

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Omega Linka
Case No. D2023-2751

1. The Parties

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

The Respondent is Omega Linka, Netherlands (Kingdom of the).

2. The Domain Name and Registrar

The disputed domain name <rothschildnco.com> is registered with GMO Internet Group, Inc. d/b/a Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2023. On June 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 29, 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 (GMO Internet Group, Inc. d/b/a Onamae.com, Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 30, 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 in English on July 3, 2023.

On June 30, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 3, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on July 6, 2023. In accordance with paragraph 5 of the Rules, the due date for Response was July 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 27, 2023.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on August 8, 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant is a company incorporated in the United Kingdom on January 1, 1968 and a member of the Rothschild & Co group (the "Complainant's Group"). The Complainant's Group has been a leading provider of financial services on a worldwide basis for over 200 years. The Complainant's Group 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 Complainant and affiliated entities are the registered owners of, or otherwise have rights in, a number of registrations for the trademarks ROTHSCCHILD & CO and ROTHSCCHILD (collectively, the "ROTHSCCHILD Marks") including the following:

- European Union Trade Mark, No. 000206458 for ROTHSCCHILD, registered on October 8, 1998;
- European Union Trade Mark, No. 017924819 for ROTHSCCHILD & CO, registered on October 31, 2018;
- United States of America Trademark, No. 3447667 for ROTHSCCHILD, registered on June 17, 2008;
- United States of America Trademark, No. 5614371 for ROTHSCCHILD & CO, registered on November 27, 2018.

There are arrangements in place through which the Complainant is licensed to use the ROTHSCCHILD Marks 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>, which is used for the Complainant's Group official website (the "Complainant's Website").

The disputed domain name was registered on June 2, 2023. At the time of filing of the Complaint, the disputed domain name resolved to an inactive website. Currently, the disputed domain name resolves to a website containing "pay-per-click" (PPC) links.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The disputed domain name incorporates the ROTHSCCHILD trademark in its entirety. The disputed domain name also incorporates the ROTHSCCHILD & CO trademark except for the replacement of the ampersand symbol "&" with the letter "n". The risk that Internet users will believe that there is a connection between the disputed domain name and the Complainant's Group is heightened by (i) the disputed domain name's incorporation of the ROTHSCCHILD trademark in its entirety and the incorporation of the ROTHSCCHILD & CO trademark except for the replacement of the ampersand symbol "&" with the letter "n"; and (ii) the fact that the disputed domain name is confusingly similar to the domain name for the Complainant's Website, which means 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.

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 or the ROTHSCHILD Marks 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 Respondent has not 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 direct to a valid website. 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 owner of the ROTHSCHILD Marks, and as the disputed domain name incorporates the ROTHSCHILD trademark in its entirety and the ROTHSCHILD & CO trademark except for the replacement of the ampersand symbol "&" with the letter "n", it carries a higher risk of implied affiliation.

The Respondent is intentionally attempting to attract Internet users to the websites and/or other online locations for commercial gain by creating a likelihood of confusion with the Complainant's ROTHSCHILD Marks as to the source, sponsorship, affiliation or endorsement of the websites and/or other online locations. The ROTHSCHILD Marks are extremely well known in connection with the Complainant's 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 the Respondent registered the disputed domain name, in particular because the disputed domain name contains the ROTHSCHILD Marks. The Respondent is using email addresses associated with the disputed domain name for the purpose of fraudulent activities (the Complainant instructed a third-party cybersecurity provider to disable the mail exchange records). The recipients of emails from an email address associate with the disputed domain name may be confused into thinking that these emails have been sent by the Complainant's Group, due to the incorporation of the ROTHSCHILD trademark in its entirety and the ROTHSCHILD & CO trademark except for the replacement of the ampersand symbol "&" with the letter "n", in the disputed domain name. The similarity between the ROTHSCHILD Marks and the disputed domain name mean that there is a heightened risk that the latter could be used to send phishing emails to the Complainant's Group's clients or be used for other fraudulent purposes. Any alleged fraudulent activities could potentially deprive the Complainant's Group of future business and/or tarnish the Complainant's Group's reputation. The disputed domain name was registered to confuse individuals into thinking that it and any email addresses associated with it are connected with the Complainant's 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

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding. The language of the Registration Agreement for the disputed domain name is Japanese.

However, the Complainant requests that the Panel adopt English as the language of this proceeding with the reasons that the disputed domain name is in Latin script and not in Japanese script indicating that the website provided under the disputed domain name is directed to, at the very least, an English-speaking public, and the Respondent is located in the Netherlands (Kingdom of the), which has the most proficient English speakers in the world outside the Anglosphere and almost 95% of the population speaks English.

The Respondent had the opportunity to submit an objection to the Complainant's request to proceed in English of which the Center had notified the Parties by email both in English and Japanese. But the Respondent did not submit any comment on the language of the proceeding. The Center also notified the Respondent in English and Japanese of the commencement of the proceeding and indicated that the Respondent may file a Response in either English or Japanese. The Respondent chose not to file any Response.

