

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. bilal latif, Heetsstore
Case No. D2023-3868

1. The Parties

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

The Respondent is bilal latif, Heetsstore, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <heetstore.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 2023. On September 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 (Contact Privacy Inc. Customer 0167625925) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 18, 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 September 20, 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 September 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 12, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on October 17, 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 a company which is part of the Philip Morris International group, a leading international tobacco company, with products sold in approximately 180 countries, under brands such as MARLBORO.

The Complainant's parent group is currently in the course of transforming its business from combustible cigarettes to "reduced risk products". One of these new products is called IQOS, a controlled heating device into which specially designed tobacco sticks under the brand names HEETS are inserted and heated to generate a flavorful nicotine-containing aerosol.

The Complainant owns a large portfolio of HEETS trademarks, including the United Arab Emirates Trademark Registration number 256864, registered on December 25, 2017.

The disputed domain name was registered on June 24, 2023, and at the time of the filing of the complaint, it resolved to an online shop allegedly selling and offering the Complainant's IQOS System, as well as third party products.

The Panel accessed the disputed domain name on October 28, 2023, which resolved to an e-commerce website entitled "Heetsstore", containing reproductions of the HEETS trademark and where tobacco sticks for heating devices were offered for sale, as well as competing products.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant is the registered owner of the HEETS trademark in numerous jurisdictions, including, but not limited to the United Arab Emirates. It is well established that the applicable Top-Level Domain ("TLD") in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. It is further established that the addition of merely descriptive, or geographical wording to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP. The disputed domain name reproduces the HEETS trademark in its entirety, in addition to the descriptive and non-distinctive word "store". Any Internet user when visiting a website provided under the disputed domain name will reasonably expect to find a website commercially linked to the owner of the HEETS trademarks. This unlawful association is exacerbated by the use of the Complainant's official product images without the Complainant's authorization.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has made a *prima facie* case 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 HEETS trademark (or a domain name which will be associated with this trademark). The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Respondent's behavior shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly divert consumers or to tarnish the trademarks owned by the Complainant. The Respondent is not an authorized distributor or reseller of the Complainant's products. The website linked to the disputed domain name is selling competing tobacco products and/or accessories of other commercial origin.

The website does not meet the requirements set out by numerous panel decisions for a *bona fide* offering of goods. In addition, the title of the website linked to the disputed domain name is "Heetstore", where relevant consumers will usually expect to find the name of the online shop and/or the name of the website provider. The 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 disputed domain name and related website are endorsed by the Complainant, which they are not. The website includes no information regarding the identity of its provider. Also, according to the principle established by previous panels, a respondent would be unable to avail itself of the safe harbor to be found in the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) on the basis that it is a reseller or distributor which is making a *bona fide* offering of goods or services where it is offering for sale third party goods of unknown commercial origin on the website.

- The disputed domain name was registered and is being used in bad faith. It is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's HEETS trademark when registering the disputed domain name. The Respondent started offering the Complainant's products immediately after registering the disputed domain name. Furthermore, the term HEETS is purely an imaginative term and unique to the Complainant. The term HEETS is not commonly used to refer to tobacco products or electronic devices. 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. It is also evident from the Respondent's use of the disputed domain name that the Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's registered HEETS trademark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location, which constitutes registration and use in bad faith. By reproducing the Complainant's registered trademark in the disputed domain name and the title of the website linked to it, the Respondent is suggesting to any Internet user visiting it that the Complainant (or an affiliated dealer of the Complainant) is its source, which it is not. This suggestion is further supported by the Respondent's use of the Complainant's official product images. Additionally, the Respondent is not only using the Complainant's HEETS trademark for the purposes of offering for sale the IQOS System, but also for purposes of offering for sale third party products of other commercial origin. Finally, the fact that the Respondent is using a privacy protection service to hide its identity may in itself constitute a factor indicating bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

Annex 6 to the Complaint shows registrations of HEETS trademarks obtained by the Complainant, including in the United Arab Emirates, in 2017.

The trademark HEETS is wholly encompassed within the disputed domain name, together with the term “store”, as well as with the TLD extension “.com”.

Previous UDRP decisions have found that the addition of descriptive terms (such as “store”) does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark. This has been held in many UDRP cases (see *e.g.*, *Inter-IKEA Systems B. V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)). See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.

It is also well established that the addition of a TLD such as “.com” is typically disregarded when determining whether a domain name is confusingly similar to a complainant’s trademark as such is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use 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; 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 at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed nor authorized the use of its well-known trademark to the Respondent, and the Panel finds no indication that the Respondent is commonly known by the disputed domain name.

Furthermore, the Complainant has evidenced that the disputed domain name resolves to a website offering the Complainant’s HEETS devices for sale, reproducing the Complainant’s trademark and logo, as well as a number of the Complainant’s official product images and marketing materials. However, according to the Complainant, the Respondent is not an authorized reseller, nor has obtained any permission for such reproductions of trademarks, logos and copyrighted materials.

Additionally, although encompassing the Complainant’s trademark HEETS at the disputed domain name and entitling the respective website “Heetstore”, such website also offers for sale competing devices and does not accurately and prominently disclose the registrant’s relationship with the trademark holder. Therefore, the Respondent does not pass the “Oki Data test” to characterize a legitimate interest on the disputed domain name (see *Oki Data Americas, Inc. v. ASD, Inc.*, *supra*).

Moreover, the Panel finds that the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

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

(ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(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 its website or location or of a product or service on its website or location.

The disputed domain name includes the distinctive trademark HEETS, which has no dictionary meaning in English.

Also, the Panel considers that the addition of the term "store" even enhances the perception that the disputed domain name is sponsored or endorsed by the Complainant, in the present case, as it may suggest that it is an official HEETS e-commerce website, operated by the Complainant or by an authorized online reseller.

Furthermore, when the disputed domain name was registered (in 2023) the HEETS trademark was already connected with the Complainant's smoking devices.

Therefore, the Panel concludes that it is not feasible that the Respondent was not aware of the Complainant's trademark and that the registration of the disputed domain name was a mere coincidence.

Actually, the content at the website linked to the disputed domain name - including reproductions of the Complainant's trademark and the description of the respective product, which is being offered for sale – indicates that the Respondent has intentionally attempted to attract, through the registration and use of the disputed domain name, the Complainant's customers, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website.

The situation is aggravated by the offer of competing products through the disputed domain name that reproduces the Complainant trademark.

Finally, the absence of a formal reply from the Respondent to the Complainant's contentions and of any justification for the use of such trademark are further evidence of bad faith in the present case.

Consequently, the Panel is satisfied that the Respondent has registered and is using the disputed domain name in bad faith, and the Complainant has proven 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 name <heetstore.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: November 1, 2023