

ADMINISTRATIVE PANEL DECISION

Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC
Case No. D2015-1527

1. The Parties

The Complainant is Philip Morris USA Inc. of Richmond, Virginia, United States of America (“United States”), represented by Arnold & Porter, United States.

The Respondent is Daniele Kanai, iKiss LLC of Kaunakakai, Hawaii, United States.

2. The Domain Names and Registrar

The disputed domain names <againstmarlboro.com> and <againstphilipmorris.com> are 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 26, 2015. On August 27, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of both disputed domain names and providing the contact details.

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 proceeding commenced on September 2, 2015. In accordance with the Rules, paragraph 5, the due date for Response was September 22, 2015. The Respondent sent an email to the Center on August 28, 2015. The Respondent did not however submit any formal response. As a reply to the Respondent’s submission, the Complainant filed a supplemental submission with the Center on August 31, 2015.

Subsequently, the Center notified the parties about the commencement of panel appointment process on September 24, 2015.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on October 12, 2015. 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.

Though the decision was due from the Panel to the Center on October 26, 2015, owing to extraordinary circumstances, the Panel extended this date to November 9, 2015.

4. Factual Background

As reflected in the registration records for the disputed domain names in the Whois database (a copy of the records appears in Annex A to the Complaint), the disputed domain names <againstmarlboro.com> and <againstphilipmorris.com> were both registered on May 12, 2015 and are due to expire on May 12, 2016.

A. The Complainant's Marks

As indicated in the Complaint, the Complainant owns various United States trademark registrations for the mark MARLBORO in stylized form, including one with a design element. The Complainant has provided, in Annex C to the Complaint, copies of these registration certificates, the details of which are as follows:

1. MARLBORO (stylized)
United States registration no.: 68,502
registered: April 14, 1908; renewed: April 14, 2008

This mark is registered for use in connection with: "Cigarettes" in international class 34. This registration claims a date of first use and first use in commerce in connection with these goods of December 31, 1883.

2. MARLBORO (stylized with design elements)
United States registration no.: 938,510
registered: July 25, 1972; renewed: July 25, 2012

This mark is registered for use in connection with: "Cigarettes" in international class 34. This registration claims a date of first use and first use in commerce in connection with these goods of December 31, 1954.

Implicitly, the Complainant is also claiming common law trademark rights in the term "Philip Morris" based on its use within the United States over the past century, and which use is continuing, both as its corporate name and as a brand-identifier for its tobacco-related products.

B. The Parties and their interaction

Since 1883, the Complainant (including its predecessors, all hereinafter simply the "Complainant") manufactures, markets, and sells cigarettes in the United States under its mark MARLBORO. For many decades, the Complainant has used both this mark and variants of it in connection with its tobacco and smoking-related products. During that time, the Complainant has spent substantial time, effort, and money advertising and promoting its MARLBORO branded goods throughout the United States. As a result, those marks have become uniquely associated with the Complainant and its products.

Additionally, the Complainant has registered the domain name <marlboro.com> which resolves to the Complainant's website which provides information regarding the Complainant, its products and special offers for age-verified smokers 21 years or older. A screen shot of the home page and a print-out of the Whois record for this domain name both appear in Annex D to the Complaint.

Further, for over a century, the Complainant has used the term "Philip Morris" continuously throughout the United States as its company name and as a mark in connection with its branded tobacco products. Thus,

the name has also become uniquely associated with the Complainant and its products. Over the years, the public media has widely recognized the association between the name of the Complainant as a source-identifier of the tobacco products which it manufactures and sells. See, e.g., Timothy Williams, "Richmond Awaits a Bold Antipoverty Plan", *The New York Times* (October 15, 2013) (describing "Philip Morris USA" as "the nation's largest tobacco company"); "No More Delay in Tobacco Decision", *Los Angeles Times* (January 27, 2012) (describing "Philip Morris USA, maker of top-selling Marlboro cigarettes" as one of "the largest U.S. cigarette makers"); "Marlboro Goes Smokeless", *Chicago Tribune* (June 12, 2007) ("For decades, the nation's largest cigarette maker, Philip Morris USA, has cranked out tens of billions of cigarettes annually, including its Marlboro brand."). Copies of these articles appear in Annex G to the Complaint.

The Complainant has also registered several domain names incorporating the term "Philip Morris", including: <philipmorris.com>; <philipmorris.net>; <philipmorris.org>; and <philipmorris.info>. The domain name <philipmorris.com> points to the home page for the Complainant's corporate website which contains information about the company. Print-outs of the WhoIs records for these domain names along with that of the home page for the website "www.philipmorris.com" are provided in Annex E to the Complaint.

