



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. A771BAC8

Determination DEFAULT

I. PARTIES

Complainant: Philip Morris Products S.A., Switzerland
Complainant's authorized representative(s): D.M. Kisch Inc., Andrew Papadopoulos, South Africa

Respondent: Djamal O Djamilov, Uzbekistan

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Name(s): IQOS-TASHKENT.ONLINE
Registry Operator: DotOnline Inc.
Registrar: PDR Ltd. d/b/a PublicDomainRegistry.com

III. PROCEDURAL HISTORY

Complaint submitted: 2019-11-27 10:23
Lock of the domain name(s): 2019-11-27 14:56
Notice of Complaint: 2019-11-27 15:16
Default Date: 2019-12-12 00:01
Default Notice: 2019-12-12 15:30
Panel appointed: 2019-12-12 15:33
Default Determination issued: 2019-12-12 18:40

IV. EXAMINER

Examiner's Name: Igor Motsnyi

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the domain name be suspended for the balance of the registration period.

The Respondent has not submitted a Response.

VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Complainant:

The Complainant is an international tobacco company, with products sold in more than 180 markets worldwide. IQOS, an innovative reduced risk tobacco device, was launched in Japan, in 2014.

The IQOS product is sold in around 48 markets. IQOS is an electronic heating device into which specially designed tobacco sticks are inserted and heated to generate a flavorful nicotine-containing aerosol.

The Complainant owns several IQOS trademark registrations, including Swiss word trademark registration "IQOS" No. 660918, registered on July 7th, 2014 in classes 9, 11 and 34.

The IQOS Trademark is registered with the Trademark Clearinghouse.

The Respondent registered the disputed domain on September 11th, 2019.

The Complainant alleges that the disputed domain name is used for a website advertising the Complainant's IQOS and HEETS products. The website holds out to be an official endorsed dealer by prominently using the Complainant's IQOS trademark in the disputed domain name and at the top of the website, where internet users usually expect to find the name of the online shop website owner. The website also uses the Complainant's copyright protected product images and marketing material. The website reveals no information regarding the identity of the website provider nor does it acknowledge the Complainant as the real brand owner. This leaves internet users under the false impression that the website is owned by the Complainant or one of its official licensees or distributors.

1. The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's trademark as it identically adopts the Complainant's registered trademark IQOS together with a merely generic supplement (Tashkent is a capital city of Uzbekistan).

2. The Complainant states that the Respondent and the website provided under the disputed domain name are not in any way affiliated to the Complainant nor has the Complainant authorized registration and use of the disputed domain name by the Respondent.

3. The Complainant claims that by registering the disputed domain name and by prominently using the Complainant's IQOS trademark and copyright protected marketing material on the website, the Respondent is attempting to attract internet users looking for Complainant's goods, and purposefully misleading users as to the source of the website.

By using Complainant's trademark in the disputed domain name and hiding the identity of the website provider, the Respondent is purposefully misleading users as to the source, sponsorship, or endorsement of the offerings under the disputed domain name.

Such use of the IQOS trademark by the Respondent while concealing his identity, does not constitute a "bona fide offering" pursuant to the "OKI Data Principles" and unquestionably demonstrates bad faith.

Respondent is intentionally using the IQOS trademark to attract customers to its site.

By registering the disputed domain name, which wholly adopts the Complainant's IQOS trademark and falsely suggests an affiliation with the Complainant, the Respondent is illegitimately and directly targeting the Complainant.

B. Respondent:

The Respondent did not submit a Response.



C. Procedural findings:

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

In accordance with URS Procedure Paragraph 9(d), in absence of a Response, the language of the Determination shall be English.

D. Findings of fact:

The disputed domain name was registered on September 11, 2019.
The Respondent as natural person, Djamil O Djamilov, located in Uzbekistan.

The disputed domain name is used for selling goods of the Complainant (or presumably goods branded by the Complainant's "IQOS" and "HEETS" marks).

The Complainant in this proceeding has demonstrated that it owns the following registered "IQOS" word trademark:

- Swiss Trademark Registration "IQOS" No. 660918, registered on July 7th, 2014.

