

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-1079

1. The Parties

Complainant is N. M. Rothschild & Sons Limited, United Kingdom, represented by Freshfields, Bruckhaus, Deringer, United Kingdom.

Respondent is Domains By Proxy, LLC, United States of America (“United States”) / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <rothschildadco.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 March 29, 2022. On March 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 31, 2022 and April 1, 2022, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on April 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 4, 2022.

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 Respondent of the Complaint, and the proceedings commenced on April 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 28, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 3, 2022.

The Center appointed Fernando Triana as the sole panelist in this matter on May 10, 2022. 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

Complainant is a recognized market leader in the financial world. Complainant and affiliated entities are the owners of, or otherwise have rights in the trademarks ROTHSCHILD (United States trademark registration No. 3447667, registered on June 17, 2008, in international classes 35 and 36), and ROTHSCHILD & CO (United States trademark registration No. 5614371, registered on November 27, 2018, in international classes 35 and 36), and the domain name <rothschildandco.com>.

The disputed domain name was registered on October 6, 2021, and it redirects to various websites including the website displaying pay-per-links to third parties' sites.

5. Parties' Contentions

A. Complainant

Complainant and its group, the Rothschild & Co group, is a recognized market leader in the financial world that provides services on a worldwide basis.

Complainant and affiliated entities are the owners of, or otherwise have rights in the trademarks ROTHSCHILD and ROTHSCHILD & CO, and the domain name <rothschildandco.com>.

Complainant's trademarks are well known in connection with financial services. In particular, it provides mergers and acquisitions (M&A), strategy and financing advice, as well as investment and wealth management solutions to large institutions, families, individuals and governments.

Complainant's rights predate Respondent's registration of the disputed domain name.

The disputed domain name is confusingly similar to the trademarks in which Complainant has rights. The disputed domain name incorporates the ROTHSCHILD trademark in its entirety. The disputed domain name also incorporates the ROTHSCHILD & CO trademark in its entirety except for the replacement of the ampersand symbol "&" with the misspelled string "ad".

Respondent has no rights or legitimate interests in the disputed domain name.

There is no relationship between Respondent and Complainant.

Neither "Rothschild" nor "Rothschild & Co" are descriptive terms.

Complainant has not licensed or otherwise permitted Respondent to use the "Rothschild" name, the ROTHSCHILD trademarks, or to register a domain name incorporating any of them.

Respondent is not a customer of Complainant or *vice versa*.

Complainant has not found any evidence that Respondent has been commonly known by the disputed domain name.

Respondent is not currently using and has not used (or made demonstrable preparations to use) the disputed domain name in connection with a *bona fide* offering of goods or services. The disputed domain name redirects Internet users to different websites.

Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

Respondent presumably intended to derive consequent financial benefit from the increased consumer volume.

The disputed domain name has been registered and is being used in bad faith as Respondent is intentionally attempting to attract, for commercial gain, Internet users to the websites and/or other online locations, by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation or endorsement.

Respondent has been a respondent in at least 230 complaints from multiple complainants since 2019, in particular, Respondent has been a respondent in two previous complaints made by Complainant in *N. M. Rothschild & Sons Limited v. Domains By Proxy, LLC and Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-2066](#), and *N. M. Rothschild & Sons Limited v. Privacy Service Provided by Withheld for Privacy ehf / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-3914](#). Therefore, Respondent has been engaged in a pattern of bad faith conduct.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Likewise, paragraph 10(d) of the Rules, provides that "the Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

The Panel wishes to place special emphasis on the evidence filed to prove assertions, which has been thoroughly studied in order to determine its relevance and weight in arriving at a decision. The statements that have been accompanied by evidence have been given more importance than the mere unsubstantiated assertions.

Paragraph 4(a) of the Policy requires that Complainant prove each of the following three elements to obtain an order that the disputed domain name be cancelled or transferred:

- (1) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (3) the disputed domain name has been registered and is being used in bad faith.

This discussion, based on the evidentiary support submitted by Complainant, noting that Respondent did not reply to Complainant's contentions, will be discussed as follows:

First of all, the Panel will determine whether or not the disputed domain name is identical or confusingly similar to the trademark in which Complainant has rights. Secondly, the Panel will verify if Respondent has any rights or legitimate interests in respect of the disputed domain name; and thirdly, the Panel will establish whether or not the disputed domain name has been registered and is being used in bad faith by Respondent.

