

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Kazi Ashikur Rasul, Pulse Tech Ltd.  
Case No. D2024-1818

### **1. The Parties**

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

The Respondent is Kazi Ashikur Rasul, Pulse Tech Ltd., Bangladesh.

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

The disputed domain name <tereailuma.com> 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 30, 2024. On May 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 2, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 27, 2024. The Respondent sent an email communication to the Center on May 12, 2024, expressing its willingness to reach a settlement. The Center sent the email regarding possible settlement to the Parties on May 13, 2024. However, the Complainant did not request a suspension for settlement talks. Accordingly, the Center notified the Parties' Commencement of Panel Appointment Process on May 30, 2024.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on June 3, 2024. 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 company part of the group of companies affiliated to Philip Morris International Inc., a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries.

In the course of transforming its business from combustible cigarettes to reduced risk products, the Complainant's group of companies has developed a number of products. One of these products is a tobacco heating system called IQOS, a precisely controlled heating device into which specially designed tobacco sticks under the various brand names like "TEREA" are inserted and heated to generate a flavourful nicotine-containing aerosol.

There are 5 versions of the IQOS heating device currently available, among which IQOS ILUMA. The IQOS System was first launched in Nagoya, Japan in 2014 and has obtained 20 per cent share of the market in Japan. Currently, the IQOS System is available in key cities in around 71 markets across the world. As a result of an investment of over USD 9 billion into the science and research of developing smoke-free products and extensive international sales, the IQOS System currently has approximately 19.1 million relevant consumers using the IQOS System worldwide. To date, the IQOS System has been almost exclusively distributed through Philip Morris official IQOS stores and websites and selected authorized distributors and retailers.

The Complainant owns several trademark registrations that consist of or contain the marks TEREА and ILUMA, among which:

- Swiss national verbal trademark No. 746602 for ILUMA, registered on May 8, 2020, for goods in classes 9 and 34;
- International verbal trademark registration No. 1544146 for ILUMA ONE, registered on June 8, 2020, for goods in class 34, in several jurisdictions;
- Swiss national verbal trademark No. 740373 for TEREА, registered on December 17, 2019, for goods in class 34;
- International figurative trademark No. 1629687 for TEREА for IQOS ILUMA, registered on August 26, 2021, for goods in class 34, in several jurisdictions.

The disputed domain name was registered on July 27, 2023, and resolves to an active website that sells tobacco 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:

- (i) the disputed domain name is confusingly similar to his TEREА and ILUMA trademarks, as it contains them in their entirety;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name for a number of reasons, among which that, (1) the Complainant has never licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its TEREА and ILUMA

trademarks or a domain name which will be associated with these trademarks; (2) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name and does not meet the requirements for a bona fide offering of goods. In the sense, the Complainant asserts that (a) the Respondent is not an authorized distributor or reseller of the IQOS System; (b) the website associated to the disputed domain name is selling competing tobacco products and/or accessories of other commercial origin in addition to the Complainant's ones, (c) the owner/administrator of the website associated to the disputed domain name prominently and without authorization presents the Complainant's registered TERE and ILUMA trademarks, uses the Complainant's official product images and marketing materials without authorization, while at the same time falsely claiming copyright in this material, (d) the website associated to the disputed domain name includes no information regarding the identity of its provider, which is only identified as "Tereailuma", being a name which similarly includes the Complainant's registered TERE and ILUMA trademarks. Moreover, the Complainant underlines that the Complainant's IQOS System is primarily distributed through official / endorsed stores. Therefore, in this case Internet users/relevant consumers are clearly misled regarding the relationship between the website associated to the disputed domain name and the Complainant, and will falsely believe that this website is an official/endorsed distributor;

(iii) the disputed domain name was registered and is being used in bad faith for a number of reasons, among which that, (1) the Respondent registered the disputed domain name with the knowledge of the Complainant's TERE and ILUMA trademarks, (2) 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 Complainant's registered TERE and ILUMA trademarks as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location, (3) by reproducing the Complainant's registered trademarks in the disputed domain name and the title of the website associate to such, the Respondent is clearly suggesting to any internet user visiting a website provided under the disputed domain name that, the Complainant (or an affiliated dealer of the Complainant) is the source of the website, which it is not. This suggestion is further supported by the Respondent's use of the Complainant's official product images and marketing materials, accompanied by a copyright notice claiming the copyright for this website and its contents; (4) the Respondent is not only using the Complainant's TERE and ILUMA trademarks for the purposes of offering for sale the IQOS System, but also for purposes of offering for sale third party products of other commercial origin.

