

## **ADMINISTRATIVE PANEL DECISION**

Philip Morris Products S.A. v. Nguyen Tat Thanh  
Case No. D2024-1913

### **1. The Parties**

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

The Respondent is Nguyen Tat Thanh, Viet Nam.

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

The disputed domain name <iqosvietplus.com> (the “Disputed Domain Name”) is registered with Nhan Hoa Software Company Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 7, 2024. On May 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 8, 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.

On May 14, 2024, the Center informed the parties in Vietnamese and English, that the language of the registration agreement for the Disputed Domain Name is Vietnamese. On May 21, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the 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 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2024. The Respondent sent an email communication to the Center on May 27, 2024.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on June 25, 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, Philip Morris Products S.A., is affiliated with Philip Morris International Inc. (PMI), a leading global company in tobacco and smoke-free products, operating in approximately 180 countries.

PMI is innovating towards Reduced Risk Products (“RRPs”), including the IQOS System, a tobacco heating system launched in Nagoya, Japan, in 2014. The IQOS System is now available in key cities across 71 markets.

The trademark IQOS has been registered for goods in classes 09, 11, and 34 in a variety of countries, including in Viet Nam, where the Respondent is located, under International Registration No. 1218246 registered on July 10, 2014, and No. 1461017 registered on January 18, 2019.

The Disputed Domain Name was registered on October 23, 2023. As of the date of this Decision, the Disputed Domain Name does not resolve to an active website. However, as shown on the Complainant's evidence, the Disputed Domain Name used to resolve to a website displaying the Complainant's IQOS trademark and logo and purportedly selling the Complainant's IQOS products (the “Website”).

#### **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, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

The Complainant contends that the Disputed Domain Name is confusingly similar to its IQOS trademark because it incorporates the trademark in its entirety. The addition of the geographical term “viet” (abbreviation for Viet Nam) and the non-distinctive word “plus” does not avoid confusing similarity between the Disputed Domain Name and the Complainant's trademark.

Moreover, the Complainant emphasizes that the presence of its official product images and marketing materials on the Website further strengthens the unlawful association with its trademark.

Finally, the Complainant submits that the addition of the Top-Level Domain (“TLD”) suffix “.com” in the Disputed Domain Name is disregarded under the first element confusing similarity test.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant submits that the elements set forth in Policy, paragraph 4(c) are not fulfilled.

First, the Complainant 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).

Second, the Complainant contends that the Respondent has not made use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods or services. Particularly, the use of Disputed Domain Name does not meet the requirements described in the decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"):

- The Disputed Domain Name itself suggests an affiliation with the Complainant and its IQOS trademark, as the Disputed Domain Name wholly reproduces the Complainant's registered IQOS trademark together with the geographical abbreviation for the Viet Nam (i.e. "viet") and the non-distinctive word "plus".
- Further, the Respondent also uses the Complainant's registered trademark IQOS as well as official marketing material and product images on its Website without authorization.
- The Website includes no information regarding the identity of the provider of the website, which is only identified as "IQOS VIETPLUS" to perpetuate the false impression of an official commercial relationship between the website and the Complainant. This false impression is amplified by the Respondent's copyright notice on the Website that "*© Bản quyền thuộc về IQOS VIETPLUS - Được sự cho phép sử dụng của IQOS VIETNAM*" (in English: "© Copyright belongs to IQOS VIETPLUS - Used with permission from IQOS VIETNAM").

Third, the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the IQOS trademarks of the Complainant.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Complainant asserts that it is evident from the Respondent's use of the Disputed Domain Name that the Respondent knew of the Complainant's IQOS trademark when registering the Disputed Domain Name.

Furthermore, the term "iqos" is purely an imaginative term and unique to the Complainant. The term "iqos" is not commonly used to refer to tobacco products or electronic devices. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the Disputed Domain Name, without the intention of invoking a misleading association with the Complainant.

It is also evident from the Respondent's use of the Disputed Domain Name 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 as to the source, sponsorship, affiliation or endorsement of its website or a product/service.

Additionally, by reproducing the Complainant's registered trademark in the Disputed Domain Name and the title of the Website, as well as using the Complainant's official product images and marketing materials and placing a false copyright notice on the Website, the Respondent created a false impression that the Website belongs to the Complainant or is an affiliated dealer endorsed by the Complainant, which it is not.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

## **B. Respondent**

The Respondent has not formally replied or submitted a Response to the Complainant's contentions. However, on May 27, 2024, the Respondent sent an email communication to the Center in Vietnamese stating his intention to remove the content from the Website but refusing to waive his ownership of the Disputed Domain Name.

## 6. Discussion and Findings

### Language of the Proceeding

The language of the Registration Agreement for the Disputed Domain Name is Vietnamese. 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 language of the Registration Agreement appears to be available in English; (ii) the Dispute Domain Name in Latin script suggests it targets an English-speaking audience, reinforced by English words on the Website indicating the Respondent's understanding in English; and (iii) the Complainant, a Swiss entity without knowledge of Vietnamese, filed the Complaint in English, a common language in global business and evidently understood by the Respondent who conducts business in this language.