A. Identical or Confusingly Similar

Complainant contends to have rights in the registered trademarks ROTHSCHILD and ROTHSCHILD & CO in several jurisdictions (see section 4 above).

a) Existence of a trademark or service mark in which Complainant has rights

Firstly, it is important to point out that paragraph 4(a) of the Policy requires the existence of a trademark or a service mark.

When a sign is registered as a trademark, it is surrounded by a presumption of sufficient distinctiveness, and the owner is granted with an exclusive right over the mark, which entitles him to prevent any third party from using the registered sign or any other sign confusingly similar to it.

In this case, Complainant has proved its rights in the trademarks ROTHSCHILD and ROTHSCHILD & CO in Annex 4 to the Complaint.

This information appears to be incontestable and conclusive evidence of Complainant's rights in the cited trademarks and the exclusive right to use them in connection with the stated services. The registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive.

Thus, Complainant established its rights in the trademarks ROTHSCHILD and ROTHSCHILD & CO.

Therefore, the Panel concludes that Complainant has demonstrated rights in the trademarks ROTHSCHILD and ROTHSCHILD & CO for purposes of paragraph 4(a)(i) of the Policy.

b) Identity or confusing similarity between the disputed domain name and Complainant's trademark

Complainant alleges that the disputed domain name incorporates the trademarks ROTHSCHILD and ROTHSCHILD & CO, changing the ampersand for the word "and" misspelled as "ad".

On the first place, before establishing whether or not the disputed domain name is confusingly similar to Complainant's trademarks, the Panel wants to point out that the addition of a generic Top-Level Domain ("gTLD"), e.g., ".com," ".biz," ".edu," ".org," or ".net" is generally disregarded when determining if the disputed domain name is identical or confusingly similar to the trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.11.

Hence, the inclusion of the ".com" gTLD, in the disputed domain name is not a factor in analyzing whether a disputed domain name is identical or confusingly similar to the mark in which Complainant asserts rights.

Furthermore, the Panel considers that the reproduction of the trademarks ROTHSCHILD in its entirety and the dominant part of ROTHSCHILD & CO in the disputed domain name is sufficient to establish that the disputed domain name is confusingly similar to the trademarks. Especially the Complainant's trademarks are clearly recognizable in the disputed domain name.

In addition, the Panel agrees with Complainant on the conclusion that an intentional misspelling of a trademark does not prevent a finding of confusing similarity between the disputed domain name and Complainant's trademark ROTHSCHILD & CO (section 1.9 of the [WIPO Overview 3.0](#)).

In consequence, as per this reasoning, the Panel finds that, the disputed domain name is confusingly similar to Complainant's trademarks and thus, the requirement set forth in paragraph 4(a)(i) of the Policy is duly complied with.

B. Rights or Legitimate Interests

a) *Prima facie* case

Regarding this second element of paragraph 4(a) of the Policy, UDRP panels have unanimously found that requiring the complainant to prove the lack of rights or legitimate interests of the respondent in the disputed domain name is often an impossible task. It is not only proving a negative but also demands access to information that is mostly within the knowledge of the respondent¹.

In *Julian Barnes v. Old Barn Studios Ltd.*, WIPO Case No. [D2001-0121](#), the Panel stated that:

“Is the Respondent required to adduce any such evidence, if the onus is on the Complainant to prove the three elements of paragraph 4 of the Policy? While the overall burden of proof is on the Complainant, this element involves the Complainant proving matters, which are peculiarly within the knowledge of the Respondent. It involves the Complainant in the often impossible task of proving a negative. In the Panel’s view the correct approach is as follows: the Complainant makes the allegation and puts forward what he can in support (e.g. he has rights to the name, the Respondent has no rights to the name of which he is aware, he has not given any permission to the Respondent). Unless the allegation is manifestly misconceived, the Respondent has a case to answer and that is where paragraph 4(c) of the Policy comes in. If the Respondent then fails to demonstrate his rights or legitimate interests in respect of the Domain Name, the complaint succeeds under this head”.

