

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. naeem naeem
Case No. D2022-1012

1. The Parties

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

The Respondent is naeem naeem, India.

2. The Domain Name and Registrar

The disputed domain name <iqosmarket.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 March 24, 2022. On March 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 25, 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 25, 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 March 28, 2022.

On March 25, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On March 28, 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 April 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 25, 2022.

The Center appointed Teruo Kato as the sole panelist in this matter on April 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

According to the Complainant, the Complainant, Philip Morris Products S.A., is a company which is part of the group of companies affiliated to Philip Morris International Inc., one of the leading international tobacco companies, with products sold in approximately 180 countries. The Complainant's portfolio includes certain products branded as "IQOS System" first launched in Japan in 2014, which is "available in key cities in around 66 markets across the world".

The Complainant owns, *inter alia*, International trademark No. 1218246 for IQOS (word), registered on July 10, 2014, International trademark No. 1338099 for IQOS (device), registered on November 22, 2016, International trademark No. 1461017 for IQOS (device), registered on January 18, 2019, International trademark No. 1329691 for IQOS (device), registered on August 10, 2016, and International trademark No. 1558395 for IQOS (device), registered on September 17, 2020, as set out more particularly in section 6.2A below.

The disputed domain name <iqosmarket.com> was registered on December 15, 2021.

The Respondent is naeem naeem, whose address is given as being in India.

According to the Complainant, the disputed domain name is linked to an online shop allegedly selling and offering the Complainant's IQOS System, and the Complainant contends with evidence that "[t]he Website is provided in Persian. The fact that the Website is indicating all prices in تومان (Iranian toman) currency, as well as the fact that visitors of the Website have the option when checking out to ship products to the territory of نیرا (informal translation 'Iran [(Islamic Republic of)]'), clearly indicates that the Website is directed to Iran [(Islamic Republic of)]."

5. Parties' Contentions

A. Complainant

The Complainant contends that it is the owner of the trademark IQOS.

The Complainant also contends that the disputed domain name is confusingly similar to the Complainant's IQOS trademark.

The Complainant further contends that the Respondent is not a licensee, an authorized agent of the Complainant, or in any other way authorized to use the Complainant's trademark IQOS and that the Respondent is not commonly known by the disputed domain name as an individual, business, or other organization, and that the Respondent does not make any *bona fide* use of the disputed domain name.

The Complainant also contends that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding. The Panel notes that in the present case the Registrar has confirmed that the language of the Registration Agreement is Japanese.

The Complainant has filed the Complaint in English, and requests that the language of the proceeding be English on the grounds, among others, that "the Website provided under the domain name is directed to, at the very least, an English-speaking public" and "the Website [...] also includes a number of English words and/or phrases, suggesting the Respondent understands English" and that English is "obviously also a language, in which the Respondent is doing business."

The Panel examined the evidence submitted by the Complainant and finds that, despite the contentions by the Complainant as above, the use of English on the website at the disputed domain name is minimal and there is no apparent indication that the website is targeted English-speaking public nor that the Respondent is conducting business in English.

The Complainant also contends that use of Japanese as the language of proceeding "would cause an unnecessary burden to the Complainant and unnecessarily delay the proceeding" and requests that the Panel in exercising its discretion to taking into account all relevant circumstances of the case, including matters such as "the parties' ability to understand and use the proposed language, time and costs."

On March 25, 2022, the Respondent was invited by the Center, in both Japanese and English, to indicate any objection to the proceeding being conducted in English by March 30, 2022. The Respondent did not indicate any objection by the specified deadline or later.

On April 4, 2022, the Center informed the Respondent, in both Japanese and English, that the Center has decided, under the circumstances of this case, to: 1) accept the Complaint as filed in English; 2) accept a Response in either English or Japanese; 3) appoint a Panel familiar with both languages mentioned above, if available. Accordingly, the Panel would have accepted a Response in Japanese, but none was submitted by the Respondent.

The Panel further notes that the Respondent is located in India, and the disputed domain name does not resolve to a website in Japanese.

In the circumstances, in accordance with paragraph 11(a) of the Rules, the Panel decides that English be the language of the proceeding. The Panel further finds that such determination would not cause any prejudice to either Party and would ensure that the proceeding takes place with due expedition.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Panel must determine whether (a) the Complainant has a trademark or service mark; and (b) whether the disputed domain name is identical or confusingly similar to that trademark or service mark.

