

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Super Privacy Service LTD c/o Dynadot / Bobbi Kontozoglou / Evgenijs Bicovs
Case No. D2022-0017

1. The Parties

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

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America (“United States”) / Bobbi Kontozoglou, Spain / Evgenijs Bicovs, Latvia.

2. The Domain Names and Registrar

The disputed domain name <aboutheatsticks.com> is registered with Gransy, s.r.o. d/b/a subreg.cz.

The disputed domain name <heatsticksreviews.com> is registered with Dynadot, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 4, 2022. On the same day, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On January 5, 2022, each Registrar transmitted by email to the Center its verification response:

- (a) confirming that the relevant disputed domain name was registered with it;
- (b) disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint; and
- (c) confirming the language of its registration agreement is English.

The Center sent an email communication to the Complainant on January 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 January 12, 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 January 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 2, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on February 8, 2022. 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 Philip Morris International (“PMI”) group. The PMI group makes and sells tobacco products and what it describes as smoke-free products. According to the Complainant, the PMI group does so in some 180 countries around the world.

In the course of transforming its business from combustible cigarettes to Reduced Risk Products (RRPs) (which it defines as “products that present, are likely to present, or have the potential to present less risk of harm to smokers who switch to those products versus continued smoking”), the PMI group has developed a tobacco heating system called IQOS. The IQOS device is loaded with specially designed tobacco sticks which the PMI group makes under the brands HEETS, HEATSTICKS, and TERA.

These particular RRPs are available in some 60 countries with some 19 million relevant consumers using the IQOS system.

The Complaint includes evidence that the Complainant has registered a number of trademarks for these products including IQOS (United States Registered Trademark No. 4,763,090), HEETS (United States Registered Trademark No. 5,860,364) and HEATSTICKS (United States Registered Trademark No. 4,758,618). The IQOS and HEATSTICKS trademarks were registered on, respectively June 30, 2015 and June 23, 2015. The HEETS trademark was registered on September 17, 2019. The Complaint also includes evidence of an International Registration, No. 1338099, for IQOS in a slightly stylised font, designating numerous countries, registered on March 8, 2018.

According to the Registrar, the disputed domain name <heatsticksreviews.com> was registered by the Respondent on October 7, 2020. The Whois record for <aboutheatsticks.com> records it as having been created shortly after on October 13, 2020.

The <aboutheatsticks.com> disputed domain name resolves to a website which is in the form of a blog providing information about various of the PMI group’s products such as “Use Online Shopping to BUY IQOS with Profits” and “See Review to Order IQOS HEETS Turquoise Stocks”. The Complainant says the images on the site have been copied without permission from official PMI group promotional materials.

The <heatsticksreviews.com> disputed domain name also resolves to a website in the form of a blog. Blog posts have titles like “The best-sales Iqos Heets Green sticks are our visit card”, “A recent study of abilities to buy online Iqos heatsticks” and “Buy Heets Bronze sticks that will change and improve your life”. The format and images used on the blog are different to the format and images on the website to which the <aboutheatsticks.com> disputed domain name resolves. The images, however, also appear to be copies of the official promotional literature used by the PMI group.

Both websites include links to buy, or apparently to buy, IQOS, HEETS, and HEATSTICKS products from the website at <smokeus.org>. This website appears to be directed to customers in the United States, includes a United States 1-800 contact number and is not associated with the PMI group in any way.

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. The courier attempting delivery of the Written Notice was unable to complete delivery. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his, her or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

As a preliminary matter, it is necessary to decide the Complainant's request to consolidate the complaints.

A. Consolidation of complaints

The Complainant has requested consolidation of its complaints as the disputed domain names have been registered in two different names.

Paragraph 3(c) of the Rules expressly permits a complaint to relate to more than one domain name where all the domain names are registered by the same domain name holder. Notwithstanding this express provision, panels have frequently held that the Panel's powers under paragraph 10(e) of the Rules may permit consolidation of multiple domain name disputes, subject to satisfaction of the other requirements of Policy and Rules. In particular, paragraph 10(b) of the Rules requires the Panel to ensure that all parties are treated equally and each is given a fair opportunity to present his, her or its case.

In accordance with those requirements, panels have typically allowed consolidation of multiple respondents who have registered different domain names where, amongst other things, the domain names in question, and/or the websites to which they resolve, appear to be under common control and consolidation would be fair and equitable to all parties. The onus of establishing that these requirements have been met falls on the party seeking consolidation. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.

