Panel Decision for dispute CAC-ADREU-008200

Case number	**CAC-ADREU-008200**
Time of filing	**2021-10-20 10:18:39**
Domain names	**iqos-rendeles.eu**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	

Respondent

Name	**Viktor Molnar**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

According to the Complainant's statement non-rebuted by the Respondent, there is no other legal proceedings pending.

FACTUAL BACKGROUND

The Complainant is Philip Morris Products S.A., a company which is part of the group of companies affiliated to Philip Morris International Inc. (jointly referred to as “PMI”), a leading international tobacco and smoke-free products company, with products sold in approximately 180 countries.
PMI is known for innovating across its brand portfolio., by developing a number of Reduced Risk Products (or “RRPs”). One of these RRPs developed and sold by PMI is called IQOS.

The IQOS System was first launched by PMI in Nagoya, Japan in 2014 and is available in key cities in around 64 markets across the world, while achieving considerable international success and reputation.

To date, the IQOS System has been almost exclusively distributed through PMI’s official IQOS stores and websites and selected authorized distributors and retailers.

For its new innovative smoke-free products the Complainant owns a large portfolio of well-known trademarks. Among them, but by no means limited to, are the following trademark registrations (referred as “Trademarks”):

- International Registration IQOS (word) No. 1218246 registered on 10 July 2014 designating Antigua and Barbuda, Bahrain, Bonaire, Saint Eustatius and Saba, Colombia, Curaçao, European Union, Georgia, Israel, India, Iceland, New Zealand, Sultanate of Oman, Philippines, Sint, TN (Tunisia), Turkey, Albania, Armenia, Bosnia and Herzegovina, Belarus, Cuba, Algeria, Egypt, Kyrgyzstan, Kazakhstan, Morocco, Monaco, Republic of Moldova, Montenegro, The former Yugoslav Republic of Macedonia, Mongolia, Serbia, Ukraine, Vietnam;and

- International Registration IQOS (device) No. 1329691 registered on 10 August 2016 designating Albania, Armenia, Australia, Azerbaijan, Bahrain, Belarus, Bosnia and Herzegovina, Botswana, China, Colombia, Curaçao, Egypt, USA, The former Yugoslav Republic of Macedonia, Russia, Philippines, Georgia, India, Iceland, Israel, Japan, Kenia, Kyrgyzstan, Liechtenstein, Morocco, Mexico, Monaco, Montenegro, Mozambique, Norway, New Zealand, OAPI, Republic of Korea, Republic of Moldavia, Serbia, Singapur, Oman, Turkmenistan, Turkey, European Union, Ukraine, Uzbekistan, Vietnam.

The Respondent seems to be Viktor Molnar, a Romanian individual. The Respondent is not known or in any way related to the Complainant or any PMI affiliate and is not authorized to use the IQOS trademark.

The disputed domain iqos-rendeles.eu is linked to an online-shop allegedly offering the Complainant's IQOS System in Hungarian language (the Website).

A. COMPLAINANT

By the Complaint, the Complainant asserts that:

- The disputed domain name iqos-rendeles.eu is confusingly similar to the Complainant's IQOS trademark registrations.
- It is well-established that the TLD extension of a domain name, such as .eu, does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of Regulation 874/2004.
- There is a CAC panel practice that domain names including a trademark combined with a mere descriptive term are confusingly similar to that trademark.
- The disputed domain name reproduces the IQOS trademark in its entirety along with the descriptive term "rendeles (= "order" or "ordering" in Hungarian) merely indicating that IQOS products can be ordered on the website.
- The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register the disputed domain name incorporating its IQOS trademark.
- 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 trademarks of the Complainant, as he is not an authorized reseller of IQOS products and the website provided under the disputed domain name does not meet the requirements set-out by previous panel decisions for a bona fide offering of goods.
- The Respondent registered and uses the disputed domain name in bad faith with the intent to attract Internet users, for commercial gain, to its hosting service by creating a likelihood of confusion with the Complainant's IQOS trademarks

B. RESPONDENT

Although properly notified, the Respondent has failed to provide a Response.

DISCUSSION AND FINDINGS

According to Paragraph B11(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR proceeding where the Respondent is the holder of the domain name in respect of which the Complaint was initiated, that:
(i) the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law and; either
(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or
(iii) the domain name has been registered or is being used in bad faith.
Article 21(1) of the Commission Regulation (EC) 874/2004 of 28 April 2004 contains similar provision to those of the ADR Rules.