Both of the disputed domain names currently resolve, as shown by the screen shots in Annex F to the Complaint, to inactive websites, each of which produces a web page simply stating "website coming soon", *i.e.*, the site remains under construction.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain names are confusingly similar to its Marks.

Specifically, the disputed domain names contain either the mark MARLBORO or PHILIP MORRIS to which the generic word "against" has been prepended, with that word being incapable of adding sufficient distinctiveness whatsoever to the disputed domain names to mitigate any resulting user confusion between the disputed domain names and the Complainant's Marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent has not used or made demonstrable preparations to use either of those disputed domain names, has never been commonly known by either name, and is not making a legitimate noncommercial or fair use of these names without intent for commercial gain. Further, the Complainant has never licensed the Respondent to use any of the Complainant's Marks, and the Respondent is not otherwise authorized to act on the Complainant's behalf.

Given the substantial reputation that the Complainant has acquired in its Marks, the Respondent chose to capitalize on and exploit that reputation, *i.e.*, the association in the minds of Internet users between these Marks and the Complainant's tobacco-related products, for its own purposes in order to misleadingly divert those users to the Respondent's websites to which the disputed domain names resolve. As this use is illegitimate, it is incapable of constituting either: (a) a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, or (b) a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy. Moreover, as the Respondent has yet to make use of either of the disputed domain names, as both

of its websites to which these domain names respectively resolve are under construction, its failure to use the disputed domain names further reflects its lack of rights or legitimate interests in both domain names.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using both disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent, having no connection whatsoever with the Complainant, registered the disputed domain names with full knowledge of and in spite of the Complainant's long-held, exclusive and substantial trademark rights, certainly in the United States, in its Marks MARLBORO and PHILIP MORRIS. The Respondent's apparent motive in doing so is to intentionally cause confusion with the Complainant's Marks and by doing so divert Internet users to its websites for its own gain.

Further, as each of the disputed domain names still resolves to "under construction" web page, *i.e.*, an inactive website, the Respondent has simply passively held the registrations ever since it registered both disputed domain names on May 12, 2015 and has not manifested any visible plans to actively use either of the disputed domain names.

B. Respondent

In response to the Complaint, the Respondent simply replied by an email message sent to the Center on August 28, 2015 which solely stated:

- “1. First Amendment
2. Freedom of Speech
3. I am allowed to express my opinion against Philip Morris and Marlboro
4. Bring it on! I am looking forward to it!”

C. Complainant's Supplemental Submission

As the Rules are silent on whether supplemental submissions are permitted, the Panel, acting in its sole discretion, has decided not to consider the Complainant's Supplemental Submission.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel recognizes that, over many years and as illustratively shown by the media reports in Annex G to the Complaint, the term "Philip Morris" has become uniquely associated with and distinctively identifies the Complainant and its products in the marketplace. As a consequence, this term, when used as a mark, has gained considerable goodwill as both the Complainant's corporate name and brand identifier. Furthermore, the Respondent did not dispute these trademark rights, nor, in all likelihood, given the substantial recognition this mark has established over nearly a century and currently enjoys, could the Respondent successfully do so. As such and as a threshold matter, the Panel accepts that the Complainant has exclusive common law trademark rights in this term sufficient to invoke paragraph 4(a)(i) of the Policy. Furthermore, other UDRP panels have similarly recognized these rights, such as: *Philip Morris USA Inc. v. Contact Privacy Inc. / Boubli Emmanuel*, WIPO Case No. D2015-1034 (acknowledging that "several UDRP panels have recently held that the PHILIP MORRIS trademark is well-known and famous due to its widespread and extensive use in connection with Complainant's tobacco products and have acknowledged Complainant's unregistered trademark rights therein"); *Philip Morris USA Inc. v. DAVID DELMAN / DAVID@DELMAN.TV*, NAF Claim No. FA1406001567138 ("Complainant has used 'Philip Morris' continuously throughout the United States for over a century and has established common law rights in the mark PHILIP MORRIS."); *Philip Morris USA Inc. v. Lori Wagner*, NAF Claim No. FA1312001534894 (holding Philip Morris US had common law rights in

“Philip Morris”); *Philip Morris USA Inc. v. DAVID DELMAN / DAVID@DELMAN.TV*, NAF Claim No. FA1406001567134 (“The Panel finds that Complainant has established common law rights in its PHILIP MORRIS mark, a long-standing and well-known mark in the tobacco industry.”).

The Panel finds that the disputed domain names are confusingly similar to the Complainant’s Marks.

From a simple comparison of the disputed domain names to the Complainant’s Marks MARLBORO and PHILIP MORRIS, no doubt exists that each of the disputed domain names is confusingly similar to the Complainant’s Marks. The differences between the disputed domain names and these Marks amount to the generic word “against” having been prepended to the marks to form a composite term and the generic Top-Level Domain “.com” having been appended to that term to form each of the disputed domain names, with the last addition being irrelevant in this case in assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP proceedings, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, prepending the word “against” in the manner which the Respondent specifically did, to the terms “Marlboro” and “Philip Morris” clearly resulted in such a minor variation. See, e.g., *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491.

