

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Tadahisa Tsurugai
Case No. D2023-4372

1. The Parties

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

The Respondent is Tadahisa Tsurugai, Japan.

2. The Domain Name and Registrar

The disputed domain name <iqostecho.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 October 21, 2023. On October 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 24, 2023, 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 (Private Registration) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 October 26, 2023.

On October 25, 2023, the Center informed the Parties in Japanese and English, that the language of the registration agreement for the disputed domain name is Japanese. On October 26, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 Japanese and English of the Complaint, and the proceedings commenced on October 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 21, 2023.

The Center appointed Erica Aoki as the sole panelist in this matter on November 27, 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 a Swiss company established under the laws of Switzerland and is part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI").

PMI is a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries. PMI's brand portfolio contains brands like MARLBORO (outside of the United States of America and Canada), the world's number one international selling cigarette brand since 1972.

In the course of transforming its business from combustible cigarettes to Reduced Risk Products (or "RRPs", which PMI defines as products that present, are likely to present, or have the potential to present less risk of harm to smokers who switch to those products versus continued smoking), PMI has developed a number of RRP products. One of these RRP products developed and sold by PMI is a tobacco heating system called IQOS. IQOS is a precisely controlled heating device into which specially designed tobacco sticks 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").

There are 5 versions of the IQOS heating device currently available: the IQOS 2.4/IQOS 2.4+ pocket charger and holder, IQOS 3 pocket charger and holder, IQOS 3 Multi device, IQOS 3 DUO/DUOS, and IQOS ILUMA. The IQOS System was first launched by PMI in Nagoya, Japan in 2014 and has obtained an extraordinary 20% share of the market in Japan. Today the IQOS System is available in key cities in around 71 markets across the world.

As a result of an investment of over USD 9 billion into the science and research of developing smoke-free products and extensive international sales (in accordance with local laws), the IQOS System has achieved considerable international success and reputation, and approximately 19.1 million relevant consumers are using the IQOS System worldwide.

To date, the IQOS System has been almost exclusively distributed through PMI's official IQOS stores and websites and selected authorized distributors and retailers.

For its new innovative smoke-free products the Complainant owns a large portfolio of well-known trademarks. Among them, but by no means limited to, are the following trademark registrations:

- Japanese Registration IQOS (word) No. 5727311 registered on December 19, 2014;
- Japanese Registration IQOS (word) No. 5770614 registered on June 12, 2015; and
- Japanese Registration ILUMA (word) No. 6320044 registered November 24, 2020.

The disputed domain name was registered on June 9, 2017. The disputed domain name is linked to a website that refers and/or includes hyperlinks which redirects to a third party online shop allegedly selling and offering the Complainant's IQOS System, as well as third party products of other commercial origin and is exclusively aiming the Japanese market.

Moreover, the Website employs a "translation" of the Complainant's IQOS trademark in the Japanese phrase (i.e. "アイコス手帳") which strengthens the false impression of an affiliation with the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the Complainant is the registered owner of the IQOS trademark in numerous jurisdictions, including, but not limited to Japan. The disputed domain name identically adopts the Complainant's IQOS trademarks, in addition to the nondistinctive and descriptive word "techo".

The addition of the generic Top-Level Domain ("gTLD") suffix ".com" does not change the overall impression of the designation as being connected to the trademark IQOS. It does not prevent a finding of confusing similarity between the disputed domain name and the Complainant and its trademark.

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 IQOS trademarks.

B. Respondent

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

6. Discussion and Findings

The Complainant is required to establish the requirements specified under paragraph 4(a) of the Policy:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is English. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that: (i) According to paragraph 11(a) of the Rules it is in the panel's authority to determine the language of the proceedings differing from the language of the registration agreement having regard to the circumstances of the administrative proceeding. (ii) In the past numerous panels have accepted English as the language of the proceedings despite the registration agreement having a differing language, where it could be presumed from the circumstances of the case that the Respondent has knowledge of the English language, while the Complainant is not capable of providing the Complaint in the language of the registration agreement (e.g., Japanese) without unreasonable effort and costs. (iii) In the present case, there is plenty of evidence showing that the Respondent is capable of communicating in English. Firstly, the disputed domain name is in Latin script and not in Japanese script indicating that the Website provided under the domain name is directed to, at the very least, an English-speaking public. Secondly, this is further supported by the fact that the Website under the disputed domain name, also includes a number of English words and/or phrases, suggesting the Respondent understands English.

(iv) The Complainant being a Swiss entity has no knowledge of Japanese and, in the light of above considerations regarding the Respondent's knowledge of English, decided to file the Complaint in English being a common language in global business and obviously also a language, in which the Respondent is doing business.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the term "techo" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. Here, the disputed domain name infers an incorrect association to the Complainant, which impersonation cannot qualify fair use. Such impersonating disputed domain name has been used to allegedly offer not only the Complainant's trademarked goods, but also third party goods. While the extent to which such goods are actually offered is unclear, the use of the Complainant's trademark in both the construction and content of the disputed domain name to then offer third party competing products cannot constitute a *bona fide* offering nor confer rights or legitimate interests upon the Complainant. [WIPO Overview 3.0](#), section 2.8.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name to make a connection with the Complainant through disputed domain name. The disputed domain name has been chosen to deliberately incorporate the entirety of the Complainant's trademark.

The Complainant's trademark was registered well before the registration of the disputed domain name, and considering the reputation of the Complainant's trademark, it is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's IQOS trademark when registering the disputed domain name and intentionally registered the disputed domain name to take advantage of the Complainant's IQOS trademark and most likely the goodwill.

Furthermore, the Complainant's IQOS trademark is distinctive and unique to the Complainant. It is therefore beyond the realm of coincidence that the Respondent chose the disputed domain name without the intention of creating a false association with the Complainant.

The Panel finds that it is clear that the Respondent registered the disputed domain name in bad faith.

Panels have held that the use of a domain name for illegal activity by linking to a website at that refers and/or includes hyperlinks which redirects one to a third party online shop allegedly selling and offering the Complainant's IQOS System, as well as third party products of other commercial origin constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <iqostecho.com> be transferred to the Complainant.

/Erica Aoki/

Erica Aoki

Sole Panelist

Date: December 11, 2023