## **B. Respondent**

The Respondent has sent on May 12, 2024 to the Center an email, in reply to the communicated Complaint, by which he mentioned that (1) such is a software development company, and its involvement with the disputed domain name is strictly limited to providing technical services; that he is neither directly nor indirectly involved with the operations or content of the website hosted on the disputed domain name; that his role has been confined to the acquisition of the disputed domain name and the creation of a CMS based website for his customer, (2) that he does not have any relation to acquiring the domain name <iqostereailimadubai.online>, (3) that he is prepared to facilitate the transfer of the disputed domain name to the Complainant, requesting a compensation of USD 1,500 from the Complainant, as he alleged that, acquiring and establishing a domain name involved a significant investment of time, effort, and resources. As such, he needs to secure a replacement domain name and rebuild the associated SEO infrastructure.

If the above proposal was acceptable to the Complainant, they expressed their intention for a settlement.

No evidence in support of the above was filed by the Responded.

The Complainant responded to this communication of the Respondent by sending an email to the Center on May 21, 2024, requesting the continuation of the proceedings in this case.

## **6. Discussion and Findings**

In order for the Complainant to succeed, such must prove, according to paragraph 4(a) of the Policy, that:

- (i) the disputed 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 with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

In case all three elements above have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. Thus, the Panel will deal with each of the requirements in turn.

### **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.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of both TERE and ILUMA marks of the Complainant are reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

In what concerns the addition of the generic Top-Level Domain ".com" in relation to the disputed domain name, such is viewed as a standard registration requirement, and is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### **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 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.

The Respondent is not a licensee of the Complainant, nor has the Complainant's authorization to use any of its trademarks or to register the disputed domain name, nor is an authorized distributor or reseller of the Complainant.

Moreover, based on the evidence filed by the Complainant, the disputed domain name resolves to an active website where tobacco products are offered for sale including the Complainant's ones, without any authorization from the Complainant, in addition to competing tobacco products and/or accessories of other commercial origin. The website incorporates the Complainant's TERE and ILUMA trademarks, official product images and marketing materials without authorization and with no disclaimers as to the lack of any relationship with the Complainant, while at the same time falsely claiming copyright in these materials, which suggests that the Respondent intended to attract Internet users to a false website looking like an official website of the Complainant or of an authorized distributor or reseller of such. The website includes no information regarding the identity of its provider, which is only identified as "Tereailuma", a name which similarly includes the Complainant's TERE and ILUMA marks. Panels have held that the use of a domain name for activity such as impersonation/passing off, as applicable to this case, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

All the above does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

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 included in their entirety both trademarks of the Complainant TERE and ILUMA, which correspond to non descriptive terms, without being a licensee of the Complainant, nor an authorized distributor or reseller of such. Therefore, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the disputed domain name without knowledge of the Complainant's TERE and ILUMINA marks and of the Complainant's activity and products, which supports a finding of bad faith registration. [WIPO Overview 3.0](#), section 3.2.2.

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.

In the present case, the Panel notes the composition of the disputed domain name, the use of the disputed domain name in relation to an active website which displays the Complainant's TERE and ILUMA trademarks, official product images and marketing materials of the Complainant, without an authorization from such and without any disclaimer as to the lack of any relationship with the Complainant, while at the same time falsely claiming copyright in this materials. This website offers for sale the Complainant's tobacco products, without any authorisation from the Complainant, in the context where these products are primarily distributed through official/endorsed stores, which the Respondent is not, in addition to competing tobacco products and/or accessories of other commercial origin. The website also includes no information regarding the identity of its provider, which is only identified as "Tereailuma", being a name which similarly includes the Complainant's TERE and ILUMA marks. All these suggest that the Respondent intended to attract Internet users to a false website for, or otherwise associated with the Complainant, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website and the products offered and promoted through said website, which support a finding of bad faith registration and use according to paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), sections 3.1.4. Moreover, Panels have held that the use of a domain name for such activity, as impersonation/passing off, as applicable to this case, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <tereailuma.com> be transferred to the Complainant.

*/Delia-Mihaela Belciu/*

**Delia-Mihaela Belciu**

Sole Panelist

Date: June 17, 2024