

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Pramod Buldak  
Case No. D2023-0342

### **1. The Parties**

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

The Respondent is Pramod Buldak, India.

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

The disputed domain names <heetsamber.com> and <heetsbronze.com> (the “Disputed Domain Names”) are 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 January 25, 2023. On January 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On January 26, 2023, 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 January 27, 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 in English on January 27, 2023.

On January 27, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 27, 2023, the Complainant submitted a 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 February 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. The Respondent did not submit

any response. Accordingly, the Center notified the Respondent's default on February 23, 2023.

The Center appointed Haig Oghigian as the sole panelist in this matter on March 7, 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 Swiss corporation which is affiliated to the Philip Morris International Inc. (hereafter "PMI"). PMI is an international tobacco and smoke-free products company, active in over 180 countries.

As it appears from Annexes 6 and 7 of the Complaint, the Complainant owns numerous trademark registrations for the mark HEETS, either in word or stylized forms. Among those registrations, the Panel notes the following trademarks registered in the United Arab Emirates:

- HEETS, No. 256864, registered on December 25, 2017, for goods in class 34;
- HEETS Stylised, No. 256867, registered on December 25, 2017, for goods in class 34;
- HEETS AMBER LABEL, No. 257770, registered on April 22, 2018, for goods in class 34;
- HEETS BRONZE LABEL, No. 269677, registered on June 25, 2018, for goods in class 34.

The Panel notes that the Complainant also provides evidence related to other trademark registrations such as IQOS and IQOS ILUMA. According to the Whois records, the Disputed Domain Names were both registered on March 23, 2022.

The websites to which the Disputed Domain Names resolve offer for sale the Complainant's tobacco heating system called "IQOS." They also seem to sell third party accessories related to consumption of smoke-free products. The websites primarily target the United Arab Emirates market. The Disputed Domain Names do not show any details regarding the provider of the webpages, but have a very small disclaimer positioned at the bottom of the webpages.

#### **5. Parties' Contentions**

##### **A. Complainant**

Restricting our summary to only the Complainant's submissions that are directly relevant to the burden that must be discharged under paragraph 4(a) of the Policy, the Complainant submits as follows:

First, the Complainant submits that the Disputed Domain Names are identical or confusingly similar to some of their trademark registrations because the Disputed Domain Names contain both the word "HEETS" followed by, respectively, the word "AMBER" and "BRONZE." These words reproduce the Complainant's trademarks in their entirety or are highly similar and phonetically almost identical to the Complainant's trademarks. The Complainant submits that such use of the words "HEETS," "AMBER," and "BRONZE" is confusingly similar to the Complainant's trademarks.

Second, the Complainant also submits that the Respondent has no rights or legitimate interests in the Disputed Domain Names because (1) the Complainant has not authorized the Respondent to register and use any domain names incorporating in their entirety or components of the HEETS, HEETS BRONZE LABEL or HEETS AMBER LABEL trademarks, (2) the Complainant has not granted any license nor any authorization to use these trademarks as part of the Disputed Domain Names, (3) the Respondent does not make a *bona fide* offering of goods because it offers third party products that are competing with the Complainant's products, and (4) the Disputed Domain Names falsely suggests an affiliation with the Complainant.

Finally, the Complainant submits that the Respondent registered the Disputed Domain Names in bad faith. First, the Complainant submits that the Respondent chose these domain names with the intention of invoking a misleading association with the Complainant. Second, the websites suggest an affiliation with the Complainant. Third, the Respondent offers for sale third party products which do not originate from the Complainant – the Respondent is therefore using the Complainant's trademarks to promote competing products.

## **B. Respondent**

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

## **6. Discussion and Findings**

Even in the absence of a substantive response from the Respondent, and in accordance with paragraph 4(a) of the Policy, the Complainant bears the burden to prove to the Panel, *prima facie*, each of the following elements:

- i. The Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- iii. The Disputed Domain Names have been registered and are being used in bad faith.

The Panel will successively rule on each of these elements.

### **A. Language of the Proceeding**

Paragraph 11(a) of the Rules provides that, unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regards to the circumstances of the administrative proceeding.

The Registrar has confirmed that the language of the Registration Agreement of the Disputed Domain Names is Japanese. The Complainant sets forth a number of arguments as to why the proceeding should be held in English, including that the Disputed Domain Names are not in Japanese script, and in order to proceed with the Complaint in Japanese, the Complainant would have to arrange for translations which would put the Complainant to great and disproportionate disadvantage due to the time and expense involved and would delay the proceeding. The Respondent did not comment on the language of the proceeding or object to the Complainant's request.

Considering the above, in accordance with paragraph 11(a) of the Rules, the Panel determines that the language of the proceeding should be English.

### **B. Identical or Confusingly Similar**

The Complainant satisfactorily established its rights in the HEETS-formative trademarks and that the Disputed Domain Names are confusingly similar to the HEETS-formative trademarks.

