

ADMINISTRATIVE PANEL DECISION

N. M. Rothschild & Sons Limited v. Ravi Persaud

Case No. D2022-3859

1. The Parties

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

Respondent is Ravi Persaud, Canada.

2. The Domain Name and Registrar

The disputed domain name <rothschildsmanagement.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2022. On October 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 17, 2022, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on October 23, 2022, 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 October 24, 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 Respondent of the Complaint, and the proceedings commenced on October 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 17, 2022. On November 14, 2022, Respondent requested for an extension to submit a Response and the due date for Response was subsequently extended to November 21, 2022. The Response was filed with the Center on November 21, 2022. The parties engaged in settlement discussions during December 2022, but those discussions were not successful in resolving the dispute.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on December 2, 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

Complainant is a member of the Rothschild & Co group. Complainant and its group are 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 two hundred years. In particular, it provides 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 names containing “Rothschild & Co.” and “Rothschild”, and has established substantial goodwill and reputation in names and trademarks containing ROTHSCCHILD & CO and ROTHSCCHILD.

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. Complainant has submitted evidence of registered trademarks in Canada (where Respondent is located), the European Union, the United Kingdom and the United States of America. These registrations include United Kingdom Trademark No. UK00001168291 for ROTHSCCHILD, registered on January 21, 1982, for goods in Class 14 (precious metals and jewelry), and the European Union Trademark No. 000206458 for ROTHSCCHILD, registered on October 8, 1998, for goods in Class 14, and services in Classes 35 (business management consulting and financial services) and 36 (insurance, financial affairs, monetary affairs and real estate affairs). There are arrangements in place through which Complainant is licensed to use the ROTHSCCHILD trademarks where registrations are held by connected entities. Rothschild & Co Continuation Holdings AG, an entity affiliated to Complainant, is the registrant of the domain name <rothschildandco.com>, among others.

The Domain Name was registered on June 16, 2022. Prior to the filing of the Complaint, the Domain Name resolved to a website that purported to offer “diversified investments”. On October 25, 2022, after the Complaint was filed, the website was changed and Respondent indicated “I have placed the domain under construction until this is resolved”. The website now reads: “Sorry, we’re doing some work on the site. Thank you for being patient. We are doing some work on the site and will be back shortly.”

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states the ROTHSCCHILD trademarks are extremely well-known in connection with the Rothschild & Co group. The Rothschild & Co group has invested substantial sums of money in developing and marketing its services under the ROTHSCCHILD trademarks and in protecting its rights in the marks. In particular, the Rothschild & Co group monitors unauthorized use of the ROTHSCCHILD marks and actively enforces the Rothschild & Co group’s rights, including through the Policy. In this regard Complainant draws the Panel’s attention to the 23 cases in which Complainant has brought proceedings under the Policy to dispute unauthorized domain name registrations taking advantage of the ROTHSCCHILD marks. Each of these cases resulted in a transfer of the disputed domain names to Complainant.

Complainant’s rights in the ROTHSCCHILD trademarks predate Respondent’s registration of the Domain Name.

The Domain Name is confusingly similar to the trademarks in which Complainant has rights. The Domain Name incorporates the ROTHSCCHILD mark in its entirety and amends it only by adding the letter “s” followed

by the term “management”. As mentioned above, Complainant has been a leading provider of financial services for over two hundred years. The majority of the ROTHSCILD trademarks have been registered for services in classes related to financial services. These services offered by the Rothschild & Co group currently include “Wealth Management” services and investment solutions under its “Asset Management” arm, as detailed on Complainant’s website. The term “management” alludes to the provision of services which may relate to wealth management and asset management services, which are core business activities of Complainant.

Complainant contends there is therefore a real risk that Internet users will believe that there is a connection between the Domain Name and Complainant’s group. This risk is heightened by Domain Name’s use of the ROTHSCILD trademark in conjunction with the term “management”, which suggests a connection between the Domain Name and the wealth management and asset management businesses operated by Complainant’s group.

(ii) Rights or legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in the Domain Name. There is no relationship between Respondent and Complainant. “Rothschild” is not a descriptive term and Complainant has not licensed or otherwise permitted Respondent to use the “Rothschild” name or the ROTHSCILD trademarks or to register a domain name incorporating any of them. So far as Complainant is aware, Respondent is not a customer of Complainant or vice versa. Furthermore, Complainant has not found any evidence that Respondent has been commonly known by the Domain Name.

