

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. tetsuro yamaguthi, yamaguthi tetsuro  
Case No. D2022-4731

### **1. The Parties**

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

The Respondent is tetsuro yamaguthi, yamaguthi tetsuro, Japan.

### **2. The Domain Name and Registrar**

The disputed domain name <iqos-laboratory.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 9, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 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 December 12, 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 in English on December 13, 2022.

On December 12, 2022, the Center notified the Parties in both English and Japanese that the language of the registration agreement for the disputed domain name is Japanese. On December 13, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on December 20, 2022. In accordance



with the Rules, paragraph 5, the due date for Response was January 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2023.

The Center appointed Douglas Clark as the sole panelist in this matter on January 19, 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 a group of companies affiliated with Philip Morris International Inc. ("PMI"). PMI is an international tobacco company with products sold in around 180 countries. PMI has developed a number of tobacco products including a tobacco heating system called IQOS. They are sold under the brand names "Heets", "HeatSticks" and "Terea". There are currently five versions of the IQOS heating device available, including the IQOS Iluma.

The Complainant is also the owner of several trade mark registrations for IQOS including the following:

Trade Mark	Registration Number	Registration Date	Jurisdiction
IQOS (word)	5727311	December 19, 2014	Japan
IQOS (word)	5770614	June 12, 2015	Japan
IQOS (word)	6100975	November 22, 2018	Japan
 (device)	1338099	November 22, 2016	International, including Japan
 (device)	1329691	August 10, 2016	International, including Japan

The Respondent is an individual based in Japan.

The disputed domain name <iqos-laboratory.com> was registered on July 27, 2022. At the date of this Complaint, the disputed domain name resolved to a website providing information on tobacco products (including e-cigarettes), and displaying third party advertisements offering the Complainant's IQOS products, along with other competitor products.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that:

- (a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name wholly incorporates the IQOS trade mark with the addition of the term "laboratory". The generic Top-Level Domain ("gTLD") ".com" in the disputed domain name does not eliminate the overall notion that the designations are connected to the trade mark and the likelihood of confusion that the disputed domain name and the trade mark are associated;
- (b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorisation or license to use the Complainant's trade mark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name; and

- (c) The disputed domain name was registered and is being used in bad faith. The Respondent immediately began selling IQOS products once the domain name was registered and must have known of the Complainant. Based on the use of the disputed domain name, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant's trade mark.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issues – Language of the Proceeding**

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In this case, the language of the Registration Agreement for the disputed domain name is in Japanese. Based on the given evidence, there is no agreement between the Complainant and the Respondent regarding the language of the proceeding. The Respondent did not respond as to the language of the proceeding. The Complainant has filed its Complaint in English and has requested that English be the language for the proceeding under the following grounds:

- a) the Complainant communicates in English and would be prejudiced if it is required to translate the Complaint and supporting documents to Japanese;
- b) in order to proceed in Japanese, the Complainant would have had to retain specialised translation services that would cause an unnecessary burden to the Complainant and delay the proceeding;
- c) the Respondent has demonstrated that he or she understands English since the disputed domain name resolve to a website including a number of English words and/or phrases;
- d) the disputed domain name is in Latin script and not Japanese script; and
- e) the English language being a common language in global business and a language in which the Respondent is doing business in.

In accordance with paragraph 11(a) of the Rules, the Panel hereby determines that the language of the proceeding shall be in English after considering the following circumstances:

- the Center has notified the Respondent of the proceeding in both English and Japanese.
- the Respondent has not commented on the language of the proceeding.
- an order for the translation of the Complaint and other supporting documents will result in significant expenses for the Complainant and a delay in the proceeding.

Further, this Panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

## 6.2 Substantive Issues

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights to;
- (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

The Panel finds that the disputed domain name <iqos-laboratory.com> is confusingly similar to the Complainant's trade mark. The disputed domain name incorporates the IQOS trade mark in full accompanied by the word "laboratory" and the gTLD ".com". The gTLD is generally disregarded when considering the first element. (see section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").)

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

The Respondent has not asserted any rights or legitimate interests in relation to the disputed domain name.

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, 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.

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under UDRP paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the 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 domain name, even if the respondent has acquired no trademark or service mark rights; 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 or service mark at issue.

The Complainant has asserted that the Respondent has no business with and is in no way affiliated with the Complainant. The Respondent is not authorized nor licensed to use the Complainant's IQOS trade mark or to apply for registration of the disputed domain name.

The disputed domain name resolves to a website, which claims to provide information on tobacco products (including e-cigarettes). However, the website also displays advertisements, which purports to sell and offer the Complainant's products, along with other competitor products. In *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), the panel in that case held that to be "bona fide" within the meaning paragraph 4(c)(i) of the Policy, the offering should meet the following requirements:

- (i) The Respondent must actually be offering the goods or services at issue;
- (ii) The Respondent must use the site to sell only the trade marked goods; otherwise, it could be using the trade mark to bait Internet users and then switch them to other goods;
- (iii) The site must accurately disclose the respondent's relationship with the trade mark owners; it may not, for example, falsely suggest that it is the trade mark owner, or that the website is the official site; and
- (iv) The respondent must not try to corner the market in all domain name, thus depriving the trade mark owner of reflecting its own mark in a domain name.

In this case, the Respondent does not meet, at least, the second and third requirements set out above. The website under the disputed domain name displays advertisements offering for sale the Complainant's competitors' goods and also does not accurately disclose its relationship with the Complainant. Further, the website does not appear to sell the Complainant's products directly but rather displays advertisements purportedly offering for sale the Complainant's products.

The second element of paragraph 4(a) of the Policy is therefore satisfied.

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

Based on the given evidence, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant has registered the IQOS trade mark. The Respondent provides information and advertisements on the Complainant's products and competing products on its website soon after registering the disputed domain name. The Panel is satisfied that the Respondent was aware of the Complainant and its IQOS trade mark when he or she registered the disputed domain name.

The Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. By reproducing the Complainant's IQOS trade mark in the disputed domain name, and displaying advertisements for selling the Complainant's products and other competing products on the website at the disputed domain name, the Respondent is clearly seeking to attract users for commercial gain.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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 <iqos-laboratory.com> be transferred to the Complainant.

*/Douglas Clark/*

**Douglas Clark**

Sole Panelist

Date: February 2, 2023