

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Sorakrit Lueangtipayajun,
Bangkok Web Design
Case No. D2022-0158

1. The Parties

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

The Respondent is Sorakrit Lueangtipayajun, Bangkok Web Design, Thailand.

2. The Domain Name and Registrar

The disputed domain name <weselliqos.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 January 18, 2022. On January 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 19, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 19, 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 24, 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 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent's default on February 14, 2022.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on February 17, 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 a Swiss subsidiary of Philip Morris International, Inc. that participates in the tobacco industry.

The Complainant is the owner of several trademark registrations around the world, among others, the following:

Trademark	No. Registration	Jurisdiction	Date of Registration
IQOS	TM416024	Thailand	May 14, 2014
IQOS iQOS	TM416616	Thailand	May 14, 2014
IQOS	1218246	International Registration	July 10, 2014
IQOS IQOS	1461017	International Registration	January 18, 2019
WE IQOS	1566578	International Registration	October 19, 2020

The Respondent registered the disputed domain name on June 13, 2021, and it resolves to a website that operates an online store that offers the Complainant's products, as well as third-party competing products.

5. Parties' Contentions

A. Complainant

The Complainant argued the following:

That the Complainant is a subsidiary of Philip Morris International, Inc., one of the leading international tobacco companies, with products sold in over 180 countries.

That the Complainant is transforming its business from combustible cigarettes to Reduced Risk Products, one of which is called IQOS, an electronic heating device that uses tobacco sticks called HEETS or TEREAs.

That, after an investment of over USD 8.1 billion, the IQOS products have achieved considerable international success and reputation, with almost 19.1 million consumers worldwide, in around 66 markets across the world.

That it owns several trademark registrations for IQOS in several jurisdictions, including Thailand, where the Respondent apparently resides.

That the disputed domain name is linked to an online shop allegedly selling and offering the Complainant's products that bear the IQOS trademarks, as well as competing third-party products.

That the Complainant's IQOS System is not currently available in Thailand. That, notwithstanding this fact, the disputed domain name is purporting to be an official retailer of the Complainant in Thailand, by using the Complainant's IQOS and WE IQOS trademarks, together with the term "sell".

That the website to which the disputed domain name resolves has displayed several of the Complainant's official product images and marketing materials without the Complainant's authorization, while at the same time made available a copyright notice at the bottom of the website claiming rights to the materials presented on said website, thereby strengthening the false impression of affiliation with the Complainant.

That the website to which the disputed domain name resolves does not acknowledge the Complainant to be the actual owner of the trademarks and copyrighted materials reproduced therein, thus leaving Internet users with the impression that said website is affiliated to the Complainant.

I. Identical or Confusingly Similar

That the disputed domain name includes entirely the Complainant's trademarks IQOS, and WE IQOS plus the addition of the term "sell".

That it is well accepted that a disputed domain name is confusingly similar to a trademark, when it includes a trademark or a confusingly similar approximation, regardless of the other terms present in the disputed domain name.

That it is well established that the addition of the generic Top-Level-Domain ("gTLD") ".com" to the disputed domain name constitutes a standard registration requirement, and that, therefore, it should be disregarded when conducting the confusing similarity test.

That the mere addition of a generic term is insufficient to avoid a finding of confusing similarity under the first element of the Policy.

That any Internet user, when coming across the disputed domain name, will reasonably expect to find the website to which said domain name resolves commercially linked to the Complainant, and be subject to confusion.

II. Rights or Legitimate Interests

That the Complainant is making a *prima facie* case that the Respondent lacks any right to or legitimate interest in the disputed domain name.

That the Complainant has not licensed or otherwise permitted the Respondent to use the IQOS and WE IQOS trademarks, or to register the disputed domain name.

That the Respondent is not making a legitimate, noncommercial, or fair use of the disputed domain name; that, on the contrary, the Respondent is trying to obtain an unfair commercial gain by misleadingly diverting consumers.

That the Respondent is not an authorized distributor or reseller of the IQOS System.

That the Respondent is selling third-party competing products on the website to which the disputed domain name resolves.

That the Respondent is not making a *bona fide* offering of goods. That a reseller or a distributor can make a *bona fide* offering of goods, and thus, have a legitimate interest in a domain name if certain requirements are

met, such as:

1. The Respondent must use the site to sell only the trademarked goods;
2. The site itself must accurately disclose the Respondent's relationship with the trademark owner; and
3. 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.

That the Respondent is using the official product images of the Complainant without its authorization while displaying a copyright notice associated thereto. That this situation further supports the false impression that the disputed domain name is endorsed by the Complainant.

That the fact that 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 is sufficient to exclude a finding of legitimate interests in the form of a *bona fide* offering of goods.

That the legitimate products that bear the IQOS trademark are sold primarily through official or endorsed stores, and that, in this case, the consumers are misled into believing that the website to which the disputed domain name resolves is related to official or endorsed distributors of the Complainant.

That the illegitimacy of the Respondent's use of the disputed domain name is further shown by the fact that the Complainant does not currently offer for sale its IQOS System in Thailand.

That the online shop made available through the website to which the disputed domain name resolves creates the false impression that the Complainant has officially introduced the IQOS System into the Thai market.

III. Registered and Used in Bad Faith

That it is evident from the use of the disputed domain name that the Respondent knew of the Complainant's trademarks when registering the disputed domain name.

That the trademark IQOS corresponds to a purely imaginative term which is unique to the Complainant; that said trademark is not commonly used to refer to tobacco products or electronic devices; and that it is no coincidence that the Respondent chose the disputed domain name intending to create a misleading impression of association with the Complainant.

