

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Privacy Service Provided by Withheld for Privacy ehf / Fahim Razzaque / Kawsar Sarwar
Case No. D2022-0681

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 / Fahim Razzaque, Bangladesh / Kawsar Sarwar, Bangladesh.

2. The Domain Names and Registrar

The Disputed Domain Names <iqosae.com> and <heetsae.com> are 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 Names. On February 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names 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").

The Respondent sent informal communications to the Center on March 1, 2022, and on March 2, 2022. Upon request from the Complainant, the Center suspended the proceedings for the purposes of settlement discussions on March 9, 2022. The proceedings were reinstated on April 7, 2022.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 8, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was April 28, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the parties that it would proceed to panel appointment on May 2, 2022.

The Center appointed Reyes Campello Estebaran as the sole panelist in this matter on May 10, 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 an international group of companies affiliated to Philip Morris International Inc., which is an international tobacco company, with products sold in approximately 180 countries, and a large brand portfolio including the globally well-known trademark MARLBORO. The Complainant and its group have developed various products to substitute combustible cigarettes, one of them identified by the trademark IQOS, which was launched in Japan in 2014, and now is sold in 66 markets across the world. The product identified by the mark IQOS is a controlled heating device, collectively referred as “IQOS” or “IQOS System”, consisting of a pocket charger specially designed to charge a specific holder, into which specially designed tobacco products, identified by the marks HEETS, HEAT STICKS, or TEREA, are inserted and heated to generate a flavored nicotine-containing aerosol. There are five versions of this 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 Complainant holds a large portfolio of registered trademark rights in the mark IQOS and in the mark HEETS in many jurisdictions, denominative or with a specific graphic representation, including:

- United Arab Emirates Registration No. 211139, IQOS, word, registered on March 16, 2016;
- United Arab Emirates Registration No. 256864, HEETS, word, registered on December 25, 2017;
- United Arab Emirates Registration No. 257763, IQOS, figurative, registered on April 22, 2018;
- United Arab Emirates Registration No. 305079, IQOS, figurative, registered June 27, 2019; and
- United Arab Emirates Registration No. 256867, HEETS, figurative, registered on December 25, 2017, (collectively the “IQOS mark” and the “HEETS mark”).

Prior UDRP decisions under the Policy have recognized the international well-known character of the IQOS mark,¹ and the HEETS mark.²

The Disputed Domain Name <iqosae.com> (“First Disputed Domain Name”) was registered on January 1, 2022, and the Disputed Domain Name <heetsae.com> (“Second Disputed Domain Name”) was registered on January 8, 2022. The Disputed Domain Names are apparently inactive, resolving to Internet browser error messages. Previously, according to the evidence provided by the Complainant, the Disputed Domain Names resolved to online shops in English language of similar layouts, allegedly offering and selling the Complainant’s IQOS System products, as well as competing third party products and accessories of other

¹ See, *inter alia*, *Philip Morris Products S.A. v. 杨英子 (yingzi0412)*, WIPO Case No. [D2020-2600](#); *Philip Morris Products S.A. v. Маханьков Михаил Владимирович / Makhankov Mikhail*, WIPO Case No. [D2020-2793](#); *Philip Morris Products S.A. v. 深圳市云熙智能科技有限公司 (shen zhen shi yun xi zhi neng you xian gong si)*, WIPO Case No. [D2021-1538](#); and *Philip Morris Products S.A. v. Chenyi Zhao, 瑪爾有限公司*, WIPO Case No. [D2020-2193](#).

² See, among others, *Philip Morris Products S.A. v. Stepan Malik (S.M.), Heets Store*, WIPO Case No. [D2020-2967](#); *Philip Morris Products S.A. v. Whois Agent, Domain Protection Services, Inc., Heets Delivery / Mohammad Khawaldeh*, WIPO Case No. [D2020-2795](#); *Philip Morris Products S.A. v. Whois Privacy Protection Service / Vitalij Solomin*, WIPO Case No. [D2019-2103](#); and *Philip Morris Products S.A. v. Anatolij Harin, heets-shop.online*, WIPO Case No. [D2020-2400](#).

commercial origin. The website that was linked to the First Disputed Domain Name included the IQOS mark, with the same graphic representation used and registered by the Complainant, at its heading, and the website that was linked to the Second Disputed Domain Name included the HEETS mark, with identical graphic representation used and registered by the Complainant, at its respective heading. These websites displayed a number of the Complainant's product images (with no authorization), while providing a copyright notice at the bottom of each of the websites claiming copyright in the material presented on the sites. These sites did not provide any details regarding their provider and/or its lack of relationship with the Complainant, and they did not acknowledge the Complainant as the brand owner of the IQOS System. Both sites provided the address of "Dubai, UAE", and prices indicated in United Arab Emirates dirhan currency (AED). The website associated with the First Disputed Domain Name contained a link to the website associated with the Second Disputed Domain Name together with the phrase "Checkout Our Other Websites" and *vice versa*.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

Through its intensive use and promotion, with over USD 8.1 billion investment, the trademark IQOS has achieved considerable international reputation with approximately 19.1 million relevant consumers.

