

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Privacy Service Provided by Withheld for Privacy ehf / Vapesouqae souqae, Vapesouqae
Case No. D2022-0739

1. The Parties

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

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Vapesouqae souqae, Vapesouqae, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <heetsdubai.net> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2022. On March 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 3, 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 Complainant on March 9, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 10, 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”).

On March 12, 2022, Respondent sent an email communication to the Center acknowledging that he is not an official seller of Complainant’s products and requesting Complainant’s cooperation in withdrawing the Complaint.

On March 16, 2022, Complainant submitted a request for suspension of the proceedings. On the same date,

the Center notified suspension of the proceedings until April 15, 2022. On March 28, 2022, Complainant submitted a request for reinstatement of the proceedings for a failure to reach settlement. The Center reinstated the proceedings on the same date.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on March 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022.

On April 19, 2022, the Center notified the Parties that it will proceed to Panel Appointment.

The Center appointed Marina Perraki as the sole panelist in this matter on April 28, 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

Complainant is part of the Philip Morris International Inc. group of companies ("PMI group"), active in the tobacco industry, with products sold in approximately 180 countries. PMI group has been transforming its business from combustible cigarettes to Reduced Risk Products ("RRP"), which PMI group 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. One of these products, developed and sold by PMI group, is a tobacco heating system branded as IQOS. IQOS 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 (together "the IQOS System"). IQOS was first launched by PMI group in 2016. Today the IQOS System is available in approximately 69 markets across the world. Per Complainant, PMI group has invested USD 8.1 billion into the science and research of developing smoke-free products and extensive international sales and, as a result, the IQOS brand has gained considerable international reputation, with almost 19.1 million users. Per Complaint, the IQOS System products have been almost exclusively distributed through PMI group's official IQOS stores and websites and selected authorized distributors and retailers.

Complainant is the owner of numerous HEETS trademark registrations. These include:

- United Arab Emirates registration No. 256864 (word mark), filed on July 20, 2016 and registered on December 25, 2017, for goods in international class 34; and
- United Arab Emirates No. 256867 (word and device mark), filed on July 20, 2016 and registered on December 25, 2017, for goods in international class 34.

The Domain Name was registered on January 7, 2022 and resolves to a website (the "Website") which is an online shop offering for sale products bearing Complainant's HEETS and IQOS trademarks and prominently displaying the HEETS trademark of Complainant, as well as competing third party products, such as an unauthorized third party cleaning product for the IQOS device of Complainant. Respondent is unknown to Complainant and is not an authorized reseller of the IQOS or HEETS Products.

On the Website, HEETS and other trademarks and logos of Complainant, as well as a number of Complainant's official product images and marketing materials, are prominently displayed, while some of the pictures, according to Complainant, are altered without authorization. Complainant's HEETS trademark appears at the top of the Website, a location where users usually expect to find the name of the online shop provider.

The Website is in the English language. It indicates all prices in United Arab Emirates currency and includes an address located in United Arab Emirates. All this suggests that the Website is addressed to United Arab

Emirates consumers. The Website does not show any details regarding the provider of the Website nor does it acknowledge Complainant as the brand owner of the IQOS System.

5. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not formally reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has demonstrated rights through registration and use on the HEETS mark.

The Domain Name incorporates the said trademark of Complainant in its entirety. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)).

The geographic word "dubai" which is added in the Domain Name does not alter the above (*BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#), *Accenture Global Services Limited v. Jean Jacques / Luck Loic*, WIPO Case No. [D2016-1315](#); *Wragge Lawrence Graham & Co LLP v. Registration Private, Domains by Proxy LLC / Ian Piggini*, WIPO Case No. [D2015-0135](#); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8).

The generic Top-Level Domain ("gTLD") ".net" is also disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is confusingly similar to the HEETS trademark of Complainant.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

(i) before any notice to Respondent of the dispute, Respondent's 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) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial 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.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any formal response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complaint, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolved at the time of filing of the Complaint to the Website, which suggested falsely that it is of an affiliated entity or of an authorized partner of Complainant.

