

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. 方文翔 (fang wen xiang)
Case No. D2024-1971

1. The Parties

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

The Respondent is 方文翔 (fang wen xiang), China.

2. The Domain Name and Registrar

The disputed domain name <iqosyd.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2024. On May 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 14, 2024, 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 (Alibaba Cloud Computing (Beijing) Co., Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 15, 2024, 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 in English on May 16, 2024.

On May 15, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On May 16, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent requested that Chinese be the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on May 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 10, 2024. The Respondent sent several email communications to the Center on May 15 and May 16, 2024, respectively. On June 11, 2024, the Center informed the Parties that it would proceed with panel appointment.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on June 19, 2024. 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's affiliated company Philip Morris International Inc. is one of the world's leading international tobacco companies, with products sold in over 180 countries. The Complainant and its group companies offer traditional combustible cigarettes and have developed various products to substitute traditional combustible cigarettes, one of which is branded "IQOS". The IQOS-system consists of a controlled heating device into which a designated tobacco product, branded "Heets", "HeatSticks", or "Terea", is inserted and heated to generate a nicotine-containing aerosol. The Complainant states that the IQOS-system has achieved considerable international success and fame, and that it currently has an estimated amount of 19.1 million regular users worldwide.

The Complainant provides evidence that it owns a large international portfolio of trademark registrations for IQOS (word and device marks) in a large number of jurisdictions around the world, including in China, where the Respondent is located, for example Chinese trademark registration No. 16314286, for the word mark IQOS, registered on May 14, 2016; and International trademark registration No. 1218246, for the word mark IQOS, registered on July 10, 2014.

The abovementioned registered trademarks adduced by the Complainant were successfully registered prior to the date of registration of the disputed domain name by the Respondent, which is November 25, 2020. The Complainant submits evidence that the disputed domain name directed to an active website, prominently using the Complainant's IQOS trademarks (including in the website tab), displaying a banner promoting channels allegedly selling and offering third party products of other commercial origin, and also, apparently offering information about IQOS products. The website also displayed third party links related to training for jewelry design, somatic vision games, and etc. However, on the date of this decision, the disputed domain name directs to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the 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 its trademarks for IQOS, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its trademarks are famous and well-regarded among the consumers in the tobacco industry, and provides printouts of its official website and of its marketing materials. Moreover, the Complainant provides evidence that the disputed domain name was linked to an active website, clearly displaying a banner promoting channels allegedly selling and offering third party products of other commercial origin and also prominently using the Complainant's IQOS trademarks, official product images,

marketing materials, and IQOS store get-up pictures, as well as displaying a misleading copyright notice. In this context, the Complainant claims that the Respondent was unlawfully using the Complainant's trademarks and product images likely protected by copyright and offering links to third party products for sale to Internet users by taking unfair advantage of the Complainant's trademarks. The Complainant essentially contends that such use does not confer any rights or legitimate interests in respect of the disputed domain name and constitutes bad faith.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. Particularly, the Respondent seems to focus on the second element under the Policy, arguing that it merely operates an e-cigarette science and information website hosted at the disputed domain name, including the topics atomization, heat without burning, iqos, international e-cigarette information, and related policies, etc. The Respondent states that the disputed domain name concerns a privately registered domain name and an independent personal website that has been used for many years. The Respondent essentially contends that the website to which the disputed domain name directs only provides information and is not promoting IQOS-content and selling IQOS-branded products. The Respondent also argues that the contents on its website are automatically generated and that any allegedly infringing content can be deleted and will not be published in the future.

6. Discussion and Findings

Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that, according to the Complainant, there are several factual elements which allegedly show that the Respondent is capable of communicating in English. Firstly, the disputed domain name is in Latin script and not in Chinese script indicating that the website provided under the disputed domain name is directed to, at the very least, an English-speaking public. Secondly, the Complainant argues that the website under the disputed domain name also includes a number of English words and/or phrases, suggesting that the Respondent understands English. Furthermore, the Complainant argues that being a Swiss entity, it has no knowledge of Chinese and that English is a common language in global business and obviously also a language in which the Respondent is doing business. Finally, the Complainant argues that the privacy registration service acting as a front company for the Respondent, in this particular instance, appears to also conduct its business in English.

