

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Stellar Custody
Case No. DCO2024-0049

1. The Parties

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

The Respondent is Stellar Custody, Switzerland.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 10, 2024. On July 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 10, 2024, 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 (Namecheap, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 15, 2024, 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 15, 2024.

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 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 12, 2024.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on August 19, 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

The Complainant and its group, the Rothschild & Co group is a recognized 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 200 years. In particular, it provides Mergers and Acquisitions (“M&A”), 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 marks containing ROTHSCHILD & CO and ROTHSCHILD.

The Complainant, through its affiliated entity Rothschild & Co Continuation Holdings AG, has rights in several trademarks for ROTHSCHILD (the “ROTHSCHILD trademark”) and ROTHSCHILD & CO (the “ROTHSCHILD & CO trademark”), including:

- United States of America Trademark Registration ROTHSCHILD No. 3447667, registered on June 17, 2008;
- European Union Trademark Registration ROTHSCHILD & CO No. 017924819, registered on October 31, 2018; and
- United Kingdom Trademark Registration ROTHSCHILD & CO No. UK00003321370, registered on November 23, 2018.

The Complainant and its affiliated entities are also the owners of domain names including the ROTHSCHILD trademark and ROTHSCHILD & CO trademark, such as the domain name <rothschildandco.com>, registered on July 22, 2013.

The disputed domain name was registered on May 28, 2024. At the time of decision and when the Complaint was filed, the disputed domain name resolved to an error webpage.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

On the first element of the Policy, the Complainant claims that the disputed domain name is confusingly similar to the ROTHSCHILD trademark. 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”. In addition, the disputed domain name is confusingly similar to the domain name of the Complainant, <rothschildandco.com>. The respective domain names are identical, save for the addition of the country code Top-Level domain (ccTLD) “.co” following the string “.com” in the disputed domain name.

On the second element of the Policy, the Complainant contends that 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 trademark, 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 the disputed domain name in connection with a bona fide offering of goods or services 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, and as the disputed domain name incorporates the ROTHSCCHILD trademark and the ROTHSCCHILD & CO trademark in their entirety, it carries a higher risk of implied affiliation. The Respondent's use of the disputed domain name cannot therefore amount to fair use. Given the clear indicia of bad faith, it is apparent that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant therefore submits that the circumstances in the present case are sufficient to establish a prima facie case to satisfy the requirements of paragraph 4(a)(ii) of the Policy.

On the third element of the Policy, the Complainant asserts that the Respondent registered the disputed domain name in bad faith. The Respondent is intentionally attempting to mislead Internet users into associating the disputed domain name with the Complainant's website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the disputed domain name. The ROTHSCCHILD trademark is extremely well known in connection with the Rothschild & Co group and the Complainant has substantial goodwill and reputation in names containing ROTHSCCHILD & CO and ROTHSCCHILD. The Complainant submits 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 ROTHSCCHILD trademark in its entirety. The disputed domain name is confusingly similar to the well-known ROTHSCCHILD 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. Recipients of emails from a "@rothschildandco.com.co" email address may be confused into thinking that these emails have been sent by the Rothschild & Co group (which is not the case), due to the incorporation of the ROTHSCCHILD trademark and the ROTHSCCHILD & CO trademark in their entirety, save for the ampersand symbol "&" with the string "and". The similarity between the ROTHSCCHILD trademark and the disputed domain name means that there is a heightened risk that the latter could be used to send phishing emails to Rothschild & Co group clients or be used for other fraudulent purposes. Any fraudulent activities could potentially deprive the Rothschild & Co group of future business and/or tarnish the Rothschild & Co group's reputation. The Complainant submits that the disputed domain name was registered to confuse individuals into thinking that it and any email addresses associated with it are connected with the Rothschild & Co group. 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.

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

- (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

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 3.0](#), section 1.7.

The applicable TLD 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. [WIPO Overview 3.0](#), section 1.11.

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 entirety of the ROTHSCHILD trademark is reproduced within the disputed domain name. Further, the entirety of the ROTHSCHILD & CO trademark is reproduced within the disputed domain name, whereby the symbol "&" is replaced by the word "and". Accordingly, the disputed domain name is confusingly similar to the ROTHSCHILD trademark and ROTHSCHILD & CO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the ROTHSCHILD trademark or ROTHSCHILD & CO trademark. The Panel finds on the record that there are no indications that the Respondent is commonly known by the disputed domain name or otherwise has any rights to or legitimate interests in the disputed domain name. Further, there are no evident preparations for the use of the disputed domain name for a bona fide offering of goods or services. Rather, the disputed domain name resolves to an error webpage.

Having reviewed the available 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 such as those enumerated in the Policy or otherwise.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel notes that the ROTHSCHILD trademark and ROTHSCHILD & CO trademark were registered before the disputed domain name, and the disputed domain name closely resembles the Complainant's prior registered domain name <rothschildandco.com>, the Panel finds that it is more likely than not that the Respondent registered the disputed domain name with the knowledge of the Complainant's trademarks, which indicates registration in bad faith.

Panels have found that the non-use of a domain name (including an error page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the ROTHSCHILD trademark and ROTHSCHILD & CO trademark, the composition of the disputed domain name (containing the Complainant's trademarks and is almost identical to the Complainant's domain name) and the Respondent's failure to submit a response and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established 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 <rothschildandco.com.co> be transferred to the Complainant.

/Christian Gassauer-Fleissner/
Christian Gassauer-Fleissner
Sole Panelist
Date: September 2, 2024