

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. sayyed abduallah
Case No. D2022-2489

1. The Parties

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

The Respondent is sayyed abduallah, India.

2. The Domain Names and Registrar

The disputed domain names <heetsoman.com> and <iqosoman.com> are registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 8, 2022. On July 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same date, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 14, 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 July 19, 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 July 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 18, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on August 24, 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 subsidiary of Philip Morris International, Inc., an international tobacco company, which is selling its products in approximately 180 countries worldwide.

The Complainant manufactures tobacco products, including a system promoted under the mark IQOS, which is an alternative to combustible cigarettes and consists of a controlled heating device into which specially designed tobacco products under the brand names “HEETS” or “HeatSticks” are inserted and heated to generate a flavourful nicotine-containing aerosol.

The IQOS System was launched in Japan in 2014 and, with investments of USD 9 billion in science, research, sales and marketing, it is currently sold in 71 markets across the globe reaching approximately 19,1 million relevant consumers. The Complainant’s IQOS System is primarily distributed through official or endorsed stores.

The Complainant holds a large portfolio of IQOS and HEETS trademarks, including the following:

- the International trademark registration number 1218246 for IQOS, registered on July 10, 2014, designating many countries worldwide, and covering goods in Nice classes 9, 11, and 34;
- the International trademark registration number 1338099 for IQOS (device), registered on November 22, 2016, designating many countries worldwide, and covering services in Nice classes 35;
- the United Arab Emirates trademark registration number 256864 for the word HEET, filed on July 20, 2016 and registered on December 25, 2017, and covering goods in Nice class 34; and
- the International trademark registration number 1328679 for the word HEETS with device, registered on July 20, 2016, and covering goods in Nice class 9, 11, 34.

The Complainant’s IQOS and HEETS trademark are well-known and highly recognized within the area of innovative tobacco products. See also *Philip Morris Products S.A. v. Whois Privacy Protection Service / Vitalij Solomin*, WIPO Case No. [D2019-2103](#); *Philip Morris Products S.A. v. Viktor Gubin*, WIPO Case No. [D2020-2196](#); *Philip Morris Products S.A. v. Yang Jiang Nan*, WIPO Case No. [D2018-1869](#); or *Philip Morris Products S.A. v. Domain Admin ContactID 5801095, FBS INC, Whoisprotection biz / Bahadır Veziroğlu*, WIPO Case No. [D2018-2596](#).

The disputed domain names <heetsoman.com> and <iqosoman.com> were registered on May 12, 2022.

At the time of filing the Complaint, the disputed domain names were connected to commercial websites allegedly offering the Complainant’s IQOS System as well as third parties competing products; displaying the Complainant’s trademarks IQOS and HEETS and official product images; claiming to be “TRUSTED IQOS Online Store”; and claiming copyright protection. On the websites under the disputed domain names, at the bottom page, there is a note stating: “HEETS IQOS OMAN/DUBAI HAVE NO AFFILIATION WITH PHILIP MORRIS INTERNATIONAL (PMI). THIS IS NOT OFFICIAL WEBSITE OF PMI AND IQOS.”

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to its well-known and distinctive trademarks HEETS and IQOS, the Respondent has no rights or legitimate interests in the disputed domain names, and the Respondent registered and is using the disputed domain names in bad faith.

B. Respondent

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

6. Discussion and Findings

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain names are 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 the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the IQOS and HEETS trademarks.

The disputed domain name <heetsoman.com> incorporates the Complainant's trademark HEETS with an additional term, "oman"; respectively the disputed domain name <iqosoman.com> incorporates the Complainant's trademark IQOS with the same additional term, "oman". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademarks are clearly recognizable within the disputed domain names.

Numerous UDRP panels have considered that the addition of other terms (whether geographical wording, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name is not sufficient to escape a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Further, it is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".site", ".info", ".shop") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademarks IQOS and HEETS, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the marks IQOS and HEETS, that the Respondent is not commonly known by the disputed domain names, and that the Respondent has not used the disputed domain names in connection

with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, “where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant’s contentions and has not come forward with relevant evidence to rebut the Complainant’s *prima facie* case.

There is nothing in the record suggesting that the Respondent has made a *bona fide* use of the disputed domain names, or has been known by these disputed domain names, or is making any legitimate noncommercial or fair use of the disputed domain names.

In fact, at the time of filing the Complaint, the disputed domain names resolved to commercial websites featuring the Complainant’s trademarks and offering for sale unauthorized products bearing the Complainant’s trademarks as well as third parties competing goods.

In this case, assuming that the products or at least some of the products offered for sale under the disputed domain names were genuine IQOS and HEETS branded products, the key question under this element is whether the Respondent’s use of the disputed domain names for such resale amounts to a *bona fide* offering of goods under paragraph 4(c)(i) of the Policy. The current state of UDRP panel decisions in relation to this issue is helpfully summarized in section 2.8 of the [WIPO Overview 3.0](#) as follows:

Normally, a reseller, distributor or service provider can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods, the site’s accurately and prominently disclosing the registrant’s relationship with the trademark holder and the respondent must not try to “corner the market” in domain names that reflect the trademark. This summary is based on UDRP panel decisions such as *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

At least two conditions that are outlined have clearly not been satisfied by the Respondent in this case: at the time of filing the Complaint, on the websites under the disputed domain names, third parties goods were offered and there was no accurate information regarding the Respondent and its relationship (in fact the lack thereof) with the Complainant thus generating a likelihood of confusion for the Internet users accessing the Respondent’s websites. The alleged disclaimers are incomplete and inconspicuous.

In addition, and without prejudice to the above, the nature of the disputed domain names, comprising the Complainant’s trademarks in their entirety in combination with a generic term, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain names, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds registered trademark rights for IQOS and HEETS since 2014 and has gained reputation worldwide.

The disputed domain names were created in 2022 and incorporate the Complainant’s marks with an additional non-distinctive term “oman”.

For the above, the Panel finds that the disputed domain names were registered in bad faith, with knowledge of the Complainant, its business and particularly targeting its IQOS and HEETS trademarks.

The Respondent is using without permission the Complainant's trademarks in order to get traffic on its web portals and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's distinctive trademarks in the disputed domain names, the content on the websites provided thereunder which includes the Complainant's trademarks and official product images.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names incorporate the Complainant's trademarks and the websites operated under the disputed domain names display the Complainant's trademarks and official product images, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain.

The mere existence of a disclaimer on the webpage to which the disputed domain name resolves is not sufficient, Panels have held that the presence of a clear and sufficiently prominent disclaimer can support a finding that the respondent has undertaken reasonable steps to avoid unfairly passing off as related to the complainant or otherwise confuse users. See section 3.7 of the [WIPO Overview 3.0](#). In the present case, the disclaimers are obscured at the bottom of the websites under the disputed domain names and contain scarce information.

Furthermore, it was consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark constitutes, by itself, a presumption of bad faith registration for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 names <heetsoman.com> and <iqosoman.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: September 1, 2022