

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Jakkapan Sae-Kow
Case No. D2022-0838

1. The Parties

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

The Respondent is Jakkapan Sae-Kow, Thailand.

2. The Domain Name and Registrar

The disputed domain name <iqosas-thai.com> (the “Domain Name”) is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 10, 2022. On March 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 14, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 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 in English on March 16, 2022.

On March 15, 2022, the Center transmitted an email communication to the Parties in English and Thai regarding the language of the proceeding. On March 16, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on 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 of the Complaint, and the proceedings commenced on March 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 19, 2022.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on April 27, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is part of Philip Morris International Inc. ("PMI"). PMI is an international tobacco company, with products sold in approximately 180 countries. PMI has developed a number of products, such as IQOS. IQOS is a controlled heating device specially designed for tobacco products under the brand names "HEETS" or "HeatSticks". The tobacco products are inserted and heated to generate a flavorful nicotine-containing aerosol. The IQOS system was first launched in 2014. Today, the IQOS system is available in key cities in around 66 markets across the world, and it has approximately 19.1 million consumers worldwide. It is almost exclusively distributed through PMI's official IQOS stores and websites and selected authorized distributors and retailers.

The Complainant has trademark registrations in IQOS relating to its products, such as International Registration No. 1218246, registered on July 10, 2014; and International Registration No. 1461017, registered on January 18, 2019. The registrations designate a multitude of jurisdictions, including Thailand where the Respondent is allegedly located.

At the time of filing the Complaint, and at the time of drafting the Decision, the Domain Name resolved to a website that allegedly sells the Complainant's products, as well as competing third party products of other commercial origin. The website purports to be an official online retailer of the Complainant's IQOS system in Thailand, *inter alia* by using the Complainant's registered logo and hummingbird trademark, and without authorization reproducing a number of the Complainant's official product images.

5. Parties' Contentions

A. Complainant

The Complainant requests the language of the proceeding to be English. The Domain Name is in Latin script. The Respondent's website includes a number of English words and/or phrases, suggesting the Respondent understands English. The Complainant has no knowledge of Thai. The Registrar appears to conduct its business in English.

The Complainant has registered trademark rights in IQOS. The Complainant submits that the Domain Name is confusingly similar to the Complainant's trademark. The Domain Name adopts the Complainant's trademark. The addition of the "as-" and "thai" is insufficient to avoid a finding of confusing similarity under the first element of the UDRP.

The Complainant submits that the Respondent has no rights or legitimate interests in the Domain Name. The Complainant asserts that the Respondent is unable to demonstrate rights or legitimate interests in the Domain Name. The Respondent has not been allowed by the Complainant to make any use of its trademark. The Domain Name resolves to a website that does not meet the requirements for a *bona fide* offering of goods or services. The Respondent is not only offering the Complainant's products but also competing tobacco products and accessories of other commercial origin. Moreover, the Respondent's use is not "fair", as consumers are misled to falsely believe that the website under the Domain Name is an official/endorsed distributor of the Complainant.

The Complainant argues that the Respondent had knowledge of the Complainant and its products at the time of registration of the Domain Name. The Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's registered IQOS trademark as to the source, sponsorship, affiliation, or endorsement of its website. By reproducing the Complainant's trademark in the Domain Name and the title of the website, the Respondent's website suggests the Complainant or an affiliated dealer as the source of the website. This is underlined by the Respondent's use of the Complainant's official product images. The Complainant further submits as bad faith evidence that the Respondent's website also offers third party products of other commercial origin. Finally, the Respondent's use of a privacy protection service to hide the Respondent's identity also indicates bad faith.

B. Respondent

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

6. Discussion and Findings

A. Language of the Proceeding

Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement, unless otherwise agreed by the parties. Importantly, paragraph 11(a) also states that the determination of the language of the proceeding is "[...] subject to the authority of the Panel [...], having regard to the circumstances of the administrative proceeding".

The language of the Registration Agreement is Thai. The Complainant submitted its Complaint in English, and requested English to be the language of the proceeding.

The Panel notes that the Domain Name consists of the Complainant's trademark, plus "as-" and "thai". At least the latter is an English word. Moreover, the Respondent's website includes English words. Crucially, the Center has sent the communication regarding the language of the proceeding to the Respondent in both English and Thai, providing the Respondent a fair chance to object and yet the Respondent remained silent. The Panel determines that the language of this proceeding to be English, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.

Turning to the merits of the case, in order to prevail, the Complainant must prove the three elements in paragraph 4(a) of the Policy.

B. Identical or Confusingly Similar

The Complainant has established rights in the trademark IQOS. The test for confusing similarity involves the comparison between the trademark and the Domain Name. In this case, the Domain Name adopts the Complainant's trademark, with the addition of "as-" and "thai". It does not prevent a finding of confusing similarity under the first element of the UDRP, since the Complainant's trademark remains recognizable.

When assessing confusing similarity, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") ".com", see [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainant has made unrebutted assertions that it has not granted any authorization to the

Respondent to register a domain name containing the Complainant's trademark or otherwise make use of the trademark. Based on the evidence, the Respondent is not affiliated or related to the Complainant in any way. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired unregistered rights. The way the Respondent has used the Domain Name to present itself as a reseller of the Complainant's products, is not *bona fide*. The website under the Domain Name gives the false impression of a commercial relationship between the website and the Complainant. The website is not only offering the Complainant's products but also competing tobacco products and accessories of other commercial origin. The Respondent's website uses the Complainant's official product images without authorization.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Taking into account the Respondent's use of the Domain Name, the Panel concludes that the Respondent knew of the Complainant and its business when the Respondent registered the Domain Name.

The Respondent has attempted to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The Respondent's website suggests and gives the false impression of a commercial relationship between the website and the Complainant. The mere registration of a domain name that is confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith, see [WIPO Overview 3.0](#), section 3.1.4. The fact that the Respondent has not replied to the Complainant's contentions further points to bad faith.

The Panel finds that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

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 Domain Name <iqosas-thai.com> be transferred to the Complainant.

/Mathias Lilleengen/

Mathias Lilleengen

Sole Panelist

Date: May 2, 2022