

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Cali Green Store, Mcglenny Ros
Case No. D2022-4968

1. The Parties

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

The Respondent is Cali Green Store, Mcglenny Ros, United States of America (“USA”).

2. The Domain Name and Registrar

The Disputed Domain Name <buy-iqos-heets.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

An original complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2022 naming the respondent as “Private Registration”. However, that name related to a different domain name rather than the Disputed Domain Name. It would appear that the Complainant annexed the wrong Whois search result. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the correct Disputed Domain Name. On December 23, 2022, the Registrar transmitted by email to the Center its verification disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Private Registration) and from the name and address contact information in the original complaint. The Registrar also confirmed that its registration agreement was in English. The Center sent an email communication to the Complainant on December 28, 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 January 3, 2023 naming as respondent the current Respondent and updating its contact details to match those provided to the Center by the Registrar.

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”).

Neither the original complaint, nor the amended complaint (the Complaint), contain any Whois information in respect of the Disputed Domain Name nor a copy of the registration agreement in use by the Registrar. The Amended Complaint includes the correct contact information about the Respondent, and the Center in fact has communicated with the Respondent using the correct information provided by the Registrar.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 25, 2023. The Panel is confident based on the material in the case file that the Respondent was duly notified in accordance with the Rules.

The Center appointed Philip N. Argy as the sole panelist in this matter on February 6, 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.

All other administrative requirements appear to have been satisfied.

4. Factual Background

In the absence of a Response the following facts, taken from the Complaint and/or the evidence accompanying it, remain uncontested.

The Complainant is a Swiss company established under the laws of Switzerland and 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 approximately 180 countries. Its brand portfolio includes MARLBORO, the world's number one international selling cigarette brand since 1972. Such historical combustible cigarettes have fallen out of favor with consumers who now favor what is known as vaping utilizing a system of heating which produces breathable vapor containing a flavored nicotine.

PMI markets a tobacco heating system called IQOS into which are inserted specially designed tobacco sticks (heat sticks) under the brand name HEETS. This combination of an IQOS-branded heating device with HEETS-branded tobacco sticks is known as the IQOS system. It was launched in Japan in 2014 and is now legally available in 71 markets across the world. PMI has invested over USD 9 billion in developing smoke-free products and extensive international sales. More than 19 million consumers worldwide have converted from smoking combustible cigarettes to vaping using the IQOS system.

In July 2016 the Complainant registered both HEETS and IQOS as trademarks in a Madrid application covering numerous countries and, in particular, USA where the Respondent is allegedly located.

The 71 markets in which the IQOS system can lawfully be sold with HEETS products do not include the USA. Although the Complainant is authorized by the (American) Food and Drug Administration to sell certain IQOS system devices with MARLBORO-branded heat sticks in USA, any sale of HEETS-branded products in or to USA is illegal.

5. Parties' Contentions

A. Complainant

The Complaint is based on the three grounds set out in the Policy, namely, that the Disputed Domain Name is identical or confusingly similar to both IQOS and HEETS being trademarks in which the Complainant has rights; that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and that the Disputed Domain Name was registered and is being used in bad faith.

In support of the first ground, Complainant alleges that the Website is purporting to be an official online retailer of the Complainant's IQOS system in the USA as well as on a global basis by using the Complainant's IQOS and HEETS trademarks in the Disputed Domain Name together with the non-distinctive and descriptive word "buy". It submits that the test for confusing similarity involves a reasoned but relatively

straightforward comparison between the complainant's trademark and the Disputed Domain Name to assess whether the mark is recognizable within the Disputed Domain Name (See Section 1.7 of the [WIPO Overview 3.0](#)). In particular, the Complainant says when a domain name includes a trademark, or a confusingly similar approximation, regardless of the other terms in the domain name it will be confusingly similar to that trademark (see *Philip Morris USA Inc. v. Steven Scully, J&S Auto Repair*, WIPO Case No. [D2015-1001](#); *Hertz System, Inc. v. Kwan-ming Lee*, WIPO Case No. [D2009-1165](#)). Thus, says the Complainant, it cannot be questioned that the Disputed Domain Name <buy-iqos-heets.com> is confusingly similar to each of the IQOS and HEETS trademarks in which the Complainant has rights.

In rounding out its submissions in support of the first ground of the Policy the Complainant notes that the ".com" generic Top-Level Domain ("gTLD") is disregarded under the first element of the Policy (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11 and the cases referenced therein). It concludes by submitting that the addition of merely generic, descriptive, or geographical wording to a trademark in a domain name would not normally be sufficient to avoid a finding of confusing similarity under the first element of the UDRP (see *Compagnie Générale des Etablissements Michelin v. PrivacyDotLink Customer 1197652 / Alex Hvorost*, WIPO Case No. [D2016-1923](#); *AB Electrolux v. ID Shield Service*, WIPO Case No. [D2015-2027](#)). The Disputed Domain Name reproduces the IQOS and HEETS trademarks in their entirety, in addition to the word "buy". The Complainant argues that the content of the Website exacerbates the unlawful association between its trademarks and the Respondent's Website.

In respect of the second limb of the Policy the Complainant notes that the Website is prominently using the Complainant's registered MARLBORO trademark within the Website banner being a location where relevant consumers usually expect to find the name of the online shop or the name of the provider of the Website. The Website is also alleged to be using a number of the Complainant's official product images without its authorization whilst at the same time claiming copyright in the material on the Website "thereby strengthening the false impression of an affiliation with the Complainant". The Complainant formally notes that it has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its IQOS and HEETS trademarks (or a domain name which will be associated with these trademarks).

