

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Md Shohel
Case No. D2023-0014

1. The Parties

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

The Respondent is Md Shohel, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <i-iluma-abudhabi.com> (the “Domain Name”) is 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 January 3, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 4, 2023, 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 the Complainant on January 4, 2023 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 5, 2023.

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 January 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 31, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on February 3, 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

The Complainant is a tobacco company, which is part of the group of companies affiliated with Philip Morris International Inc., an international tobacco company. The Complainant is the owner of several IQOS ILUMA and ILUMA trademarks worldwide, including:

- United Arab Emirates Registration No. 322506 for the ILUMA mark, registered on March 28, 2020;
- United Arab Emirates Registration No. 322505 for the IQOS ILUMA mark, registered on March 28, 2020;

The Domain Name was registered on May 12, 2022. The Domain Name used to direct to a website in English that offered for sale purported IQOS ILUMA products, systems and compatible tobacco sticks in Abu Dhabi. The website at the Domain Name did not provide any information about its owner, which was identified only as “Phlox” or “Phlox shop”. The website also displayed a copyright notice: “2022©. My blog” and the Complainant’s *prima facie* copyrighted images of its products. After the Respondent was notified about this proceeding, the Domain Name ceased resolving to an active site.

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows:

The Domain Name is confusingly similar to the Complainant’s ILUMA trademark, registered in the United Arab Emirates and other countries, because the Complainant’s trademarks constitute the dominant element of the Domain Name. The difference between the Complainant’s ILUMA trademark and the Domain Name is not sufficient to overcome the confusing similarities.

The Respondent is not making a legitimate noncommercial or fair use of the Domain Name, because the Respondent’s behavior shows an intent to obtain an unfair commercial gain. The Respondent is not an authorized distributor or reseller of the IQOS System. In addition, the website under the Domain Name does not meet the requirements for a *bona fide* offering of goods, because: (i) the composition of the Domain Name suggests an affiliation with the Complainant and its ILUMA mark; (ii) the owner / administrator of the website, prominently and without authorization presents the Complainant’s registered ILUMA trademark and the Complainant’s official product images; (iii) the website claims copyright in the Complainant’s copyrighted material appearing on the website; (iv) the website provides no information regarding the identity of the provider of the website, which is only identified as “IQOS Iluma Prime in Abu Dhabi”. Because the Complainant’s IQOS System is primarily distributed through official/endorsed stores, consumers will mistakenly believe that the website under the Domain Name belongs to an official/endorsed distributor.

The Respondent’s registration and use of the Domain Name constitutes bad faith. The Respondent knew of the Complainant’s ILUMA trademark at the time of the Domain Name registration. The Respondent chose the Domain Name intending to invoke a misleading association with the Complainant because the term “Iluma” is imaginative and unique to the Complainant. The Complainant claims that the Respondent registered and is using the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s registered ILUMA trademark as to the source, sponsorship, affiliation, or endorsement of its website or its services. By reproducing the Complainant’s trademark in the Domain Name and by using the Complainant’s product images, the Respondent’s website suggests the affiliation between the Complainant and the Respondent. The

Complainant states that the Respondent's use of a privacy protection service to hide its true identity may in itself constitute a factor indicating bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns a trademark registration for the ILUMA trademark. Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

"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" (section 1.8, [WIPO Overview 3.0](#)). It is well-established that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement. Section 1.11.1, [WIPO Overview 3.0](#).

The Domain Name consists of the letter "i", a hyphen, the Complainant's ILUMA trademark in its entirety, the words "abudhabi" and the gTLD ".com". Because the Complainant's ILUMA trademark is recognizable within the Domain Name, neither the addition of the geographical term "Abu Dhabi", nor the addition of the hyphen or the letter "i", prevents a finding of confusing similarity. The gTLD ".com" is disregarded as a standard registration requirement. Therefore, the Domain Name is confusingly similar to the Complainant's ILUMA trademark.

The Complainant has satisfied the first element of the UDRP.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on the evidence, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice 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 (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent 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.

To prove the second UDRP element, the Complainant must make out a *prima facie* case¹ in respect of the lack of rights or legitimate interests of the Respondent.

