

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Jahed Hossainn

Case No. D2023-0595

### **1. The Parties**

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

The Respondent is Jahed Hossainn, United Arab Emirates (“UAE”).

### **2. The Domain Name and Registrar(s)**

The disputed domain name <dxbheets.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 9, 2023. On February 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 9, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 2023, 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 February 10, 2023.

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 February 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 10, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on March 16, 2023. 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 Philip Morris International Inc. (hereinafter referred to as “PMI”), an international tobacco conglomerate that sells tobacco products in around 180 countries of the world.

One of its products is the IQOS system, a precisely controlled heating device into which specially designed tobacco products under the trademarks HEETS, HEATSTICKS, or TEREA are inserted, and heated to generate flavorful nicotine-containing aerosol. Such products are being marketed in key cities in around 71 markets across the world through almost exclusively official IQOS stores and websites and selected authorized distributors and retailers.

The Complainant owns among others the following trademarks (Annexes 6 and 7 to the Complaint):

- UAE registration No. 256864 for the word mark HEETS, registered on December 25, 2017, in international class 34;
- UAE registration No. 211139 for the word mark IQOS, registered on March 16, 2016, in international class 34; and
- UAE registration No. 256867 for the device mark HEETS, registered on December 25, 2017, in international class 34.

The disputed domain name was registered on December 14, 2022, and presently resolves to an online shop directed to the UAE market purportedly offering the Complainant’s IQOS system as well as competing third party products of other commercial origin, describing itself as the “best IQOS & HEETS online shop in UAE”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant claims to have developed the IQOS system, first launched in Nagoya, Japan in 2014. Asserting to have invested over USD 9 billion in extensive international sales and marketing efforts to promote its IQOS system, the Complainant states that its new product has obtained considerable international success and reputation, approximately having 19.1 million relevant consumers worldwide.

According to the Complainant, the use of the disputed domain name in connection with an online shop directed to the UAE market, allegedly selling and offering the Complainant’s IQOS system and HEETS tobacco sticks as well as competing third party products, clearly indicates that the Respondent purports to be an official online retailer of the Complainant’s IQOS system in the UAE, when it is not, by reproducing the Complainant’s trademarks, official product pictures, and logos. In addition to that, an unremarkable disclaimer positioned at the bottom of the Website, after the offers for visitors to the website available at the disputed domain name to make purchases states that “Dxbheets.com has no affiliation with Philip Morris International (PMI). This is not official website of PMI and IQOS”.

Under the Complainant’s view, the disputed domain name is confusingly similar to the Complainant’s HEETS trademark given that it is well accepted that the test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name to assess whether the trademark is recognizable within the disputed domain name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

Furthermore, also according to the Complainant, the addition of the geographical abbreviation for Dubai, “dxb” is insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP.

Regarding the absence of the Respondent’s rights or legitimate interests, the Complainant argues that:

(i) the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its HEETS trademark (or a domain name which would be associated with this trademark);

(ii) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name given that the Respondent is not an authorized distributor or reseller of the IQOS system and the online shop available at the disputed domain name is selling competing tobacco products and/or accessories of other commercial origin;

(iii) the criteria for a *bona fide* offering of goods or services as established in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), are not met (given that the Respondent is not only offering the Complainant’s products but also competing products and accessories of other commercial origin and products that infringe the Complainant’s IQOS trademark);

(iv) the disputed domain name in itself suggests at least an affiliation with the Complainant and its HEETS trademark, as the disputed domain name wholly reproduces the Complainant’s registered HEETS trademark together with the non-distinctive addition, namely the geographical abbreviation for Dubai, “dxb”;

(v) the website to which the disputed domain name resolves uses the Complainant’s official product images without authorization what further supports the false impression that the disputed domain name is endorsed by the Complainant, which it is not;

(vi) the website to which the disputed domain name resolves does not include any information regarding the identity of the provider of the website which further serves to perpetuate the false impression of an official commercial relationship between the disputed domain name and the Complainant; and

(vii) the disclaimer included at the bottom of the Respondent’s website is inaccurate and does not correctly identifies the owner of the HEETS trademark and its relationship (or lack thereof) to the Respondent, also not being capable of offsetting the risk of initial interest confusion.

As to the registration and use of the disputed domain name in bad faith, the Complainant states that:

(i) the Respondent knew of the Complainant’s trademarks when registering the disputed domain name;

(ii) the term “heets” is purely an imaginative term and unique to the Complainant, not commonly used to refer to tobacco products or electronic devices and therefore it is beyond the realm of reasonable coincidence that the Respondent chose the disputed domain name without intention of invoking a misleading association with the Complainant;

(iii) the purpose of the Respondent’s registration of the disputed domain name was to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant’s registered trademark as to the source, sponsorship, affiliation, or endorsement of its website;

(iv) by reproducing the Complainant’s registered trademarks in the disputed domain name and in the title of the website, the website at the disputed domain name suggests the Complainant or an affiliated dealer of the Complainant as the source of the website which is not the case; being this suggestion also supported by the Respondent’s use of the Complainant’s official product images; and

(v) the Respondent's choice to retain a privacy protection service to hide its true identity may in itself constitute a factor indicating bad faith (see [WIPO Overview 3.0](#), section 3.6).

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

### **A. Identical or Confusingly Similar**

The Complainant has established rights over the HEETS trademark.

The disputed domain name reproduces in its entirety the Complainant's HEETS trademark being confusingly similar therewith, and the addition of the term "dxb" does not prevent a finding of confusing similarity under the Policy. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a nonexclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default, as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent whom has not been commonly known by the disputed domain name and is neither an authorized reseller of the Complainant's IQOS system and HEETS tobacco products nor has it been licensed or otherwise permitted to use any of the Complainant's trademarks or to register a domain name incorporating its HEETS trademark.

Also according to the evidence submitted by the Complainant, the use made of the disputed domain name in connection with an online shop allegedly offering the Complainant's products, unauthorizedly reproducing the Complainant's official marketing materials and product images, clearly suggest at least an affiliation with the Complainant, which in fact does not exist.

Selling other parties competing products at the online shop that resolves from the disputed domain name does not meet the criteria for a *bona fide* offering of goods or services as established in *Oki Data Americas, Inc. v. ASD, Inc, supra*.

Lastly, the disclaimer on the website is not clear as to the identity of the responsible for the online shop, not properly indicating who is the owner of the IQOS and HEETS trademarks. Further, the presence of the disclaimer is not clear and sufficiently prominent on the website. Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

### **C. Registered and Used in Bad Faith**

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy, paragraph 4(b)(iv) in view of the reproduction of the Complainant official marketing materials and purportedly offering the Complainant's products at the online shop that is available at the webpage relating to the disputed domain name, which creates a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement thereof.

Moreover, bad faith of the Respondent is also supported here by (i) the choice to retain a privacy protection service in an attempt to conceal the Respondent's true identity; (ii) the lack of reply by the Respondent invoking any rights or legitimate interests; and (iii) the false or incomplete information used by the Respondent for registering the disputed domain name, since the Written Notice was not delivered to the Respondent by courier service.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

## 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 <dxbheets.com> be transferred to the Complainant.

*/Wilson Pinheiro Jabu/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: March 21, 2023