

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Privacy Protection / Shishir Amhed /org
Whiteregistrar Inc
Case No. D2022-2130

1. The Parties

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

The Respondent is Privacy Protection, United States of America (“United States”) / Shishir Amhed /org
Whiteregistrar Inc, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <vapeheetsuae.info> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2022. On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 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 June 16, 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 June 20, 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 June 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2022.

The Center appointed Andrew F. Christie as the sole panelist in this matter on August 15, 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 the group of companies affiliated to Philip Morris International Inc. (“PMI”). PMI is a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries.

PMI has developed a precisely-controlled heating device, called “Iqos”, into which specially designed tobacco products, sold under the brand names “HEETS”, “HeatSticks” or “Terea”, are inserted and heated to generate a flavourful nicotine-containing aerosol (collectively referred to as the “IQOS System”). The IQOS System was first launched by PMI in Japan in 2014, and is now available in around 71 markets across the world, with approximately 19.1 million consumers. To date, the IQOS System has been almost exclusively distributed through PMI’s official IQOS stores and websites and selected authorized distributors and retailers.

The Complainant owns a large portfolio of trademark registrations, including United Arab Emirates Trademark Registration No.256864 (registered on December 25, 2017) for the word trademark HEETS (“HEETS Trademark”) and United Arab Emirates Registration No. 256867 (registered on December 25, 2017) for the device trademark HEETS (“HEETS Device Trademark”), and United Arab Emirates Registration No. 305079 (registered on June 27, 2019) for the device trademark IQOS (“IQOS device mark”).

The disputed domain name was registered on May 15, 2022. The Complainant has provided screenshots, taken on June 9, 2022, of the website resolving from the disputed domain name, at which appear the words “VAPE HEETS”, “Vape Heets UAE | Best vape collection in Dubai, UAE”, the HEETS word and device trademarks, the IQOS Device Trademark, a selection of purported HEETS products offered for sale apparently using the Complainant’s official product images, and purported products of the Complainant’s competitors. At the time of this decision, it appears that the disputed domain name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The disputed domain name adopts the Complainant’s HEETS Trademark. It is well established that the applicable generic Top-Level Domain (“gTLD”) in a domain name is viewed as a standard registration requirement and, as such, is disregarded. The disputed domain name reproduces the HEETS Trademark in its entirety, in addition to the non-distinctive and descriptive word “vape” and the geographical abbreviation for the United Arab Emirates, *i.e.*, “uae”. 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 Trademark. The unlawful association is exacerbated by the use of the Complainant’s official product images without the Complainant’s authorization.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of 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 the HEETS Trademark or a domain name which will be associated with this trademark. 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. The Respondent is not an authorized distributor or reseller of the IQOS System. The website resolving from the disputed domain name, and the third-party online shop to which the user is redirected from that website, were selling competing tobacco products and/or accessories of other commercial origin. The website resolving from the disputed domain name does not meet the requirements set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), because: (i) the Respondent was offering not only the Complainant's products but also competing products; (ii) the disputed domain name in itself suggests at least an affiliation with the Complainant and its HEETS trademarks; and (iii) the owner / administrator of the website prominently, and without authorization, presented the Complainant's registered HEETS Trademark at the top left of the website and used the Complainant's official product images without authorization, while at the same time falsely claiming copyright in this material. Internet users and relevant consumers are clearly misled regarding the relationship between the website resolving from the disputed domain name and the Complainant, and will falsely believe that this website is an official or endorsed distributor of the Complainant's products.

The Complainant made the following contentions to establish that 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 it knew of the Complainant's HEETS Trademark when registering the disputed domain name, as it started offering the Complainant's IQOS System immediately after registration. The term "heets" is purely an imaginative term and unique to the Complainant, and it is 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 evident from the Respondent's use of the disputed domain name that it registered and used it 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 of a product or service on its website. The Respondent is not only using the Complainant's HEETS Trademark for the purposes of offering for sale the IQOS System, but also for the sale of third-party products of other commercial origin, which is a clear-cut trademark infringement. The Respondent shows a pattern of bad faith conduct in connection with domain names incorporating the Complainant's trademarks. The Respondent is using a privacy 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

Once the gTLD ".info" is ignored (which is appropriate in this case), the disputed domain name consists of the Complainant's registered HEETS Trademark, preceded by the word "vape" and followed by the letters "uae". The Complainant's trademark is clearly recognizable within the disputed domain name. The addition of the word "vape" (which most likely will be read as the name for an e-cigarette or similar device) and the string "uae" (which most likely will be read as an abbreviation of the United Arab Emirates) does not avoid a finding of confusing similarity of the disputed domain name with the trademark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its HEETS Trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name.

The evidence provided by the Complainant shows that the disputed domain name has been used to resolve to a website displaying the HEETS Trademark, and purporting to offer HEETS products for sale, as well as products of the Complainant's competitors. The contents of the Respondent's website and the nature of the disputed domain name are such that many Internet users will form the false belief that the website is operated by, or affiliated with, the Complainant. Given the confusing similarity of the disputed domain name to the Complainant's trademark, the absence of any relationship between the Respondent and the Complainant, and the failure to avoid the implied false affiliation with the Complainant, the Respondent's use of the disputed domain name is neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The disputed domain name was registered several years after the Complainant first registered its HEETS trademark. It is inconceivable that the Respondent registered the disputed domain name ignorant of the existence of the Complainant's trademark, given the renown of the Complainant's trademark, that the disputed domain name consists of the Complainant's trademark with merely the addition of the word "vape" and the geographical abbreviation "uae", and that the Respondent used the disputed domain name to resolve to a website that displays the Complainant's HEETS trademark and purports to offer for sale the Complainant's goods.

Given the Respondent's lack of rights or legitimate interests in the disputed domain name, and the confusing similarity of the disputed domain name to the Complainant's trademark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain name in these circumstances is a bad faith registration.

Furthermore, the evidence on the record provided by the Complainant indicates that the Respondent has used the disputed domain name in an attempt to attract, for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainant. The Respondent's use of the disputed domain name in this manner is a bad faith use.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

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, <vapeheetsuae.info>, be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: August 29, 2022