

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Name Redacted
Case No. D2022-4880

1. The Parties

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

The Respondent is Name Redacted¹.

2. The Domain Name and Registrar

The disputed domain name <rothschildandsco.com> is registered with Wild West Domains, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 20, 2022. On December 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 21, 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, Domains By Proxy, LLC, and contact information in the Complaint. The Center sent an email communication to the Complainant on December 21, 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 December 28, 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

¹ The registrant of the disputed domain name <rothschildandsco.com> appears to have used the name and contact details of a third party when registering the disputed domain name <rothschildandsco.com> (see below). In light of the potential identity theft, the Panel has redacted the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name <rothschildandsco.com>, which includes the name provided for the registration of the disputed domain name <rothschildandsco.com>. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

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 January 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2023. The Center received an email from the Respondent on January 24, 2023.

The Center appointed Taras Kyslyy as the sole panelist in this matter on February 3, 2023. 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

The Complainant is a provider of financial services for over two hundred years. In particular, it provides M&A, strategy and financing advice, as well as investment and wealth management solutions to large institutions, families, individuals and governments. The Complainant provides its services under names containing ROTHSCHILD & CO and ROTHSCHILD, and has established substantial goodwill and reputation in names and trademarks containing ROTHSCHILD. The Complainant has invested substantial sums of money in developing and marketing its services under its trademarks and in protecting its rights.

The Complainant and affiliated entities are the registered owners of, or otherwise have rights in, a number of registrations for the trademarks ROTHSCHILD & CO, including for instance the United States of America trademark registration No. 5614371, registered on November 27, 2018. There are arrangements in place through which the Complainant is licensed to use the Rothschild & CO trademarks where registrations are held by connected entities.

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 October 27, 2022 and resolves to inactive webpage.

5. Parties’ Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant’s trademark. The disputed domain name incorporates the Complainant’s trademark in its entirety except for the replacement of the ampersand symbol “&” with the string “and” with an extra ‘s’ between the strings “and” and “co”.

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’s trademark is not a descriptive term and the Complainant has not licensed or otherwise permitted the Respondent to use its trademark, or to register a domain name incorporating it. The Respondent is not a customer of the Complainant or *vice versa*. The Complainant has not found any evidence that the Respondent has been commonly known by the disputed domain name. The 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 (nor could it do so) because the disputed domain name does not lead to an active website. The Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. The disputed domain name falsely suggests affiliation with the Complainant and carries a higher risk of implied affiliation.

The disputed domain name was registered and is being used in bad faith. The 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 the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the websites and/or other online locations. The Complainant's trademarks are extremely well-known, and the Respondent must have been aware of the Complainant's rights at the time it registered the disputed domain name, in particular because it contains the Complainant's trademark. The disputed domain name is confusingly similar to the well-known Complainant's trademark, and Internet users are therefore likely to be misled into believing that the disputed domain name is affiliated to, endorsed by, or otherwise connected to, the Complainant and/or its group. In addition, there is a risk that the Respondent is using email addresses associated with the disputed domain name. The disputed domain name has an active MX record, indicating that the email addresses associated with the disputed domain name are active. If this is the case, recipients of emails from a "@rothschildandsco.com" email address may be confused into thinking that these emails have been sent by the Complainant (which is not the case), due to the incorporation of the Complainant's trademark in its entirety. There is a heightened risk that the disputed domain name could be used to send phishing emails to the Complainant's clients or be used for other fraudulent purposes. These activities could potentially deprive the Complainant of future business and/or tarnish the Complainant's reputation. The disputed domain name was registered to confuse individuals into thinking that it and any email addresses associated with it are connected with the Complainant. As a result, the mere registration of the disputed domain name by the Respondent indicates bad faith on its part.

B. Respondent

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

The Respondent sent an email to Center on January 24, 2023 that stated: "I am sorry it has taken me so long to respond. I have been researching how my name became associated with the domain name of rothschildandsco.com. I do not want to dispute the domain name. I contacted Wild West Domains abuse hotline to find out how my information became associated with the Rothchild domain. They had informed me that I had been comprised. They contacted WHO IS on my behalf to let them know that my information is not associated with Rothchild. WHO IS has corrected this mistake and has now removed my information from the Rothchild domain."

6. Discussion and Findings

A. Redaction of the Respondent's name

While the Panel notes that the registrant's email address is the same used by the Respondent in its email communication, it appears that, due to an identity theft, a third party used the contact details of the listed registrant without its knowledge. Accordingly, the Panel finds it appropriate to redact the Respondent's name from the record of this proceeding.

B. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") the applicable generic Top-Level Domain ("gTLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant's trademark.

According to section 1.9 of the [WIPO Overview 3.0](#) a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark

for purposes of the first element. The Panel considers the disputed domain name consisting of intentional misspelling of the Complainant's trademark, in particular the addition of the "s" letter.

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence does not suggest that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The Respondent has no rights or legitimate interests in the disputed domain name resolving to an inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)).

Noting the composition of the disputed domain name, confusingly similar to the well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant (see, e.g., *Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / Zayed*, WIPO Case No. [D2019-2897](#)).

Considering the above, the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to section 3.1.4 of the [WIPO Overview 3.0](#) 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. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark both in the United Kingdom and internationally. Thus, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and was registered in bad faith.

According to section 3.3 of the [WIPO Overview 3.0](#) from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. In this regard the Panel takes into account (i) the high degree of distinctiveness and reputation of the Complainant's trademark, (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 concealing its identity while registering the disputed domain name, and (iv) the implausibility of any good faith use to which the disputed domain name may be put. Thus, the Panel finds the bad faith use of the disputed domain name in the present case.

Considering the above, the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under paragraph 4(a)(iii) of the Policy.

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 <rothschildandsco.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: February 15, 2023