

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Вознюк Евгений Васильевич
Case No. D2024-1876

1. The Parties

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

The Respondent is Вознюк Евгений Васильевич, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <takeiqos.com> is registered with Internet Invest, Ltd. dba Imena.ua (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on May 3, 2024. On May 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 2024, 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 May 10, 2024, 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 the same date.

On May 10, 2024, the Center informed the parties in Ukrainian and English, that the language of the registration agreement for the disputed domain name is Ukrainian. On the same date, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 in English and Ukrainian, and the proceedings commenced on May 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 18, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on July 9, 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 which is part of the group of companies affiliated to Philip Morris International Inc. ("PMI"). PMI is a leading international tobacco company and smoke-free products company, with products sold in approximately 180 countries.

The Complainant's group of companies has developed a number of reduced risk products ("RRP"). One of these RRP's developed and sold by PMI is a tobacco heating system called IQOS. IQOS is a precisely controlled heating device into which specially designed tobacco sticks 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"). The IQOS System was first launched by PMI in Nagoya, Japan in 2014. Today 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 (in accordance with local laws), the IQOS System has achieved considerable international success and reputation, and approximately 19.1 million consumers use the IQOS System worldwide. To date, the IQOS System has been almost exclusively distributed through official IQOS stores and websites and selected authorized distributors and retailers.

The Complainant is the owner of the following registrations, among others:

- United Arab Emirates Trademark Registration No. 211139 for IQOS, registered on March 16, 2016 for goods in International Class 34;
- United Arab Emirates Trademark Registration No. 305079 for IQOS, registered on June 27, 2019 for goods in International Class 34;
- International Trademark Registration No. 1764390 for ILUMA (word), registered on October 12, 2023 for goods in International Class 34;
- International Trademark Registration No. 1544199 for IQOS ILUMA PRIME (word), registered on June 8, 2020 for goods in International Class 34;
- International Trademark Registration No. 1218246 for IQOS, registered on July 10, 2014 for goods in International Classes 9, 11 and 34;
- International Registration No. 1338099 for IQOS, registered on November 22, 2016 for services in International Class 35.

The disputed domain name was created on September 26, 2023 and used to resolve to the online shop selling the Complainant's IQOS System, as well as competing third party products of other commercial origin. At the time of this Decision, the website under the disputed domain name is inactive.

5. Further Procedural Considerations

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. Since the Respondent's mailing address is stated to be in Ukraine (whether this is indeed accurate is not clear), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue. Having considered all the circumstances of the case, the Panel is of the view that it should.

The Panel notes, as shown by the evidence submitted by the Complainant, that the website hosted at the disputed domain name was in the English language and indicated, in particular, "Our office is located Dubai International City. Dragon Mart Mall", which may support an inference that the Respondent is not located in

Ukraine. The Panel notes further that the Center sent the Notification of Complaint by email to the Respondent at its email address as registered with the Registrar and to a postmaster email address as specified by the Rules. There is no evidence that the case notification email to the first email address was not successfully delivered.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark. The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

6. 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.

Identical or confusingly similar

The Complainant states that the disputed domain name identically adopt the Complainant's IQOS trademark. The addition of the nondistinctive and descriptive word "take" is insufficient itself to avoid a finding of confusing similarity.

Thus, Internet users will reasonably expect to find the website commercially linked to the Complainant.

Rights or legitimate interests

The Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain name.

According to the Complainant's contentions, the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register the disputed domain name.

The Complainant further states that the Respondent is not an authorized distributor or reseller of the IQOS System. Moreover, the website is selling competing tobacco products and/or accessories of other commercial origin.

Furthermore, the Complainant also contends that the website uses the Complainant's official product images.

In addition, the website under the disputed domain name includes no information regarding the identity of the provider of the website.

The Complainant further asserts that the disputed domain name in itself suggests at least an affiliation with the Complainant and its IQOS trademark, as the disputed domain name wholly reproduces the Complainant's IQOS trademark together with the non-distinctive and descriptive word "take".

Registration and use in bad faith

The Complainant contends that the Respondent knew of the Complainant's trademarks when registering the disputed domain name. The Respondent started offering the Complainant's IQOS System immediately after registering the disputed domain name.

Consequently, the Complainant asserts 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 Complainant's IQOS trademark.

B. Respondent

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

7. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- i. that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. that the disputed domain name has been registered and is being used in bad faith.