In the present case, each of the disputed domain names is formed around the Complainant's trademark, HEATSTICKS. The disputed domain names were registered close together. Both disputed domain names resolve to websites which purport to be blogs about the Complainant's IQOS products including HEATSTICKS components. The two blogs are somewhat differently formatted, although the content is very close. Both also heavily feature images which appear to have been reproduced from the PMI group's official

promotional materials without permission. Both websites also redirect users to the same online site, <smokeus.org>, to purchase products. Although the registrants appear to have different names and be located in different countries, the couriers attempting to deliver the Written Notice were unable to effect delivery. In at least one case, the courier recorded “bad address”. Both instances lead the Panel to believe the registrant contact details provided are false (which commonality supports consolidation). Moreover, neither named Respondent, if he or she exists, has filed a Response. Nor have they sought to dispute consolidation (let alone advance any facts or arguments against doing so).

Taking all these matters into account, it appears to the Panel to be fair and equitable to all parties, and an efficient use of resources, to consolidate both disputed domain names in the one Complaint.

For ease of reference, the Panel will refer just to the “Respondent” unless it becomes necessary in a particular case to distinguish between particular Respondents or disputed domain names.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the trademark HEATSTICKS relevantly for this purpose.

The second stage of this inquiry simply requires a visual and aural comparison of each disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, both disputed domain names consist of the Complainant’s registered trademark and a common word in plain English; “about” in one case and “reviews” in the other. As this requirement under the Policy is essentially a standing requirement, the inclusion of such terms in the disputed domain names does not preclude a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within each disputed domain name.

Accordingly, the Panel finds that the Complainant has established that both disputed domain names are confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

(iii) [the Respondent] is 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 trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

Both disputed domain names have been registered well after the Complainant registered its trademark and also after the Complainant began using its trademark.

The Complainant states that it has not authorised either Respondent to use the disputed domain names. Nor is either Respondent affiliated with the Complainant or the PMI group in any way.

Neither disputed domain name is derived from either Respondent's name. Nor is there any suggestion of some other name by which either Respondent is commonly known from which the disputed domain names could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain names.

Neither Respondent has disputed these matters.

These matters are usually sufficient to raise the required *prima facie* case. In the present case, however, the content of both the disputed domain names and the websites to which they resolve can be seen as some kind of informational or review site about the PMI group's RRP products. That is, the content could suggest a basis for rights or legitimate interests as some kind of nominative fair use.

At least two and arguably up to four considerations lead to the Panel concluding that the Respondent cannot successfully rely on nominative fair use to claim rights or legitimate interests in either disputed domain name.

First, both websites link through to the <www.smokeus.org> website which purports to be selling the Complainant's IQOS and related products. This introduces a significant commercial element and, typically under the Policy, this weighs against finding nominative fair use. See e.g. [WIPO Overview 3.0](#), sections 2.5.2 and 2.7.

Secondly, neither website makes clear its relationship with the Complainant or the PMI group. The failure to clearly indicate that the websites are not authorised by or officially associated with the PMI group is a strong indicator against rights or legitimate interests. That is all the more so in the present case where both websites make significant use of the PMI group's own promotional images and neither website clearly identifies who is operating it.

The use of these promotional materials without permission may also give rise to a third consideration to the extent, as the Complainant argues, that these uses infringe its copyright.

Fourthly, the Complainant suggests that the website at <smokeus.org> may not be selling genuine PMI group products at all. However that may be, at least some of the products being offered for sale from the website to customers in the United States, in particular the HEETS products, have not received marketing approval from the United States Food and Drug Administration and so cannot legally be sold there.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in either disputed domain name. As the Respondent has not sought to rebut that *prima facie* case or advance any claimed entitlement, therefore, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd.*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The content of both disputed domain names and the websites to which they resolve means there can be no doubt about the Respondent's awareness of the Complainant's trademark: they are domain names and websites directed to the PMI group's products associated with the Complainant's trademark.

Having regard to how recently the disputed domain names were registered, it is reasonable to infer that both were registered for the purpose to which they have been put. That is, both websites appear to have been set up to direct traffic to or take advantage of the website at <smokeus.org> which offers for sale RRP's under or by reference to the Complainant's trademarks.

In circumstances where the Respondent does not have rights or legitimate interests in the disputed domain names, therefore, registration and use for that purpose constitutes registration and use under the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 names, <aboutheatsticks.com> and <heatsticksreviews.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: February 28, 2022