

## **ADMINISTRATIVE PANEL DECISION**

Swedish Match North Europe and Philip Morris International, Inc. v. Juan Carlos Herrera

Case No. D2024-3229

### **1. The Parties**

The Complainant is Swedish Match North Europe, Sweden, and Philip Morris International, Inc., United States of America (“United States”), represented by D.M. Kisch Inc., South Africa.

The Respondent is Juan Carlos Herrera, Mexico, represented by Dmitriy Chirkin, Ukraine.

### **2. The Domain Names and Registrars**

The disputed domain name <comprazyn.com> is registered with CloudFlare, Inc., and the disputed domain name <zynxs.com> is registered with Squarespace Domains LLC (the “Registrars”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 6, 2024. On August 7, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On August 7, 2024, and August 8, 2024, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Private Registrations) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 14, 2024, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. Later that day, the Respondent sent an email communication to the Center. The Complainant filed an amended Complaint on August 16, 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 August 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2024. The Response was filed with the Center on September 6, 2024.

The Center appointed Adam Taylor as the sole panelist in this matter on September 26, 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 Complainants, who are part of the Philip Morris International tobacco group, are collectively referred to hereafter as “the Complainant”, unless it is necessary to refer to them separately.

Since 2016, the Complainant has manufactured and sold nicotine pouches under the mark ZYN.

The Complainant owns a number of registered trade marks for ZYN including International Registration No. 1421212, registered on April 18, 2018, in class 34. This mark designates Mexico, amongst other countries.

The disputed domain name <comprazyn.com> was registered on February 12, 2024, and the disputed domain name <zynxs.com> was registered on February 13, 2024.

As of August 2, 2024, the disputed domain name <zynxs.com> resolved to a website in both Spanish and English branded “ZYN in Mexico” (English translation) with a “ZXS” logo, and purporting to offer the Complainant’s products for sale, including use of the Complainant’s official product images. The site also purported to offer products for sale that competed with those of the Complainant.

At some point, the following appeared in the footer of the website: “Important Notice: Zynxs.com is an independent retailer and is not affiliated with, sponsored by, or authorized by Swedish Match, Philip Morris International, or any official distributor of ZYN products. All trademarks, service marks, and logos used on this site, including but not limited to ‘ZYN’, are the property of their respective owners. The images and content on this site are original and were created by our team for the purpose of showcasing our products. For more information about the ZYN brand, please visit the official ZYN website.” (English translation).

The disputed domain name <comprazyn.com> redirected to the same website to which disputed domain name <zynxs.com> resolves.

#### **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 names.

##### **B. Respondent**

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Respondent contends that:

- the Respondent possesses a legitimate interest in the disputed domain names and registered them in good faith because they reflected a generic and commonly-used term, and with no intent to cause confusion;
- the word “zyn” is a generic term with many meanings including accessories, decorations etc., in Arabic as well as being a modern personal name;
- there are many third-party United States trade marks for ZYN, including in the class that relates to tobacco;

- accordingly the Complainant lacks exclusivity in relation to the term “zyn”;
- common words and descriptive terms are legitimately subject to registration as domain names on a 'first-come, first-served' basis;
- the disclaimer on the Respondent's website eliminates any possibility of affiliation with the Complainant;
- the fact that the Respondent has used the disputed domain names for a long period without consumer confusion is probative evidence that confusion with the Complainant's marks is unlikely;
- the Complainant has not submitted sufficient evidence to demonstrate either a lack of legitimate interests or bad faith;
- none of the factors evidencing bad faith apply in this case; and
- the Complainant has engaged in reverse domain name hijacking as it knew that a generic word could not have protection under the UDRP and that there was no plausible basis for its Complaint.

## **6. Discussion and Findings**

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- the disputed domain names have been registered and are being used in bad faith.

### **Consolidation: Multiple Complainants – Preliminary Issue**

The Panel is satisfied that (a) the Complainants (which are part of a group of companies), have a specific common grievance against the Respondent and the Respondent has engaged in common conduct that has affected the Complainants in similar fashion and (b) it would be equitable and procedurally efficient to allow this proceeding to be filed by both Complainants. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.11.

### **Multiple Domain Names – Preliminary Issue**

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder, which is the case here.

#### **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 trade mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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

The Panel finds the mark is recognisable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 recognised 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 names. 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 names such as those enumerated in the Policy or otherwise.

As to paragraph 4(c)(i) of the Policy, the Respondent purports to resell the Complainant’s own goods. The consensus view of UDRP panels is that to establish a bona fide offering of goods or services in such circumstances, a respondent must comply with certain conditions (the “Oki Data requirements”). [WIPO Overview 3.0](#), section 2.8.

In this case, as further discussed in section 6C below, the Panel considers that the Respondent has failed to comply with the Oki Data requirements to accurately and prominently disclose the Respondent’s relationship with the trade mark holder. In addition, the Respondent is not using the site to sell only the trademarked goods.

Accordingly, the Panel considers that the Respondent’s use of the disputed domain names cannot be said to be bona fide.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy are relevant in the circumstances of this case.

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 considers that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant’s trade mark, including for the purpose of sale of competing products, in accordance with paragraph 4(b)(iv) of the Policy.

Not only do the disputed domain names include the Complainant’s distinctive mark (in conjunction with the terms “compra”, meaning “buy” in Spanish, and “xs”), but the Respondent has used the disputed domain names for a website that creates the impression that it is officially associated with the Complainant including by prominent use of the Complainant’s mark as well as its official product images, and by the lack of a prominent disclaimer.

In the Panel’s view, even if it was in place at all relevant times (which is unclear), the disclaimer invoked by the Respondent (see section 4 above) appears to be far from prominent and unlikely to be seen by most users of the site. Furthermore, this disclaimer gives no information about the operator of the website. The Panel finds that the Respondent has not undertaken sufficient steps to avoid causing confusion to Internet

users. In any case, the mere existence of a disclaimer cannot cure bad faith where, as here, the overall circumstances point to bad faith including use of the website to offer competing products. Indeed, the Panel considers that the Respondent's use of a disclaimer amounts to an admission that Internet users may be confused. [WIPO Overview 3.0](#), section 3.7.

The gist of the Response is that the Respondent allegedly registered the disputed domain names in good faith because they reflected the generic word "zyn" which is the Respondent claims is in common use as well as being the subject of many third-party trade marks. However, even if the Respondent is correct to say that this term is in common use as a dictionary term and/or trade mark, the fact that the Respondent used the disputed domain names to offer the Complainant's products, and those of its competitors, shows that the Respondent registered the disputed domain names with reference to the Complainant's mark rather than due to their alleged genericness. Accordingly, the Panel rejects the Respondent's claim that he did not set out to create a likelihood of confusion with the Complainant's mark.

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 names <comprazyn.com> and <zynxs.com> be transferred to the Complainant.

*/Adam Taylor/*

**Adam Taylor**

Sole Panelist

Date: October 10, 2024