

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Shahadat Hossain
Case No. D2023-1869

1. The Parties

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

The Respondent is Shahadat Hossain, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <vapeiqonline.com> (the “Domain Name”) is registered with Purple IT Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2023. On April 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 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 May 9, 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 May 10, 2023. The Center received an email communication from the Respondent on May 10, 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 May 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2023. The Center notified the commencement of Panel appointment process on June 6, 2023.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on June 15, 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 part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as "PMI"), a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries. PMI *inter alia* sells a tobacco heating system called IQOS which is available in cities in around 71 markets across the world and is almost exclusively distributed through PMI's official IQOS stores and websites and selected authorized distributors and retailers.

With respect to the IQOS system, the Complainant owns *inter alia* the following trademark registrations (hereafter the "Trade Marks"):

- United Arab Emirates word mark IQ registered under No. 322648 on December 18, 2019;
- Andorra word mark IQ registered under No. 40687 on November 5, 2019;
- United Arab Emirates word mark IQOS registered under No. 211139 on March 16, 2016;
- United Arab Emirates word mark HEETS registered under No. 256864 on December 25, 2017.

The Domain Name was registered on May 6, 2021 and resolves to a website with an online shop (the "Website"). The Website is provided in English and prices are indicated in United Arab Emirates Dirham currency, and presents the address of "Dragon Mart, International city, Dubai, UAE". On the Website, several of the Trade Marks are used in connection with images of products for the Complainant's IQOS system, as well as third party products of other commercial origin and third party accessories.

5. Parties' Contentions

A. Complainant

The Complainant submits that the Domain Name is identical or similar to the Trade Marks as it reproduces the IQ mark in its entirety and/or a mark highly similar/phonetically almost identical to the IQOS mark, in addition to the non-distinctive and descriptive words "vape" and "online".

According to the Complainant, the addition of merely generic, descriptive, or geographical wording to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity. Furthermore, the Complainant states that the generic Top-Level Domain in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Complainant contends that it has made a *prima facie* case that the Respondent lacks any rights or legitimate interests in the Domain Name. The Complainant states that it has not licensed or otherwise permitted the Respondent to use any of the Trade Marks or to register a domain name incorporating the IQ or IQOS marks. According to the Complainant, the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, its behavior showing a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the Trade Marks. The Complainant states that the Respondent is not an authorized distributor or reseller of the IQOS system, while the Website is also offering competing tobacco products and/or accessories of other commercial origin for sale. According to the Complainant, the Domain Name falsely suggests an affiliation with the Complainant and the Trade Marks, while the Website without authorization presents the Trade Marks (or a highly similar/phonetically almost identical mark) within the tab interface of the Website, where relevant consumers will usually expect to find the name of the online shop and/or the name of the website provider. Furthermore, the Complainant points

out, the Website uses the Complainant's official product images without authorization, while at the same time falsely claiming copyright in this material, thereby supporting the false impression that the Website is endorsed by the Complainant. The Complainant states that the Website includes no information regarding the identity of the provider of the Website, which is only identified as "Vape IQ online", being a name which similarly includes the IQ mark and/or the IQOS mark and further serves to perpetuate the false impression of an official commercial relationship between the Website and the Complainant. The Complainant contends that the disclaimer, stating that the Website is not endorsed nor affiliated with PMI and that the store is not an official website for PMI and IQOS, is inaccurate and not presented in a clear and sufficiently prominent manner and therefore not sufficient to clarify the relationship between the Website and the Complainant. Furthermore, the Complainant submits that its IQOS system is primarily distributed through endorsed stores and that Internet users are misled regarding the relationship between the Website and the Complainant, falsely believing the Website under the Domain Name to be from an endorsed distributor of the Complainant.

According to the Complainant, it is also evident from the Respondent's use of the Domain Name, as set out above, 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 Trade Marks 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. The Complainant adds that it is evident from the Respondent's use of the Domain Name that the Respondent knew of the Trade Marks when registering the Domain Name as it started offering the IQOS system immediately after registering the Domain Name. Furthermore, the Complainant points out, the terms IQ and IQOS are purely imaginative terms, unique to the Complainant and not commonly used to refer to tobacco products or electronic devices.

Finally, the Complainant points out that the fact that the Respondent is using a privacy protection service to hide its true identity may in itself constitute a factor indicating bad faith.

B. Respondent

The Respondent sent an email communication on May 10, 2023 stating:

"I am very sorry to inform you that the complaint made against my domain vapeiqonline.com is not true, vapeiqonline.com only buys the products from the store and delivers them properly to the customer's home, vapeiqonline.com only buys the products from outside to the customer. Providing home delivery services, now if the domain is closed vapeiqonline.com will incur a huge loss of 10000 dollars. vapeiqonline.com spent 10000/dollars to develop the website and do SEO marketing for the website, vapeiqonline.com If any kind of product is closed before buying and selling from the store then this 10000/ dollars spent domain website will be a complete loss.

