

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Al Emran, Nobo Digital Case No. D2023-1649

1. The Parties

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

The Respondent is Al Emran, Nobo Digital, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <heetsvapehero.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 April 14, 2023. On April 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 18, 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 (Private Registration) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 21, 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 April 24, 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 April 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on June 16, 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 part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI"). PMI is a tobacco and smoke-free products manufacturing company. It sells its products in approximately 180 countries.

PMI has developed a tobacco heating system called IQOS. It is a heating device into which tobacco products under the brand names "HEETS", "HEATSTICKS" or "TEREA" are inserted and heated to generate a nicotine-containing aerosol (collectively referred to as the "IQOS System"). Currently, the IQOS System is available in around 71 markets across the world. To date, the IQOS System has been almost exclusively distributed through PMI's official stores and websites and selected authorized distributors and retailers.

The Complainant is the owner of numerous HEETS trademark registrations, including:

- the United Arab Emirates Trademark Registration HEETS No. 256867 registered on December 25, 2017; and
- the International Trademark Registration HEETS No. 1326410 registered on July 19, 2016.

The Domain Name was registered on February 6, 2023.

At the time of submitting the Complaint, the Domain Name resolved to an online shop allegedly offering for sale the Complainant's IQOS System and the competing third party products, as well as reproducing the Complainant's HEETS trademark (the "Website").

5. Parties' Contentions

A. Complainant

The Complainant requests that the Domain Name be transferred to the 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 Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid HEETS trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term “vapehero” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant’s HEETS trademark. UDRP panels have consistently held that 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 section 1.8, [WIPO Overview 3.0](#).

The generic Top-Level Domain (“gTLD”) “.com” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s HEETS trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the Complainant’s HEETS trademark registrations predate the Respondent’s registration of the Domain Name. There is no evidence in the case

record that the Complainant has licensed or otherwise permitted the Respondent to use the HEETS trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a *bona fide* offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name.

The Respondent could make a *bona fide* offering of goods and services as a reseller or distributor of the Complainant's products, and thus have a legitimate interest in the Domain Name, if its use meets certain requirements as set out in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). These requirements are that: (1) the Respondent must actually be offering the goods or services at issue; (2) the Respondent must use the website to sell only the trademarked goods, otherwise, it could be using the trademark to bait Internet users and then switch them to other goods; (3) the Website must accurately disclose the Respondent's relationship with the trademark owner; and (4) the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in the Domain Name.

In the present case, the above referred requirements are not met.

First, the Respondent does not sell on the Website only the Complainant's trademarked goods, but also the competing tobacco products and/or accessories of other commercial origin, primarily for the customers in the United Arab Emirates.

Second, the Domain Name and the Website suggest at least an affiliation with the Complainant and its HEETS trademark, while the Respondent is not an authorized distributor or reseller of the IQOS System. The use of the Complainant's HEETS trademark in the Domain Name and on the Website, as well as the use of the Complainant's official product images mislead consumers, as they may falsely believe that the Respondent is an official/endorsed distributor of the Complainant's IQOS products. At the same time, the identity of the Respondent, as well as the relationship between the Respondent and the Complainant (or a lack thereof) is not disclosed on the Website. This further perpetuates the false impression of a relationship between the Respondent and the Complainant.

In sum, the Respondent's use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or

- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the HEETS trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Domain Name. This finding is supported by the content of the Website allegedly offering the Complainant's IQOS System, as well as displaying the Complainant's HEETS trademark and the official product images. Moreover, it has been proven to the Panel's satisfaction that the Complainant's HEETS trademark is well known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's HEETS trademark.

Furthermore, the Domain Name is being used in bad faith by the Respondent to allegedly offer for sale the Complainant's IQOS System, as well as competing third party products. By reproducing the Complainant's registered HEETS trademark in the Domain Name and on the Website, together with the Complainant's official marketing materials accompanied by a false copyright notice, the Respondent suggests to be an official online retailer of the Complainant's products. There is thus little doubt that the Respondent intended to earn profit from the confusion created with Internet users. In consequence, the Panel finds that the Respondent registered and used the Domain Name deliberately in order to take advantage of the Complainant's reputation and to give credibility to its operations.

Finally, the Respondent's use of a privacy service that concealed registrant information is a further evidence of bad faith.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements under paragraph 4(a)(iii) of the Policy.

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 <heetsvapehero.com> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: June 30, 2023