The Panel finds that the Complainant satisfied its burden of proof for the following reasons. First, the evidence on file shows that the Respondent has not been commonly known by the Domain Name because the Respondent's name is reportedly Md Shohel and its store name is supposedly Phlox shop. Second, the Complainant contends, and the Respondent does not deny that the Complainant did not authorize the Respondent's use of the Complainant's trademark in the Domain Name. Third, the Respondent is not making legitimate noncommercial or fair use of the Domain Name, because the Respondent used to use the Domain Name, which suggests affiliation between the Complainant and the Respondent², to direct to an online store selling purported IQOS ILUMA products.

Fourth, the Respondent's use of the Domain Name does not satisfy requirements of *bona fide* offering of goods and services. Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant's trademark to undertake sales of the complainant's goods may be making a *bona fide* offering of goods and thus have a right or legitimate interest in such domain names in some situations.

Outlined in the Oki Data case³, the following cumulative requirements must be satisfied for the respondent to make a *bona fide* offering of goods and services:

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iv) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (v) the respondent must not try to corner the market in domain names that reflect the trademark.”⁴

The Panel finds the Respondent's use of the Domain Name does not amount to a *bona fide* offering of goods and services because that the website at the Domain Name suggests affiliation between the Complainant and the Respondent by displaying official images of the Complainant's products and offering for sale purported IQOS ILUMA System, which is primarily distributed through the Complainant's official or endorsed stores. While the website under the Domain Name refers to “Phlox shop”, this information is buried in the website. No specific information about the owner of the website or about its lack of affiliation between the Complainant and the Respondent is provided, let alone accurately and prominently disclosed on the website under the Domain Name.

For the reasons stated, the Panel finds that the Complainant has made a *prima facie* case in respect to the lack of rights or legitimate interests of the Respondent in the Domain Name. Once a complainant makes a *prima facie* case, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Domain Name. The Respondent has failed to do so.

¹ Section 2.1, [WIPO Overview 3.0](#).

² See, Section 2.5, [WIPO Overview 3.0](#). Prior UDRP panels held that use of a domain name consisting of a trademark plus additional term cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

³ *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

⁴ Section 2.8, [WIPO Overview 3.0](#).

Therefore, the Complainant has satisfied the second element of the UDRP.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must prove that the Domain Name was registered and is being used in bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), “bad faith” registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to source, sponsorship, affiliation or endorsement of the respondent’s website or location, or of a product or service on the respondent’s website or location. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found “the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark:… (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent’s commercial benefit, even if unsuccessful, (iii) the lack of a respondent’s own rights to or legitimate interests in a domain name, … (vi) absence of any conceivable good faith use”.

In addition, the website at the Domain Name was designed to look like a website of an official or authorized reseller of the Complainant’s products in Abu Dhabi. The Respondent’s website prominently displays the Complainant’s IQOS and IQOS ILUMA trademarks and it appears, the Complainant’s photographs of its products. The website at the Domain Name comprises the Complainant’s registered ILUMA and IQOS ILUMA mark and the term Abu Dhabi (where the Complainant’s sells its products), and does not prominently display information about its owner. While the website references to the “Phlox Shop”, such information is buried in the text appearing on the site. The Panel concludes that the Respondent registered and is using the Domain Name to intentionally attempt to attract, for commercial gain, the Internet users to the Respondent’s website or other online location, by creating a likelihood of confusion with the Complainant’s mark as to source, sponsorship, affiliation or endorsement of the Respondent’s website or location, or of a product or service on the Respondent’s website or location. Such use is in bad faith.

Finally, the Panel notes that the Respondent’s current non-use or passive holding of the Domain Name, given the circumstances on this case, constitutes further evidence of the Respondent’s bad faith. It is well-established that non-use of a domain name would not prevent finding of bad faith. The Respondent’s failure to submit a response, its registration of the Domain Name incorporating the distinctive the Complainant’s trademark and the Respondent’s prior bad-faith use of the Domain Name that makes any good faith use of the Domain Name implausible have all been found to support finding of bad faith by prior panels. Therefore, the totality of circumstances of this case indicate that the Respondent is registered and is using the Domain Name in bad faith.

The Complainant has satisfied the third element of the UDRP.

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 <i-iluma-abudhabi.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: February 17, 2023