

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. La Thien Nhi, Thien Nhi  
Case No. D2024-1878

### **1. The Parties**

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

The Respondent is La Thien Nhi, Thien Nhi, Viet Nam.

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

The disputed domain name <thuociqos.com> is registered with GMO Internet Group, Inc. d/b/a Onamae.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 3, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 7, 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 9, 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 May 10, 2024.

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 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 5, 2024.

The Center appointed Aaron Newell as the sole panelist in this matter on June 11, 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:

- i) is a company that is part of the group of companies affiliated with Philip Morris International Inc. ("PMI"). The Complainant asserts that PMI is a leading international tobacco and smoke-free products company with products sold in approximately 180 countries. PMI's portfolio of brands includes the well-known (and allegedly since 1972 the world's best-selling) cigarette brand Marlboro;
- ii) owns various trademark registrations (including International Registrations designating, inter alia, Viet Nam where the Respondent is based and large markets such as the European Union, China and the United States of America) for the sign IQOS (stylized in a particular font). By way of example, the Complainant's International Registration No. 1218246 for the trademark IQOS (a word mark) was registered on July 10, 2014, covers electronic cigarettes and related goods in classes 9, 11 and 34 and designates multiple countries;
- iii) asserts that the IQOS name is used by PMI for a tobacco heating system that is part of PMI's range of "Reduced Risk Products". The Complainant asserts that the IQOS system presently claims 20% of the share market in Japan, is available in seventy-one markets around the world, and has roughly 19.1 million consumers around the world. PMI's primary website promoting the IQOS system is at "www.iqos.com";
- iv) asserts that it has no connection with the Respondent and that it has not authorized the Respondent to use the trademark IQOS, including in the disputed domain name;
- v) provides evidence demonstrating that the disputed domain name has been used to load an online shop purporting to sell PMI's IQOS-branded products as well as competing products manufactured by third parties, including tobacco products sold under the brand NUSO. The website uses images of PMI's IQOS products with the text "Thuociqos.com" superimposed, and does not obviously feature any text to identify the owner or operator of the website or the underlying business, or to explain what if any relationship there is between the website and/or the disputed domain name and the Complainant and/or PMI;
- vi) asserts that it owns copyright in various of the images used at the Respondent's website and that the Respondent has not been authorized to use these images. The Complainant further provides evidence that the Respondent has used a copyright notice at its website that suggests that the entire content of the website, including the Complainant's images, belongs to the Respondent.

The Respondent did not respond to the Complaint or otherwise engage with the Complainant, the Center or these proceedings.

The disputed domain name was registered November 15, 2023. As at the date of writing, the disputed domain name loaded a website that appears as described by the Complainant as outlined at v) and vi) above, and the publicly-available Whois information shows the Respondent as the registrant.

#### **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:

a) the disputed domain name, being <thuociqos.com>, is confusingly similar to its trademark registrations for IQOS, noting that the non-distinctive word “thuoc” roughly translates from Vietnamese to English as “medicine”;

b) the Respondent has no rights or legitimate interests in the disputed domain name, including because the Respondent is not authorized to use the Complainant’s IQOS trademark and is not making a legitimate noncommercial fair use of the disputed domain name. Rather the Respondent is using the disputed domain name in a confusing way to misrepresent a commercial connection with the Complainant contrary to fact, and to sell third party products;

c) the disputed domain name was registered and is being used in bad faith. The Respondent was clearly aware of the Complainant and its rights in the IQOS sign prior to registering and using the disputed domain name. The Respondent has claimed that the intellectual property of the Complainant is its own, as part of an overarching misrepresentation as to some commercial connection with the Complainant and/or authorization by the Complainant to use and/or sell PMI’s IQOS products. Further, the Respondent is using the Complainant’s IQOS name to unfairly profit from its goodwill and reputation by using it to attract customers to its website and then offer competing third party products to those customers.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 the 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 the term “thuoc” may bear on the 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 demonstrated that the disputed domain name is being used to load a website at which the Complainant's products are offered for sale. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a number of UDRP decisions, starting with the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

[WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark 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', 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 'Oki Data test' does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

The Panel considers that the Respondent fails the Oki Data test in at least two respects. While the Complainant has submitted evidence that the Respondent may be selling genuine IQOS-branded products at its website, the Complainant has also demonstrated that the Respondent has made misrepresentations as to the Complainant's copyright (which the Panel considers exacerbates any likelihood of consumers being misled by the disputed domain name and/or the related website), has not disclaimed its actual relationship with the Complainant on the website (further increasing the risk of confusion), and has used the disputed domain name to offer for sale third party products unrelated to and competing with those of the Complainant and PMI.

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. Given the Respondent's failure to respond to and rebut the Complainant's assertions, there is no basis for determining that it may have rights or a legitimate interest in the disputed domain name. [WIPO Overview 3.0](#), section 2.8.

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.

These circumstances include those set out at Policy paragraph 4(b)(iv), which are as follows:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

In the present case the Complainant has provided compelling evidence that the Respondent has used the disputed domain name in a confusing way that is likely to mislead and/or confuse consumers into believing that it is or is somehow authorized by or affiliated with the Complainant, and that the Respondent is taking unfair advantage of the Complainant's IQOS trademark by using it in respect of the offer for sale of competing third party products.

Again, the Respondent did not respond to the Complaint and did not rebut the prima facie compelling submissions made by the Complainant.

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 <thuociqos.com> be transferred to the Complainant.

*/Aaron Newell/*

**Aaron Newell**

Sole Panelist

Date: June 25, 2024