "now".

The Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant has not authorised the Respondent to use its trade mark.

The Respondent is not making legitimate non-commercial or fair use of the disputed domain name.

Nor is the Respondent making a *bona fide* offering of goods.

The Respondent does not qualify as a legitimate reseller because the disputed domain name of itself suggests at least an affiliation with the Complainant, as does the Respondent's website, including by means of use of the Complainant's trade mark, favicon and official product images as well as by the lack of information about the Respondent's identity and the use of an inadequate disclaimer.

The disputed domain name was registered and is being used in bad faith.

The Respondent was aware of the Complainant's trade mark when registering the disputed domain name.

The term "heets" was coined by the Complainant and is unique to it.

The Respondent registered and used the disputed domain name with the intention of creating a likelihood of confusion under paragraph 4(b)(iv) of the Policy, including by reproducing the Complainant's trade mark in the disputed domain name and in the website title as well as by unauthorised use of the Complainant's official product images.

The Respondent has been found to have registered and used other domain names reflecting the Complainant's marks in bad faith: *Philip Morris Products S.A. v. WhoisGuard Protected / WhoisGuard, Inc. / Xinke Liu*, WIPO Case No. [D2019-0918](#) (<iqospost.com>); *Philip Morris Products S.A. v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Liu Xinke / IQOSPOST/Japan Tokyo Trading Pty Limited*, WIPO Case No. [D2021-2767](#) (<heatsshop.com>, <iqosale.com>, and <iqosales.com>); and *Philip Morris Products S.A. v. Withheld for Privacy ehf / Xinke Liu*, WIPO Case No. [D2021-3733](#) (<heetsales.com>).

Use of a privacy protection service is further evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established registered rights in the mark HEETS, as well as unregistered trade mark rights deriving from the Complainant's extensive use of that mark.

Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the Complainant's distinctive trade mark is readily recognisable within the disputed domain name and, accordingly, the addition of the term "now" does not prevent a finding of confusing similarity.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes

out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

As to paragraph 4(c)(i) of the Policy, the Respondent is purporting to resell the Complainant's own goods. The consensus view of UDRP panels – as expressed in section 2.8 of [WIPO Overview 3.0](#) – is that to establish a *bona fide* offering of goods or services in such circumstances, a respondent must comply with certain conditions (the “Oki Data requirements”).

In this case, the Panel considers that the Respondent has failed to comply with the Oki Data requirements to accurately and prominently disclose the Respondent's relationship with the trade mark holder. On the contrary, as explained in section 6C below, the Panel considers that the Respondent has effectively set out to impersonate the Complainant. In addition, the Respondent is not using the site to sell only the trade marked goods. The Panel notes that the website at the disputed domain name includes links to competing products such as “Relx”.

Accordingly, the Panel considers that the Respondent's use of the disputed domain name cannot be said to be *bona fide* under the Policy.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

The Panel finds that the Complainant has established a *prima facie* case of lack of rights or legitimate interests and there is no rebuttal by the Respondent.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Given the Respondent's selection of a domain name reflecting the Complainant's distinctive mark in its entirety, and the evidence of its use for a website that (1) effectively sets out to impersonate the Complainant including by prominent use of the Complainant's mark as well as by use of the Complainant's favicon and official product images and (2) includes links to competing products, the Panel readily concludes that the disputed domain name was registered and is being used in bad faith by the Respondent, in accordance with paragraph 4(b)(iv) of the Policy. The Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark.

In the Panel's view, the disclaimer on the Respondent's site does not assist the Respondent. The disclaimer is not in a prominent position and is unlikely to be seen by most users of the site. In addition, the disclaimer gives no information whatsoever as to the identity of the operator of the website or seller of the products on offer. The Panel finds that the Respondent has not undertaken sufficient steps to avoid causing confusion to Internet users. In any case, section 3.7 of the [WIPO Overview 3.0](#) explains that where, as here, the overall circumstances of a case point to a respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. Indeed, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused. This Panel does indeed treat the disclaimer as such an admission.

The Panel also notes that the Respondent has engaged in a pattern of bad faith registration and use of other domain names reflecting the Complainant's trade marks.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) 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, <heetsnow.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: April 12, 2022