Having regard to the circumstances of the administrative proceeding including that the proceeding in English would be easier at least for the Complainant to understand than the proceeding in Japanese, the Panel decides that English should be the language of the proceeding.

6.2 Substantive Elements of the Policy

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (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 disputed domain name consists of the ROTHSCHILD trademark in its entirety and the terms "nco" along with the generic Top-Level Domain ("gTLD") ".com".

According to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity. The addition of the term "nco", which is possibly an abbreviation of "and corporation", does not prevent a finding of the confusing similarity between the Complainant's ROTHSCHILD trademark and the disputed domain name (see *Fidelity International Limited v. Fidelity&Co*, WIPO Case No. [D2019-0131](#)).

The disputed domain name also incorporates the ROTHSCHILD & CO trademark except for replacing the ampersand symbol "&" ("and") with the letter "n" along with the gTLD ".com".

According to section 1.7 of the [WIPO Overview 3.0](#), the assessment of whether the trademark is recognizable within the disputed domain name may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity. The letter "n" is frequently used as an abbreviation for the word "and". The disputed domain name is confusingly similar to the ROTHSCHILD & CO trademark because the ROTHSCHILD & CO trademark remains recognizable in the disputed domain name.

As stated in section 1.11.1 of the [WIPO Overview 3.0](#), the gTLD is viewed as a standard registration requirement and as such may be disregarded for purposes of assessing identity or confusing similarity.

Accordingly, the Panel finds that the disputed domain name is identical or confusingly similar to the ROTHSCHILD Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

As the Complainant asserts, there is no evidence that the Respondent is commonly known by the disputed domain name. Moreover, the Complainant has not granted a license or other permission to the Respondent to use the “Rothschild” name or the ROTHSCHILD Marks or to register a domain name incorporating any of them.

According to section 2.5 of the [WIPO Overview 3.0](#), if the Respondent falsely suggests affiliation with the trademark owner, the Respondent’s use of the disputed domain name will not be considered “fair”. In the present case, although there is no relationship between the Respondent and the Complainant, the Respondent registered the disputed domain name, which incorporates a common abbreviation of the ampersand symbol in the Complainant’s ROTHSCHILD & CO trademark with the letter “n” and therefore there is a risk that Internet users will not notice the subtle change. The Panel finds in the present case that the composition of the disputed domain name carries a risk of implied affiliation as it may mistakenly be seen as effectively impersonating or suggesting some connection to the Complainant. The disputed domain name did not resolve to any active website at the time of filing of the Complaint, and according to the Complainant, it seems that the disputed domain name was used for sending phishing emails, to which the Respondent has not rebutted. Such use by the Respondent cannot be characterized as a legitimate noncommercial or fair use of the disputed domain name nor a *bona fide* offering of goods or services.

Since the Complainant submits that the circumstances in this case are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in respect of the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent failed to submit any response in this proceeding and there is no evidence of the existence of any rights or legitimate interests before the Panel. Therefore, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant’s Group has established substantial goodwill and reputation in the ROTHSCHILD Marks as a market leader in the financial world with over 200 years of history. The Complainant’s trademark rights in the ROTHSCHILD Marks predate the Respondent’s registration of the disputed domain name. It is inconceivable that the Respondent was unaware of the Complainant’s ROTHSCHILD Marks at the time of registration of the disputed domain name (see *N.M. Rothschild & Sons Limited v. Domain Administrator, PrivacyGuardian.org / Albert Rothschild*, WIPO Case No. [D2018-0652](#)).

The disputed domain name which incorporates the ROTHSCHILD & CO trademark except for replacing the ampersand symbol “&” with the letter “n” is inherently deceptive for Internet users and ripe to be used in a phishing scam or other nefarious activity and thus, the disputed domain name has the hallmarks of bad faith registration and use (see *N. M. Rothschild & Sons Limited v. Contact Privacy Inc. Customer 12410746041 / “FAPI III”*, WIPO Case No. [D2021-3915](#)).

At the time of filing of the Complaint, the disputed domain name did not resolve to any active website. However, considering the reputation of the ROTHSCHILD Marks, the lack of Response from the Respondent, and the implausibility of any good faith use that the disputed domain name may be put, the Panel finds that the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of “passive holding”. See section 3.3 of the [WIPO Overview 3.0](#).

Further, according to the Complainant’s allegation, the Complainant became aware on June 7, 2023 that a website had been registered under the disputed domain name, with a presence of mail exchange records and promptly instructed a third-party cybersecurity provider to disable the mail exchange records, and the provider confirmed that it had disabled these records on June 12, 2023. The email address associated with the disputed domain name has already been used for the purpose of fraudulent activities including an

authorized push payment-type fraud against a client of the Complainant's Group. The Respondent's has not rebutted the Complainant's contentions. The Panel finds that the use of the disputed domain name for purposes of sending phishing emails also constitutes bad faith. See section 3.4 of the [WIPO Overview 3.0](#).

Consequently, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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 <rothschildnco.com> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: August 22, 2023