Therefore, Complainant is required to make a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Once this *prima facie* case is made, the burden of production shifts to Respondent, who must come forward with concrete evidence of its rights or legitimate interests². If Respondent fails to do so, Complainant is deemed to have met the second element of paragraph 4(a) of the Policy.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name because of the following: i) Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services; ii) Respondent is not a licensee of Complainant, nor has Respondent been otherwise authorized by Complainant to make any use of its trademarks, in a domain name or otherwise; iii) Complainant has no prior business relationship with Respondent; iv) The disputed domain name has been used as to redirect to third parties’ sites; v) Respondent is not commonly known by the disputed domain name; and vi) Respondent is not currently making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers.

The Panel accepts these assertions as a *prima facie* case made by Complainant that shifts the burden of production to Respondent.

b) Respondent’s rights or legitimate interests in the disputed domain name

Paragraph 4(c) of the Policy includes a non-limited listing of circumstances that serve to prove Respondent’s rights or legitimate interests in the disputed domain name:

(i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if Respondent has acquired no trademark or service mark rights; or

¹ See *Arla Foods amba v. Bel Arbor / Domain Admin, PrivacyProtect.org*, WIPO Case No. [D2012-0875](#); see also *F. Hoffmann-La Roche AG v. Bargin Register, Inc. - Client Services*, WIPO Case No. [D2012-0474](#).

² See *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

(iii) Respondent is 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 trademark or service mark at issue.

Respondent did not file any Response, thus, failed to rebut Complainant's *prima facie* case, and to show his rights or legitimate interests in the disputed domain name. Hence, as per paragraph 14 of the Rules, the Panel shall draw such inferences therefrom as it considers appropriate:

- Respondent's use of the disputed domain name is not in connection with a *bona fide* offering of goods or services, as it uses a third party's trademarks to divert consumers to various third parties' sites. Consequently, Respondent's use is directed to capitalize Complainant's trademarks ROTHSCHILD and ROTHSCHILD & CO goodwill by attracting Internet users to its website.
- There is no evidence within the file proving that Respondent is commonly known by the disputed domain name.
- There is no evidence within the file proving that Complainant licensed or otherwise permitted any use by Respondent of its trademarks.
- There is no evidence within the file justifying the choice of the trademarks ROTHSCHILD and ROTHSCHILD & CO to create the disputed domain name for a *bona fide* purpose.
- There is no evidence within the file proving Respondent's rights over the trademarks ROTHSCHILD and ROTHSCHILD & CO anywhere in the world.
- There is no evidence within the file proving that Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without the intention of commercial gain by misleadingly divert consumers.

The Panel thus concludes that Respondent lacks rights or legitimate interests in the disputed domain name.

Therefore, the second requirement of paragraph 4(a) of the Policy is met.

C. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

(i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to his/her website or other online location, by creating a likelihood of

confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his/her website or location or of a product or service on his/her website or location.

For the Panel it is evident that Respondent knew of the existence and importance of Complainant's trademarks when registering the disputed domain name, in particular, Respondent has been a respondent in two previous complaints filed by Complainant. Further, it is not a coincidence to include a widely-known trademark within a domain name. Thus, the Panel finds that Respondent deliberately took Complainant's trademarks to register the disputed domain name, which constitutes bad faith.

In addition, Complainant contends in the Complaint that Respondent is using the disputed domain name in bad faith. The disputed domain name redirects to various websites. Complainant also mentions that Respondent's website contains sponsored links being a pay-per-click site, and the Panel accepts the uncontested assertions by Complainant that Respondent has used the disputed domain name to host a page consisting of pay-per-click links to commercial websites related to other businesses. Thus, Respondent chose the disputed domain name, which is confusingly similar to Complainant's trademarks, in order to generate Internet traffic to its website.

The Panel finds that Respondent must have known that including Complainant's trademarks within the disputed domain name would attract Internet users seeking Complainant's services. Thus, Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement.

The Panel further notes that Respondent has been involved in numerous previous proceedings under the Policy, which is further evidence of Respondent's bad faith.

Therefore, the third element of the Policy, paragraph 4(a) is satisfied in the present case in respect to Respondent's bad faith registration and use of the disputed domain name.

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 <rothschildadco.com> be transferred to Complainant.

/Fernando Triana/

Fernando Triana

Sole Panelist

Date: May 23, 2022