

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Privacy Service Provided by Withheld for Privacy ehf / Rabiul Hossen
Case No. D2022-0862

1. The Parties

The Complainant is Philip Morris Products S.A., Switzerland, represented by Boehmert & Boehmert, Germany.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Rabiul Hossen, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <heetdubai.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 March 11, 2022. On March 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 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 17, 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 amendment to the Complaint on March 18, 2022.

The Center verified that the Complaint together with the amendment to the 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 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 29, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on May 11, 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 67 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 marks HEET, HEETS, HEATSTICKS, IQOS, and IQOS THIS CHANGES EVERYTHING, denominative or with a specific graphic representations, as well as in a logo consisting of a blue-green hummingbird, in many jurisdictions, including:

- International Registration No. 1312086, HEET, word, registered on May 17, 2016;
- International Registration No. 1326410, HEETS, word, registered on July 19, 2016;
- International Registration No. 1328679, HEETS, figurative, registered on July 20, 2016;
- International Registration No. 1217386, HEATSTICKS, word, registered on July 21, 2014;
- International Registration No. 1218246, IQOS, word, registered on July 10, 2014;
- International Registration No. 1352087, IQOS THIS CHANGES EVERYTHING, word, registered on March 23, 2017; and
- International Registration No. 1331054, figurative (consisting of a blue-green hummingbird), registered on October 11, 2016.

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

The disputed domain name was registered on July 2, 2021, and resolves to an online shop in English language (with some content in Arabic language), allegedly offering the Complainant’s IQOS and HEETS branded products as well as competing third party products and accessories of other commercial origin. This website includes an adaptation of the Complainant’s HEETS trademark (similar to the graphic representation used and registered by the Complainant) together with the term “Dubai”, at its heading, and displays a number of the Complainant’s product images (with no authorization), while providing a copyright notice at the bottom of the site claiming copyright in this material. This website does not show any details regarding the

¹ 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. Anatoliy Harin, heets-shop.online*, WIPO Case No. [D2020-2400](#).

identity of its provider and/or its lack of relationship with the Complainant, and it does not acknowledge the Complainant as the brand owner of the IQOS System. Coming to the bottom of the landing page, this website provides a bilingual (English/Arabic) warning notice informing about the potential harm of nicotine and the convenience of respecting legal smoking age, including at the end of this notice a short disclaimer (only in English language) indicating that “HeetsDubaiUAE (HEETS DUBAI UAE) has no affiliation with Philip Morris International(PMI). This is Not the official Website of PMI and IQOS”.

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 name is confusingly similar to the HEET trademark. The disputed domain name incorporates the Complainant's trademark adding a geographical term (“Dubai”), which is insufficient to avoid a finding of confusing similarity, and the applicable generic Top-Level Domain (“gTLD”) is considered 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 name. 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 name. The Respondent's website do not meet the requirements set out by numerous panel decisions for a *bona fide* offering of goods 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 do not only offer the Complainant's products but also competing tobacco products and/or accessories of other commercial origin and even counterfeit products, the disputed domain name suggests affiliation with the Complainant and its trademarks, and the Respondent's website strengthens this affiliation (displaying prominently its trademarks, using and claiming copyright on the Complainant's official images). The Respondent's website does not include information regarding the identity of their provider and the lack of relationship with the Complainant. The disclaimer offered at the bottom of the landing page of the Website is not presented in a clear and sufficiently prominent manner, and it is inaccurate as the Complainant but not Philip Morris International owns the IQOS, HEET, HEETS and HEATSTICKS trademarks. Internet users will normally order products in the online shop without recognizing the disclaimer, and even if they see the disclaimer, it is unlikely that the user will fully review the long warning text and see the information regarding the relationship between the website and the Complainant's trademarks. Such disclaimer do not avoid users will erroneously believe that the website is provided by the Complainant or one of its affiliates or official dealers.

The disputed domain name was registered and is being used in bad faith. The use of the disputed domain name clearly reveals that the Respondent knew of the Complainant and its trademarks when registering the disputed domain name. The term “heet” (or “heets”) is purely imaginative and not commonly used to refer to tobacco products or electronic devices. The Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks. The Respondent is further misappropriating the Complainant's IQOS and IQOS THIS CHANGES EVERYTHING trademarks in an infringing manner to offer counterfeit products, which is another clear indication for the Respondent's bad faith. The Respondent seeks 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, and requests the transfer of the disputed domain name.

