

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Ibrahim Hosen, Dream Game Shop
Case No. D2022-3398

1. The Parties

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

The Respondent is Ibrahim Hosen, Dream Game Shop, Bangladesh.

2. The Domain Names and Registrar

The disputed domain names <iqosterea.com> and <tereqosuae.com> are 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 September 13, 2022. On September 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 14, 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 September 15, 2022. The Center received email communications from the Respondent on September 15, and September 20, 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 September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. The Respondent did not submit a formal response. Accordingly, the Center notified the commencement of panel appointment process on October 18, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on November 7, 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 Philip Morris Products S.A., a company which is part of the group of companies affiliated to Philip Morris International Inc.

The Complainant is a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries. The Complainant's unequalled brand portfolio contains brands like MARLBORO (outside of the United States of America and Canada), an international selling cigarette brand since 1972.

The Complainant is known for innovating across its brand portfolio. In the course of transforming its business from combustible cigarettes to Reduced Risk Products of these products developed and sold by the Complainant is a tobacco heating system called "IQOS".

"IQOS" is a precisely controlled heating device into which specially designed tobacco sticks under the brand names "HEETS", "HeatSticks" or "TEREA" are inserted and heated to generate a flavorful nicotine-containing aerosol (collectively referred to as the "IQOS System"). There are five versions of the IQOS heating device currently available: the IQOS 2.4/IQOS 2.4+ pocket charger and holder, IQOS 3 pocket charger and holder, IQOS 3 Multi device, IQOS 3 DUO/DUOS and IQOS ILUMA. The IQOS System was first launched by the Complainant in Nagoya, Japan in 2014, and has obtained an extraordinary 20% share of the market in Japan. Today the IQOS System is available in key cities in around 71 markets across the world. As a result of an investment of over USD 9 billion into the science and research of developing smoke-free products and extensive international sales (in accordance with local laws), the Complainant claims that the IQOS System has achieved considerable international success and reputation, and approximately 19.1 million relevant consumers using the IQOS System worldwide.

To date, the IQOS System has been almost exclusively distributed through the Complainant's official IQOS stores and websites and selected authorized distributors and retailers.

For its new innovative smoke-free products the Complainant owns a large portfolio of well-known trademarks. Among them, but by no means limited to, are the following trademark registrations (referred as "Trademarks"): - United Arab Emirates Registration IQOS (word) No. 211139 registered on March 17, 2016; - United Arab Emirates Registration TEREA (word) No. 322508 registered on March 29, 2020; - United Arab Emirates Registration ILUMA (word) No. 322507 registered on March 29, 2020; - United Arab Emirates Registration IQOS ILUMA (word) No. 211139 registered on March 17, 2016; - United Arab Emirates Registration (word/stylized) No. 305079 registered June 28, 2019; - United Arab Emirates Registration HEETS (word) No. 256864 registered on December 26, 2017; and - United Arab Emirates Registration (word/device) No. 256867 registered on December 26, 2017.

The Complainant has their official website displayed at the domain name "www.iqos.com" which was registered in the year 1997.

The disputed domain name <iqosterea.com> was registered on August 5, 2022, and the other disputed domain name <tereaiqosuae.com> was registered on August 24 2022.

The disputed domain names were at the time of filing the Complaint linked to an online shop at "www.iqosterea.com" (referred to as the "Website"), allegedly selling and offering the Complainant's IQOS System, as well as competing third party products of other commercial origin.

The Website displayed on both disputed domain names were in English. The fact that the Website was indicating all prices in AED currency, as well as presenting the address of “Dubai, United Arab Emirates” (with Dubai being an emirate of the United Arab Emirates), clearly indicates that the Website is directed to the United Arab Emirates. Notwithstanding the Website is clearly purporting to be an official online retailer of the Complainant’s IQOS System in the United Arab Emirates by using the Complainant’s IQOS and TERA trademarks in the disputed domain names together with the geographical abbreviation for the United Arab Emirates (*i.e.* “uae”) in respect of the disputed domain name <tereiqosuae.com>. The Website is prominently using the Complainant’s registered IQOS and TERA trademarks at the top of the Website, as well as using the Complainant’s registered TERA and IQOS trademarks within the tab interface of the Website, being locations where users / relevant consumers usually expect to find the name of the online shop and/or the name of the provider of the Website. Any user or relevant consumer being confronted with the disputed domain names and the Website provided thereunder will usually expect to find the name of the online shop and/or the name of the provider of the Website.