Therefore, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s Marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a

claim of rights or legitimate interests by the Respondent to either of the disputed domain names under paragraph 4(c) of the Policy.

As the Respondent is not actively using the disputed domain names and the record before this Panel does not reflect any demonstrable preparations to do so which the Respondent has made prior to receiving notice of this dispute, the Respondent does not qualify under paragraph 4(c)(i) of the Policy.

Further, the Complainant has never authorized the Respondent to utilize any of the Complainant's Marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent.

The record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by either of the disputed domain names, a name similar to either one, or more generally either of the terms "Marlboro" and "Philip Morris". Given the exclusive trademark rights that reside in the Complainant and the substantial reputation now inherent in its Marks, the Respondent could not legitimately acquire any public association between itself and the Complainant's Marks or even any mark similar thereto, at least for the goods provided by the Complainant under its marks. This is so in light of the Complainant's exclusive trademark rights which date back to 1883 in connection with the mark MARLBORO and nearly a century ago in connection with its mark PHILIP MORRIS and the extensive reputation which both marks have long since acquired – which greatly predate the date, May 12, 2015, when the Respondent registered the disputed domain names. See, e.g., *Valero, Cummins, Staatliche Porzellan-Manufaktur Meissen GmbH, Forideas, National Westminster, Tommy Bahama, Space Needle, Oakley, Burberry, HRB Innovations and MySpace*, all cited *supra*; and *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106. As such, the Respondent could never likely become commonly known by either of the disputed domain names or the Complainant's Marks for any of the goods which are either identical or sufficiently similar to those listed on the Complainant's trademark registrations or with which it uses its corporate/brand name without infringing on the exclusive trademark rights of the Complainant. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

There can simply be no question that the Respondent was well aware of the Complainant, its Marks and the Complainant's exclusive rights in those marks, and the reputation of those Marks when the Respondent registered the disputed domain names. Yet, in spite of that knowledge, the Respondent intentionally registered the disputed domain names. Though the Respondent's websites contain no content – whether critical of the Complainant or not, it is clear to this Panel that the Respondent is currently using the disputed domain names to misappropriate and exploit the reputation inherent in the Complainant's Marks to the Complainant's detriment through deliberately causing confusion with those marks and by doing so divert Internet users to those sites.

Had the Respondent posted content, the purpose of which was solely to criticize the Complainant, that content may constitute – under facts not present here – protected speech under the First Amendment. However, the Respondent did not do so. Its site is devoid of any content other than simply a three-word announcement stating "Website coming soon". Thus, the use of the disputed domain names, each of which incorporates one of the Complainant's Marks in its entirety, to cause user confusion and consequently user diversion to the Respondent's own websites is illicit and consequently does not qualify as a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

Accordingly, based on the evidence presently before the Panel, the Respondent does not fall within any of circumstances under paragraph 4(c) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain names.

Thus, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain names within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain names, constitute bad

faith registration and use.

It is indisputable that the Respondent was well aware of the Complainant, its MARLBORO and PHILIP MORRIS Marks, and the substantial reputation which the Complainant exclusively has in those marks when the Respondent registered the disputed domain names. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain names for their potential to cause confusion with those marks. Relying on that confusion, the Respondent uses the disputed domain names to direct Internet users to its own websites. Since the date of which the Respondent registered the disputed domain names, its websites have been devoid of any content other than a simple message indicating the sites are under construction, and hence, for all practical purposes, are inactive. There is no indication in the record as to when, if ever, the Respondent will post any substantive content to its websites – let alone content critical of the Complainant.

While critical content may under appropriate circumstances – which are missing here – justify use of the disputed domain names to the point where all the content coupled with use of the disputed domain names constitute constitutionally protected speech under the First Amendment, such justification is entirely absent here as the websites are totally devoid of any such critical content.

In view of the totality of the present circumstances here, namely the intentional registration of the disputed domain names containing the Complainant's marks in their entirety, the use of those domain names to cause user confusion and diversion and the continuing inactivity of those sites since the date the disputed domain names were registered, the Panel finds that the Respondent registered and used the disputed domain names in bad faith under the general bad faith provision of paragraph 4(b) of the Policy. See, paragraph 3.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition, which states in pertinent part:

“With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, panels have found that the apparent lack of so-called active use (*e.g.*, to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark”

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain names, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainants. The disputed domain names <againstmarlboro.com> and <againstphilipmorris.com> are to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: November 9, 2015