

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Ismail Hossain
Case No. D2022-2952

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, United Arab Emirates.

2. The Domain Names and Registrar

The disputed domain names <iqosheetsabudhabi.com> and <iqosheets-dubai.net> are registered with Hostinger, UAB (the “Registrar”)

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 10, 2022. On August 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 11, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 August 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 1, 2022. The Respondent’s informal communications were received on August 12, 2022. On August 18, 2022, the Complainant requested that the proceeding be suspended. On August 26, 2022, the Complainant sent a communication to the Center indicating that the Parties were unable to reach a settlement. The proceeding was reinstated on August 29, 2022. The Response due date was extended to September 14, 2022. The Center notified the Commencement of Panel Appointment Process to the Parties on September 15, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on September 21, 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.

The Complainant requested consolidation of the two matters in accordance with paragraph 10(e) of the Rules. Given that the Registrants for the disputed domain names are identical; that the disputed domain names are similarly composed, each with inclusion of an emirate of the United Arab Emirates (“UAE”); that the websites to which each disputed domain name resolves offer and promote identical third-party competing and infringing products; that the websites each contain the same telephone contact number; and that the Respondent entered into correspondence seeking to settle both matters, the Panel holds that consolidation of proceedings in relation to both disputed domain names is appropriate and desirable.

4. Factual Background

The Complainant is associated with Philip Morris International Inc. and is an international tobacco and smoke-free products company with products sold in approximately 180 countries. The Complainant produces what it refers to as Reduced Risk Products that are not combustible and said to be less harmful to smokers than traditional cigarettes and the like. In the process of converting to such products, it developed a tobacco heating system referred to as IQOS and into which tobacco sticks can be inserted that are branded “HEETS”.

The Complainant has a large number of relevant trademark registrations, including United Arab Emirates Registration No. 211139 for IQOS (word), registered on March 16, 2016; United Arab Emirates Registration No. 256864 for HEETS (word), registered on December 25, 2017; United Arab Emirates Registration No. 305079 for IQOS (word/stylised), registered on June 27, 2019; United Arab Emirates Registration No. 211143 for IQOS (device), registered on March 16, 2016; United Arab Emirates Registration No. 256867 for HEETS (word/device), registered on December 25, 2017; and International Registration No. 1557546 for IQOS, registered on August 27, 2020, designating Albania, Algeria, Armenia, Australia, Azerbaijan, Bosnia and Herzegovina, Bahrain, Belarus, Brazil, Brunei, Cambodia, Canada, Colombia, Curaçao, Egypt, Estonia, Georgia, Indonesia, Israel, India, Iceland, Kazakhstan, Kyrgyzstan, Malaysia, Morocco, Liechtenstein, Monaco, Moldova, Montenegro, Mexico, Norway, New Zealand, North Macedonia, Sultanate of Oman, Philippines, San Marino, Serbia, Republic of Korea, Singapore, Thailand, Turkey, Ukraine, United Kingdom, and Viet Nam.

Both disputed domain names resolve to online shops allegedly selling the Complainant’s IQOS System, as well as competing third party products and accessories with a different commercial origin, and directed at consumers in the UAE.

The disputed domain name <iqosheetsabudhabi.com> was registered on July 1, 2022 and the disputed domain name <iqosheets-dubai.net> was registered on June 11, 2022.

5. Parties’ Contentions

A. Complainant

The Complainant says that its IQOS System has achieved international success and reputation, and that approximately 19.1 million consumers are using the IQOS System worldwide. The IQOS System has been almost exclusively distributed through the Complainant’s official IQOS stores and websites and selected authorized distributors and retailers.

The Complainant points out that a domain name is confusingly similar to a trademark, when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name. The disputed domain names are said both to identically adopt the HEETS and IQOS trademarks. The addition of merely generic, descriptive, or geographical wording to a trademark in a domain name is normally insufficient to avoid a finding of confusing similarity under the first element of the UDRP. Internet users would expect to find a website linked in commerce to the Complainant, a misleading association further enhanced by representations of the Complainant's official products on the said websites.