The Respondent requested the language of the proceeding to be Chinese, since it claimed not to have sufficient understanding of English. The Panel notes that the Respondent sent several email communications in Chinese defending its registration and use of the disputed domain name.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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 entirety of the mark IQOS 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.

Although the addition of other terms here, the letters "yd", may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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 states that the disputed domain name concerns a privately registered domain name and an independent personal website that has been used for many years. The Respondent essentially contends that the website to which the disputed domain name directs only provides information and is not promoting IQOS-content and selling IQOS-branded products.

The Panel cannot agree with the Respondent's arguments. Firstly, it is the settled view of panels applying the Policy that the mere registration of a domain name is insufficient to show, by itself, rights or legitimate interests in such domain name. The Panel also disagrees with the Respondent and finds that the website at the disputed domain name was not just a personal or information website, as it clearly displayed a banner promoting channels allegedly selling and offering third party products of other commercial origin. The website also displayed third party links related to training for jewelry design, somatic vision games, and etc.

In the Panel's view, upon review of the facts and evidence, the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Instead, the Respondent was using the disputed domain name to attract users looking for the Complainant's products to the Respondent's website for commercial gain. Given the abovementioned elements, the Panel concludes that the Respondent's use does not constitute a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name.

However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive or blank webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, also does not confer any rights or legitimate interests in the disputed domain name on the Respondent in this case (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (Jun Cui)*, WIPO Case No. [D2021-1685](#)).

Considering the above, the Panel finds that the Respondent has not successfully rebutted the Complainant's prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Given the longstanding, intensive use, and distinctiveness of the Complainant's prior registered trademarks (which have been considered well-known trademarks by previous panels applying the Policy, see for instance *Philip Morris Products S.A. v. Whois Agent, Domain Protection Services, Inc. / jise cai*, WIPO Case No. [D2021-3353](#)), the Panel finds that the subsequent registration of the disputed domain name, which is confusingly similar to such well-known marks, clearly and consciously targeted the Complainant's prior registered trademarks. The Panel therefore deducts from the Respondent's efforts to consciously target the Complainant's well-known prior trademarks that the Respondent knew of the existence of the Complainant's trademarks at the time of registering the disputed domain name. This finding is confirmed by the fact that the website linked to the disputed domain name was used to prominently display the Complainant's IQOS trademarks, official product images, marketing materials, and IQOS store get-up pictures, since this proves that the Respondent was fully aware of the Complainant's business and its prior trademarks. In the Panel's view, the foregoing elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directed to an active website which showed a clear intent on the part of the Respondent to mislead Internet visitors by creating a misleading affiliation with the Complainant and potentially with the intention to attract users looking for the Complainant's products to the Respondent's website for commercial gain. The website also displayed third party links related to training for jewelry design, somatic vision games, and etc. The Panel disagrees with the argument relied on by the Respondent, stating that the contents on the disputed domain name would be automatically generated and therefore not the Respondent's responsibility. According to the [WIPO Overview 3.0](#), section 3.5, respondents cannot disclaim responsibility for content appearing on the website associated with its domain name including automatically generated pay-per-click links. The Panel concludes from the above that the Respondent is intentionally attracting Internet users for commercial gain to such website, by creating consumer confusion between the website associated with the disputed domain name and the Complainant's trademarks. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

On the date of this Decision, the disputed domain name directs to an inactive website. However, the Panel finds that the current non-use of the disputed domain name does not change the Panel's finding on the Respondent's bad faith considering the circumstances of this case.

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 <iqosyd.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: June 28, 2024