

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. NGUYEN HUU THUAN  
Case No. D2022-4664

### **1. The Parties**

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

The Respondent is NGUYEN HUU THUAN, Viet Nam.

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

The disputed domain name <thuaniquos.com> (“Disputed Domain Name”) is registered with P.A. Viet Nam Company Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 9, 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 11, 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 December 13, 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 the Respondent of the Complaint, and the proceedings commenced on December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2023.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on January 19, 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, Philip Morris Products S.A., is an affiliated company of Philip Morris International Inc. (jointly referred to as “PMI”), a leading international tobacco company, with products sold in approximately 180 countries.

IQOS is one of PMI’s brands, which are developed and used for smoke-free tobacco products. IQOS was first introduced in Nagoya, Japan in 2014 and now is available in around 71 markets across the world. The IQOS products have been almost exclusively distributed through PMI’s official IQOS stores, websites, selected authorized distributors and retailers.

The trademark IQOS has been registered for goods in class 34 in a variety of countries, including in Viet Nam, where the Respondent resides, under International Registrations No. 1218246 dated July 10, 2014; No. 1461017 dated January 18, 2019; and No. 1557546 dated August 27, 2020. The Complainant also registered the trademark IQ under the European Union Registration No. 18226787; and the United Kingdom Registration No. UK00918226787.

The Respondent registered the Disputed Domain Name <thuaniqos.com> on November 14, 2022. As of the date of this Decision, the Disputed Domain Name is resolving to an online store of the Respondent, via which the Complainant’s products under the IQOS trademark and also other competing brands are advertised and offered for sale.

#### **5. Parties’ Contentions**

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

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is confusingly similar to the trademark in which the Complainant has rights.

First, the Complainant contends that the Complainant is the registered owner of trademark registrations for IQOS in numerous jurisdictions, including, but not limited to Viet Nam.

Second, the Complainant asserts that the Disputed Domain Name is confusingly similar to the IQOS trademark owned by the Complainant since the Disputed Domain Name identically adopts the Complainant’s IQOS trademark. Furthermore, the Complainant asserts that the addition of the non-distinctive word “thuan”, which is unofficially translated as “defeat” in English, could not dispel any likelihood of confusion.

Finally, the Complainant submits that the addition of the Top-Level Domain (“TLD”) suffix “.com” in the Disputed Domain Name should not be taken into account under the first element.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant submits that the elements set forth in Policy, paragraph 4(c) are not fulfilled.

First, the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its "IQOS" trademark (or a domain name, which will be associated with this trademark).

Second, the Complainant submits that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of the Complainant.

Third, the Complainant contends that the Respondent has not made use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Particularly, the use of Disputed Domain Name does not meet the requirements described in the decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#):

- The Disputed Domain Name itself suggests an affiliation with the Complainant and its IQOS trademark, as the Disputed Domain Name wholly reproduces the Complainant's registered IQOS trademark together with the non-distinctive word "thuan" (informal translation as "defeat").

- Further, the Respondent also uses the Complainant's logo IQOS at the top left of the Website as well as uses the Complainant's registered IQ trademark within the tab interface of the Website, where relevant consumers will usually expect to find the name of the online shop and/or the name of the website provider. Also, the Respondent further uses the Complainant's official products images without authorization on its Website.

- The Website includes no information regarding the identity of the provider of the Website, which is only identified as "thuaniqos" to perpetuate the false impression of an official commercial relationship between the Website and the Complainant.

- In addition, the Respondent is not only offering the Complainant's products but also competing heated tobacco products and/or accessories of other known and unknown commercial origin.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Complainant asserts that 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.

Furthermore, the IQOS trademark is purely an imaginative term and unique to the Complainant. The term IQOS is not commonly used to refer to tobacco products. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the Disputed Domain Name, without the intention of invoking a misleading association with the Complainant.

It is also evident from the Respondent's use of the Disputed Domain Name that the Respondent registered and used the Disputed Domain Name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's IQOS trademark as to the source, sponsorship, affiliation or endorsement of its website or a product/service.

Additionally, by reproducing the Complainant's registered trademark in the Disputed Domain Name and the title of the website, as well as using the Complainant's official product images accompanied by a copyright notice, the Respondent created false impression that the website belongs to the Complainant or is an affiliated dealer endorsed by the Complainant, which it is not.