The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its IQOS and/or HEETS trademarks. The Complainant also contends that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names. The Respondent's behavior in fact shows a clear intent to realize an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademarks owned by the Complainant. The Respondent is not an authorized distributor or reseller of the IQOS System, and the relevant websites sell competing tobacco products and accessories of other commercial origin. According to the Complainant, the websites associated with the disputed domain names do not accord with the requirements of *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). In the present case, the associated websites suggest an association with the Complainant that does not in fact exist, and those websites also sell products not emanating from the Complainant. The websites further use both the HEETS and IQOS trademarks without any authorization, and also official and copyright product images of the Complainant, so the Complainant asserts. The websites in question do not make the absence of any affiliation with the Complainant clear, the Complainant points out. Given that the Complainant distributes its goods only through official or endorsed stores, consumers would be led to believe there is such an association between the Complainant and the Respondent's websites.

The Complainant maintains that it is evident from the Respondent's use of the disputed domain names, that it was aware of the HEETS and IQOS trademarks and that they belong to the Complainant. The IQOS and HEETS marks are invented terms with no inherent or descriptive meaning and not commonly used to describe smoking products. It is therefore unimaginable that they were chosen for incorporation in the disputed domain name by pure chance or coincidence. It is also evident from all the above, according to the Complainant, that the Respondent registered and used the disputed domain names with the intention to attract, for commercial gain, Internet users to the website(s) by creating a likelihood of confusion with the Complainant's registered IQOS and HEETS trademarks as to the source, sponsorship, affiliation, or endorsement of its website(s) or location(s) or of a product or service on its website(s) or location(s), which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Complainant also says that by reproducing its registered trademarks in the disputed domain names and the websites to which they resolve, the Respondent is clearly suggesting that the Complainant (or an affiliated dealer of the Complainant) is the source of the said websites, which it is not. This false suggestion is further supported by the Respondent's use of the Complainant's official product images accompanied by a false copyright claim notice.

Finally, in relation to bad faith, the Complainant asserts that the relevant websites are also used for the purpose of offering for sale third party products with a different commercial origin including an infringing cleaning product for use with the Complainant's IQOS System.

B. Respondent

The Respondent did not submit a formal Response to the Complainant's contentions. The Respondent's informal submissions did not lead to a settlement between the Parties, and the Panel finds that there was no substance to the Respondent's representation, and do not alter the outcome of this decision.

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain names are not identical to the HEETS or IQOS trademarks of the Complainant. However, those marks are visible and recognizable in the disputed domain names, and therefore the latter are confusingly similar to the Complainant's registered trademarks. The addition of geographical terms is of no consequence in this regard.

Therefore, the Panel holds that both disputed domain names are confusingly similar to the Complainant's registered trademarks.

B. Rights or Legitimate Interests

The Respondent has not formally replied to the contentions of the Complainant. He is not authorized to use the Complainant's distinctive marks in any form, and he is not an authorized reseller of the Complainant's HEETS and IQOS products. His use of the Complainant's registered marks in relation to the online stores they resolve to, does not fall within the criteria recognized in *Oki Data* and commonly applied in UDRP panel decisions. There is nothing before the Panel that indicates that the Respondent has rights through registration or legitimate use in the HEETS or IQOS marks or in the disputed domain names. The Respondent is not known by those marks or by either of the disputed domain names. The websites to which the disputed domain names resolve rely on the false impression of a connection with the Complainant, generated by the composition of the disputed domain names, to offer products that are in competition with those of the Complainant. Images and marks used on the websites associated with the disputed domain names include those that are the property of the Complainant and not of the Respondent. They have been reproduced without authorization, an illegitimate activity that cannot be allowed to benefit the Respondent.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

It is clear from the composition of the disputed domain names, and the subsequent use to which they have been put, that the Respondent must have been fully aware of the rights the Complainant has in the HEETS and IQOS marks, and in fact that they are the exclusive commercial property of the latter. When the disputed domain names were registered, the Complainant already had a well-established reputation in those marks and the associated products. The disputed domain names falsely suggest affiliation with the Complainant, a false and misleading suggestion further enhanced by the use of the Complainant's marks on the relevant websites, and by the copying of product images the copyright in which belongs to the Complainant. It is incontrovertible that the Respondent has sought to benefit from the apparent association of the disputed domain names with the Complainant and to give the resulting websites the air of being those of an official distributor of the Complainant.

Therefore the Panel holds that the disputed domain names were registered and used in bad faith.

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 names, <iqosheetsabudhabi.com> and <iqosheets-dubai.net>, be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: October 5, 2022