

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. rookie rookieman
Case No. D2024-3453

1. The Parties

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

The Respondent is rookie rookieman, Thailand.

2. The Domain Name and Registrar

The disputed domain name <iqosman.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 23, 2024. On August 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 23, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 26, 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 August 26, 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 September 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 30, 2024.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on October 2, 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 a company forming part of a group of companies affiliated to Philip Morris International Inc. The latter is an international tobacco and smoke-free products company, whose products are sold in approximately 180 countries.

The Complainant has a number of trademark registrations in different jurisdictions for or related to IQOS including: International Registration IQOS (word mark) No. 1218246 registered on July 10, 2014, designating Antigua and Barbuda, Albania, Armenia, Bosnia and Herzegovina, Bahrain, Bonaire, Sint Eustatius and Saba, Belarus, Colombia, Cuba, Curaçao, Republic of Korea, Algeria, Egypt, European Union, Gambia (the), Georgia, Israel, India, Iceland, Kyrgyzstan, Kazakhstan, Liberia, Madagascar, Malawi, Morocco, Monaco, Republic of Moldova, Montenegro, North Macedonia, Tajikistan, Mongolia, New Zealand, Oman, Sao Tome and Principe, Serbia, Sudan, Türkiye, Ukraine, and Viet Nam, Zambia, Zimbabwe; and International Registration (device, stylized rendering of the word IQOS) No. 1338099 registered on November 22, 2016 designating Albania, Armenia, Australia, Azerbaijan, Bosnia and Herzegovina, Bahrain, Belarus, Colombia, Algeria, Egypt, European Union, Georgia, Israel, India, Iceland, Japan, Republic of Korea, Kazakhstan, Morocco, Monaco, Montenegro, Mexico, Norway, New Zealand, Oman, Philippines, Serbia, Russian Federation, Singapore, Türkiye, Ukraine, and the United States of America.

The disputed domain name was registered on July 23, 2024. The disputed domain name links to a website allegedly selling and offering the Complainant's IQOS products, as well as competing third party products with an unrelated commercial origin.

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. The latter is said to identically adopt the Complainant's IQOS trademarks. The Complainant further argues that the addition of merely generic, descriptive, or geographical wording, such as the term "man" here, to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP.

The Complainant points out that its IQOS system is not currently sold in Thailand. However, the website to which the disputed domain name resolves is provided in Thai, and the fact that it indicates all prices in Thai baht, clearly indicates that it is directed to Thailand. The Complainant points out that notwithstanding this fact, the relevant website is clearly purporting to be an official online retailer in Thailand by using the Complainant's IQOS trademark in the disputed domain name together with the non-distinctive and descriptive word "man".

Further, the same website is prominently using the Complainant's registered IQOS trademark at the top as well as within its tab interface, being a location where relevant consumers usually expect to find the name of the online shop and/or the name of the provider of the website. The said website also uses the Complainant's official product images and marketing materials without the Complainant's authorization, while at the same time providing a notice claiming copyright in the material presented and thereby strengthening the false impression of an affiliation with the Complainant. Importantly according to the Complainant, the Respondent uses the IQOS trademark in the disputed domain name in circumstances where the latter is not known to the Complainant, nor authorized to use the Complainant's IQOS trademarks.

The Complainant says that it has made out a prima facie case that the Respondent lacks any right or legitimate interest in the disputed domain name. 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. Further, the Complainant asserts that the Respondent is not an authorized distributor or reseller of IQOS products. The website to which the disputed domain name resolves is also selling tobacco products and/or accessories with other commercial origins, of which the Complainant gives examples. The Complainant

contends that as a consequence, the said website does not meet the requirements set out by numerous panel decisions for a bona fide offering of goods to be found to exist.

Further, the Complainant points out that in accordance with *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), the use of a domain name cannot be “fair” if it suggests an affiliation with the trademark owner that does not in fact exist. The disputed domain name itself suggests at least an affiliation with the Complainant, as it wholly reproduces the Complainant’s registered IQOS trademark together with the non-distinctive and descriptive word “man”. In addition, the Complainant says, the Respondent prominently and without authorization presents the Complainant’s registered IQOS trademark on the website, as well as within the tab interface, where relevant consumers will usually expect to find the name of the website provider. Additionally, the Complainant points out that the relevant website uses the Complainant’s official product images and marketing materials without authorization, while at the same time falsely claiming copyright in this material. All this, the Complainant says, reinforces the false impression that the website is endorsed by the Complainant. The Complainant also says that the relevant website includes no information regarding the identity of its provider, who is only identified as “IQOS MAN” which further enhances the false impression of an official commercial relationship between the said website and the Complainant.

The Complainant also reiterates that in accordance with *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) the fact that the Respondent is not only offering the Complainant’s but also competing products and/or accessories is in itself sufficient to exclude a legitimate interest in the form of a bona fide offering of goods. The Complainant says that the illegitimacy of the Respondent’s use of the disputed domain name is further established by the fact that the Complainant does not currently offer its IQOS products for sale in Thailand, the Respondent’s website giving the false impression that the Complainant has officially introduced the IQOS System into the Thai market.

The Complainant contends that it is evident from the Respondent’s use of the disputed domain name that the latter knew of the Complainant’s IQOS trademark rights when registering it. The Respondent started offering the Complainant’s IQOS System immediately after registering the disputed domain name. The Complainant also points out that the term “iqos” is purely an invented term and unique to the Complainant, and it is therefore beyond the realm of reasonable coincidence that the Respondent chose it without the intention of invoking a misleading association with the Complainant.

Additionally, the abusive use of the Complainant’s IQOS trademark for purposes of promoting competing products is a clear-cut trademark infringement and constitutes clear evidence of the Respondent’s bad faith, the Complainant contends. Finally, the fact that the Respondent is using a privacy protection service to hide its true identity may in itself constitute a factor indicating bad faith, a proposition which the Complainant supports by referencing previous Panel decisions to that effect.

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.

Although the addition of other terms here “man”, 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.

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.

The Respondent has not made a legitimate noncommercial or fair use of the disputed domain name, if that were even possible, and the website to which the disputed domain name resolves contains unauthorized reproductions of the IQOS mark of the Complainant, as well as other intellectual property belonging to the latter. The said website contains links to goods other than those of the Complainant and gives the false impression of being the official presence in Thailand of the Complainant in relation to its IQOS products which are in fact not available for sale in that country. The illegitimacy and deceptive nature of the website to which the disputed domain name resolves cannot give rise to rights or recognition of legitimate interests in 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 was clearly aware of the rights of the Complainant in the IQOS trademark and the nature of the goods in relation to which the Complainant uses it. The deceptive website to which the disputed domain name resolves was established immediately after the registration of the disputed domain name by the Respondent. The disputed domain name incorporates the IQOS trademark as a whole, that being a highly distinctive mark whose ownership would be very easily established prior to registration by some simple searches.

The fact that the website to which the disputed domain name resolves contains reproductions of the IQOS mark of the Complainant as well as other intellectual property belonging to it and is contrived to look like the Complainant’s official IQOS product related presence in Thailand, is evidence of bad faith use of the disputed domain name. The combination of the inclusion of IQOS in the disputed domain name and the deceptive website to which it resolves indicates that the Respondent is out to derive some advantage from misleading consumers into thinking the website belongs to or is authorized by the Complainant, where that is not the case.

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 <iqosman.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: October 16, 2024