The Complainant has shown its rights in the HEETS-formative trademarks through the above-cited valid United Arab Emirates registrations as well as through the list of other trademark registrations included at Annexes 6 and 7 of the Complaint. Evidence of such registrations was sufficient to *prima facie* satisfy the

threshold requirement of having trademark rights in the HEETS-formative trademarks, according to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

As stated in section 1.7 of the [WIPO Overview 3.0](#), a domain name which incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name will normally be considered confusingly similar to that trademark. The test for identity or confusing similarity typically involves a side-by-side comparison of the domain name, to assess whether the trademark is recognizable within the domain name.

In this case, the Disputed Domain Names are composed of two elements: (1) the word “HEETS” followed by (2) the words “AMBER” or “BRONZE.” The Panel is free to ignore the generic Top-Level Domain “.com”, in accordance with section 1.11.1 of the [WIPO Overview 3.0](#). The trademark HEETS is included in its entirety in the Disputed Domain Names. The HEETS-formative trademarks of the Complainant (HEETS AMBER LABEL and HEETS BRONZE LABEL) are clearly recognizable within the Disputed Domain Names, despite the absence of the word “LABEL”.

Therefore, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant’s trademarks and thus the Complainant has discharged its burden under subparagraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

The Respondent has no rights or legitimate interests in the Disputed Domain Names.

Following section 2.1 of the [WIPO Overview 3.0](#), the Complainant must demonstrate, *prima facie*, that the Respondent has no rights to or legitimate interests in the Disputed Domain Names. If the Complainant succeeds, and in order to avoid the Complainant having to prove that a Respondent lacks rights or legitimate interests in the Disputed Domain Names, which may result in the often-impossible task of “proving a negative,” the burden of production of this second element under subparagraph 4(a)(ii) of the Policy shifts to the Respondent. Here, the Respondent must now produce relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names. Such a legitimate interest is defined, non-exhaustively at section 2.1 of the [WIPO Overview 3.0](#), as either use of the domain name in connection with a *bona fide* offering of goods or services, the Respondent being commonly known by the Disputed Domain Names, or a legitimate noncommercial fair use of the Disputed Domain Names, without misleading the consumers or tarnishing the trademark at issue.

In the present case, the Respondent did not file a response and thus provided no evidence that it holds any such rights or legitimate interests in the Disputed Domain Names, namely that it has used or made preparation to use the Disputed Domain Names in connection with a *bona fide* offering of goods and services.

There is a clear presence of the HEETS-formative trademarks in the Disputed Domain Names, and in the absence of evidence from the Respondent to the contrary, this is sufficient for the Panel to agree with the Complainant’s submissions that the Complainant did not authorize the Respondent to register or use the Disputed Domain Names, that there is no connection between the Complainant and the Respondent and thus, no conceivable basis upon which the Respondent could possibly claim to have any rights or legitimate interests in respect of the Disputed Domain Names.

The Disputed Domain Names include inaccurate information and does not correctly identify the owners of the IQOS and HEATSTICKS trademarks, and the websites use the Complainant’s trademarks and official product images without Complainant’s authorization. The disclaimers offered at the bottom of the webpage are not presented in a sufficiently prominent manner, and in any case, they are not sufficient to prevent a risk of implied affiliation arising from the composition of the disputed domain name, all contrary to section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent does not hold any rights or legitimate interests in the Disputed Domain Names and that the Complainant has discharged its burden under subparagraph 4(a)(ii) of the Policy.

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

The Complainant satisfactorily established that the Respondent is using and has registered the Disputed Domain Names in bad faith.

Subparagraph 4(a)(iii) of the Policy states this double requirement. According to section 3.1 of the WIPO Overview 3.0, bad faith occurs if the Respondent takes unfair advantage of or otherwise abuses the Complainant's trademark. The same subsection lists non-exhaustive scenarios which could constitute evidence of bad faith.

The Panel notes that the trademark registrations for the HEETS-formative trademarks in the United Arab Emirates date back to 2017 and 2018. The Panel also notes that since the launch of the IQOS System in 2014, which uses HEETS sticks as the substance being consumed, more than 19.1 million consumers used that system worldwide. Therefore, the Complainant's reputation is well established. The Complainant has thus demonstrated that the HEETS-formative trademarks were well-known in association with its products and services. Given the extensive notoriety of the HEETS-formative trademarks, and that the Respondent is active in reselling products to consumers in the exact same market as that of the Complainant, and in fact distributing (without authorization) the Complainant's own products, the Panel is of the view that the Respondent was necessarily aware of the HEETS-formative trademarks and the Complainant's reputation.

The Respondent has included a disclaimer at the bottom of the webpages at the Disputed Domain Names. Noting the composition of the Disputed Domain Name, the Panel finds that the mere existence of a disclaimer, which is not presented in a sufficiently prominent manner, cannot cure the Respondent's bad faith.

The Respondent has attempted to attract Internet users to the Disputed Domain Names by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Names.

#### **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 <heetsamber.com> and <heetsbronze.com> be transferred to the Complainant.

*/Haig Oghigian/*

**Haig Oghigian**

Sole Panelist

Date: March 21, 2023