

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Md Yamin, BitTech BD
Case No. D2022-4518

1. The Parties

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

The Respondent is Md Yamin, BitTech BD, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <heetsindubai.com> (the “Disputed Domain Name”) 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 November 28, 2022. On November 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 29, 2022, 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 December 28, 2022 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 on January 3, 2023.

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 of the Complaint, and the proceedings commenced on January 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2023. The Respondent did not file a formal Response, but sent three emails to the Center on December 29 and 30, 2022. After receiving these emails, the Complainant requested suspension of the proceeding and the proceeding was suspended on January 4, 2023. As the Parties could not reach an agreement, the Complainant requested the reinstatement of the proceeding and the Center reinstated the proceeding on March 1, 2023, reopening the deadline for

Response, which due date was March 21, 2023. The Respondent has not sent any further communication. On March 27, 2023, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Nicholas Weston as the sole panelist in this matter on March 31, 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. The language of the proceedings shall be English, being the same as the language of the registration agreement.

4. Factual Background

The Complainant is part of the group of companies affiliated to Philip Morris International Inc. (collectively, "PMI"), a multinational company that sells nicotine based products in approximately 180 countries. The Complainant holds registrations for the trademark HEETS in several countries, including, for example, HEETS (word), International Trademark Registration No. 1326410, registered on July 19, 2016 in classes 9, 11, and 34 which it uses to designate what it describes as "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').".

The Disputed Domain Name <heetsindubai.com> was registered on October 18, 2022. The Disputed Domain Name resolves to an online store that sells products that are or resemble the Complainant's IQOS System.

5. Parties' Contentions

A. Complainant

The Complainant cites trademark registrations including United Arab Emirates Registration No. 256864 registered on December 25, 2017 for the mark HEETS, as *prima facie* evidence of ownership.

The Complainant submits that the trademark HEETS is well-known and that its rights in that trademark predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the HEETS trademark, and that the addition of the word "in" and the geographical term "dubai" is not sufficient to avoid a finding of confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it "has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its HEETS trademark (or a domain name which will be associated with this trademark) [... and t]he Respondent is not making a legitimate noncommercial or fair use of the Domain Name. On the contrary, the Respondent's behaviour shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademarks owned by the Complainant", and contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules having regard to the widespread prior use of the Complainant's trademark.

B. Respondent

The Respondent sent three emails to the Center on December 29 and 30, 2022. Two of those communications do not substantively reply to the Complainant's contentions. The third states: "it is just a name which is 'heets' and heets is a product like tobacco. So what is the problem here?"

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in 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.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the trademark HEETS in the United States and in many countries throughout the world. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the HEETS trademark, the Panel observes that the Disputed Domain Name comprises (a) the Complainant's trademark HEETS, (b) followed by the word "in", (c) followed by the geographical term "dubai", and (d) followed by the generic Top-Level Domain ("gTLD") ".com".

It is well-established that the gTLD used as part of a domain name is generally disregarded. The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name: "heetsindubai".

As the Disputed Domain Name incorporates the Complainant's trademark in its entirety, it is confusingly similar to that mark despite the addition of the word "in" and the geographical term "dubai", which do not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the respondent may demonstrate rights or legitimate interests in the disputed domain name. The Policy also places the burden on the complainant to establish the absence of respondent's rights or legitimate interests in the disputed domain name. Because of the inherent difficulties in proving a negative, the consensus view is that the complainant need only put forward a *prima facie* case that the respondent lacks rights or legitimate interests. The burden of production then shifts to the respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is not his name, there is no license from the Complainant to use the Complainant's trademark, there is no evidence of the Respondent's use, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods and services, and the evidence is that it resolves to a webpage selling Complainant's products.

The uncontested evidence is that the Respondent has not made, and is not currently making, a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers pursuant to paragraph 4(c)(iii) of the Policy. Nor, alternatively, does paragraph 4(c)(ii) of the Policy apply.

The Panel also finds that the nature of the Disputed Domain Name and the associated website content fails to meet the tests that apply to *bona fide* offerings or goods or services by resellers or distributors (see [WIPO Overview 3.0](#), section 2.8). The website at the Disputed Domain Name is using a number of the Complainant's official product images without the Complainant's authorization, while at the same time providing a copyright notice at the bottom of the website claiming copyright in the material presented on it and thereby strengthening the false impression of an affiliation with the Complainant.

This Panel accepts that the Complainant has made out a *prima facie* case that the Respondent lack rights or legitimate interests in the Disputed Domain Name and, in the absence of a Response by the Respondent, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that the complainant must also demonstrate is that the disputed domain name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant's trademark HEETS when it registered the Disputed Domain Name (see *Philip Morris Products S.A. v. Privacy Protection, Hosting Ukraine LLC / Кузьменко Егор Александрович / Kuzmenko Egor*, WIPO Case No. [D2021-0915](#); *Philip Morris Products S.A. v. Stepan Malik (S.M.), Heets Store*, WIPO Case No. [D2020-2967](#)).

On the issue of use, the Complainant's evidence is that the Disputed Domain Name diverts to a webstore that unlawfully offers the Complainant's HEETS and IQOS System products for sale. This Panel finds the Respondent registered the Disputed Domain Name primarily to disrupt the business of the Complainant for commercial gain (see [WIPO Overview 3.0](#), section 3.1.3).

Further, the Panel finds that the Respondent's conduct is an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (see [WIPO Overview 3.0](#), section 3.1.4).

In the absence of any plausible explanation from the Respondent, and any evidence to the contrary, this Panel accepts the Complainant's evidence, and finds that the Respondent has taken the Complainant's trademark HEETS, and incorporated it in the Disputed Domain Name along with the word "in", and the geographical term "dubai" without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <heetsindubai.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: April 14, 2023