

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Maryam Shamkhal
Case No. DIR2022-0013

1. The Parties

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

The Respondent is Maryam Shamkhal, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name, <iqosmall.ir> (the “Domain Name”), is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2022. On June 14, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the Domain Name. On June 17, 2022, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 21, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was July 11, 2022. On July 12, 2022, the Center notified the Respondent’s default.

The Center appointed Tony Willoughby as the sole panelist in this matter on July 26, 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 member of the group of companies headed by Philip Morris International Inc., a leading international tobacco company. In addition to its core business of production and sale of combustible cigarettes, the group of companies of which the Complainant forms part has since 2014 included the production and sale of non-combustible alternatives, which it markets under *inter alia* the trade marks IQOS and HEETS.

The Complainant is the registered proprietor of numerous trade mark registrations covering these trade marks. For present purposes it is only necessary to detail three of those registrations, all of which are for tobacco-related goods or services in one or more of classes 9, 11, 34, and 35 namely:

International Registration No. 1218246 IQOS (word) registered on July 10, 2014.

International Registration No. 1338099 IQOS (figurative) registered on November 22, 2016.

International Registration No. 1326410 HEETS (word) registered on July 19, 2016.

The Complainant markets its IQOS products primarily through its official IQOS stores and websites and selected authorized distributors and retailers, but does not currently sell these products in Iran (Islamic Republic of).

None of the trade mark registrations upon which the Complainant relies designates Iran (Islamic Republic of) as a jurisdiction covered by the registration.

The Domain Name was registered on May 15, 2022, and is connected to a Persian language website devoted to the sale of IQOS HEETS products of the Complainant. The only English language elements of the website intelligible to the Panel are those appearing on the branding of the Complainant's products depicted on the website along with associated descriptions and website logos comprising a device followed by "iqos mall". There does not appear to the Panel to be any indication as to the operator of the website other than the name "iqos mall".

As to this and given the Panel's lack of familiarity with the Persian language, the Panel made use of Google Translate in an attempt to locate the name and/or contact details of the owner/operator of the website, but was unable to locate anything of relevance.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Complainant's IQOS registered trade mark; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent registered the Domain Name for the purpose for which she is using it, namely to connect to a website devoted to the sale of the Complainant's IQOS products, but falsely appearing to be an official/authorised website of the Complainant.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

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

Given the similarities between the .IR Dispute Resolution Policy and the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the Panel takes note of the applicable sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), where relevant.

B. Identical or Confusingly Similar

The Domain Name comprises the Complainant’s registered trade mark IQOS, and the dictionary word “mall”, followed by the “.ir” country-code Top-Level Domain identifier.

Section 1.7 of [WIPO Overview 3.0](#) explains the test for identity or confusing similarity under the first element of the UDRP and includes the following passage:

“While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The Complainant’s IQOS registered trade mark is readily recognizable in its entirety in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

While it is the case that none of the trade mark registrations upon which the Complainant relies covers the Respondent’s home jurisdiction, that is not a matter of any relevance under this, the first, element of the Policy. The reasoning behind this is explained in section 1.1.2 of [WIPO Overview 3.0](#): “Noting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element.”

C. Rights or Legitimate Interests

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy and contends that none of them is applicable. The Complainant contends that the Domain Name and the website to which it connects are likely to indicate to Internet users that the website to which the Domain Name connects is an official website of or authorised by the Complainant. The Complainant points to the prominent uses of the IQOS and HEETS trade marks, the copious and unauthorised use of the Complainant’s “official product images”, and the absence of any information as to the entity responsible for the website. The Complainant contends that the presence in the Domain Name of the word “mall” does nothing to remedy the situation.

The Complainant asserts that it has no connection with the Respondent and has given the Respondent no permission to use any of its trade marks. This is an assertion that the Panel readily accepts given the unchallenged evidence of the Complainant that it does not sell its IQOS products to Iran (Islamic Republic of). However, there are circumstances where the unauthorized use of a third party's trade mark in a domain name may give rise to the acquisition by a respondent of rights or legitimate interests in respect of that domain name. The issue frequently falls to be considered where, as here, the respondent is using the domain name to connect to a website selling the goods of the complainant.

The issue is addressed in section 2.8.1 of [WIPO Overview 3.0](#):

"Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test" [a test derived from the decision in *Oki Data Americas, Inc. v. Asdinc.com* WIPO Case No. [D2001-0903](#), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark."

The Panel is of the view that to many people the Domain Name is likely to mean "IQOS shopping area" and, if not a website of the Complainant, one authorised by the Complainant. The Panel agrees with the Complainant that the absence of any indication on the website that it is not a website of or authorised by the Complainant (a matter that the Panel has sought to verify – see section 4 above) renders it potentially deceptive. It fails the Oki Data test in that it does not "accurately and prominently disclose the registrant's relationship with the trademark holder".

The Panel is satisfied that the Complainant has made out a *prima facie* case under this element of the Policy; in other words a case calling for an answer from the Respondent. The Respondent has chosen not to provide an answer.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered or Used in Bad Faith

There can be no doubt that when registering the Domain Name the Respondent was well aware of the Complainant and its IQOS trade marks and products. As indicated above the website makes widespread use of the Complainant's IQOS and HEETS trade marks and copious use of images of the Complainant's IQOS products. In failing to include on the website any reference to the entity responsible for the website, the Panel finds for the reasons given in C above that visitors to the website are likely to believe that the website is an official website of the Complainant or one authorised by the Complainant.

Individuals using the website to purchase product from the Respondent are likely to believe that they are trading with the Complainant or an authorised licensee of the Complainant. The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(iv) 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 Domain Name <iqosmall.ir> be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: August 2, 2022