

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Valo IT, valoit.net  
Case No. D2022-1130

### **1. The Parties**

The Complainant is Philip Morris Products S.A., Switzerland, represented by Boehmert & Boehmert, Germany.

The Respondent is Valo IT, valoit.net, Bangladesh.

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

The disputed domain name <heedubai.net> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 1, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 2022, the Registrar 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 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 April 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 28, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on May 3, 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 part of the group of tobacco companies affiliated with Philip Morris International, Inc.

Amongst other things, the group produces tobacco products branded “Heets” or “HeatSticks”, that are designed to be inserted into another of the Complainant’s products, “IQOS”, a heating device which the Complainant describes as a “Reduced Risk Product”. There are approximately 19.1 million customers using the IQOS system worldwide.

The Complainant owns a number of registered trade marks for HEETS including International Registration No. 1326410 for HEETS, registered on July 19, 2016, in classes 9, 11, and 34.

The disputed domain name was registered on June 2, 2021.

The disputed domain name was used for a website that was branded with “Hee Dubai” logo and headed “IQOS. NOT A VAPE. NOT A CIGARETTE”. The site purported to offer the Complainant’s IQOS and Heets products for sale, including use of unauthorised copies of the Complainant’s product images, some of which had the Respondent’s logo superimposed. In addition, the site offered competing products such as “LAMBDA”, as well as non-official products that were marketed under the Complainant’s mark such as an “IQOS cleaning care kit”.

The footer of the website included a “Heedubai.net” copyright notice as well as the following statement: “Hee Dubai is the best online vape shop in Abu Dhabi. Hee Dubai is the trusted supplier of iqos vape, heets-marlboro E-cigarette, iqos accessories uae and all branded Vaporizer product in Abu Dhabi”.

#### **5. Parties’ Contentions**

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

The following is a summary of the Complainant’s contentions.

The disputed domain name is confusingly similar to the Complainant’s trade mark as it comprises a phonetically-similar misspelling of the Complainant’s trade mark, in addition to the geographical term “Dubai”.

The use of the Respondent’s website to target the Complainant’s trade mark confirms confusing similarity.

The Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant has not authorised the Respondent to use its trade mark.

The Respondent is not making legitimate noncommercial or fair use of the disputed domain name.

Nor is the Respondent making a *bona fide* offering of goods.

The Respondent does not qualify as a legitimate reseller because its website is offering competing, and even counterfeit, products. Also, the disputed domain name of itself suggests at least an affiliation with the Complainant, as does the Respondent’s website, including by describing itself as the “trusted supplier” of the Complainant’s products in Abu Dhabi and by using the Complainant’s official product images with a copyright notice, as well as by the lack of information about the Respondent’s identity.

The Respondent’s use of the Complainant’s trade marks in the disputed domain name and website constitute trade mark infringement.

The disputed domain name was registered and is being used in bad faith.

The Respondent was aware of the Complainant's trade mark when registering the disputed domain name, which it has used to offer products which compete with those of the Complainant, as well as for counterfeit goods. Furthermore, the term "heet" was coined by the Complainant and is unique to it, and the term "hee" can only be understood as a misspelling of this term.

The Respondent registered and used the disputed domain name with the intention of creating a likelihood of confusion under paragraph 4(b)(iv) of the Policy, including by use of an adaptation of the Complainant's trade mark in the disputed domain name as well as by the Respondent's description of itself as a "trusted supplier" of the Complainant's products and its unauthorised use of the Complainant's official product images.

The Respondent's infringement of the Complainant's trade marks and use of the disputed domain name to offer counterfeit products are further evidence of bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has established registered rights in the mark HEETS, as well as unregistered trade mark rights deriving from the Complainant's extensive use of that mark.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") makes clear that the first element functions primarily as a standing requirement. The test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trade mark and the disputed domain name. Where at least a dominant feature of the relevant mark is recognisable in the disputed domain name, it will normally be considered confusingly similar to that mark for purposes of UDRP standing.

As explained in section 1.7 of [WIPO Overview 3.0](#), the overall facts and circumstances of a case, including relevant website content, may support a finding of confusing similarity in certain situations, particularly where it appears that the respondent registered the domain name precisely because it believed that the domain name was confusingly similar to a mark held by the complainant.

Section 1.9 of [WIPO Overview 3.0](#) makes clear that a domain name which consists of a common, obvious, or intentional misspelling of a trade mark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.

Section 1.8 of [WIPO Overview 3.0](#) states that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive, geographical or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the disputed domain name consists of the word “hee” – a dominant part of the Complainant’s distinctive trade mark and most likely intended as a misspelling of the Complainant’s mark - plus the additional term “Dubai”, which does not prevent a finding of confusing similarity for reasons explained above. Furthermore, the content of the Respondent’s website indicates that the Respondent registered the domain name precisely because it believed that the disputed domain name was confusingly similar to the Complainant’s mark.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

## **B. Rights or Legitimate Interests**

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, the Respondent is purporting to resell the Complainant’s own goods. The consensus view of UDRP panels – as expressed in section 2.8 of [WIPO Overview 3.0](#) – is that to establish a *bona fide* offering of goods or services in such circumstances, a respondent must comply with certain conditions (the “Oki Data requirement”).

In this case, the Panel considers that the Respondent has failed to comply with the Oki Data requirement to accurately and prominently disclose the Respondent’s relationship with the trade mark holder, as explained in section 6C below. In addition, the Respondent is not using the site to sell only the trademarked goods.

Accordingly, the Panel considers that the Respondent’s use of the disputed domain name cannot be said to be *bona fide* under the Policy.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

The Panel finds that the Complainant has established a *prima facie* case of lack of rights or legitimate interests and there is no rebuttal by the Respondent.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

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

Given the Respondent’s selection of a domain name most likely intended as a typosquatting variation of the Complainant’s distinctive mark, and the evidence of its use for a website that (1) creates the impression that it is officially associated with the Complainant including by prominent use of the Complainant’s marks as well as official product images, and by the Respondent’s description of itself as a “trusted supplier” of the Complainant’s products, and by the lack of any prominent disclaimer; and (2) includes links to competing products, the Panel readily concludes that the disputed domain name was registered and is being used in bad faith by the Respondent, in accordance with paragraph 4(b)(iv) of the Policy. The Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant’s trade mark.

For the above reasons, the Panel considers that the Complainant has established the third element of 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 <heedubai.net> be transferred to the Complainant.

*/Adam Taylor/*

**Adam Taylor**

Sole Panelist

Date: May 17, 2022