

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. asad ghani

Case No. D2022-4028

### **1. The Parties**

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

The Respondent is asad ghani, United Arab Emirates.

### **2. The Domain Name and Registrar**

The disputed domain name <iqosilumauae.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 28, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 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 November 1, 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 November 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 25, 2022.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on November 30, 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, Philip Morris Products S.A., is a company which is part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI").

PMI is a leading international tobacco and smoke-free products company with products sold in more than 180 countries. PMI produces and sells a controlled heating, smoke-free device under its IQOS mark into which specially designed tobacco products under the brand name HEETS, amongst others, are inserted and heated to generate a flavorful nicotine-containing aerosol. IQOS products were first launched in 2014 and are available in 71 markets across the world. The Complainant's IQOS and HEETS marks have been recognized as being well known by prior UDRP panels.

The Complainant owns a large portfolio of well-known trademarks. Among them, but by no means limited to, are the following trademark registrations:

- United Arab Emirates Trademark Registration IQOS (word) No. 211139, registered on March 16, 2016;
- United Arab Emirates Trademark Registration IQOS ILUMA (word) No. 322505, registered on March 28, 2020;
- United Arab Emirates Trademark Registration ILUMA (word) No. 322507, registered on March 28, 2020.

The disputed domain name was registered on August 15, 2022. At the time of filing the Complaint, the disputed domain name was linked to an online shop allegedly selling and offering the Complainant's IQOS System. Currently, the disputed domain name is not in use.

#### **5. Parties' Contentions**

##### **A. Complainant**

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

With respect to bad faith the Complainant specifically states that the following:

- It is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's IQOS and/or ILUMA trademarks when registering the disputed domain name. The Respondent started offering the Complainant's IQOS System immediately after registering the disputed domain name.
- The website at the disputed domain name 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/or ILUMA trademark(s) in the disputed domain name together with the geographical abbreviation for the United Arab Emirates, *i.e.* "UAE".

- Furthermore, the terms IQOS and/or ILUMA are purely imaginative terms and unique to the Complainant. The terms IQOS and/or ILUMA 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 name, without the intention of invoking a misleading association with the Complainant.

- It is also evident from the Respondent's use of the disputed domain name that the Respondent registered and used the disputed domain name 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/or ILUMA trademark(s) 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. In this regard, we may refer to the above explanations.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (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.

### **A. Identical or Confusingly Similar**

The first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The Complainant holds valid trademark registrations for IQOS, IQOS ILUMA, and ILUMA.

The disputed domain name <iqosilumauae.com> contains the trademarks IQOS, IQOS ILUMA, and ILUMA of the Complainant in their entirety with the addition of the term "uae", most likely the abbreviation for the United Arab Emirates. Since the three trademarks IQOS, IQOS ILUMA, and ILUMA of the Complainant are easily recognizable in the disputed domain name, this is sufficient to establish that the disputed domain name is confusingly similar to the Complainant's trademarks. The addition of the term "UAE" does not prevent a finding of confusing similarity.

The Panel finds the first element of the Policy has therefore been met.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

"(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

There is no evidence of the existence of any of those rights or legitimate interests in this case.

The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name.

Moreover, the Complainant has asserted that at the time of filing the Complaint, the disputed domain name resolved to a website purporting to be an official online retailer of the Complainant's IQOS System in the United Arab Emirates by using the Complainant's IQOS, IQOS ILUMA, and ILUMA trademarks in the disputed domain name together with the geographical abbreviation for the United Arab Emirates. It is the view of the Panel, this use of the disputed domain name by the Respondent does not qualify as a *bona fide* offering of products or services.

The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption. The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant must prove both that the disputed domain name was registered and used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the disputed domain name in bad faith have been considered by the Panel. The Respondent has not contested these allegations.

There is no doubt that the Respondent was aware of the Complainant's trademarks when he registered the disputed domain name given that the website reproduced not only one but three of the Complainant's trademarks.

With respect to use in bad faith, the Complainant has asserted that at the time of filing the Complaint, the disputed domain name resolved to a website purporting to be an official online retailer of the Complainant's IQOS System in the United Arab Emirates by using the Complainant's IQOS, IQOS ILUMA, and ILUMA trademarks in the disputed domain name together with the geographical abbreviation for the United Arab Emirates. It is the view of the Panel, this is evidence of bad faith.

In addition, as pointed out by the Complainant, the present Respondent was also a respondent in the prior *Philip Morris Products S.A. v. Asad Ghani*, WIPO Case No. [D2021-0552](#), where it was held that the disputed domain name in such case (<buyheetsuae.com>) was registered in bad faith by the same Respondent. The Panel takes this also as further evidence of a bad faith conduct pattern and therefore, bad faith of the Respondent.

In light of the evidence, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to his website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website and services and products offered on it under paragraph 4(b)(iv) of the Policy, and likely to disrupt the business of the Complainant.

Therefore, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and is being used in bad faith and has satisfied the third limb of the Policy, under paragraphs 4(a)(iii) and 4(b)(iv).

## 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, <iqosilumauae.com>, be transferred to the Complainant.

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Sole Panelist

Date: December 14, 2022