

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. iqos thai
Case No. D2023-1515

1. The Parties

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

The Respondent is iqos thai, Thailand.

2. The Domain Name and Registrar

The disputed domain name <iqosthai.net> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 6, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 0166741795) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2023, 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 April 12, 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 April 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 5, 2023.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on May 30, 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 is part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI"), a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries. PMI *inter alia* sells a tobacco heating system called IQOS which is available in cities in around 71 markets across the world and is almost exclusively distributed through PMI's official IQOS stores and websites and selected authorized distributors and retailers.

With respect to the IQOS system, the Complainant owns *inter alia* the following trademark registrations (hereafter the "Trade Marks or IQOS Trade Marks"):

- Thai Registration IQOS (word) No. ๓416024 registered on May 4, 2016;
- International Registration IQOS (word) No. 1218246 registered on July 10, 2014;
- International Registration IQOS (device) No. 1461017 registered on January 18, 2019 designating *inter alia* Thailand.

The Domain Name was registered on March 13, 2023, and resolves to an online shop (the "Website") allegedly selling and offering the Complainant's IQOS System, as well as competing third party products of other commercial origin. The Website is provided in English and prices are indicated in Thai baht currency. On the Website the designation "IQOSTHAI", is used, as well as the IQOS Trade Marks within the tab interface of the Website, and one or more images of the Complainant's products.

5. Parties' Contentions

A. Complainant

According to the Complainant, the Domain Name is confusingly similar to the IQOS Trade Marks which it includes in its entirety, while the addition of "thai", being the geographical abbreviation for Thailand, is insufficient in itself to avoid a finding of confusing similarity.

The Complainant states that it has not licensed or otherwise permitted the Respondent to use any of the Trade Marks or to register a domain name incorporating the IQOS Trade Marks. The Complainant submits that the Respondent is not making a legitimate non-commercial or fair use of the Domain Name, since the Website shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the Trade Marks. The Complainant points out that the Respondent is not an authorized distributor or reseller of the IQOS System.

Furthermore, the Complainant contends that the Website does not meet the requirements for a *bona fide* offering of goods or services, already because it is also selling competing tobacco products and/or accessories of other commercial origin through the Website. In addition, the Complainant states, the Domain Name falsely suggests an affiliation with the Complainant and its IQOS Trade Marks, as it includes the Trade Mark together with the geographical abbreviation for Thailand ("thai"), while the Website, prominently and without authorization presents the IQOS Trade Marks and official product images, but contains no information on the identity of the provider of the Website, which is only identified as "IQOSTHAI" on the Website. Furthermore, the Complainant submits that its IQOS system is primarily distributed through endorsed stores and that Internet users are misled regarding the relationship between the Website and the Complainant, falsely believing the Website under the Domain Name to be from an endorsed distributor of the Complainant.

The Complainant concludes that the Respondent does not have an own right or legitimate interest in the Domain Name.

With respect to bad faith registration, the Complainant contends that it is evident that the Respondent knew of the IQOS Trade Marks when registering the Domain Name, since it started offering the Complainant's

IQOS system immediately after registering the Domain Name. Furthermore, the Complainant points out, the term “IQOS” is not commonly used to refer to tobacco products or electronic devices.

According to the Complainant, the bad faith use of the Domain Name is evident from the use of the IQOS Trade Marks in the Domain Name and on the Website and the use of the Complainant’s official product images, whereby the Respondent is suggesting to any Internet user visiting the Website that the Complainant (or an affiliated dealer of the Complainant) is the source of the Website, which it is not, while it is also offering third party products for sale on the Website.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it wholly incorporates the Trade Marks. The addition of the term “thai” does not avoid a finding of confusing similarity between the Domain Names and the Trade Marks (see [WIPO Overview 3.0](#), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The generic Top-Level Domain (“gTLD”) “.net” is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has registered rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the Complainant has to make out a *prima facie* case that the Respondent does not have rights to or legitimate interests in the Domain Name upon which 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 names ([WIPO Overview 3.0](#), section 2.1). Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent is not an authorized dealer and has not received the Complainant’s consent to register or use the Domain Name or make any other use of the Trade Marks. The Respondent has not provided evidence, nor is it *prima facie* evident that its use of the Trade Marks and the Domain Name has resulted in it becoming commonly known by the Domain Name (paragraph 4(c)(ii) of the Policy). The Domain Name resolves to a website on which products of the Complainant and those of competitors are offered for sale. Therefore, the Respondent cannot (and in fact does not) show that it is making a legitimate noncommercial or fair use of the Domain Name (paragraph 4(c)(iii) of the Policy). The Panel concludes that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name.

This leaves the question whether the Respondent’s use of the Domain Name at the time of filing the Complaint can be considered to be in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. In this connection, the Complainant in the Complaint has referred to the criteria of the *Okidata* decision (*Okidata Americas, Inc., v. ASD Inc.*, WIPO Case No. [D2001-0903](#)). In accordance with that decision, a service provider, such as the Respondent, using a domain name containing the complainant’s trade mark 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 only if the following conditions are satisfied: (1) the respondent must actually be offering the goods or services at issue; (2) the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trade mark in a domain name to

bait consumers and then switch them to other goods); (3) the site itself must accurately disclose the respondent's relationship with the trade mark owner; and (4) the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trade mark owner of the ability to reflect its own mark in a domain name.

The Respondent's use of the Domain Name does not meet the *Oki Data* criteria.

The Complainant has not refuted that the Respondent through the Website sells its IQOS system products, be it that such products are not yet offered by the Complainant in Thailand where the Website apparently focuses on, judging by the fact that prices are quoted in Thai baht.

However, the Respondent does not sell only the trademarked goods, but also those of competitors (second Oki Data requirement) and does not accurately disclose its relationship with the Complainant (third Oki Data requirement).

In the Panel's view, the first impression for the Internet user who types in the Domain Name and subsequently views the home page of the Website will most likely be that the Respondent is in some way linked to the Complainant, whether through affiliation, approval, as an authorized dealer, or otherwise.

Therefore, the Respondent's use of the Domain Names prior to the notice of the dispute cannot be considered to be in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy.

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

C. Registered and Used in Bad Faith

It is evident that the Respondent knew or should have been aware of the Trade Marks prior to registering the Domain Name, since:

- the Respondent's registration of the Domain Name occurred almost nine years after the registration of the earliest of the Trade Marks;
- the Respondent has incorporated IQOS, of which a number of the Trade Marks consist, in its entirety;
- the IQOS mark is not a dictionary term, nor a term of which it is likely that a registrant would spontaneously think at the time of registration of the Domain Name; and,
- a simple trade mark register search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks.

In view of these circumstances and (i) the fact that the Domain Name includes the IQOS Trade Mark in its entirety; (ii) the use of the Trade Marks on the Website; (iii) the offering on the Website of products competing with products of the Complainant; and (iv) the lack of a disclaimer on the Website accurately disclosing the Respondent's relationship with the Complainant, the Panel concludes that the Respondent registered and used the Domain Names to intentionally attempt to attract, for commercial gain, Internet users to the website or other online location creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation or endorsement of the website or location or of the services on the Website, in accordance with paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith.

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 <iqosthai.net> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: June 13, 2023