

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Saeed Farahani  
Case No. D2022-2822

### **1. The Parties**

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

Respondent is Saeed Farahani, India.

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

The disputed domain names <iiiiiiiiitehraniquosiiiiiiii.com> and <xxxxxxxxxiqosxlandxxxxxxxx.com> are registered with Mat Bao Corporation (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 1, 2022. On August 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 2, 2022, 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 (Domain Admin, Whoisprotection.cc, Malaysia) and contact information in the Complaint. The Center sent an email communication to Complainant on August 18, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 18, 2022. Respondent sent two identical informal communications to the Center on August 18, 2022.

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 Respondent of the Complaint, and the proceedings commenced on August 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 19, 2022. The Center proceeded to inform the Parties of panel appointment on October 4, 2022.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on October 24, 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

Complainant, Philip Morris Products S.A., is a company affiliated to Philip Morris International Inc., an international tobacco and smoke-free products company which provides its products and services in approximately 180 countries.

Complainant is a company focused in technological innovation in tobacco and smoking, creator of the IQOS tobacco heating system technology – which received the brand names “Heets”, “HeatSticks” and “Terea”.

Complainant owns a large portfolio of trademark registrations internationally containing the word mark IQOS. Some examples of Complainant’s international trademark registrations can be found below:

Registration No.	Trademark	Jurisdictions	International Classes	Date of Registration
1218246	IQOS	designating multiple jurisdictions including India	9, 11, 34	July 10, 2014
1461017	IQOS	designating multiple jurisdictions including India	9, 34	January 18, 2019
1329691	IQOS	designating multiple jurisdictions including India	9, 11, 34	August 10, 2016

Complainant is well known around the world for its services provided on the tobacco sector and technology improvements related to tobacco and the smoking industry.

The disputed domain names were registered on June 15, 2022, by same Respondent with same contact information, and similarly resolve to websites which contain Complainant’s trademarks and allegedly offer to sale Complainant’s products, as well as third party products.

#### 5. Parties’ Contentions

##### A. Complainant

Complainant pleads that the disputed domain names are confusingly similar to its registered trademark IQOS, since it fully incorporates Complainant’s trademark IQOS.

Complainant affirms that Respondent creates a confusion, considering specially that the disputed domain names use the trademark IQOS in its entirety, with the following differences each: (i) the addition of the non-distinctive prefix and suffix “xxxxxxx” and the generic word “land” in the disputed domain name <xxxxxxxqiqosxlandxxxxxxx.com>; and (ii) the addition of the non-distinctive prefix and suffix “iiiiiii” and the geographic indicator “tehran” in the disputed domain name <iiiiiiitehranqiqosiiiiiii.com>.

Therefore, according to Complainant, the disputed domain names present a risk of confusion to consumers, who will likely believe the disputed domain names are linked with Complainant’s trademark IQOS, fulfilling paragraph 4(a)(i) of the Policy and paragraphs 3(b)(viii) and 3(b)(ix)(1) of the Rules.

In addition, Complainant states that Respondent would not have any rights or legitimate interests in respect of the disputed domain names, nor is Respondent commonly known by neither of the disputed domain names. Further, Respondent has not been authorized, or licensed to use Complainant's trademark IQOS as a domain name nor is Respondent associated with Complainant.

Complainant observes that Respondent uses the websites that purports from the disputed domain names to unauthorizedly distribute/resell Complainant's IQOS products; and that both websites allegedly sell products and/or accessories of other commercial origins that compete with Complainant's business.

Furthermore, Complainant notes that the use of the disputed domain names do not represent a *bona fide* offering of goods.

Complainant states that no legitimate use of the disputed domain names could be reasonably claimed by Respondent, thus paragraph 4(a)(ii) of the Policy and paragraph 3(b)(ix)(2) of the Rules has been fulfilled.

Moreover, Complainant states that (i) Respondent certainly would have known about Complainant's trademark IQOS when registering the disputed domain names, since the referred trademark is unique and well known, and not frequently used to refer to tobacco products; (ii) Respondent registered the disputed domain names containing Complainant's IQOS trademark with the intention to attract Internet users to obtain commercial gain; (iii) Respondent presents a pattern of behavior of bad faith in connection of other domain names registered with Complainant's trademarks; and (iv) the fact that Respondent used a privacy service constitutes an indicative of bad faith.

Thus, the requirements for bad faith registration and use of the disputed domain names would have been fulfilled pursuant to paragraph 4(b)(iv) of the Policy.

## **B. Respondent**

Respondent presented two identical informal communications to the Center via email on August 18, 2022.

In the referred communications, Respondent listed 12 links that would supposedly represent online stores in Iran that sell Complainant's products "in a non-original way". Respondent further stated it was his "duty to inform" the Center and Complainant about the alleged infringements.

Nevertheless, Respondent failed to present a formal Response to Complainant's contentions.

## **6. Discussion and Findings**

To succeed in a UDRP complaint, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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 burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to submit a formal Response. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the complaint.

## A. Identical or Confusingly Similar

Complainant has duly proven that it owns prior registered rights for IQOS.

The disputed domain names are constituted of (i) Complainant's IQOS trademark with the addition of the non-distinctive prefix and suffix "xxxxxxx" and the word "land", separated from IQOS with another "x", in the disputed domain name <xxxxxxxxiqosxlandxxxxxxxx.com>; and (ii) Complainant's IQOS trademark with the addition of the non-distinctive prefix and suffix "iiiiiii", and the geographic indicator "tehran", in the disputed domain name <iiiiiiitehranqiqosiiiiiii.com>.