The Complainant submitted evidence of various trademark registrations and the Panel is satisfied that the Complainant is the owner of IQOS registered trademarks, including:

- International trademark No. 1218246 for IQOS (word), registered on July 10, 2014, designating multiple jurisdictions including India, covering goods in classes 9, 11, and 34;
- International trademark No. 1338099 for IQOS (device), registered on November 22, 2016, designating multiple jurisdictions including India, covering services in class 35;
- International trademark No. 1461017 for IQOS (device), registered on January 18, 2019, designating multiple jurisdictions including India, covering goods in classes 9 and 34;
- International trademark No. 1329691 for IQOS (device), registered on August 10, 2016, designating multiple jurisdictions including India, covering goods in classes 9, 11, and 34; and
- International trademark No. 1558395 for IQOS (device), registered on September 17, 2020, designating multiple jurisdictions, covering goods and services in classes 9, 18, 34, 35, 37, and 41.

As to the confusing similarity element for the purposes of the Policy, the Panel has proceeded to compare the disputed domain name to the trademarks which have been provided.

Section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) states that “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”. The Panel finds no reason why this established practice should not be applied to the present case.

Apart from the TLD “.com”, the Panel finds that the disputed domain name contains the Complainant’s trademark IQOS in its entirety, followed by the word “market”.

The Panel notes that section 1.7 of the [WIPO Overview 3.0](#) states that “[w]hile each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The Panel also notes that section 1.8 of the [WIPO Overview 3.0](#) states that “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

In the circumstances, the Panel sees no reason why these established practices should not be applied to the present case.

Therefore, the Panel concludes that the disputed domain name is confusing similar to the Complainant’s IQOS mark.

Accordingly, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate a respondent’s rights or legitimate interests in a domain name:

- (i) before any notice to it of the dispute, the 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the 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 consensus view of UDRP panels is that the burden of proof in establishing no rights or legitimate interests in respect of a domain name rests with the complainant in making out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie case* is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant contends that “the Respondent lacks any right or legitimate interest in the Disputed Domain Name. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its IQOS trademark (or a domain name which will be associated with this trademark).”

The Complainant further contends with evidence that “[t]he Respondent is not making a legitimate non-commercial or fair use of the Domain Name. On the contrary, the Respondent’s behaviour shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademarks owned by the Complainant.”

Having examined the contentions and evidence submitted by the Complainant, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

By not submitting a Response, the Respondent has failed to overturn such *prima facie* case and has also failed to invoke any of the defenses as set out in paragraph 4(c) of the Policy.

Further, the Panel notes that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the Respondent has no rights nor legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

To fulfill the third requirement, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

In order to assess whether the Respondent registered and is using the disputed domain name in bad faith, paragraph 4(b) of the Policy provides non-exhaustive examples constituting evidence of bad faith, which includes the following:

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

The Panel notes and accepts that the trademark IQOS was registered and is known internationally, including in India, in which the Respondent resides, before the disputed domain name was registered on December 15, 2021.

The Panel also accepts the Complainant's contention that the term "Iqos" is purely an imaginative term and unique to the Complainant and that the term "Iqos" is not commonly used to refer to tobacco products or electronic devices other than those of the Complainant.

Therefore, the Panel holds that the Respondent is most likely to have known of the Complainant, its products, and trademarks prior to registering the disputed domain name (see section 3.2.2 of the [WIPO Overview 3.0.](#))

As to the use in bad faith, the Complainant contends, among others, that "[t]he Respondent started offering the Complainant's IQOS System immediately after registering the Disputed Domain Name. [...] It is therefore beyond the realm of reasonable coincidence that the Respondent chose the Disputed Domain Name, without the intention of invoking a misleading association with the Complainant."

The Complainant further contends that "[t]he Website further uses the Complainant's official product images without authorization, while at the same time falsely claiming copyright in this material. This illegitimate and false claim of rights in the Complainant's official copyright protected material further supports the false impression, that the Website is endorsed by the Complainant, which it is not" and "that the Complainant does not currently offer for sale its IQOS System in the territory of Iran [(Islamic Republic of)], and the on-line shop provided under the Disputed Domain Name creates the false impression that the Complainant has officially introduced the IQOS System into the Iranian market."

The Complainant submitted materials to support such contentions, including "Print-outs of the Website" at the disputed domain name which were dated March 22, 2022. The Respondent was given an opportunity to raise its objection to the contentions made by the Complainant but has not done so.

Taking all matters into consideration, the Panel holds that the Respondent has registered and used the disputed domain name in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel therefore concludes that the third requirement of the Policy has been met.

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, <iqosmarket.com>, be transferred to the Complainant.

/Teruo Kato/

Teruo Kato

Sole Panelist

Date: May 13, 2022