

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Privacy Service Provided by Withheld for Privacy ehf / MELENDEZ PEDRO J

Case No. D2022-1234

1. The Parties

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / MELENDEZ PEDRO J, United States of America.

2. The Domain Name and Registrar

The disputed domain name <rothschildandcoins.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 7, 2022. On April 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 8, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 26, 2022 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 April 27, 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 the Respondent of the Complaint, and the proceedings commenced on May 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 25, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on May 31, 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.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

According to un rebutted information from the Complainant, the Complainant and its group, the Rothschild & Co group, is a recognised market leader in the financial world that provides services on a worldwide basis. The Rothschild & Co group has been a leading provider of financial services for over two hundred years.

The Complainant or its group entities have registered several trademarks consisting of ROTHSCHILD or ROTHSCHILD & CO including the European Union trademark registration No. 000206458, registered on October 8, 1998 for ROTHSCHILD, and the European Union trademark registration No. 017924819, registered on October 31, 2018, for ROTHSCHILD & CO.

Rothschild & Co Continuation Holdings AG, an entity affiliated to the Complainant, is the registrant of the domain name <rothschildandco.com> (among others).

The disputed domain name was registered on November 29, 2021 and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to the trademarks in which the 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 string "and". The disputed domain name also includes the addition of "incs" at the end, which, as per the Complainant, is an abbreviation of "incorporated", and does not exclude the confusing similarity between the disputed domain name and the Complainant's ROTHSCHILD trademarks.

With respect to the second element, the Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name. There is no relationship between the Respondent and the Complainant. The Complainant has not licensed or otherwise permitted the Respondent to use its trademarks, or to register a domain name incorporating any of them. Furthermore, the Complainant has not found any evidence that the Respondent has been commonly known by the disputed domain name. The disputed domain name does not resolve to an active website; thus, the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

As regards to the third element, the Complainant argues that the disputed domain name has been registered and is being used in bad faith because of the Respondent's non-use of the disputed domain name. The ROTHSCHILD trademarks are extremely well-known in connection with the Rothschild & Co group, and the Complainant has substantial goodwill and reputation in ROTHSCHILD & CO and ROTHSCHILD. The Complainant argues that the Respondent must have been aware of the Complainant's rights at the time it registered the disputed domain name, in particular because the disputed domain name contains the ROTHSCHILD trademarks.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Preliminary Matters

No communication has been received from the Respondent in this case. However, given that notice of the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent's failure to file any Response.

6.2 Substantive Matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant has produced a list of trademark registrations for ROTHSCHILD and ROTHSCHILD & CO. No copies of certificates of trademark registration or other official documents have been produced. However, the Panel has no reason to doubt the accuracy of the information submitted by the Complainant. For completeness, noting the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, the Panel has undertaken limited factual research, and notes from the public trademark records that the Complainant or its group companies is indeed the owner of a multitude of trademark registrations. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8. The Panel is satisfied that the Complainant is the owner of the trademarks ROTHSCHILD and ROTHSCHILD & CO.

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. The trademark ROTHSCHILD is reproduced in its entirety in the disputed domain name. The addition of the terms "and", "co" and "incs" does not prevent a finding of confusing similarity with the Complainant's trademark ROTHSCHILD, which is recognizable in the disputed domain name. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of an additional term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

It is well accepted by UDRP panels that a generic Top Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademarks ROTHSCHILD and ROTHSCHILD & CO, and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because he did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

To fulfill the third requirement of the Policy, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

According to the un rebutted assertions of the Complainant, its ROTHSCHILD and ROTHSCHILD & CO trademarks were widely used in commerce well before the registration of the disputed domain name in November 2021 and are well-known (as also held *e.g.* in *N. M. Rothschild & Sons Limited v. Contact Privacy Inc. Customer 12410746041 / "FAPI III"*, WIPO Case No. [D2021-3915](#)). The disputed domain name is confusingly similar with the Complainant's trademarks. Under these circumstances, it is most likely that the Respondent was aware of the Complainant's trademark at the registration date of the disputed domain name. The Respondent provided no explanations for why he registered the disputed domain name.

As regards to the use, the disputed domain name is passively held.

Section 3.3 of the [WIPO Overview 3.0](#) describes the circumstances under which the passive holding of a domain will be considered to be a bad faith registration: "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

The Panel finds that passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence in the record of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. UDRP panels have 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 section 3.1.4 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

Based on the evidence and circumstances of this case, the Panel concludes that the disputed domain name was registered and used in bad faith.

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 <rothschildandcoins.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: June 14, 2022