

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Ismail Hossain Emon
Case No. D2023-3943

1. The Parties

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

The Respondent is Ismail Hossain Emon, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <starheetdubai.com> 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 September 21, 2023. On September 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 22, 2023, 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 September 28, 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 October 2, 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 October 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2023. The Respondent sent several email communications to the Center, on September 28, 2023, October 9, 2023, and November 12, 2023. The Response was filed with the Center on October 17, 2023, and the Respondent confirmed on October 28, 2023 that it was the final Response.

The Center appointed Luca Barbero as the sole panelist in this matter on November 13, 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 a group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI"). PMI is a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries. PMI has developed a number of smoke-free products, one of which is a tobacco heating system called IQOS. IQOS is a precisely controlled heating device into which specially designed tobacco sticks identified with the brand names HEETS, HEATSTICKS and TEREА are inserted and heated to generate a flavorful nicotine-containing aerosol (collectively referred to as the "IQOS System"). There are 5 versions of the IQOS heating devices currently available: the IQOS 2.4/IQOS 2.4+ pocket charger and holder, IQOS 3 pocket charger and holder, IQOS 3 Multi device, IQOS 3 Duo/Duos, and IQOS ILUMA. The IQOS System was first launched by PMI in Nagoya, Japan, in 2014 and has obtained a 20 percent share of the market in such country. Today, the IQOS System is available in key 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.

The Complainant is the owner, amongst others, of the following trademark registrations, as per trademark registration certificates submitted in Annex 6 to the Complaint:

- United Arab Emirates trademark registrations Nos. 253929, 253930 and 253931 for HEET (word mark), filed on May 18, 2016, and registered on March 5, 2018, respectively in classes 9, 11, and 34;
- United Arab Emirates trademark registration No. 256864 for HEETS (word mark), filed on July 20, 2016, and registered on December 25, 2017, in class 34;
- United Arab Emirates trademark registration No. 211139 for IQOS (word mark), filed on May 4, 2014, and registered on March 16, 2016, in class 34;
- United Arab Emirates trademark registration No. 305079 for IQOS (figurative mark), filed on January 23, 2019, and registered on June 27, 2019, in class 34;
- United Arab Emirates trademark registration No. 322507 for ILUMA (word mark), filed on December 17, 2019, and registered on March 28, 2020, in class 34;
- United Arab Emirates trademark registration No. 322508 for TEREА (word mark), filed on December 17, 2019, and registered on March 28, 2020, in class 34.

The disputed domain name <starheetdubai.com> was registered on August 24, 2022, and is pointed to a website purportedly offering for sale the Complainant's IQOS System, as well as competing third-party products of other commercial origin. At the bottom of the website, the following disclaimer is published: "Company names are trademarks™ or registered trademarks® of their respective holders. Use of them does not imply any affiliation with or endorsement by them. "IQOS", "Marlboro", and "Heatsticks" are registered trademarks of PMI (Phillip Morris International Inc.) in the United Arab Emirates and/or other countries. StarHeets Dubai is not endorsed nor affiliated with PMI (Phillip Morris International Inc.)."

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the three elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the trademark HEET in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the word "star" and the geographical indicator "dubai", followed by the generic Top-Level Domain ".com".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent has in no way been licensed, authorized or otherwise permitted by the Complainant, to use any of its trademarks or to register a domain name incorporating its HEET trademark and submits that the Respondent's clear intent is to obtain an unfair commercial gain, with a view to misleadingly divert consumers whilst tarnishing the trademarks owned by the Complainant, an approach that does not meet the requirements set forth in the leading case *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Ok! Data*") for a *bona fide* offering of goods or services.

Moreover, the Complainant underlines that the Respondent is prominently using the Complainant's HEET, HEETS, IQOS, TERE, and ILUMA trademarks and offering for sale Complainant's related products, whilst displaying official product images without authorization, and is also selling competing tobacco products and/or accessories of other commercial nature, further failing to meet the requirements for a *bona fide* offering of goods or services.

With reference to the circumstances evidencing bad faith, the Complainant indicates that considering the Respondent registered the disputed domain name using the mark HEET, which is a coined term associable purely to the Complainant's products, and that the Respondent immediately after registering the disputed domain name, started offering for sale the Complainant's HEETS, IQOS, TERE, and ILUMA products as well as competing tobacco products also compatible with the Complainant's IQOS system, there is no doubt the Respondent knew about the Complainant at the time of registering the disputed domain name.