Refuting in anticipation any resort the Respondent might make to defensive safe harbors in the Policy, the Complainant submits that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. On the contrary, the Respondent's behavior shows a clear intent to obtain an unfair commercial gain by misleadingly diverting consumers or to tarnish the Complainant's trademark. The Respondent is not an authorized distributor or reseller of the IQOS system, the Website is selling competing tobacco products and accessories of other commercial origin and the products being sold on the Website does not constitute a *bona fide* offering of goods because it is not confined to selling the trademarked goods, it does not disclose that the Respondent has no relationship with the Complainant and it reflects an attempt by the Respondent to deprive the Complainant of the ability to reflect its own mark in a domain name.

The Complainant regards as particularly egregious the Respondent's offering on the Website of HEETS and IQOS products and devices not authorized for sale in the USA. The Website creates the entirely false impression, says the Complainant, that it has officially introduced these products into every market in the world or at least into the USA market when it has not done so because that would be illegal. Such conduct not only cannot be considered a *bona fide* offering of goods but it cannot establish a legitimate interest on the part of the Respondent.

The Complaint alleges that the Website does not show any details regarding the provider of the Website nor acknowledge the Complainant as the real brand owner of the IQOS System, "leaving the Internet user under the false impression that the online shop provided under the Website, is that of the Complainant or that it is connected to that of the Complainant or one of its official distributors, which it is not". The Complaint also submits that the provider of the Website is using the Complainant's IQOS and HEETS trademarks in its name in circumstances where the provider of the Website is not known to the Complainant, nor authorized to use the Complainant's IQOS and HEETS trademarks.

In support of the third limb of the Policy the Complainant submits that it is evident from the Respondent's use of the Disputed Domain Name that it knew of the Complainant's IQOS and HEETS trademarks when it was registered last November because it started offering the IQOS system and HEETS products immediately thereafter. The Complainant notes that IQOS and HEETS are not commonly used to refer to tobacco products or electronic devices putting it beyond the realm of reasonable coincidence that the Respondent chose the Disputed Domain Name without any intention of invoking a misleading association with the Complainant.

The Complainant alleges that the Website contains prices in USD currency and promises that worldwide shipping is available, thus indicating that IQOS and HEETS products are being illegally offered by the Respondent for sale to consumers in USA. In support of this contention the Complainant annexes screenshots from an unidentified website prominently displaying the words "VATAGE" and "SYLTE" MARLBORO as well as embedding in the Complaint disembodied images of HEETS (and third party competing) products in what appears to be a catalogue-style display format with "add to cart" associated text but otherwise with no apparent context or source. The provided screenshots include references to VAT, which the Panel understands is a Value Added Tax imposed on products sold in the United Kingdom.

The Complainant submits that the foregoing conduct on the Respondent's part is evidence 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 HEETS trademarks and therefore as to the source, sponsorship, affiliation or endorsement of its website or the location of a product or service on its website which conduct constitutes the end registration and use in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

The Complainant otherwise repeats points made in relation to the second limb which it says additionally demonstrate registration and use in bad faith of the Disputed Domain Name.

In conclusion the Complainant says that use of a privacy protection service to hide its identity may in itself constitute a factor indicating bad faith (see [WIPO Overview 3.0](#), para. 3.6 and the cases referenced therein).

B. Respondent

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

6. Discussion and Findings

Despite the absence of a Response the onus remains on the Complainant to make out each of the grounds of the Policy and these are dealt with sequentially below.

A. Identical or Confusingly Similar

The evidence is conclusive that the Complainant is the registered proprietor of numerous registered trademarks for both IQOS and HEETS in respect of relevant products in numerous countries including USA.

It is equally clear under the Policy that a domain name in which a registered trademark is embedded with nothing else other than a common word and a gTLD must be regarded as confusingly similar to that trademark.

Where, as here, two registered trademarks are embedded, both belonging to the Complainant, the confusing similarity is multiplied and reinforced.

The Panel is satisfied that the first limb of the Policy has been made out by the Complainant.

B. Rights or Legitimate Interests

Whilst the separate annexure said to contain screenshots of the Respondent's website as at December 22, 2022 does indeed contain a footer suggesting that it was taken from a website to which the Disputed Domain Name resolved at that time, it differs in many respects from the website to which the Disputed Domain Name currently resolves. However, the Panel does note that links embedded in the annexure asserted by the Complainant to be excerpts and screenshots from the Website do direct to the Disputed Domain Name. For example, selecting an HEETS product in the annexure relating to the Disputed Domain Name, direct to the Website offering that product for sale, though in a different lay-out than evidenced.

Nevertheless, when the contents of the Respondent's current website are considered together with the lack of authority for the Respondent to use the Complainant's trademarks, and the offering for sale of IQOS and HEETS branded products on the Respondent's website, as well as references to USA as a target market and the fact that the sale of HEETS products in USA is illegal, the Panel is satisfied that the second limb of the Policy has been made out by the Complainant.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent is the registrant of the Disputed Domain Name; that is proven by the Registrar's response to the Center's initial queries.

It is equally clear that the Disputed Domain Name resolves to a website in which HEETS and other brands of heated tobacco products are offered for sale in USA, which is illegal. That illegality is sufficient to remove any legitimacy from whatever interests the Respondent might have been able to demonstrate had it bothered to respond to the Complaint and also more than sufficient to constitute bad faith for the purposes of the third limb of the Policy.

In addition to the third limb of the Policy having been made out on first principles, it is also clear that the Respondent's misleading conduct on its real website falls clearly within paragraph 4(b)(iv) of the Policy, thus satisfying the third limb of the Policy by that alternative means.

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 <buy-iqos-heets.com> be transferred to the Complainant.

/Philip N. Argy/

Philip N. Argy

Sole Panelist

Date: February 20, 2023