

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Beasley, Ben
Case No. D2023-2795

1. The Parties

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

The Respondent is Beasley, Ben, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <rothschiidandco.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 June 30, 2023. On June 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 4, 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 July 4, 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 July 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on August 28, 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 one of the leading providers of financial services in the world, operating under the brands ROTHSCHILD and ROTHSCHILD & CO.

The Complainant owns several ROTHSCHILD & CO trademark registrations in multiple countries, including the Canadian registration no. TMA1062927, filed on June 8, 2015, and registered on November 13, 2019; the United States trademark registration no. 5614371, filed on March 9, 2017, and registered on November 27, 2018; and the United Kingdom trademark registration no. 3321370, filed on June 29, 2018, and registered on November 23, 2018.

The Complainant is also the owner of numerous domain names containing the term “Rothschild & Co”, such as <rothschildandco.com>.

The Respondent registered the disputed domain name on June 19, 2023.

The disputed domain name does not resolve to any active website¹. The Complainant brought evidence that the Respondent has used the disputed domain name to setup email servers.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant’s rights in the ROTHSCHILD trademarks predate the Respondent’s registration of the disputed domain name. 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, except the replacement of the “l” with the “i”. 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” and with the replacement of the “l” with the “i” in “Rothschild”. 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”. Section 1.9 of further clarifies that “This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark”. Previous UDRP decisions have found that the substitution of the string “and” for “&” in the ROTHSCHILD & CO trademark does not avoid a confusing similarity with the ROTHSCHILD trademarks. Therefore, there is a real risk that Internet users will believe that there is a connection between the disputed domain name and the Complainant’s group. It is likely that Internet users that intend to visit the Complainant’s website might accidentally visit the disputed domain name as a result of a spelling error.

¹ Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8, “[n]oting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision...This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the disputed domain name...”.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no relationship between the Respondent and the Complainant. Neither "Rothschild" nor "Rothschild & Co" is a descriptive term and the Complainant has not licensed or otherwise permitted the Respondent to use the "Rothschild" name, the ROTHSCHILD & CO trademark or the ROTHSCHILD trademarks, or to register a domain name incorporating any of them. So far as the Complainant is aware, the Respondent is not a customer of the Complainant or vice versa. Furthermore, 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 Complainant submits that 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 trademark owner. Given the clear indicia of bad faith, it is apparent that the Respondent has no legitimate interest in the disputed domain name.

- The disputed domain name was registered and is being used in bad faith. The Complainant submits that the disputed domain name has been registered and is being used in bad faith because 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 ROTHSCHILD trademarks are extremely well-known in connection with the Rothschild & Co group and the Complainant has substantial goodwill and reputation in names containing ROTHSCHILD & CO and ROTHSCHILD. The Respondent must have been aware of the Complainant's rights at the time it registered the disputed domain name. The degree of reputation of the ROTHSCHILD trademarks makes it implausible that the Respondent could put any good faith use to the disputed domain name. 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 email exchange ("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 "@rothschildandco.com" email address may be confused into thinking that these emails have been sent by the Rothschild & Co group (which is not the case). This means there is a heightened risk that the disputed domain name could be used to send phishing emails to Rothschild & Co group clients or be used for other fraudulent purposes. These activities could potentially deprive the Rothschild & Co group of future business and/or tarnish the Rothschild & Co group's reputation.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) The disputed 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 the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel has no doubt that “Rothschild & Co” is a term directly connected with the Complainant’s trademarks and centenary financial services.

Annex 4 to the Complaint shows trademark registrations for ROTHSCHILD & CO that date as early as in 2015.

The disputed domain name contains the mark ROTHSCHILD & CO in its entirety, except for the replacement of the ampersand symbol “&” with the string “and” and with the replacement of the “l” with the “i”. Such misspelling of the Complainant’s trademark may characterize a practice commonly called “typosquatting”, a kind of cybersquatting in which a respondent registers a domain name in order to take advantage of typing errors eventually made by Internet users seeking a complainant’s website (see *CPP, Inc. v. Virtual Sky*, WIPO Case No. [D2006-0201](#)).

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. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark. See section 1.9 of the [WIPO Overview 3.0](#).

Finally, it is also already well established that the addition of a generic Top-Level Domain (“gTLD”) such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name; or
- (iii) the 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 at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Complainant has showed that the disputed domain name was used to setup an email server. Anyone receiving an email from “@rothschiidandco.com” would naturally - and mistakenly - conclude that it came from the Complainant.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the 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, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2023) the trademark ROTHSCCHILD & CO was already well-known worldwide and directly connected to the Complainant's financial services.

According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's famous trademark, as well as that the adoption of the expression "rothschiidandco" together with the gTLD ".com" could be a mere coincidence.

UDRP panels have frequently found that the apparent lack of so-called active use of the disputed domain name (passive holding) does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

The non-collaborative posture of the Respondent, *i.e.*, (a) not presently using the disputed domain name, (b) not indicating any intention to use it, and (c) not at least submitting a Response to this procedure or providing justifications for the use of a famous third party trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion. Such circumstances, together with (d) the lack of any plausible interpretation for the adoption of the term "rothschiidandco" by the Respondent, and (f) with the fact that the disputed domain name could be used to send email messages that would probably confuse the recipient as to the identity of the sender, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and used in bad faith, and the Complainant has also satisfied the third element 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 <rothschiidandco.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: September 11, 2023