Complainant states that Respondent is currently using the Domain Name in connection with what it claims is an offer of “diversified investments”, as advertised on its active website. In addition to the Domain Name itself, the prominent reference to “diversified investments” across “global markets” clearly suggest an association with the financial services industry – an industry in which Complainant has substantial goodwill and reputation. The website contains very little information about the business and the specific services it purports to offer. In particular, the website contains links that do not resolve to any content, provides only filler text (in Latin) and no relevant details in the “About Us” section and the site requires consumers to request a “private offer” in respect of the services. It would be highly unusual for a legitimate financial services business seeking to advertise its activities to contain such a notable lack of substantive content.

Complainant submits that Respondent’s motives for registering the Domain Name were clearly commercial, in that the Domain Name is designed to attract consumers who associate it with Complainant’s business and therefore assume some connection between Complainant and the website. Complainant therefore submits that Respondent is not making any legitimate non-commercial or fair use of the Domain Name.

(iii) Registered and used in bad faith

Complainant submits that the Domain Name has been registered and is being used in bad faith. As stated above, the website contains links that do not resolve to any content and it requires consumers to request a “private offer” in respect of Respondent’s services. It would therefore appear that, in addition to advertising financial services under the “Rothschild” name, the site is also using the “Rothschild” name to misleadingly attract consumers and induce them to receive private offers, which may or may not be fraudulent. Complainant therefore submits that Respondent chose to register and use the Domain Name that is confusingly similar to Complainant’s ROTHSCILD mark in order to knowingly and intentionally confuse Internet users into thinking that the Domain Name and/or website are connected with Complainant in order to attract a higher volume of consumers to the site and receive greater interest in the services offered. Respondent’s unauthorized and abusive use of the “Rothschild” name to lend legitimacy to the site in order to sell financial services to consumers is clearly not *bona fide*: Respondent can only be using the ROTHSCILD trademarks in bad faith.

Section 3.1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) further states that “seeking to cause confusion (including by technical means beyond

the domain name itself) for the respondent's commercial benefit, even if unsuccessful" constitutes evidence in support of a finding that a respondent has registered a domain name in bad faith. By analogy, therefore, even if Respondent is not profiting from requiring consumers to request a "private offer", the use of the Domain Name cannot be in good faith where the "Rothschild" name is used to attract and direct consumers to another place, under the pretense that this other place is connected to or endorsed by Complainant.

Section 3.3 of the [WIPO Overview 3.0](#) also states that the Panel will look at the totality of the circumstances in each case, which could include "the degree of distinctiveness or reputation of the complainant's mark" and "the implausibility of any good faith use to which the domain name may be put". Further, in section 3.1.4 of the [WIPO Overview 3.0](#): "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." The ROTHSCCHILD trademarks are extremely well-known in connection with the Rothschild & Co group and Complainant has substantial goodwill and reputation in names containing ROTHSCCHILD. Complainant submits that Respondent must have been aware of Complainant's rights at the time it registered the Domain Name, in particular because the Domain Name contains the ROTHSCCHILD trademarks. It is inconceivable that Respondent was unaware of Complainant's mark at the time of registration of the Domain Name. Complainant submits that the degree of reputation of the ROTHSCCHILD trademarks makes it implausible that Respondent could put any good faith use to the Domain Name.

Complainant states the Domain Name is confusingly similar to the well-known ROTHSCCHILD trademarks, and Internet users who access the Domain Name are therefore likely to be misled into believing that the Domain Name is affiliated to, endorsed by, or otherwise connected to, Complainant and/or its group. Complainant submits that the Domain Name was registered to confuse individuals into thinking that it is connected with the Rothschild & Co group. As a result, the mere registration of the Domain Name by Respondent indicates bad faith on its part.

Complainant further contends the Domain Name is being used to impersonate Complainant's group. The Domain Name incorporates the name ROTHSCCHILD in its entirety and without modification. Complainant believes that it is more likely than not that the Domain Name has been registered to facilitate phishing or other fraudulent activities, for example, by sending emails from addresses associated with the Domain Name. This also appears to be the case in the present Complaint. Complainant believes Respondent has registered the Domain Name to try to mislead members of the public into believing that they are connected to Complainant's group. Respondent has done this by registering the ROTHSCCHILD name in its entirety as part of the Domain Name. In view of the above, it is submitted that the Domain Name has been registered and is being used in bad faith by attempting to impersonate Complainant and its group.

B. Respondent

Respondent states that he registered the Domain Name because he was working with two married individuals whose last name is Rothschild. Respondent states he met these two individuals while working on a Live Aid benefit concert, and that one of them agreed to assist in marketing Respondent's music business and signed a contract that effect in June 2022, while Respondent was asked to build a website for this person's handmade jewelry business. Respondent states he was also working with the other individual whose last name is Rothschild to organize a commodities business and that they had agreed to build a website for this purpose. Respondent also states that one of these two individuals is a family relative of the Rothschild family, which is associated with Complainant.