The Disputed Domain Names are confusingly similar to the Complainant's trademarks. The Disputed Domain Names incorporate the Complainant's trademarks in their entirety adding the equivalent of the country code Top-Level Domain ("ccTLD") for the United Arab Emirates, namely the letters "ae" albeit at the second level, and the applicable generic Top-Level Domain ("gTLD") ".com", which is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Respondent is not authorized to use the Complainant's trademarks, is not an authorized distributor or reseller of the IQOS System, and is not making a legitimate noncommercial or fair use of the Disputed Domain Names. The Respondent's websites do not meet the requirements set out by numerous panel decisions for a *bona fide* offering of goods or services for resellers or distributors (being the leading case on this point *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)). The Respondent does not only offer the Complainant's products but also competing tobacco products and/or accessories of other commercial origin, the Disputed Domain Names suggest affiliation with the Complainant and its trademarks, and the Respondent's websites exacerbate this affiliation (displaying prominently its trademarks, using and claiming copyright on the Complainant's official images). The Respondent's websites do not include information regarding the identity of their provider and the lack of relationship with the Complainant. The IQOS System has been almost exclusively distributed through the Complainant's IQOS stores and websites, as well as selected authorized distributors and retailers, so Internet users will be believe that the Respondent's sites are official or belong to endorsed distributors.

The Disputed Domain Names were registered and are being used in bad faith. The use of the Disputed Domain Names clearly reveals that the Respondent knew of the Complainant and its trademarks when registering the Disputed Domain Names. The terms "iqos" and "heets" are purely imaginative and not commonly used to refer to tobacco products or electronic devices. The Respondent registered and used the Disputed Domain Names with the intention to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's trademarks. The Respondent seek to generate the confusion and affiliation with the content of its websites and used a privacy protection service to hide its identity.

The Complainant has cited previous decisions under the Policy as well as various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)") that it considers supportive of its position.

The Complainant requests the consolidation of the Complaint against multiple registrants, and the transfer of the Disputed Domain Names.

B. Respondent

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

In an email communication addressed to the Center (dated March 1, 2022), the Respondent indicated that the Disputed Domain Names were legally bought from the Registrar, having all rights to hold them until their respective expiration. The Respondent added that any Complaint should be addressed to the Registrar, and all the Respondent's investment in time, money and effort shouldn't go in vain just for the mistake of the registrar.

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Preliminary Issue: Complaint Consolidated against Multiple Registrants

The Panel considers that the circumstances of this case substantiate the consolidation of the Complaint against the multiple Registrants of the Disputed Domain Names, indicating in a balance of probabilities that the Disputed Domain Names are subject to common control. Particularly, the fact that the Disputed Domain Names were registered within a short period of just eight days following a similar pattern (incorporating the Complainant's IQOS or HEETS mark followed by the letters "ae"), and the fact that websites that were linked to the Disputed Domain Names were almost identical, including each of them a link to the website associated to the other Disputed Domain Name, together with the phrase "Checkout Our Other Websites".

The Panel considers that this consolidation is fair and equitable to all the Parties and benefits the procedural efficiency. The Panel therefore accepts, in accordance with paragraph 10(e) of the Rules, the Complainant's request for consolidation. See also section 4.11.2 of the [WIPO Overview 3.0](#).

Accordingly, the Panel will refer to the registrants of the Disputed Domain Names collectively as "the Respondent".

B. Identical or Confusingly Similar

The Complainant indisputably has rights in the registered trademarks IQOS and HEETS, both by virtue of its trademark registrations and as a result of their global goodwill and reputation.

The Disputed Domain Names incorporate these trademarks in their entirety followed by the letters "ae", which do not avoid a finding of confusing similarity between the Disputed Domain Names and the respective trademarks. The IQOS mark is recognizable in the First Disputed Domain Name, the HEETS mark is recognizable in the Second Disputed Domain Name, and the gTLD ".com" is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, 1.8, and 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the Disputed Domain Names are confusingly similar to the Complainant's trademarks, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

C. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the Respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the Respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests.

The Complainant's assertions and evidence effectively shift the burden to the Respondent of producing evidence of rights or legitimate interests in the Disputed Domain Names, providing the circumstances of paragraph 4(c) of the Policy, without limitation, that may establish rights or legitimate interests in the Disputed Domain Names in order to rebut the Complainant's *prima facie* case. However, the Respondent has not formally replied to the Complainant's contentions, not providing any explanation and evidence of rights or legitimate interests in the Disputed Domain Names.

