

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Ellen Paul
Case No. D2024-0751

1. The Parties

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

The Respondent is Ellen Paul, United States of America (“US”).

2. The Domain Name and Registrar

The disputed domain name <rothchildsandco.com> (“Disputed Domain Name”) is registered with NameCheap, 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 Disputed Domain Name. On the same date, 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., Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 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 amended Complaints on February 20 and 23, 2024.

The Center verified that the Complaint together with the amended Complaints 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 February 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 18, 2024.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on March 20, 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 is a company incorporated in England and Wales in 1968 and is a member of the Rothschild & Co group (the "Group"). The Complainant and the Group have been providing financial services such as merger and acquisition, investment and wealth management to individuals, large institutions, and governments for over 200 years.

The Group owns several trademark registrations for the ROTHSCHILD and ROTHSCHILD & CO marks (the "Complainant's Trademarks") in various jurisdictions, including, inter alia, European Union ("EU") Trademark Registration No. 000206458 for ROTHSCHILD registered on October 8, 1998, in Classes 14, 35, and 36; US Trademark Registration No. 5614371 for ROTHSCHILD & CO registered on November 27, 2018, in Classes 35 and 36; and UK Trademark Registration No. 3321370 for ROTHSCHILD & CO registered on November 23, 2018, in Classes 35 and 36.

One of the Complainant's affiliates is the registrant of the domain name <rothschildandco.com>, which resolves to the Group's website.

The Disputed Domain Name was registered on November 28, 2023. At the time of the Complaint and at the time of the decision, the Disputed Domain Name resolved to an inactive website. The Respondent appears to be an individual residing in the US based on the information provided by the Registrar.

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.

Notably, the Complainant contends the following:

(a) The Disputed Domain Name is confusingly similar to the Complainant's Trademarks as it incorporates the Complainant's Trademarks almost in their entirety. The Disputed Domain Name incorporates the ROTHSCHILD trademark in its entirety, save for the removal of the letter "s" from the string "rothschild". The Disputed Domain Name also incorporates the ROTHSCHILD & CO trade mark in its entirety, except for the removal of the "s" from the string "rothschild", the addition of the letter "s" following the string "rothschild" and the replacement of the ampersand symbol "&" with the string "and";

(b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent is not in any relationship with the Complainant, nor has the Respondent obtained any licence or authorisation from the Complainant to use the Complainant's Trademarks as part of a domain name or otherwise. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods and services; and

(c) The Complainant's well-established, worldwide reputation and the extensive use of the Complainant's Trademarks indicate that the Respondent was or should have been aware of the Complainant's Trademarks prior to registering the Disputed Domain Name. The Respondent intentionally registered the Disputed Domain Name to mislead Internet users into associating it with the Complainant and/or the Group and

potentially tarnishing the Group's reputation. The Complainant submitted that the Disputed Domain Name could be used to send phishing emails to the Group's clients or be used for other fraudulent purposes, although no such email was annexed in the Complaint.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of 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 by the Respondent 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 Trademarks and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

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 Complainant's Trademarks are recognisable within the Disputed Domain Name. The Disputed Domain Name incorporates the ROTHSCILD trademark in its entirety, save for the removal of the letter "s" from the string "rothschild". The Disputed Domain Name also incorporates the ROTHSCILD & CO trademark in its entirety, except for the removal of the "s" from the string "rothschild", the addition of the letter "s" following the string "rothschild" and the replacement of the ampersand symbol "&" with the string "and". The intentional misspelling of the Complainant's Trademarks does not alter this finding. [WIPO Overview 3.0](#), section 1.9. It is also well established that the generic Top-Level Domain ("gTLD"), ".com" in this case, may be disregarded. See section 1.11.1 of the [WIPO Overview 3.0](#). Accordingly, the Disputed Domain Name is confusingly similar to the Complainant's Trademarks 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.

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 Respondent's failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

The Respondent would likely not have adopted the Complainant's Trademarks if not for the purpose of creating an impression that the Disputed Domain Name is associated with, or originates from, the Complainant. In this regard, the Panel notes the composition of the Disputed Domain Name, which the Panel considers is an intentional misspelling of the Complainant's Trademarks.

The Panel further notes that the Disputed Domain Name does not resolve to any active website. There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name, is in connection with a bona fide offering of goods or services or be regarded as legitimate noncommercial or fair use.

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.

In the present case, the Panel notes that it is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that it has incorporated sufficiently recognisable aspects of the Complainant's Trademarks. As discussed above, the Respondent lacks any rights or legitimate interests in the Disputed Domain Name (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)). Further, the Respondent failed to respond to the Complainant's contentions and has provided no evidence of its actual or contemplated good faith use of the Disputed Domain Name.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the Disputed Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's Trademarks, the composition of the Disputed Domain Name, and the Respondent's failure to come forward with any explanation for the registration and use of the Disputed Domain Name, 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 <rothchildsandco.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: April 2, 2024