B. Respondent

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

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. Identical or Confusingly Similar

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

The disputed domain name incorporates the HEET mark in its entirety, as well as a substantial part of the HEETS mark, with a common, obvious, or intentional misspelling of this trademark, deleting its last letter "s", and adds the geographical term "Dubai", which do not avoid a finding of confusing similarity between the disputed domain name and these trademarks. The HEET and HEETS trademarks are recognizable in the 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, 1.9, and 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

B. 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 name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case. However, the Respondent has not replied to the Complainant's contentions, not providing any explanation and evidence of rights or legitimate interests in the disputed domain name.

It is to be noted that resellers or distributors, using a domain name containing the 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 name resolves to a website, which commercializes alleged HEETS and other IQOS System products together with competing third party products and accessories of other commercial origin. It is further to be noted that according to the Complainant allegations some of the goods included in the Respondent’s website are counterfeit goods illegally bearing the IQOS trademark and using as well the IQOS THIS CHANGES EVERYTHING trademark for their promotion in the site. The use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (See section 2.13, [WIPO Overview 3.0](#)). However, the Panel considers that there is not sufficient evidence in the record or circumstances that may support and allow assessing this allegation of illegal activity.

The content of the Respondent’s website further leads to create an affiliation with the Complainant and its trademarks: i) including a version of the Complainant’s trademarks (with a very similar graphic representation used and registered by the Complainant, adding the term “Dubai”) prominently at its heading, 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.

The Respondent’s website includes a disclaimer. However, this disclaimer is not prominently displayed in the site, being placed at the bottom of the landing page of the site, included at the end of a warning notice referred to the negative effects of nicotine and the legal smoking age. This disclaimer is further inaccurate referring generically to the Complainant’s parent company (Philip Morris International), and not specifically to the Complainant as the owner of the IQOS mark, and, most important, referring only to the IQOS trademark and not to the HEET and HEETS marks. The Panel therefore considers that this disclaimer may easily go unnoticed by any Internet user or potential customer visiting the site, and even in case any user reads it, the disclaimer would not sufficiently clearly inform about the lack of relationship of the site with the Complainant and/or its HEET and HEETS trademarks.

Furthermore, the disputed domain name incorporates the HEET mark and the substantial part of the HEETS mark, adding the geographical term “Dubai”, which, in the Panel’s view, may also point to the Complainant and its reputed trademarks, as an indication of its official store or its authorized distributor or retailer for this country.

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 Dubai, 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 increase the risk of confusion and association generated by the disputed domain name, giving the impression that the website that is linked to the disputed domain name is an official store, an authorized distributor or retailer of the Complainant.

It is further remarkable that the Respondent has not replied to the Complaint nor 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 name.

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 case cumulative facts and circumstances point to consider that the Respondent lacks of any rights or legitimate interests in the disputed domain name.

Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is 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 name:

- (i) the Complainant’s trademarks are well-known and internationally used, including in Dubai, and in Bangladesh, where the Respondent is located according to the Registrar verification;
- (ii) the disputed domain name incorporates the HEET mark and the HEETS mark (with a common, obvious, or intentional misspelling of this trademark, deleting its last letter “s”), adding the geographical term “Dubai”, which may contribute to generate a risk of confusion or implied association, creating the impression that the disputed domain name refers to official store, authorized distributor or retailer of the Complainant for this country;
- (iii) the use of a common, obvious, or intentional misspelling of the HEETS trademark signals to an intention on the part of the Respondent to confuse users seeking or expecting the Complainant;
- (iv) the website linked to the disputed domain name corroborates the Respondent’s intention to generate confusion or affiliation with the Complainant and its trademarks including prominently a similar version of the Complainant’s trademark in its heading, official product images of the Complainant’s IQOS System products, claiming copyright on this material, and a not sufficiently clear and prominent disclaimer;² and
- (v) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name, and has not come forward to deny the Complainant’s assertions of bad faith, choosing not to reply to the Complaint.

Therefore, on the balance of probabilities, taking into consideration all cumulative circumstances of this case, the Panel considers that the disputed domain name was 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 name and the Complainant, to increase the traffic of the Respondent’s website for a commercial gain, which constitutes bad faith.

All of the above-mentioned circumstances lead the Panel to conclude that the disputed domain name was registered and is 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 name in bad faith under the third element of the Policy.

² It is to be noted that where the overall circumstances of a case point to the respondent’s bad faith, the mere existence of a disclaimer cannot cure such bad faith. On the contrary, in such cases, the respondent’s use of a disclaimer may be considered as an admission by the respondent that users may be confused. See section 3.7 of [WIPO Overview 3.0](#).

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 <heetdubai.com> be transferred to the Complainant.

/Reyes Campello Estebaranz/

Reyes Campello Estebaranz

Sole Panelist

Date: May 25, 2022