

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Maria Domenica Pugliese
Case No. D2022-4297

1. The Parties

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

Respondent is Maria Domenica Pugliese, Italy.

2. The Domain Name and Registrar

The disputed domain name <iqospremiumpartner.com> (“Domain Name”) is registered with Register SPA (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 11, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 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 Complainant on November 14, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 14, 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 Respondent of the Complaint, and the proceedings commenced on November 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2022.

On December 5, 2022, Respondent sent an informal communication. On December 7, 2022, the Center indicated that a UDRP proceeding may be suspended to implement a settlement agreement between the Parties.

On December 16, 2022, the Center notified the Parties that it will proceed to Panel Appointment. On December 19, 2022, Complainant requested the suspension of the proceedings. On December 19, 2022, the administrative proceeding was suspended. On December 31, 2022, Respondent sent an informal communication. On January 9, 2023, Complainant sent a request to reinstitute the proceedings. The present UDRP proceeding was reinstated as of January 11, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on January 17, 2023. 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

Complainant is part of the Philip Morris International Inc. group of companies (“PMI group”), active in the tobacco industry, with products sold in approximately 180 countries. PMI group has been transforming its business from combustible cigarettes to Reduced Risk Products (“RRP”), which PMI group defines as products that present, are likely to present, or have the potential to present less risk of harm to smokers who switch to those products versus continued smoking. One of these products, developed and sold by PMI group, is a tobacco heating system branded as IQOS. IQOS is a controlled heating device into which specially designed tobacco sticks under the brand names HEETS, HEATSTICKS or TEREAs are inserted and heated to generate a flavourful nicotine-containing aerosol (together “the IQOS System”). IQOS was first launched by PMI group in 2014. Today the IQOS System is available in approximately 71 markets across the world. Per Complainant, PMI group has invested USD 9 billion into the science and research of developing smoke-free products and extensive international sales and as a result the IQOS brand has gained considerable international reputation, with almost 19.1 million users. Per Complaint, the IQOS System products have been almost exclusively distributed through PMI group’s official IQOS stores and websites and selected authorized distributors and retailers.

Complainant is the owner of numerous IQOS trademark registrations. These include:

- Italian trademark registration IQOS (word), No. 0001626574, registered on February 17, 2015; and
- European Union trademark registration IQOS (word) No. 017681727, registered on August 20, 2018.

The Domain Name was registered on August 20, 2018, and resolved at the time of filing of the Complaint to a website (the “Website”), which was an online shop, allegedly offering for sale Complainant’s IQOS System. It contained hyperlinks which redirected one to Complainant’s official IQOS Italy website (namely “www.it.iqos.com”). The Website is prominently displaying Complainant’s registered logos within the Home page and window appearing in the user interface of the Website (*i.e.*), as well as using Complainant’s registered IQOS trademark and logo 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. Furthermore, it contains hyperlinks which redirect one to Complainant’s official Italian website. The Domain Name currently leads to a parked page.

5. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not formally reply to Complainant's contentions. She sent emails to the Center on December 5 and 31, 2022, stating that she had requested the registrar to cancel the Domain Name and that she was never asked by Complainant to transfer the Domain Name.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has demonstrated rights through registration and use on the IQOS mark.

The Panel finds that the Domain Name that incorporates Complainant's IQOS mark in its entirety plus the additional terms "premium" and "partner" is confusingly similar to the IQOS trademark of Complainant. The addition of the terms "premium" and "partner" does not prevent a finding of confusing similarity.

The generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, 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) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or
- (iii) 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 Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any formal response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complaint, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolved to the Website, which suggested falsely that it is of an affiliated entity or of an authorized partner of Complainant.

Per Complaint, at the time of registering the Domain Name, Respondent was an authorized distributor / reseller of Complainant in Italy however, such authorization did not extend to the registration and/or use of a domain name incorporating Complainant's IQOS trademarks. Upon learning of the registration of the Domain Name, Complainant attempted to amicably resolve the matter and with that failing it terminated the agreement. Although Respondent is known to the Complainant, it is not related to the Complainant or any Complainant affiliate in any way and the Respondent is not authorized to use the IQOS trademarks.

A distributor or reseller can be making a *bona fide* offering of goods and thus have a legitimate interest in a domain name only if the following cumulative requirements are met (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.)

These requirements are not cumulatively fulfilled in the present case. The Domain Name falsely suggests that the Website is an official site of Complainant or of an entity affiliated to or endorsed by Complainant. The Website extensively reproduces, without authorization by Complainant, Complainant's trademarks and logos, without any disclaimer of association (or lack thereof) with Complainant.

The Website includes no information regarding the identity of the provider of the Website, which is only identified as "IQOS PREMIUM PARTNER". This creates the false impression of an official commercial relationship between the Website and Complainant and/or that the Website is endorsed by Complainant.

Furthermore, the use of a domain name which intentionally trades on the fame of another and suggests affiliation with the trademark owner contrary to the fact cannot constitute a *bona fide* offering of goods or services (*Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#); *AB Electrolux v. Handi Sofian, Service Electrolux Lampung*, WIPO Case No. [D2016-2416](#); [WIPO Overview 3.0](#), section 2.5).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) 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 Respondent has engaged in a pattern of such conduct; or

- (iii) Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. As per Complaint, Respondent was an authorized distributor / reseller of Complainant in Italy though such authorization did not extend to the registration and/or use of a domain name incorporating Complainant's IQOS trademarks. Accordingly, it is evident that Respondent was aware of Complainant upon registering the Domain Name and, as such, its registration of the Domain Name was in bad faith.

As regards bad faith use of the Domain Name, Complainant has demonstrated that the Domain Name was used to create the Website, which prominently displayed Complainant's registered trademarks and logos, thereby giving the false impression that it was operated by Complainant or a company affiliated to Complainant or an authorised dealer of Complainant. The Domain Name operated therefore by intentionally creating a likelihood of confusion with Complainant's trademark and business as to the source, sponsorship, affiliation or endorsement of the website it resolves to. This can be used in support of bad faith registration and use (*Booking.com BV v. Chen Guo Long*, WIPO Case No. [D2017-0311](#); *Ebel International Limited v. Alan Brashear*, WIPO Case No. [D2017-0001](#); *Walgreen Co. v. Muhammad Azeem / Wang Zheng*, *Nicenic International Group Co., Limited*, WIPO Case No. [D2016-1607](#); *Oculus VR, LLC v. Sean Lin*, WIPO Case No. [DCO2016-0034](#); and [WIPO Overview 3.0](#), section 3.1.4).

Moreover, despite Complainant's termination of Respondent's agreement, Respondent has maintained the Domain Name. The Domain Name currently leads to an inactive website. The non-use of a domain name does not prevent a finding of bad faith under the circumstances of this proceeding (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy paragraph 4(a)(iii).

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 <iqospremiumpartner.com> be transferred to the Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: January 31, 2023