In arriving to the findings in this case, the Panel has reviewed and considered both Complainant's and Respondent's failure to respond and the appendixes in detail and has, based on article B7(a) of the ADR rules, further taken note of the decisions in ADR cases sand of Overview of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name
Disputes, 2nd Edition ("CAC .EU Overview 2.0")

I. Condition according to Paragraph B11(d)(1)(i) of the ADR Rules

The disputed domain name includes the word trademark - IQOS- which is protected internationally, including EU, under no 1218246 registered on 10 July 2014 in respect of goods and services in classes 9,11,34 for the Complainant.
The IQOS trademark is reproduced entirely in the disputed domain name along with the descriptive term "rendeles (= "order" or "ordering" in Hungarian) merely indicating that IQOS products can be ordered on the website, and the TLD extension ".eu". It is well acknowledged in the CAC Panel practice that the addition of the term Hungarian"rendeles" does not render the disputed domain name distinctive according to Overview of CAC Panel Views on Selected Questions
of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition("CAC .EU Overview 2.0").
Moreover, according to the same practice, it is well-established that the TLD extension of a domain name, such as .eu, does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of Regulation 874/2004 and that a domain name including a trademark combined with a mere descriptive term is confusingly similar to that trademark.

Considering all the above, this Panel finds that the Complainant has demonstrated rights in the word trademark - IQOS- under no

1218246 registered on 10 July 2014 according to Article 21(1) of the Commission Regulation (EC) 874/2004 of 28 April 2004 and the disputed domain name is "identical and confusingly similar" to names in respect of which a right of the Complainant is recognized within the meaning of Paragraph B.11(d)(1) of the ADR Rules.

II. Condition according to Paragraph B11(d)(1)(ii) of the ADR Rules

This Panel considers that the disputed domain name has been registered by the Respondent without rights or legitimate interest in the names since neither a right nor a legitimate interest in accordance with article 21 No. 2 of the Regulation (EC) No. 874/2004 of April 28 2004 was demonstrated by the Respondent or is otherwise apparent.

The Complainant has made a prima facie case that 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 trademarks of the Complainant, as he is not an authorized reseller of IQOS products and of the website provided under the disputed domain name does not meet the requirements set-out by previous panel decisions for a bona fide offering of goods.

In view of this Panel, there is, despite certain possible highly special circumstances which are not present here and were not invoked by the Respondent, as he did not provide for a Response, no legitimate reason for a reseller of genuine products nor a provider of genuine or non-genuine spare parts or accessories, independently of the admissibility of their offers, to use the related trademark in the domain name itself.

III. Condition according to Paragraph B11(d)(1)(iii) of the ADR Rules

Considering the finding under condition according to Paragraph B11(d)(1)(ii) of the ADR Rules and the fact that the requirements Art. 21 sec. 1 lit a and b Regulation (EC) No. 874/2004 are alternative this Panel needs not examine whether or not the disputed domain name has been registered or is being used in bad faith in accordance with article 21 No.1(b), No. 3 of the Regulation (EC) No. 874/2004 of April 28 2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name IQOS-RENDELES.EU be revoked.

PANELISTS

Name	**Beatrice Onica Jarka**

DATE OF PANEL DECISION 2021-10-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: IQOS-RENDELES.EU

II. Country of the Complainant: Switzerland, country of the Respondent: Romania

III. Date of registration of the domain name: [XX Month XXXX]

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trademark registered internationally in Antigua and Barbuda, Bahrain, Bonaire, Saint Eustatius and Saba, Colombia, Curaçao, European Union, Georgia, Israel, India, Iceland, New Zealand, Sultanate of Oman, Philippines, Sint, TN (Tunisia), Turkey, Albania, Armenia, Bosnia and Herzegovina, Belarus, Cuba, Algeria, Egypt, Kyrgyzstan, Kazakhstan, Morocco, Monaco, Republic of Moldova, Montenegro, The former Yugoslav Republic of Macedonia, Mongolia, Serbia, Ukraine, Vietnam under no 1218246 registered on for the term of 10 years, filed on 01.05.2014 registered on 10 July 2014 in respect of goods and services in classes 9,11,34

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. Yes
2. Why: 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 trademarks of the Complainant, as he is not an authorized reseller of IQOS products and the website provided under the disputed domain name does not meet the requirements set-out by previous panel decisions for a bona fide offering of goods.
VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. No need to analyse as the requirements in Art. 21 sec. 1 lit a and b Regulation (EC) No. 874/2004 are alternative,
2. Why:

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: None