Per Complaint, and as acknowledged by Respondent, Respondent is not an affiliated entity or an authorized distributor or reseller of Complainant and no agreement, express or otherwise, exists allowing the use of Complainant's trademarks on the Website and the use of the Domain Name by Respondent.

A distributor or reseller can be making a *bona fide* offering of goods and thus have a legitimate interest in a domain name only if the following cumulative requirements are met (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.)

These requirements are not cumulatively fulfilled in the present case. The Domain Name falsely suggests that the Website is an official site of Complainant or of an entity affiliated to or endorsed by Complainant. The Website extensively reproduces, without authorization by Complainant, Complainant's trademark, without any disclaimer of association (or lack thereof) with Complainant.

Furthermore, as Complainant has demonstrated, the Website also offers for sale competing third party products, as well as an unauthorized third party cleaning product for Complainant's IQOS system that infringes Complainant's trademark.

In addition, the nature of the Domain Name, comprising Complainant's trademark in its entirety, carries a risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1). The use of a domain name which intentionally trades on the fame of another and suggests affiliation with the trademark owner cannot constitute a *bona fide* offering of goods or services (*Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#); *AB Electrolux v. Handi Sofian, Service Electrolux Lampung*, WIPO Case No. [D2016-2416](#); [WIPO Overview 3.0](#), section 2.5.3).

Lastly, the Domain Name was initially registered with a privacy shield service.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. As per Complaint, Complainant’s HEETS trademark is well known for RRP smoking devices. Furthermore, “HEETS” is a fictitious word. Because the HEETS mark had been widely used and registered at the time of the Domain Name registration by Respondent, the Panel finds it more likely than not that Respondent had Complainant’s mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

As regards bad faith use of the Domain Name, Complainant has demonstrated that the Domain Name was used to create the Website, which prominently displays Complainant’s registered trademarks, logos, and official product images and marketing material, some of them altered without authorization, thereby giving the false impression that it is operated by Complainant or a company affiliated to Complainant or an authorized dealer of Complainant. The Domain Name operates therefore by intentionally creating a likelihood of confusion with Complainant’s trademark and business as to the source, sponsorship, affiliation or endorsement of the website it resolves to. This can be used in support of bad faith registration and use (*Booking.com BV v. Chen Guo Long*, WIPO Case No. [D2017-0311](#); *Ebel International Limited v. Alan Brashear*, WIPO Case No. [D2017-0001](#); *Walgreen Co. v. Muhammad Azeem / Wang Zheng, Nicenic International Group Co., Limited*, WIPO Case No. [D2016-1607](#); *Oculus VR, LLC v. Sean Lin*, WIPO Case No. [DCO2016-0034](#); and [WIPO Overview 3.0](#), section 3.1.4).

The Panel considers the following factors: (i) the reputation of Complainant’s mark, (ii) the failure of Respondent to submit a response, (iii) the fact that the Website displays not only Complainant’s HEETS and IQOS trademarks and logos but also Complainant’s official product images and marketing material without authorization, some of them even altered, while it also offers for sale competing products of Complainant’s competitors as well as an unauthorized cleaning liquid product of Complainant’s own IQOS system, and (iv) the implausibility of any good faith use to which the Domain Name may conceivably be put, given that, as Complainant has demonstrated, the Domain Name resolves to the Website which gives the false impression that it is operated by Complainant or an official retailer of Complainant. Furthermore, on March 12, 2022, Respondent sent an email to the Center with which he acknowledged the fact that he is not an official seller of IQOS and HEETS.

Lastly, the Domain Name was registered with a privacy shield service to hide the registrant's identity. Respondent's concealment of the Domain Name holder's identity through use of a privacy shield constitutes further indication of bad faith in the circumstances of this case (*Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#)).

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established 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 Domain Name <heetsdubai.net> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: May 12, 2022