

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Yiiri Matveev  
Case No. D2023-2739

### **1. The Parties**

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

The Respondent is Yiiri Matveev, Ukraine.

### **2. The Domain Name and Registrar**

The disputed domain name <iqosdonetsk.com> is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on June 27, 2023. On June 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed 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 July 3, 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 in English on July 4, 2023.

On July 3, 2023, the Center sent a communication to the Parties in Russian and English in relation to the language of the proceeding. On July 4, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comments on the language of the proceeding or on the Complainant's request.

The Center verified that the Complaint and 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 in both Russian and English, and the proceedings commenced on July 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 22, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on August 31, 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 affiliated to Philip Morris International Inc., which is a leading international tobacco company with products sold in about 180 countries. The Complainant's group of companies has developed the IQOS system – a heating device into which specially designed tobacco products are inserted and heated to generate a nicotine-containing aerosol. The IQOS system is now available in key cities in 71 countries through official IQOS stores and websites and selected authorized distributors and retailers and has about 19.1 million users.

The Complainant is the owner of the following trademark registrations for the signs IQOS (the "IQOS Trademark"):

- the International trademark IQOS with registration No. 1218246, registered on July 10, 2014 for goods in International Classes 9, 11 and 34; and
- the International trademark IQOS (figurative) with registration No. 1338099, registered on November 22, 2016 for services in International Class 35.

The Complainant is the owner of the following trademark registrations for the signs HEETS (the "HEETS Trademark"):

- the International trademark HEETS with registration No. 1326410, registered on July 19, 2016 for goods in International Classes 9, 11 and 34; and
- the International trademark HEETS (figurative) with registration No. 1328679, registered on July 20, 2016 for services in International Classes 9, 11 and 34.

The disputed domain name was registered on May 25, 2023. It is currently deactivated. At the time of filing of the Complaint, it resolved to a Russian language online shop offering for sale the Complainant's tobacco products for the IQOS system and third party products. The website had the following header: "Купить стики для iqos (Айкос), жижи, поды в Донецке" (in English: "Buy sticks for Iqos, liquids, pods in Donetsk").

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its IQOS Trademark, because it reproduces this trademark in its entirety with the addition to the geographical indication "Donetsk".

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been licensed by the Complainant to use the IQOS Trademark or to register a domain name incorporating it. In the Complainant's view, the Respondent's behavior shows an intent to obtain commercial gain by misleadingly diverting consumers, because the website at the disputed domain name is selling the Complainant's products and also competing tobacco products and accessories of other commercial origin. The Complainant notes that the Respondent presents the Complainant's HEETS Trademark appearing at prominent positions at top of the website at the disputed domain name and the Complainant's IQOS Trademark in the header of the same website where relevant consumers will usually expect to find the name of the online shop or the name of the website provider. The Complainant adds that the website at the disputed domain name uses the Complainant's official product images without authorization, while at the same time claiming copyright in this material. It states that this illegitimate and false claim of rights in the Complainant's official copyright protected material supports the false impression that the website at the disputed domain name is endorsed by the Complainant. The Complainant notes that the website at the disputed domain name includes no information regarding the identity of its provider, which is only identified as "PARLIFE VAPESHOP" on the website at the disputed domain name. The Complainant states that Internet users would be misled regarding the relationship between the website at the disputed domain name and the Complainant, and will falsely believe the website at the disputed domain name to be an official distributor of the Complainant.

The Complainant contends that the disputed domain name was registered and is being used in bad faith.

The Complainant maintains that the Respondent knew of the Complainant's IQOS Trademark when registering the disputed domain name, as it started offering the Complainant's IQOS products immediately after registering the disputed domain name. The Complainant adds that the term IQOS is purely imaginative and unique to it and is not commonly used to refer to tobacco products or electronic devices. According to the Complainant, the Respondent chose the disputed domain name with the intention of invoking a misleading association with the Complainant to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant's IQOS Trademark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name or location or of a product or service on the website at the disputed domain name or location.