That it is evident that the Respondent registered and used the disputed domain name to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks, as to their source, affiliation, or endorsement of the website to which the disputed domain name resolves, which constitutes registration in bad faith. That this is further supported by the fact that the Respondent is using the Complainant's official product images.

That the Respondent is using the disputed domain name in bad faith to sell third-party competing products, which is a clear-cut trademark infringement and constitutes clear evidence of the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant is required to prove that each of the three following elements is satisfied:

- (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 was registered and is being used in bad faith.

Given the Respondent's failure to submit a Response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations under paragraphs 5(e), 14(a) and 15(a) of the Rules, and shall draw such inferences it considers appropriate under paragraph 14(b) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#), and *Encyclopaedia Britannica, Inc. v. null John Zuccarini, Country Walk*, WIPO Case No. [D2002-0487](#)).

A. Identical or Confusingly Similar

The Complainant has proven to be the owner of registrations for the trademark IQOS throughout the world, including in Thailand, where the Respondent has declared to be located.

The disputed domain name is confusingly similar to the IQOS and WE IQOS trademarks since it includes them entirely.

The incorporation of the term "sell" does not prevent a finding of confusing similarity, because the Complainant's trademarks IQOS, and WE IQOS are recognizable in the disputed domain name (see sections 1.7, and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)").

The addition of the gTLD ".com" to the disputed domain name constitutes a technical requirement of the Domain Name System ("DNS"). Therefore, it has no legal significance in the present case (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#); *International Business Machines Corporation v. chenaibin*, WIPO Case No. [D2021-0339](#), and *Société Air France v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues*, WIPO Case No. [D2019-0578](#)).

In light of the above, the first element of the Policy has been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in the disputed domain name:

- (i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the 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 it did not acquire trademark or service mark rights; or
- (iii) the respondent is 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.

The Complainant has asserted that there is no relationship between the Complainant and the Respondent, that it has not granted any authorization to the Respondent to use its trademarks IQOS and WE IQOS, and that the Respondent has not been commonly known by the disputed domain name. The Respondent has not contested the Complainant's *prima facie* case (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#); and *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#)). The Respondent did not contest these allegations.

As asserted by the Complainant, the products bearing the IQOS trademark are sold primarily through official or endorsed stores. Noting the composition of the disputed domain name and its use, the disputed domain name may mislead Internet users into believing that the website to which it resolves is related to official or

authorized distributors or resellers of the Complainant, which cannot be deemed as a *bona fide* offering of goods.

Moreover, the fact that the Complainant's products are not available in Thailand, strengthens the risk of confusion among Internet users, who might think that the Respondent is an official retailer of the Complainant in the Thai market.

The facts of this case do not pass the *Okidata* test¹. The website to which the disputed domain name resolves offers not only the Complainant's goods, but also products of competitors, which are promoted in a blog comprised in said website. Such website does not display a disclaimer stating that it is not related to the Complainant (see section 2.8.1 of the [WIPO Overview 3.0](#); see also *Philip Morris S.A. v. bprapan bpaetaa*, WIPO Case No. [D2020-3372](#), and *Philip Morris S.A. v. Rohan mubbahir Khan*, WIPO Case No. D2021-1314).

The website to which the disputed domain name resolves predominantly displays the Complainant's IQOS and WE IQOS trademarks, as well as reproductions of images of the Complainant's official products, which copyrights, according to the Complainant, belong to the said Complainant. Moreover, the copyright notices displayed on said website purport that the Respondent is the rights holder to said images. This shows that the Respondent has attempted to impersonate the Complainant (see sections 2.5.1, and 2.13.1 of the [WIPO Overview 3.0](#); see also *Self-Portrait IP Limited v. Franklin Kelly*, *supra*).

In light of the above, the second element of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or the respondent has 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's web site or location or of a product or service on its web site or location.

Considering the intensive investments in advertising that the Complainant has undertaken, the reputation that its trademark IQOS enjoys internationally, and that said fanciful trademark does not correspond to a dictionary word, it is safe to infer that said trademark is highly distinctive.

The fact that the Respondent chose to register the disputed domain name, which resolves to a website that displays the trademarks IQOS and WE IQOS of the Complainant, makes available images which rights apparently belong to the Complainant, and also sells other third-party competing products, suggests that the Respondent knew the Complainant, its trademarks, and its business when registering the disputed domain name, and that the Respondent has targeted the Complainant (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#);

¹ *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903.

Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot, WIPO Case No. [D2019-0980](#); *Dream Marriage Group, Inc. v. Romantic Lines LP, Vadim Parhomchuk*, WIPO Case No. [D2020-1344](#); and *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#)).

These facts also show that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the website to which the disputed domain name resolves, by creating the impression among Internet users that said website is related to, associated with, or endorsed by the Complainant, which conduct constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#).; see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

According to the evidence submitted by the Complainant, the Respondent has used the disputed domain name in an attempt to impersonate the Complainant for commercial gain, which also constitutes bad faith under the Policy (see also *Philip Morris Products S.A. v. Domain Administrator, Registrant of iqosatismaganiz.com (apiname com) / Anl Girgin, Teknoloji Sarayi*, WIPO Case No. [D2019-0466](#); *Self-Portrait IP Limited v. Franklin Kelly, supra*; and *Friedman and Soliman Enterprises, LLC v. Gary Selesko, M&B Relocation and Referral, LLC*, WIPO Case No. [D2016-0800](#)).

Therefore, the third element of the Policy has been met.

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, <weselliqos.com> be transferred to the Complainant.

/Kiyoshi Tsuru/

Kiyoshi Tsuru

Sole Panelist

Date: March 3, 2022