Moreover, the Complainant submits that the Respondent has used the disputed domain name in bad faith, with the intention of attracting, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its websites.

Lastly, the Complainant informs the Panel that the Respondent was recently involved in a UDRP case, *Philip Morris Products S.A. v. Ismail Hossain Emon*, WIPO Case No. [D2021-1413](#), concerning the domain name <iqosdubais.com>, and contends that this shows a pattern of bad faith conduct in connection with domain names incorporating the Complainant's trademarks.

B. Respondent

The Respondent sent informal email communications to the Center, on September 28, 2023, October 9, 2023, and November 12, 2023, in which it stated that it registered the disputed domain name as it corresponded to the name of its shop in Downtown Dubai, requested updates on the case stating that its operation was unjustly on hold due to the pending UDRP case and sought clarifications as to its knowledge it was not violating any law.

On October 17, 2023, the Respondent sent the Center a formal Response, denying all the Complainant's allegations and stating that the disputed domain name is not confusingly similar to the Complainant's HEET mark, since the disputed domain name refers to the brand name "StarHeet Dubai" that is distinct from the Complainant's IQOS, IQOS HEET or HEETS brands and therefore submits that "Starheet" is an independently established brand that in no way suggests association. The Respondent emphasizes that it purposely utilizes a logo with a star on the website to distinguish its brand from the Complainant's brand and avoid evoking any association with the IQOS logo.

With reference to rights or legitimate interests in respect of the disputed domain name, the Respondent claims its use of the "StarHeet Dubai brand" is purely in connection with a brand that has become commonly known even without a formal trademark registration and submits that it has engaged in a legitimate establishment of its brand without infringing the Complainant's property rights. The Respondent further claims that it has used the disputed domain name for a *bona fide* offering of goods or services, and it is commonly known by the disputed domain name.

With reference to the circumstances evidencing bad faith, the Respondent states it did not register the disputed domain name with the intention of primarily selling, renting or otherwise transferring the disputed

domain name to the Complainant or any other competitor, not did it register the disputed domain name with the intention of preventing the Complainant from obtaining a corresponding domain name or to create confusion with the Complainant's mark. The registration of the disputed domain name was undertaken for the legitimate purpose of establishing a brand identity for the Respondent's business. The Respondent emphasizes the inclusion of a disclaimer in the footer of the website associated with the disputed domain name.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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

It is well accepted that the first element functions primarily as a standing requirement. The standing threshold for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the HEET mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the dictionary term "star" and the geographical indicator "dubai" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Therefore, based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has filed a response but has failed to raise any convincing evidence that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's marks.

Furthermore, there is no convincing evidence before the Panel that the Respondent is commonly known by the disputed domain name, has made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, or that it intends to make a legitimate, noncommercial or fair use of the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website which purportedly promotes the sale of the Complainant's products as well as competing third party products of other commercial origin. The Panel notes that the Respondent has failed to provide a plausible explanation as to the reason why it selected the disputed domain name incorporating the Complainant's HEET mark, and that there appears to be no reasonable explanation for doing this other than to refer to the Complainant's trademark and products being offered on the website.

Moreover, the Panel finds that although the footer of the website includes a disclaimer regarding the Respondent's lack of relationship with the Complainant, such disclaimer only appears at the bottom of the website. Moreover, the website purports to offer for sale the Complainant's products as well as competing third party products of other commercial origin. Therefore, the Respondent's use of the disputed domain name does not meet the requirements set forth in the "*Oki data* test" for a reseller or distributor to be making a *bona fide* offering of goods under a domain name containing a complainant's trademark. WIPO Overview, 3.0, section 2.8.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In view of the prior registration and use of the Complainant's trademark HEET, the distinctiveness of the trademark and the fact that the disputed domain name has been pointed to a website featuring the Complainant's trademarks and products, the Panel finds that the Respondent was clearly aware and intended to target the Complainant and its trademarks at the time of registration of the disputed domain name.

As described in the factual section above, the Respondent has pointed the disputed domain name to a website purportedly offering for sale the Complainant's products along with products of the Complainant's competitors. The Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy, paragraph 4(b)(iv), since the Respondent is using the disputed domain name to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website and the products offered therein.

The Panel also finds that the disclaimer inserted by the Respondent at the bottom of its website is not sufficient to prevent a finding of bad faith and can be considered as an admission by the Respondent that users may be confused. WIPO Overview, section 3.7.

Therefore, based on the available record, the Panel finds the third element of the Policy has been 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 <starheetdubai.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: November 27, 2023