The Complainant maintains that by reproducing the Complainant's IQOS Trademark in the disputed domain name and the header of the website at the disputed domain name, the Respondent misleads Internet users visiting the website at the disputed domain name that the Complainant or an affiliated dealer of the Complainant is the source of this website. According to the Complainant, this suggestion is further supported by the Respondent's use of the Complainant's official product images accompanied by a copyright notice claiming the copyright for the website at the disputed domain name and its contents. The Complainant adds that the Respondent is not only using the Complainant's IQOS Trademark for the purposes of offering for sale the Complainant's specially designed HEETS tobacco products, but also for purposes of offering for sale third-party products of other commercial origin.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Procedural issue – Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including that English is a common language in global business, that it could be presumed that the Respondent has knowledge of the English language, while the Complainant is not capable of providing the Complaint in Russian without unreasonable effort and costs, that the disputed domain name is in Latin script and not in Cyrillic script, that the website at the disputed domain name includes a number of English words and phrases, suggesting the Respondent understands English.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainants' request that the proceedings be conducted in English.

Having considered all the matters above, the Panel considers that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **6.2. Further Procedural Considerations – Location of the Respondent**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition. The location of the Respondent disclosed by the Registrar appears to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification. It is therefore appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

The record shows that the Center's written notice could not be delivered by postal-mail to the Respondent's mailing address disclosed by the Registrar, in terms of the paragraph 2(a)(i) of the UDRP Rules. However, it appears that the Notification of Complaint's emails were delivered to the Respondent's email address, as provided by the Registrar. There is no evidence that the case notification was not successfully delivered to the disclosed Respondent's email address. The Notification of Complaint and the written communication were also sent by the Center via the Registrar's privacy protection email address for the disputed domain name and at the privacy service postal address, and both Notification of Complaint emails and written communication were delivered.

As noted above, the Complainant has submitted evidence showing that the disputed domain name previously resolved to a website that displayed the Complainant's IQOS and HEETS Trademarks and offered tobacco products. Following the submission of the Complaint, the disputed domain name was deactivated. The Respondent thus appears to be capable of controlling the disputed domain name and its content and that, having apparently received notification of the Complaint by email, it would have been able to formulate and file a Response in the administrative proceeding in case it wished to do so.

The Panel concludes that the Respondent allegedly located in Ukraine has been given a fair opportunity to present its case, and so that the administrative proceeding takes place with due expedition, the Panel will proceed to a Decision accordingly.

### 6.3. Substantive Issues

#### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the IQOS Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the IQOS Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, "Donetsk" – the name of a large Ukrainian city), may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

#### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

As summarized in section 2.8.1 of [WIPO Overview 3.0](#), panels under the Policy have recognized that resellers and distributors using a domain name containing the complainant's trademark to undertake sales of the complainant's goods may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name, if they comply with certain cumulative requirements, among which are the requirements that the reseller's or distributor's website must accurately and prominently disclose its relationship with the trademark holder and must offer only the trademarked goods.

These requirements have not been complied with by the Respondent. The evidence in the case, which has not been disputed by the Respondent, shows that it has used the disputed domain name for a website that offered for sale the Complainant's products for its IQOS system alongside third-party products, while displaying the Complainant's IQOS and HEETS Trademarks and official product images in the website without authorization by the Complainant, claiming copyright in the website and not disclosing the lack of relationship between the Parties. It appears that the Respondent, being aware of the goodwill of the

Complainant's IQOS and HEETS Trademarks, has registered and used the disputed domain name in an attempt to exploit the trademarks' goodwill to attract and mislead Internet users that the Respondent's website offering the Complainant's and third-party products has been authorized by the Complainant and is commercially linked to it. Such conduct does not appear to be legitimate and giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

Based on the available record, the Panel therefore finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

As discussed above, the disputed domain name is confusingly similar to the IQOS Trademark and has been linked to a website that offered the Complainant's IQOS products alongside third-party products and displayed the Complainant's IQOS and HEETS Trademarks and product images, claiming copyright in the website without disclosing the lack of relationship with the Complainant.

Taking the above into account, the Panel accepts that it is more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the IQOS Trademark in an attempt to attract traffic to the disputed domain name by confusing Internet users that they are reaching an official or authorized online location where the Complainant's IQOS products are offered for sale, and has used the disputed domain name to offer the Complainant's and third-party products for commercial gain. This supports a finding of bad faith under paragraph 4(b)(iv) of the Policy.

The fact that the disputed domain name is currently deactivated does not affect the above conclusions, as its deactivation took place after the submission of the Complaint.

Based on the available record, the Panel therefore finds the third element of the Policy has been established.

### **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, <iqosdonetsk.com>, be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: September 4, 2023