

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. digiiqos digiiqos, co
Case No. D2022-1646

1. The Parties

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

The Respondent is digiiqos digiiqos, co, India.

2. The Domain Name and Registrar

The disputed domain name <digiiqos.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 6, 2022. On May 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 11, 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 May 11, 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 on May 13, 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 3, 2022.

The Center appointed Taras Kyslyy as the sole panelist in this matter on June 21, 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 a company which is part of the group of companies affiliated to Philip Morris International Inc., an international tobacco company with products sold in approximately 180 countries. The Complainant *inter alia* owns IQOS International trademark registrations designating multiple jurisdictions, for instance:

- International trademark IQOS (word) No. 1218246, registered on July 10, 2014;
- International trademark IQOS (device) No. 1329691, registered on August 10, 2016.

The disputed domain name was registered on October 10, 2021 and resolved to a website mainly in Persian with minor English and Russian wording offering for sale the Complainant's and third party products, and prominently featuring the Complainant's trademark. At the time of the decision the disputed domain name redirects to <dgiqos.ir> which does not resolve to any active website.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's trademarks. The disputed domain name identically adopts the Complainant's trademark. The applicable Top-Level-Domain ("TLD") is viewed as a standard registration requirement and as such is disregarded under the confusing similarity test. Addition of geographical wording to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity. The disputed domain name reproduces the Complainant's trademark in its entirety, in addition to the nondistinctive and descriptive word "digi", which appears to be an abbreviation of the word "digital".

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use its trademarks and to register the disputed domain name. The Respondent has clear intent to obtain commercial gain with a view to misleadingly divert consumers or tarnish the trademark owned by the Complainant. The website at the disputed domain name is designed to make an impression it is related or authorized by the Complainant, which is not true, and does not clarify the real Respondent's relationship to the Complainant. All these cannot be considered a *bona fide* offering of goods.

The disputed domain name was registered and is being used in bad faith. The Respondent knew of the Complainant's trademark when registering the disputed domain name as confirmed by its further use to offer for sale the Complainant's products. The Respondent registered and used the disputed domain name with the intention of attracting, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or location or a product or service on its website or location. The Respondent is using privacy protection service to hide its true identity.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") the applicable generic TLD ("gTLD") 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. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant's trademark.

According to section 1.8 of the [WIPO Overview 3.0](#) where 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. The panel finds that the addition of the term "digi" to the disputed domain name does not prevent finding of the confusing similarity.

Considering the above the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing complainant's trademark to undertake sales related to the complainant's goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the "Okidata Test"), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant's relationship with trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the second and the third above requirements, as the website at the disputed domain name also offers for sale competing goods and does not in any way disclose its actual relationship (or a lack thereof) with the Complainant. Thus, the disputed domain name fails to pass the *Okidata Test*. The Respondent's use of the disputed domain name misleads consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent's use of the disputed domain name cannot be considered *bona fide*.

The Respondent's use of the confusingly similar disputed domain name on a website offering for sale overlapping products is neither a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use pursuant to the Policy (see, e.g., *Option One Mortgage Corporation v. Option One Lending*, WIPO Case No. [D2004-1052](#)).

The Respondent has no rights or legitimate interests in the disputed domain name resolving at the time of the decision to an inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

Noting the risk of implied affiliation between the disputed domain name and the confusingly similar well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant (see, e.g., *Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / Zayed*, WIPO Case No. [D2019-2897](#)).

Considering the above the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent's use of the disputed domain name to purport to sell the Complainant's products shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted the Complainant's prior registered and famous trademark, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#) the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in Switzerland and internationally. Thus, the Panel finds that the disputed domain name confusingly similar to the Complainant's trademark was registered in bad faith.

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location. In this case, the disputed domain name resolves to a website featuring the Complainant's trademark and making false impression of being the Complainant's local website to intentionally attract Internet users by creating likelihood of confusion with the Complainant's trademarks as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

Although at the time of this decision the disputed domain name resolves to inactive webpage, its previous bad faith use and lack of explanation of possible good faith use from the Respondent makes any good faith use of the disputed domain name implausible. Thus, the current passive holding of the disputed domain name does not prevent a finding of bad faith (see, e.g., *Abbott Diabetes Care Inc. v. Privacy Protection, Hosting Ukraine LLC / Виталий Броцман (Vitalii Brocman)*, WIPO Case No. [DPW2017-0003](#)).

Considering the above the Panel believes the disputed domain name was registered and is being used in bad faith, therefore, the Complainant has established its case under paragraph 4(a)(iii) 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, <digiiqos.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: July 5, 2022