The addition of the prefixes and suffixes "xxxxxxx" and "iiiiiii" do not prevent a finding of confusing similarity with Complainant's trademark IQOS – as Complainant's trademark IQOS is clearly recognizable in the disputed domain names.

Furthermore, according to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. Thus, this Panel finds that the addition of the prefixes and suffixes "xxxxxxx" and "iiiiiii" to Complainant's trademark IQOS in the disputed domain names does not avoid a finding of a confusing similarity on the present case.

Similarly, the addition of the letter "x", the word "land" and the geographical indicator "tehran" is not able to avoid a finding of confusing similarity between the disputed domain names and Complainant's trademark IQOS.

Additionally, section 1.15 of the [WIPO Overview 3.0](#) defines that the content of a website associated with a domain name can be relevant to conclude if a respondent seeks to provoke a confusing similarity with a complainant's trademark. As can be seen in *The Canadian Hockey Association and The Canadian Olympic Committee v. Lin Lin*, WIPO Case No. [D2016-0322](#), the panel found that the content of the website which purported from the disputed domain name could be relevant to analyze if there was any intent by a respondent to create confusion with a complainant's trademark.

The disputed domain names resolve to websites where Complainant's IQOS trademarks are unauthorizedly exposed, and Complainant's products are supposedly offered for sale. These circumstances lead to the Panel's conclusion that Respondent seeks to target Complainant's trademark IQOS through the disputed domain names.

Thus, the Panel finds that the disputed domain names are confusingly similar to Complainant's trademark IQOS, and so the requirement of the first element of paragraph 4(a) of the Policy is satisfied.

## B. Rights or Legitimate Interests

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the [WIPO Overview 3.0](#) as follows: "[w]hile 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."

In this case, noting the facts and contentions listed above, the Panel finds that Complainant has made out a *prima facie* case showing that Respondent lacks rights or legitimate interests in the disputed domain names, so the burden of production shifts to Respondent.

Although Respondent has informally contacted the Center on August 18, 2022, Respondent failed to present a formal Response to the Complaint filed by Complainant. According to the [WIPO Overview 3.0](#), section 4.3, the submission of a so-called informal response (failing to specifically address the case merits as they relate to the three UDRP elements as the case here) may be treated in a similar manner as a respondent default.

Nevertheless, Respondent's informal communications were not able to show any evidence that Respondent owns rights or legitimate interests related to the disputed domain names to rebut Complainant's *prima facie* case. Therefore, and considering the Panel's findings under section 6C, the Panel finds that the requirement of the second element of paragraph 4(a) of the Policy is also satisfied.

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

Paragraph 4(b) of the Policy lists a number of circumstances that, without limitation, are deemed evidence of registration and use of a domain name in bad faith.

Respondent has registered the disputed domain names that fully incorporate Complainant's well-known trademark IQOS, plus the addition of suffixes and prefixes "xxxxxxx" and "iiiiiii", and the letter "x", the terms "land" and "Tehran". The Panel finds that it was duly demonstrated that Respondent was aware of Complainant's rights to the trademark IQOS at the time of the registration – as Complainant enjoys a worldwide reputation with the use of the referred trademark.

With that in sight, the Panel finds that Respondent registered the disputed domain names with the intention of attracting Internet users in search of Complainant's IQOS products or services.

In addition, the registration of the disputed domain names in the present circumstances allows a finding of bad faith registration and use, since the evidence indicate that Respondent uses the disputed domain names to impersonate Complainant and supposedly sell products under the IQOS trademark. As concluded by the panel in *All-Clad Metalcrafters LLC v. Eugene Preston*, WIPO Case No. [D2021-0799](#), the attempt to impersonate Complainant by using its registered trademark and allegedly offering its products/services is an indicative of bad faith:

"This point is further confirmed by Respondent's use of the Domain Names. The evidence indicates that Respondent has used the Domain Name <all-clad.store> in an attempt to impersonate Complainant, by displaying Complainant's logo and copying pictures of Complainant's products on Respondent's site, and then attempting to profit from the confusion by offering Complainant's products (or counterfeits) for sale at a discounted price. Respondent's actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of this Domain Name, and Respondent is using the fame of Complainant's ALL--CLAD mark to improperly increase traffic to the site linked to this Domain Name for Respondent's own commercial gain. Further, Respondent's use of the Domain Names <all-clad.club>, <allclad.online> and <all-cladus.online> disrupts Complainant's business because they are confusingly similar to Complainant's ALL-CLAD mark and the websites linked to them are being used to offer either competing or counterfeit goods. The Panel finds that Respondent, through this scheme, has intentionally attempted to attract for commercial gain Internet users to Respondent's online location by creating a likelihood of confusion with Complainant's ALL-CLAD marks as to the source, sponsorship, affiliation, and endorsement of Respondent's scheme."

The Panel finds that the circumstances of the present case allows a finding of bad faith in the registration and use of the disputed domain names pursuant to paragraph 4(b)(iv) of the Policy, considering specially that (i) Respondent clearly tries to obtain profit by using Complainant's trademark IQOS and products images and supposedly offering IQOS products for sale; and (ii) the trademark IQOS is well known internationally, and Respondent most likely knew (or should have known) its existence; and (iii) the websites at the disputed domain names also offer for sale third party products.

In light of the above, the Panel finds that the disputed domain names have been registered and are being used in bad faith. Therefore, the requirement of the third element of paragraph 4(a) of the Policy is satisfied.

## 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 <iiiiiiiitehraniosiiiiiii.com> and <xxxxxxxxiqosxlandxxxxxxxx.com> be transferred to Complainant.

*/Gabriel F. Leonardos/*

**Gabriel F. Leonardos**

Sole Panelist

Date: November 7, 2022