

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Carolina Rodrigues, Fundacion Comercio Electronico

Case No. D2023-0648

1. The Parties

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <rothshildandco.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 February 13, 2023. On February 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 2023, 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, United States of America) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 2023 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 February 21, 2023.

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 March 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on March 31, 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 in this administrative proceeding is N. M. Rothschild & Sons Limited, a company incorporated in England & Wales. The Complainant is a member of the Rothschild & Co group.

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>.

The disputed domain name was registered on December 5, 2022 and resolves to a webpage with pay-per-click ads.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name.

The Complainant is of the opinion that the disputed domain name is confusingly similar to its registered trademarks.

Furthermore, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It is rather argued that the disputed domain name falsely suggests that there is some official or authorized link between the Complainant and the Respondent.

Finally, it is argued that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark ROTHSCCHILD & CO is recognizable within the disputed domain name <rothshildandco.com>. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor made 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. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2;
- the Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3;

- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that:

- The disputed domain name <rothshildandco.com> is almost identical (except for the missing first letter “c”) to the domain name <rothschildandco.com>, for which Rothschild & Co Continuation Holdings AG, an entity affiliated to the Complainant, is the registrant.
- The Respondent in this proceeding has been a respondent in four previous complaints filed by the Complainant in relation to the Rothschild Trade Marks: (1) *N. M. Rothschild & Sons Limited v. Domains By Proxy, LLC and Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-2066](#); (2) *N. M. Rothschild & Sons Limited v. Privacy Service Provided by Withheld for Privacy ehf / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-3914](#); (3) *N. M. Rothschild & Sons Limited v. Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2022-1078](#); and (4) *N. M. Rothschild & Sons Limited Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2022-1079](#). Therefore the Respondent was aware of the Complainant when she registered the disputed domain name.
- In addition, the panel also notes that a search for “Carolina Rodrigues” as a named respondent. On the WIPO database of UDRP cases shows that the Respondent has been a respondent in at least 350 complaints from multiple complainants since the year 2019. This extensive evidence of the Respondent’s past poor conduct in the registration of domain names further supports the Complainant’s assertion that the Disputed Domain Name has been registered in bad faith.
- The disputed domain name contains pay-per-click ads, including links to competitors of the Complainant.
- The Respondent has defaulted.

The 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, and the Respondent has engaged in a pattern of such conduct. Paragraph 4(b)(ii) of the Policy, and [WIPO Overview 3.0](#), section 3.1.2.

The Panel concludes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s web site or location or of a product or service on the Respondent’s web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <rothshildandco.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: April 18, 2023.