It is to be noted that resellers or distributors, using a domain name containing a complainant's trademark to undertake sales related to the complainant's goods or services, may be making a *bona fide* offering of goods and services and thus have a right or legitimate interest in such domain name, if the following cumulative requirements are met:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The analysis of these requirements is commonly known as the "Oki Data test" (referring to *Oki Data Americas, Inc. v. ASD, Inc.*, *supra*). See section 2.8, [WIPO Overview 3.0](#).

The evidence in the file shows the Disputed Domain Names have been linked to websites, which commercialized alleged HEETS and other IQOS System products together with competing third party products and accessories of other commercial origin, not disclosing the lack of relationship with the Complainant and its trademarks. The content of the Respondent's websites further tends to create an appearance of affiliation with the Complainant and its trademarks: i) including the Complainant's trademarks (with the same graphic representation used and registered by the Complainant) prominently at their respective headings, common location of the indication related to the website provider or the origin of the website; and ii) including various official images of the Complainant's products, claiming copyright in this material. The Panel considers that these circumstances contribute to a risk of affiliation and confusion.

Furthermore, the Disputed Domain Names incorporate respectively the IQOS mark or the HEETS mark adding the letters "ae", commonly known as the ccTLD for the United Arab Emirates or at least a geographical reference thereto, which also may point to the Complainant and its notorious trademarks, as an indication of its official store or its authorized distributor or retailer for this jurisdiction.

The Panel, under its general powers articulated *inter alia* in paragraph 10 of the Rules, has corroborated, through the Complainant's official website ("www.iqos.com") and various searches over the Internet, that the Complainant's IQOS System products are sold in the United Arab Emirates, and that the IQOS System is distributed through official IQOS stores and websites, as well as other sites of distributors and/or retailers. These circumstances may contribute to generate a risk of confusion and association, giving the impression that the websites that were linked to the Disputed Domain Names were official stores, an authorized distributors or retailers of the Complainant.

It is further remarkable that the Respondent has not properly replied to the Complaint not providing any explanation connected to any of the circumstances included in paragraph 4(c) of the Policy or any other circumstance that may be considered as rights or legitimate interests in the Disputed Domain Names. The Respondent only forwarded an email communication indicating, as sole argument for its registration and use of the Disputed Domain Names, that they were legally acquired from the Registrar, supposedly investing time, money and effort in the development of its business.

All the above-mentioned circumstances lead the Panel to conclude that the Respondent has not produced evidence to rebut the Complainant's *prima facie* case, and all these cumulative facts and circumstances point to consider that the Respondent lacks any rights or legitimate interests in the Disputed Domain Names. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

D. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establishes that the Disputed Domain Names have been registered and are being used in bad faith.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the Disputed Domain Names:

(i) the IQOS mark and the HEETS mark are well-known and internationally used, including in the United Arab Emirates, jurisdiction corresponding to "ae", and in Bangladesh, where the Respondent is apparently located according to the Registrar verification;

(ii) the Disputed Domain Names incorporate the Complainant's trademarks adding the letters "ae", which may contribute to generate a risk of confusion or implied association, creating the impression that the Disputed Domain Names refer to official stores, authorized distributors or retailers of the Complainant;

(iii) the websites that were linked to the Disputed Domain Names included prominently the Complainant's trademarks (with the same graphic representations used and registered by the Complainant) in their respective headings, as well as various official product images of the Complainant's IQOS System products, claiming copyright on this material;

(iv) the Respondent has not offered any explanation of any rights or legitimate interests in the Disputed Domain Names, apart from the allegation that they were legally purchased from the Registrar, and has not come forward to deny the Complainant's assertions of bad faith, choosing not to reply to the Complaint; and

(v) the Respondent's reaction to this proceeding seems to be taken down the websites that were linked to the Disputed Domain Names.

It is further to be noted that non-use of the Disputed Domain Names do not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of [WIPO Overview 3.0](#).

Therefore, on the balance of probabilities, taking into consideration all cumulative circumstances of this case, the Panel considers that the Disputed Domain Names were registered targeting the Complainant's trademarks with the intention of obtaining a free ride on their established reputation, seeking to mislead Internet users to believe that there is a connection between the Disputed Domain Names and the Complainant, to increase the traffic to the Respondent's sites for a commercial gain, which constitutes bad faith.

All of the above-mentioned circumstances lead the Panel to conclude that the Disputed Domain Names were registered and are being used in bad faith. Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the Respondent registered and is using the Disputed Domain Names in bad faith under 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 Names <iqosae.com> and <heetsae.com> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: May 24, 2022