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted in accordance with the Policy and the Rules. Under paragraph 5(f) and paragraph 14(b) of the Rules, if a respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint, and where a party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

7.1. Procedural issue - Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Ukrainian. 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.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the Complainant is not capable of providing the Complaint in the language of the registration agreement without unreasonable effort and costs; (ii) the records of the case include the evidence showing that the Respondent is capable of communicating in English, which includes (a) the disputed domain name is in Latin script indicating that the website under the disputed domain name is directed to, at the very least, an English-speaking public, (b) the website under the disputed domain name is presented in English, suggesting the Respondent understands English; (iii) the privacy registration service acting as a front company for the Respondent, in this particular instance, appears to also conduct its business in English, as its website is a multi-language website as one is able to select "English" at the Language plugin located at the top right of the website.

The Respondent did not make any submissions with respect to the language of the proceeding. Language requirements should not lead to undue burdens being placed on the Parties and undue delay to the proceeding. (see, e.g., *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#) stating that "[o]ne important consideration of this issue is the fairness to both Parties in their abilities to prepare the necessary documents and protect their own interests").

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).

Considering that both Parties have been given a fair opportunity to present their case and the Respondent has been given an opportunity to object to the proceedings being conducted in English but has not responded, the Panel finds that in the circumstances of this case, paragraph 11 of the Rules is best served by allowing the proceedings to be conducted in English in accordance with the Complainant's request as the Complainant could suffer significant disadvantages if the proceedings are conducted in Ukrainian (see, e.g., *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#)).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

7.2. Substantive Elements of the Policy

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.

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 Panel finds the mark IQOS is recognizable 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, "take", 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.

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.

The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the IQOS trademark. The Complainant has prior rights in the IQOS trademark which precede the Respondent's registration of the disputed domain name.

Based on the records of the case the Panel has established that the disputed domain name used to resolve to a commercial website, purporting to offer for sale the products under the Complainant's IQOS trademark

and replicating the Complainant's IQOS trademark, and, as per the Complaint, images of the original products under the IQOS trademark. At the website under the disputed domain name the Respondent was not only offering the Complainant's products under the IQOS trademark but also competing tobacco products and accessories of other commercial origin (i.e. the Pulze, JUUL and JUUL Pods products).

According to section 2.8.1 of the [WIPO Overview 3.0](#), panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark – with other terms appended to the trademark as within the domain name 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. Outlined in the "Oki Data test" (*Oki Data Americas, Inc. v. ASD Inc.*, WIPO Case No. [D2001-0903](#)), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- i. the respondent must actually be offering the goods or services at issue;
- ii. the respondent must use the site to sell only the trademarked goods or services;
- iii. the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- iv. the respondent must not try to "corner the market" in domain names that reflect the trademark.

The current case at least does not satisfy the second and third requirements under the Oki Data test because the evidence provided by the Complainant shows that the Respondent used to sell or offer for sale the Complainant's goods and also competing third-party goods on the website at the disputed domain name. Further, there was no accurate and prominent disclaimer regarding the Respondent's relationship with the Complainant shown on the website at the disputed domain name. The website included no information regarding the identity of the provider of the website, which was only identified as "Takeiqos" on the website, while the website included only the statement claiming that "Our office is located Dubai International City. Dragon Mart Mall" that does not help to identify the identity of the provider of the website.

The Panel also holds that the current passive holding of the disputed domain name by the Respondent in this case as evidence that the Respondent did not register and use the disputed domain name in connection with any bona fide offering of goods or services.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name. In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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.

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.

Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship,

affiliation, or endorsement of [respondent's] website or location or a product or service on [respondent's] website or location".

The Panel accepts that the Complainant's use and registration of the IQOS trademark long predated the Respondent's registration of the disputed domain name. The Respondent clearly knew of the Complainant's business and trademark as the disputed domain name used to resolve to a website purportedly offering products bearing the Complainant's trademark.

Furthermore, the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register the disputed domain name incorporating the Complainant's IQOS trademark. Neither the Respondent is an authorized reseller and/or dealer of the Complainant's products.

In addition, the Complainant submitted evidence that the Respondent's website misled Internet users into believing that the online shop is somehow linked with the Complainant in the United Arab Emirates. Thus, Internet users might have well been under the impression that it is a website created and operated by a distributor or reseller of the Complainant with the Complainant's consent.

Due to this conduct, it is obvious that the Respondent intentionally created likelihood of confusion with the Complainant's IQOS trademark in order to attract Internet users for his own commercial gain, in line with paragraph 4(b)(iv) of the Policy.

Under section 3.3 of the [WIPO Overview 3.0](#), the current non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Previous UDRP panels have held that the passive holding of a domain name that incorporates a well-known trademark may confirm the bad faith. See, *Te/stra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Thus, current passive holding of the disputed domain name does not prevent a finding of bad faith.

The Panel finds that the Complainant has established the third element of the Policy.

8. 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 <takeiqos.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: August 5, 2024