The Respondent did not make any formally specific submissions with respect to the language of the proceeding. After the notification of the Complaint, the Respondent sent an email communication to the Center in Vietnamese stating his intention to remove the content from the Website but refusing to waive his ownership of the Disputed Domain Name, which shows in the Panel's opinion at least some understanding of the circumstances surrounding the Complainant's claims.

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).

Having considered all the matters above, and noting that the Respondent was informed of the proceeding in Vietnamese, but chose not to submit a formal reply nor any comments on the Complainant's language request, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

#### 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 that the Complainant has established rights to the IQOS trademark, with registrations in multiple countries including Viet Nam, where the Respondent is located.

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 geographical abbreviation "viet" and the term "plus" 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.

In addition, the Panel finds that the addition of the generic Top-Level Domain (“gTLD”) “.com” to the Disputed Domain Name is disregarded as it is a technical requirement. [WIPO Overview 3.0](#), section 1.11.1.

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.

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, based on the Complainant’s submissions, that the Respondent has not been granted any license, permission, or authorization to use the Complainant’s IQOS trademark. Furthermore, there is no evidence presented to indicate that the Respondent possesses any registered or unregistered trademark rights in any jurisdiction concerning the term “iqos”. Consequently, the Panel finds that the Respondent lacks rights and legitimate interests in the Disputed Domain Name.

A reseller or distributor may be making a bona fide offering of goods or services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Okí Data*, including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods or services (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);

- the site itself must accurately and prominently disclose the respondent's relationship with the trademark owner; and

- the respondent must not try to "corner the market" in domain names that reflect the trademark, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, as shown on the Complainant's evidence in Annex 8 of the Complaint, the Panel finds the Respondent does not place any statement or disclaimer disclosing accurately its relationship with the Complainant, or the lack thereof. Further, the Website also used to contain the Complainant's IQOS trademark as well as its marketing materials and product images.

In addition, the Respondent claims itself as "IQOS VietPlus" and places the Copyright notice "© Bản quyền thuộc về IQOS VIETPLUS - Được sự cho phép sử dụng của IQOS VIETNAM" (in English: "© Copyright belongs to IQOS VIETPLUS - Used with permission from IQOS VIETNAM") on the Website. These indications may mislead Internet users into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality.

With such a view, the Panel finds that the unauthorized use of the Disputed Domain Name does not meet the *Oki Data* criteria and thus, does not constitute a bona fide use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds no evidence indicating that the Respondent, whether as an individual, business, or entity, is commonly known by the Disputed Domain Name, nor is the Respondent making a legitimate noncommercial or fair use of it. According to the Complainant's assertions and unrebutted evidence, the Respondent registered the Disputed Domain Name with full knowledge of the IQOS trademark, intending to capitalize on the goodwill and reputation associated with the Complainant.

Based on the foregoing findings, 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, including:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

In the present case, the Panel notes that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not formally reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence concerning the Respondent's registration and use of the Disputed Domain Name. It is evident from the record that the Complainant's IQOS trademark enjoys widespread recognition across numerous jurisdictions worldwide. Furthermore, the IQOS trademark has been actively used and has acquired substantial reputation in the tobacco products sector over many years. Importantly, the Complainant's registrations of the IQOS trademarks precede the registration date of the Disputed Domain Name.

The Disputed Domain Name prominently incorporates the Complainant's IQOS trademark in its entirety. Given the extensive use of the IQOS trademark by the Complainant in the tobacco products sector, including in Viet Nam where the Respondent is located, it is implausible that the registration was coincidental. The Panel further observes that the Respondent clearly had knowledge of the Complainant and its IQOS trademark at the time of registration. Therefore, the Panel concludes that the registration of the Disputed Domain Name was in bad faith and constitutes an effort by the Respondent to unfairly exploit the Complainant's goodwill and the established reputation of the IQOS trademark.

As of the date of this Decision, the Panel accessed the Disputed Domain Name and found that it currently resolves to a website displaying the message "iqosvietplus.com This account has been suspended". However, compelling the evidence in the case file as presented demonstrates that the Website previously operated under the Disputed Domain Name offered tobacco products bearing the IQOS trademark. Moreover, the Disputed Domain Name incorporates the IQOS trademark as a distinct part of its structure. Furthermore, the Panel notes that the Respondent's Website featured the Complainant's IQOS trademark prominently alongside official product images and marketing materials without authorization. Of particular concern is the reproduction of the Complainant's official IQOS System videos, accompanied by a misleading copyright notice. This notice falsely implies a legitimate association or authorization from the Complainant, further misleading Internet users and strengthening the false impression of affiliation.

The Panel determines that Internet users seeking to purchase IQOS products are likely to mistakenly perceive a connection or association between the Respondent's Website and the Complainant, despite no such relationship existing. Therefore, the Panel concludes that by using the Disputed Domain Name, the Respondent intentionally attempted to attract Internet users to its Website for commercial gain by creating a likelihood of confusion with the Complainant's trademark regarding the source, sponsorship, affiliation, or endorsement of its Website. This conduct falls under the definition of bad faith as outlined in paragraph 4(b)(iv) of the Policy.

Based on the foregoing findings, 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, <iqosvietplus.com>, be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: July 8, 2024