At the moment of this Decision the disputed domain name <iqosterea.com> is not active and the disputed domain name <tereiqosuae.com> currently resolves to a website that displaying pay-per-click (“PPC”) links of products offered by third parties.

5. Parties’ Contentions

A. Complainant

The Complainant argues that both of the disputed domain names are confusingly similar to its trademarks IQOS and TERA. Due to the fact that both disputed domain names include the trademarks IQOS and TERA in its entirety, in one case both trademarks together in combination, <iqosterea.com>, and the other case, <tereiqosuae.com>, both trademarks in combination with the additional word “uae” which refers to the United Arab Emirates. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain names and finally, that the Respondent registered and is using the disputed domain names in bad faith.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. The Respondent sent two informal communications to the Center on September 15, and September 20, 2022, stating “Received, thank you.”, and “Hello sir We don’t need this two domain. Please don’t give info more. Please dismiss this two domain. We don’t work with this domain. Thanks”.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established its trademark rights in the IQOS and TERA trademarks. The test that a panel must carry out for both disputed domain names in order to establish if a domain name is confusingly similar to a trademark involves the comparison between the trademark and the domain name.

Regarding whether the disputed domain names are identical or confusingly similar to the IQOS and TERA trademark, this Panel observes that both disputed domain names are compromising the trademarks in the following form: (a) the Complainant’s trademark IQOS and TERA in combination in both disputed domain names; (b) In the disputed domain name <tereiqosuae.com> is compromising both trademarks in combination with the additional word “uae” that stands for United Arab Emirates (c) followed by the generic Top-Level Domain (“gTLD”) “.com”.

The disputed domain names <iqosterea.com> and <tereiqosuae.com> includes the trademarks IQOS and TEREА in its entirety. The only difference in the second disputed domain name <tereiqosuae.com> is the inclusion of the word “uae” that stands for United Arab Emirates.

It is well established that where a domain name incorporates a complainant’s trademark in its entirety, the domain name will be normally considered confusingly similar to that mark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), section 1.8.

The addition of the gTLD “.com” is viewed as a standard registration requirement and therefore is irrelevant to determine the confusing similarity between the trademarks and the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the 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 has been commonly known by the domain name, even if it has acquired no 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.

Even though the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#) that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant allegations and evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with arguments or evidence proving its rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not commonly known by the disputed domain names or the trademarks IQOS and TEREА. The Respondent has not been authorized by the Complainant to register or use the trademarks IQOS and TEREА in conjunction or separately in any way including the disputed domain names. The website that is displayed on the disputed domain names does not show any *bona fide* offering of goods or services, due to the fact that what is displayed on the website at the disputed domain names is an online shop selling and offering the Complainant’s IQOS System, as well as competing third party products of other commercial origin.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been refuted by the Respondent.

In the present case, the Panel has the view that the use of trademarks IQOS and TEREА in the disputed domain names do not constitute a *bona fide* offering goods or services or legitimate noncommercial or fair use by the Respondent within paragraphs 4(c)(i) and (iii) of the Policy. Regarding paragraph 4(c)(ii) of the Policy, the Panel notes that there is no evidence that the Respondent has been commonly known by the terms IQOS or TEREА or the disputed domain names.

In conclusion, in this case, the Panel finds that the Complainant has made out a *prima facie* case for both disputed domain names. The Respondent has not submitted any arguments or evidence to rebut the Complainant's *prima facie* case. Furthermore, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the IQOS and TERE A trademark. That the Complainant does not have any type of business relationship with the Respondent. Based on the use made of the disputed domain names that resolves to a website that offers similar third parties' products of what the Complainant sells with the trademarks IQOS and TERE A. This Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of both of the disputed domain names. On the contrary, the Respondent is using the IQOS and TERE A trademarks in the disputed domain names to promote its website for illegitimate commercial gain. In the present case, the Respondent intentionally attempted to create a likelihood of confusion by using the disputed domain names incorporating the IQOS and TERE A trademarks to increase Internet user traffic to its own products.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in both of the disputed domain names. In light of the above, the Complainant has complied with the second element of the Policy. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

This Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy. In order to prevail under the Policy, the Complainant must demonstrate that both disputed domain names have been registered and are being used in bad faith, accordingly it is a cumulative requirement.

