

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Anna Mayer
Case No. D2022-1245

1. The Parties

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

The Respondent is Anna Mayer, the Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <rothschildglobaladvisory.com> is registered with 123-Reg Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 7, 2022. On April 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 12, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 2022, 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 April 25, 2022.

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 April 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on May 25, 2022. 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 was incorporated in England and Wales on January 1, 1968, and is a member of the Rothschild & Co group.

The Complainant and its affiliated entities are the registered owners of, or otherwise have rights in, a number of registrations for the trademarks ROTHSCHILD and ROTHSCHILD & CO (the “Rothschild Trademarks”), including:

- European Union Trademark, number 000206458 for ROTHSCHILD, filed on April 1, 1996;
- United Kingdom Trademark, number 3321370 for ROTHSCHILD & CO, filed on June 29, 2018;
- United States Trademark, number 5614371 for ROTHSCHILD & CO, filed on March 9, 2017;
- Canadian Trademark, number TMA1062927 for ROTHSCHILD & CO, filed on June 8, 2015.

The Complainant is licensed to use the ROTHSCHILD trademarks 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> (among others).

The disputed domain name was registered on September 7, 2021, and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it and its group is a recognized market leader in the financial world and that it has established substantial goodwill and reputation in names and trademarks containing ROTHSCHILD & CO and ROTHSCHILD.

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the domain name reproduces the Complainant's trademark ROTHSCHILD in its entirety;
- the addition of the term “globaladvisory” does not distinguish the disputed domain name from the Complainant's trademark ROTHSCHILD as the services offered by the Rothschild & Co group include strategic M&A and financial solutions under its “Global Advisory “ arm and the term is therefore clearly a reference to its core business activities in the financial sector.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- there is no relationship between the Respondent and the Complainant;
- "Rothschild" is not a descriptive term and the Complainant has not licensed or otherwise permitted the Respondent to use the "Rothschild" name or the Rothschild Trademarks or to register a domain name incorporating any of them;
- the Respondent is not a customer of the Complainant or vice versa;
- there is no 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 and is not making any legitimate non-commercial or fair use of the disputed domain name, since as the disputed domain name does not resolve to an active website.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues 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 Rothschild Trademarks which are distinctive in the sector of banking and financial services, and have been in use for two hundred years;
- 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;
- the disputed domain name is confusingly similar to the Complainant's well-known Rothschild Trademarks, and Internet users who access the disputed domain name 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;
- the disputed domain name was registered to confuse individuals into thinking that it is connected with the Rothschild & Co group and that as a result, the mere registration of the disputed domain name by the Respondent indicates bad faith on its part;
- the disputed domain name is being used to impersonate the Complainant's group;
- as the disputed domain name incorporates the name ROTHSCHILD in its entirety and without modification it is likely that the disputed domain name has been registered to facilitate phishing or other fraudulent activities, for example, by sending emails from addresses associated with the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following 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 Complainant has demonstrated that it owns multiple trademark registrations for the mark ROTHSCHILD in the European Union, the United Kingdom and Canada prior to the registration of the disputed domain name on September 7, 2021.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases. (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))).

In this case, the disputed domain name contains the disputed domain name in its entirety and only differs from the Complainant’s trademark ROTHSCHILD by the addition of the term “globaladvisory” which is perceived by consumers as a descriptive term referring to the services provided by the Complainant. The addition of a merely descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)).

Furthermore, it is well accepted under the UDRP case law that the specific generic Top-Level-Domain designation such as “.com”, “.net”, “.org” is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s Rothschild Trademarks in which the Complainant has exclusive rights.

B. Rights or Legitimate Interests

Pursuant to Paragraph 4(c) of the Policy a 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 [the 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 [the 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 [the 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 Complainant has asserted that it has not authorized the Respondent to register or use the disputed domain name and presented evidence that the disputed domain name has not been actively used. These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. 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 Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, it is evident that the Respondent was aware of the Complainant and its ROTHSCHILD mark and has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, in light of the level of reputation the Complainant has acquired in its ROTHSCHILD marks in connection with financial services, the Panel concludes that the selection of the disputed domain name incorporating the Complainant's ROTHSCHILD mark cannot be considered *bona fide* and that therefore the Respondent has no rights or legitimate interests in the disputed domain name as set forth by paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has 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 the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has 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 the Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds multiple trademark registrations for the mark ROTHSCHILD that predate the registration of the disputed domain name and which are distinctive in the sector of banking and financial services.

Given the degree of reputation of the Rothschild Trademarks and that the term ROTHSCHILD is so obviously connected with the Complainant and its characteristic services it is inconceivable that the Respondent coincidentally selected the disputed domain name without any knowledge of the Complainant and its trademark ROTHSCHILD.

The Panel therefore concludes that the Respondent registered the disputed domain name in bad faith.

Furthermore, as there is no active website at the disputed domain name, the Panel notes that panels have consistently found that, in certain circumstances, passive holding does not prevent a finding of bad faith under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

While UDRP panels 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;
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- (iv) the implausibility of any good faith use to which the domain name may be put. (See *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*; see also [WIPO Overview 3.0](#), section 3.3.)

The circumstances of the present case are sufficiently similar to those present in *Telstra* to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's ROTHSCHILD mark is highly distinctive, and well-known all over the world.

The Respondent failed to provide any response or evidence of actual or contemplated good-faith use. In fact, given that the disputed domain name is confusingly similar to the well-known ROTHSCHILD Trademarks, Internet users would, if actively used, 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.

It is therefore not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

In light of these particular circumstances, the Panel concludes that the Respondent's passive holding of the domain name in this particular case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is being used in bad faith" by the Respondent.

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 <rothschildglobaladvisory.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: June 10, 2022