

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Sheikh Mohammad Raihan Uddin,  
Unique Online Communication  
Case No. D2023-4719

### **1. The Parties**

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

The Respondent is Sheikh Mohammad Raihan Uddin, Unique Online Communication, Bangladesh.

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

The disputed domain name <vapeiqosdubai.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2023. On November 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 14, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 20, 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 November 21, 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 November 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 12, 2023.



The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on December 18, 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.

On December 21 and 28, 2023, the Center received two informal communications from the Respondent. On December 26, 2023, the Panel requested an extension of the Decision due date. On December 27, 2023, the Center notified the parties of the extension of the Decision due date.

#### **4. Factual Background**

The Complainant is a world-renowned company specialized in the selling of tobacco and smoke-free products since 1972.

The Complainant is the owner of several registered trademarks incorporating the terms “iqos” to promote its unique tobacco heating system called IQOS, and IQ trademarks including (the “IQOS Trademarks”):

- the International wordmark IQOS, No. 1218256 registered on July 10, 2014, for products and services in classes 9, 11 and 34;
- the International semifigurative mark , No. 1329691 registered on August 10, 2016, for products and services in class 9, 11 and 24;
- the International semifigurative mark  No. 1338099, registered on November 22, 2016, for services in class 35.

The Disputed Domain Name was registered on June 28, 2021, and resolves to an online shop directed to the United Arab Emirates, purportedly selling, and offering the Complainant's products commercialized under the IQOS Trademarks without its authorization, as well as competing third party products.

#### **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.

Notably, the Complainant contends that the Disputed Domain Name is identical or confusingly similar to a trademark in which it has rights. The Complainant argues that it has registered its IQOS Trademarks in numerous jurisdictions including the United Arab Emirates. The Complainant considers that the Disputed Domain Name identically incorporates its IQOS Trademarks. The Complainant submits that the addition of merely descriptive word “vape” and the geographical indication “dubai” to its IQOS Trademarks in the disputed domain name is insufficient in itself to avoid a finding of confusing similarity.

Then, the Complainant stands that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant explains 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 trademark (or a domain name which will be associated with this trademark). The Complainant considers that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name and that on the contrary the Respondent's behavior is evidence of its intent to obtain an unfair commercial gain and to tarnish the Complainant's IQOS Trademarks. Indeed, the Complainant indicates that the Respondent is not an authorized distributor or reseller of its IQOS system, and secondly that competing products are sold on the website to which the Disputed Domain Name resolves. The Complainant adds that the Respondent is not making a *bona fide* offering of goods and service since it does not only sell the Complainant's trademarks goods and since it does not disclose its relationship, or lack thereof, with the Complainant.

The Complainant highlights that the Respondent is suggesting its affiliation with the Complainant since its IQOS Trademarks are reproduced on several occasions on the website linked to the Disputed Domain Name.

Finally, the Complainant, asserts that the Disputed Domain Name was registered and is used in bad faith by the Respondent. The Complainant considers that it is obvious, from the use of the Disputed Domain Name, that the Respondent knew of the Complainant's IQOS Trademarks, when registering the Disputed Domain Name. The Complainant indicates that the term IQOS is a purely imaginative term and unique to the Complainant. The Complainant also considers that the intent of the Respondent when registering the Disputed Domain Name was to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's registered IQOS Trademarks as to the source, sponsorship, affiliation, or endorsement of its website. The Complainant stands that the Respondent is clearly suggesting to any Internet user visiting its website linked to the Disputed Domain Name that the Complainant is at the origin of the website which is not the case. Finally, the Complainant submits that the Respondent is making an abusive use of the IQOS Trademarks for promoting competing products which constitutes a clear-cut trademark infringement and a clear evidence of the Respondent's bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions. However, the Respondent sent an informal communication on December 21, 2023, via email, to the Center comprising of a settlement proposal.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

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

### **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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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 Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the Complainant's IQOS mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "vape" and "dubai" may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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.

Indeed, it appears that the Respondent has not received any authorization to use the IQOS Trademarks in any manner, including for the registration of the Disputed Domain Name.

Moreover, the Respondent is using the Disputed Domain Name to apparently sell, without any authorization, products of the Complainant sold under the IQOS Trademarks. The Respondent is also apparently selling products from the Complainant’s competitors. Finally, the Respondent is making an extensive use of the Complainant IQOS Trademarks on its website while trying to pass off as the Complainant or someone affiliated with it. Accordingly, the Panel finds that the Respondent cannot be assessed as a legitimate dealer for the Complainant’s products in light of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“Oki Data”) and thus is not entitled to use the Disputed Domain Name.

Based on the available record, the Panel 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.

In the present case, the Panel notes that the Respondent has registered the Disputed Domain Name well after the registration of the IQOS Trademarks. The Panel notes that the Respondent must have had the Complainant and its IQOS Trademarks in mind when registering the Disputed Domain Name.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Indeed, the Panel also notes that the Disputed Domain Name is apparently used to sell, without its authorization, the Complainant’s products and competing third party products. This use of the Disputed Domain Name is evidence that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s IQOS Trademarks as to the source, sponsorship affiliation or endorsement.

Based on the available record, the Panel finds that the Complainant has established the third element 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 disputed domain name <vapeiqosdubai.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: January 10, 2024