

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Ahmed Serag

Case No. DCO2024-0013

1. The Parties

Complainant is N. M. Rothschild & Sons Limited, United Kingdom (“UK”), represented by Freshfields, Bruckhaus, Deringer, UK.

Respondent is Ahmed Serag, Canada.

2. The Domain Name and Registrar

The disputed domain name <rothschildand.co> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 19, 2024. On February 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 20, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Tucows Domains Inc., REDACTED FOR PRIVACY, Contact Privacy Inc. Costumer 0170176178) and contact information in the Complaint. The Center sent an email to Complainant on February 20, 2024, 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 the same date.

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 February 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2024. Respondent sent emails to the Center on February 20, 21, 26, and March 18, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on March 21, 2024. 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

According to the Complaint:

“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. In particular, it provides M&A [mergers and acquisitions], strategy and financing advice, as well as investment and wealth management solutions to large institutions, families, individuals and governments. The Rothschild & Co group provides its services under names containing ROTHSCCHILD & CO and ROTHSCCHILD, and has established substantial goodwill and reputation in names and trade marks containing ROTHSCCHILD & CO and ROTHSCCHILD.”

Complainant holds numerous trademark registrations for the mark ROTHSCCHILD around the world, including UK Reg. No. 1168291, registered on January 21, 1982, in connection with, among other things, “precious metals”, and UK Reg. No. 1285832, registered on October 12, 1990, in connection with, among other things, “banking” and “financial services”. Complainant also holds trademark registrations for the mark ROTHSCCHILD & CO, including United States Reg. No. 5614371, registered on November 27, 2018, in connection with, among other things, “financial services”, and UK Reg. No. 3321370, registered on November 23, 2018, in connection with, among other things “banking, financial affairs”.

Complainant’s main commercial website is accessible via the domain name <rothschildandco.com>.

The Domain Name was registered on February 8, 2024. According to the evidence submitted in the Complaint, the Domain Name redirected to the LinkedIn profile page for Respondent. According to Complainant, Respondent is not and has not been associated with Complainant.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not file a formal Response. As noted above, however, Respondent sent the Center a series of emails between February 20, 2024, and March 18, 2024. Respondent’s position vis-à-vis the Domain Name is quoted below, with edits to reduce redundancy:

“If the complaint filer would like to purchase my domain like a normal Citizen and participant in the market just like everyone else, they can do so here: [URL omitted]. Be aware I already have a couple offers, so better they purchase it quickly. Otherwise if they pursue this unjustified complaint, I’ll have to make the marketplace aware of this attempted theft by Freshfields / Rothschild & Co. This isn’t legal or acceptable in the United States of America and Canada.”

“There’s an ongoing dispute between many people and companies sharing the Rothschild name at this moment, as evidenced here: [URL omitted]. I’m in discussions with other parties - like Edmond de Rothschild Group & Nicky Hilton/Rothschild - interested in making use of this domain with me, and as the

current Owner, I reserve the Right to do so privately without enquiry from a possibly interested party like Freshfields / Rothschild & Co. As I mentioned, they're free to make an offer on the domain if they want to build something with it sooner than I want to do something with it."

"Sure, but it should be taken into consideration that Freshfields has no claim to this domain, and that there are multiple families, companies, and people with interests in 'Rothschild' as a name. I've already mentioned Edmond de Rothschild is in conflict with 'Freshfields / Rothschild & Co' which is likely why they filed this complaint in an attempt to take control of a domain they have no Right to. I look forward to a decision against Rothschild & Co / Freshfields."

"My name is Ahmed Serag and attached is my official argument in favor of granting me continued ownership of my domain against Rothschild & Co. I'm the owner of RothschildAnd.co and have been since its inception as of February 4, 2024 8:26PM EST when I purchased it from Squarespace and Tucows. Freshfields and Rothschild & Co have no legitimate claim to my domain because: 1. They never purchased it 2. They never used it 3. They never had intention to purchase it 4. They only want to take my domain to justify their hourly costs to Rothschild & Co to pretend they do something at work 5. They have no purpose for the domain even if they did purchase it 6. They don't plant on using it even if you awarded it to them against my will 7. There are many parties with the name Rothschild interested in my domain, including Edmond de Rothschild Group, a competitor to Rothschild & Co, who are both embroiled in a naming dispute currently as evidenced by Bloomberg here [URL omitted]."

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel finds that Complainant holds rights in the marks ROTHSCHILD and ROTHSCHILD & CO through registrations demonstrated in the record. The Panel finds that the Domain Name is confusingly similar to those marks. The mark ROTHSCHILD is entirely reproduced in the Domain Name and is clearly recognizable within it. The mark ROTHSCHILD & CO is also recognizable in the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. Respondent has not come forward to articulate some bona fide basis for registering the Domain Name. Respondent's entire argument appears to be that he registered the Domain Name first, and that he is in discussions with others to sell it. It is apparent from the record that Respondent targeted Complainant's longstanding and well-known mark. His attempt to leverage that mark by registering the Domain Name and offering it for sale does not vest Respondent with a legitimate interest in the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the 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 its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the 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) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. The Panel incorporates here its discussion above in the "Rights or Legitimate Interests" section. The Panel finds, on this undisputed record and on a balance of probabilities, that Respondent had Complainant and its well-known marks in mind when registering the Domain Name, with the intention of selling it to the Complainant or someone else.

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <rothschildand.co> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: April 4, 2024