The Panel is satisfied that the Respondent must have been aware of the Trademarks when it registered the disputed domain names as both of the disputed domain names contain the Complainant's widely known Trademarks in its entirety. Furthermore, the terms IQOS and TERE A are purely imaginative terms and unique to the Complainant. The terms IQOS and TERE A are not commonly used to refer to tobacco products or electronic devices. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the disputed domain names, without the intention of invoking a misleading association with the Complainant. A factor indicating bad faith (see [WIPO Overview 3.0](#), section 3.6 and the cases referenced therein).

Also, from all the available evidence, the disputed domain names were registered long after the Complainant attained registered rights in the Trademark and their official website, 1997. Previous UDRP panels have consistently found that registration of a domain name that is confusingly similar to a widely known trademark, as it is the present case in both disputed domain names, creates a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Also, other UDRP panels have found that a respondent was likely to be aware of a complainant's trademark rights when it registered a confusingly similar domain name and began operating a website that provides products in direct competition with the complainant. Here, the Respondent clearly registered the disputed domain names to divert Internet traffic from the Complainant's site to a website offering similar products of the Complainant using the well-known trademarks IQOS and TERE A.

On the issue of registration, in light of the reputation of the Complainant's Trademark and the scope of its operations, for this Panel it is evident that the Respondent had knowledge of both the Complainant and its Trademarks at the time the disputed domain names were registered. Furthermore, it is well established that when the disputed domain names are so obviously connected with renowned trademarks such as the IQOS and TERE A Trademarks in the field of smoke free products.

Further, the Panel finds that the use of the disputed domain names is also in bad faith due to the fact that it illegally reproduces content taken from the Complainant's website. Due to the fact according with the evidence presented in the present case, the Respondent started offering the Complainant's IQOS System

immediately after registering the disputed domain names.

The Panel accepts the Complainant's submissions that the trademarks IQOS and TEREА are distinctive, creative and invented terms and that it is obvious that the Respondent registered the disputed domain names with the intention of referring to the Complainant's trademark and the products associated.

The Panel finds that the Respondent registered and used the disputed domain names with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's registered IQOS and TEREА trademarks as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy. Due to the fact that by reproducing the Complainant's registered trademark in the disputed domain names and the title of the Website, the Respondent is clearly suggesting to any Internet user visiting a website provided under the disputed domain names that the Complainant (or an affiliated dealer of the Complainant) is the source of the Website, which it is not. This suggestion is further supported by the Respondent's use of the Complainant's official product images accompanied by a copyright notice claiming the copyright for the Website and its contents. Additionally, the Respondent is not only using the Complainant's IQOS and TEREА trademarks for the purposes of offering for sale the IQOS System, but also for purposes of offering for sale third party products of other commercial origin. Such abusive use of the Complainant's IQOS and TEREА trademarks for purposes of promoting competing products constitutes clear evidence of the Respondent's bad faith. The Respondent changed one of the disputed domain names content from an active website, which used to display similar products to the products offer by the Complainant and under the IQOS trademark to an inactive website. This Panel consider that this type of conduct also is evidence of bad faith.

At the moment of this decision one of disputed domain names <iqosterea.com> is currently inactive. In terms of inactive domain names, section 3.3 of the [WIPO Overview 3.0](#) provides: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding."

Section 3.3 of the WIPO overview 3.0 further states:

"While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

Taking into account all the circumstances of this case, the Panel concludes that the current inactive use of this disputed domain name <iqosterea.com> by the Respondent is in bad faith, due to the fact that both of the trademarks included in that disputed domain name are renowned.

In summary, this Panel finds that the Respondent, by choosing to register and use of the disputed domain names, which are confusingly similar to the Complainant's well-known trademarks, intended to disrupt the Complainant's business. In the absence of convincing evidence and rebuttal to the contrary from the Respondent, the choice of the disputed domain names and the conduct of the Respondent are indicative of registration and use of the disputed domain names in bad faith.

The Panel therefore finds that both disputed domain names have been registered and are being used in bad faith. Therefore, the Panel sustain that the Complaint fulfils the third condition of paragraph 4(a) of the Policy.

8. 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 <iqosterea.com> and <tereaigosuae.com> be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: November 21, 2022