We are poor people, we distribute the products to poor people's homes and collect food, we have a request not to close this vapeiqonline.com domain.

It is a humble request to you that our domain should not be blocked, and if it is blocked, we should be compensated 10000/dollars. If it gets shut down, we will shut it down ourselves if the website pays back the cost of SEO marketing, development, etc."

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it wholly incorporates the IQ mark. The addition of the descriptive terms "vape" and "online" does not avoid a finding of confusing similarity between the Domain Name and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition

(“[WIPO Overview 3.0](#)”), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#) and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The generic Top Level Domain “.com” is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11.1).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has registered rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the Complainant has to make out a *prima facie* case that the Respondent does not have rights to or legitimate interests in the Domain Name upon which the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Domain Name ([WIPO Overview 3.0](#), section 2.1). Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent is not an authorized dealer and has not received the Complainant’s consent to register or use the Domain Name or make any other use of the Trade Marks. The Respondent has not provided evidence, nor is it *prima facie* evident that its use of the Trade Marks and the Domain Name has resulted in it becoming commonly known by the Domain Name (paragraph 4(c)(ii) of the Policy). The Domain Name resolves to a website on which products of the Complainant and those of competitors are offered for sale. Therefore, the Respondent cannot (and in fact does not) show that it is making a legitimate noncommercial or fair use of the Domain Name (paragraph 4(c)(iii) of the Policy). The Panel concludes that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name.

This leaves the question whether the Respondent’s use of the Domain Name prior to the notice of the dispute at the time of filing the Complaint can be considered to be in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. In this connection, the Complainant in the Complaint has referred to the criteria of the Oki Data decision (*Oki Data Americas, Inc., v. ASD Inc.*, WIPO Case No. [D2001-0903](#)). In accordance with that decision, a service provider, such as the Respondent, using a domain name containing the complainant’s trade mark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name only if the following conditions are satisfied: (1) the respondent must actually be offering the goods or services at issue; (2) the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trade mark in a domain name to bait consumers and then switch them to other goods); (3) the site itself must accurately disclose the respondent’s relationship with the trade mark owner; and (4) the respondent must not try to “corner the market” in all relevant domain names, thus depriving the trade mark owner of the ability to reflect its own mark in a domain name. Subsequent decisions have held that the Oki Data criteria also apply to distributors and resellers of goods or services (see *inter alia* *Research in Motion Limited v. One Star Global LLC*, WIPO Case No. [D2009-0227](#)).

The Respondent’s use of the Domain Name does not meet the Oki Data criteria.

The Complainant has not refuted that the Respondent through the Website sells its IQOS system products.

However, the Respondent does not sell only the trademarked goods, but also those of competitors (second Oki Data requirement) and does not accurately disclose its relationship with the Complainant (third Oki Data requirement). In the Panel’s view, the first (but incorrect) impression for the Internet user who types in the Domain Name and subsequently views the home page of the Website will most likely be that the Respondent is in some way linked to the Complainant, whether through affiliation, approval, as an authorized dealer, or otherwise. The disclaimer, displayed in very thin lettering at the bottom of the home page at the same level as the copyright notice and the technical support notice (both in much bolder print), does not prominently disclose the Respondent’s relationship with the Complainant and would normally be overlooked by Internet users who would visit the Website looking for IQOS system products.

Therefore, the Respondent's use of the Domain Name prior to the notice of the dispute cannot be considered to be in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

It is evident that the Respondent knew or should have been aware of the Trade Marks prior to registering the Domain Name, since:

- the Respondent's registration of the Domain Name occurred almost five years after the registration of the earliest of the Trade Marks;
- the Respondent has incorporated IQ, of which a number of the Trade Marks consist, in its entirety, together with the word "vape", which is a direct reference to the products marketed and sold by the Complainant under the Trade Marks; and,
- a simple trade mark register search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks.

In view of these circumstances and (i) the fact that the Domain Name includes the IQ mark in its entirety; (ii) the use of the Trade Marks on the Website as well as images of the Complainant's products; (iii) the offering on the Website of products competing with products of the Complainant; and (iv) the lack of a disclaimer on the Website accurately and prominently disclosing the Respondent's relationship with the Complainant, the Panel concludes that the Respondent registered and used the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the website or other online location creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation or endorsement of the website or location or of the services on the Website, in accordance with paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith.

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 <vapeiqonline.com> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: July 4, 2023