Also, the Respondent is not only using the Complainant's IQOS trademark for offering for sale of IQOS System, but also offering for sale third party products of other commercial origins, which constitutes clear evidence of bad faith.

Finally, the fact that the Respondent is using a privacy protection service to hide its true identity may in itself constitute a factor indicating bad faith.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Procedural issues**

#### **(i) The Respondent's Identity**

The Panel notes that at the time the Complaint was filed on December 6, 2022, the Respondent was identified as "Private Registration". On December 9, 2022, the Registrar revealed the underlying registrant "Nguyen Huu Thuan". The Center sent an email communication to the Complainant on December 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On December 13, 2022, the Complainant filed an amended Complaint, replacing the respondent named in the initial Complaint by the underlying Registrant. Hence, the Panel considers "NGUYEN HUU THUAN" as the Respondent of the subject case.

#### **(ii) The Respondent's Failure to Respond**

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#); and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

## **B. Identical or Confusingly Similar**

The Complainant is required to establish the two following elements: (1) that it has trademark rights, and, if so, (2) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Panel finds that the Complainant has clearly evidenced that it has registered trademark rights in IQOS, well before the Disputed Domain Name was registered.

Second, the Disputed Domain Name incorporates the entirety of the Complainant's IQOS trademark, in which the Complainant has exclusive rights. The difference between the Disputed Domain Name and the trademark is the addition of the prefix "thuan". In this regard, the Panel duly notes the Complainant's argument that "thuan" is informally translated into English as "defeat". In this regard, the Panel finds that the word "thuan", if supported by different tone marks available in the Vietnamese language, may have several different meanings. However, from the Panel's experience, it is highly likely that the element "thuan" reflects the Respondent's first name as disclosed by the Registrar. Under any circumstance, the Panel finds that the element "iqos" remains clearly recognizable in the Disputed Domain Name as a distinctive element, while the combination "thuaniqos" does not have any meaning under any language known to the Panel. In any event, the addition of such word does not prevent a finding of confusing similarity (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Third, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD “.com” to the Disputed Domain Name does not constitute an element as to avoid confusing similarity for the Policy purposes (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. [D2012-2066](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A. v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's IQOS trademark, and the first element of the Policy is established.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Noting the facts and arguments set out above, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The consensus of previous UDRP panels is that while the overall burden of proof in UDRP proceedings is on the Complainant, once a *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating his rights or legitimate interests in the Disputed Domain Name (see e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); and *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted with evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that no license, permission or authorization of any kind to use the Complainant's trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the IQOS trademark.

A reseller or distributor may be making a *bona fide* offering of goods and services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“*Oki Data*”), including:

- the respondent must actually be offering the goods or services at issue;

- the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the website itself must accurately disclose the respondent's relationship with the trademark owner; and
- the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, the Panel finds the Respondent does not place any statement or disclaimer disclosing accurately its relationship with the Complainant. In addition, the website under the Disputed Domain Name also contains the Complainant's IQOS trademark as well as its official product images. Further, the Respondent is not only offering the Complainant's products but also offering competing tobacco-related products of other commercial origins.

With such a view, the Panel finds that the unauthorized use of the Disputed Domain Name does not meet the *Oki Data* criteria and thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the IQOS trademark and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy is established.

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

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel further finds that the Complainant's IQOS trademark has been registered in numerous countries. The Complainant's trademarks have been registered and used in, among other countries, Viet Nam where the Respondent resides. These trademark registrations well predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the IQOS trademark in its entirety. Given the extensive use of the IQOS trademark for tobacco products by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website there under, the Panel is of the view that the Respondent obviously knew of the Complainant and its IQOS trademark when it registered the Disputed Domain Name, and the Panel considers the registration an attempt by the Respondent as to take advantage of the Complainant's goodwill.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it is resolving to a web shop not only offering the tobacco products branded with the Complainant's IQOS trademark but also offering tobacco-related products from other brands. In addition to the adoption of the Complainant's IQOS trademark as a uniquely distinctive part in the Disputed Domain Name, the Respondent used the Complainant's trademarks and product images on the website.

The Panel takes the view that any Internet users seeking to purchase the Complainant's IQOS products would very likely mistakenly believe that the Respondent is either connected to or associated with the Complainant. However, no such connection exists in fact. Such misleading behavior is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy, on the part of the Respondent.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is established.

## **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, <thuaniqos.com> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: February 1, 2023