E. Reasoning:

According to Paragraph 13 of the URS Rules, the Examiner shall make a Determination of a Complaint in accordance with the URS Procedure, the URS Rules and any rules and principles of law that it deems applicable.

Even though the Respondent has defaulted, URS Procedure 1.2.6, requires Complainant to make a *prima facie* case, proven by clear and convincing evidence, for each of the following three elements to obtain an order that a domain name should be suspended.

For the Complainant to succeed, it must establish that each of the three following conditions under 1.2.6 URS Procedure are satisfied:

- That the disputed domain name is identical or confusingly similar to a word mark;
- That the Registrant has no legitimate right or interest to the disputed domain name;
- That the disputed domain name was registered and is being used in bad faith.

1. The domain name(s) is(are) identical or confusingly similar to a word mark

The disputed domain name fully incorporates Complainant's IQOS word trademark with the addition of a geographical term Tashkent.

As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element..." (see par. 1.8).

In the present case the disputed domain name includes the Complainant's IQOS word trademark plus the additional geographical term – Tashkent, a capital city of Uzbekistan. The Complainant's mark is clearly recognizable in the disputed domain name. The Complainant provided evidence that its word trademark is in use.

The domain zone .online shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Examiner finds that the requirements set forth under Paragraph 1.2.6.1. of the URS Procedure have been satisfied.

2. Respondent has no rights or legitimate interests to the domain name(s)

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests.

The Respondent appears to be engaged in selling Complainant's branded goods via the web site under the disputed domain name.

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 (see par. 2.8.1. of WIPO Overview 3.0).

Outlined in the "Oki Data test", the following cumulative requirements shall be applied in the specific conditions of a 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.

In the present case the Respondent fails to accurately and prominently disclose his relationship with the Complainant - trademark holder.

The Complainant has made a prima facie case and the Respondent failed to respond and explain any rights or interests in respect of the disputed domain name.

Based on the above, the Examiner finds that the Respondent lacks any rights or legitimate interests with respect to the disputed domain name as per the requirements set forth under Paragraph 1.2.6.2. of the URS Procedure.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

The Complainant alleges that the Respondent is attempting to attract internet users looking for Complainant's goods, and purposefully misleading users as to the source of the website.

As provided in par. 3.2.1 of WIPO Overview 3.0 particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith *inter alia* include:

- (i) the nature of the domain name;



- (ii) the content of any website under the disputed domain name;
- iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or
- (iv) other indicia generally suggesting that the respondent had somehow targeted the complainant.

Panels have also consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see par. 3.1.4 of WIPO Overview 3.0).

Facts of the present dispute indicate that the Respondent targeted the Complainant by choosing its "IQOS" trademark that is distinctive and widely-known. The disputed domain name is used in such a way as to create confusion with the Complainant and the content of the web site confirms this.

The Complainant's IQOS trademark has been a target of cybersquatters before as confirmed by previous panels in both UDRP and URS proceedings (see e.g. Forum case No. 1871671; Philip Morris Products S.A. v. Ninh Van Thanh, WIPO Case No. D2019-2350; Philip Morris Products S.A. v. Domain Admin, Domain Whois Protection Service / Tran Minh Bao, WIPO Case No. D2019-2241; Forum case No. 1869481 and Philip Morris Products S.A. v. Protection of Private Person / Daniil Nesterov, WIPO Case No. D2019-2150).

From the evidence available in this case, it is clear that the Respondent has intentionally attempted to attract for commercial gain Internet users to his website by creating a likelihood of confusion with the Complainant's mark by fully incorporating Complainant's IQOS trademark into the disputed domain name coupled with a geographical term and by using Complainant's copyright materials and by conducting business activity.

This conduct is considered by the URS as a demonstration of bad faith registration and use, under Paragraph 1.2.6.3 (d) of the URS Procedure.

Therefore, the Examiner finds that the requirements set forth under Paragraph 1.2.6.3. of the URS Procedure have been satisfied by the Complainant.

4. Abusive Complaint

Finding of abuse of proceedings: Not finds

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Name(s): IQOS-TASHKENT.ONLINE

Suspends for the balance of the registration period

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Igor

Surname: Motsnyi

Date: 12 December 2019