Respondent states he searched GoDaddy for an appropriate domain name to house the management services related to the collaborative efforts of Respondent and the two Rothschild individuals, and that on June 16, 2022, he purchased the Domain Name and began working on the "Rothschilds Management" website. Respondent states he purchased the Domain Name to use for their consulting services that trades, buys and sells commodities, including gold, silver, and many other commodities. Respondent further states there have been no sales to this point in any of the endeavors under the name Rothschilds Management and that none of the websites have been completed or gone live yet. Respondent states there was no malicious

intent, as “Rothschild” is the legal last name of the two individuals who Respondent refers to as his “affiliates, partners and clients”.

(i) Identical or confusingly similar

Complainant acknowledges that although the ROTHSCCHILD trademark predates Respondent’s registration of the Domain Name, the use of the “Rothschilds” name by Respondent’s affiliates, partners and clients is their legal family name. Respondent contends that to have a trademark does not mean that anyone, whoever they may be, has a monopoly on publicly available domain names. Moreover, while phonetically similar to the trademark ROTHSCCHILD, the name “Rothschilds” is currently not under trademark in jurisdiction where Respondent is located. Further, Respondent states he was not made aware of any licensed or restrictive uses of the “Rothschilds” name by his affiliates, partners and clients, the two Rothschild individuals. Respondent claims there are others using the “Rothschilds” name in relation to businesses in jurisdictions such as Chile and other parts of the world, but not in Canada where Respondent’s is located.

(ii) Rights or legitimate interest

Respondent claims he has a legitimate interest in the Domain Name due to the relationship between himself and the two individuals who are Respondent’s “partners, affiliates and clients” and who are commonly referred to by their legal family name – the “Rothschilds” – when addressed collectively. Respondent states he purchased the Domain Name in relation to legitimate business and services conducted by Respondent and these two individuals within similar industries to Complainant, including consulting and management of commodities, financial services, jewelry, trades, and music related projects and other potential services.

Respondent states that at the time Complainant was able to screenshot the website linked to the Domain Name, it was under construction and in the early stages of development, and was being tested for discussion between Respondent and his partners, affiliates and clients. The Latin text “Lorem Ipsum” is a commonly used placeholder for text elements, and all content on the website was placeholders for the legitimate intended business activities.

Respondent claims there was no intent of malice. As soon as Respondent became aware of the legal actions being taking against him, he placed the site “under construction” pending the result in this case. Respondent claims he did not set out to disrupt or otherwise compete with the ongoing business activities of Complainant, and has no further plans to engage in any future activities under the name, unless permission is expressly granted to Respondent, his affiliates, partners and clients by Complainant. Moreover, Respondent states he had no intention of taking advantage of or tarnishing Complainant’s trademark. The Domain Name was registered through a reputable Registrar. Respondent argues that if it is illegal to use the legal family name of his affiliates, partners and clients due to a pre-existing ROTHSCCHILD trademark, then the Domain Name should have never been made available for purchase via the Registrar in the first place.

Respondent states that as he purchased the Domain Name for legitimate use from the Registrar, Respondent is respectfully not disagreeable to transferring of the Domain Name, even though the purchase has caused confusion and duress amongst the individuals who are his current partners, affiliates, and clients, and whose last name is Rothschild. As a result, Respondent indicates there will be no business activity moving forward under the Domain Name, unless Complainant should decide to formalize an arrangement with Respondent and his affiliates, partners and clients. Respondent humbly requests to stop all legal process against him regarding the Domain Name. Respondent states he believes that a rational and realistic transferring of the Domain Name may be possible, without involving any further legal processes.

(iii) Registered and used in bad faith

Respondent states he was not attempting to use the Domain Name in bad faith, had no intent of misleading customers within the existing and mutual network of Respondent and his affiliates, partners and clients, the Rothschilds. Respondent states he was not made aware of any existing trademarks relating to the

Rothschild's use of their family name and in relation to their relatives. Respondent was in the early stages of preparing a legitimate business operation, and was building and testing mock-ups for use to further discussions and formalize relationships in business structure and operations as a shared partnership.

Respondent also states there was no phishing or fraudulent activities undertaken, and no emails set up relating to the Domain name. Respondent has suffered significant stress as result of the allegations against him, and there has been significant disruption to his career, business partners and personal life due to the confusion regarding the Domain Name. Respondent did not intend to mislead innocent third parties into believing they were dealing with Complainant, and there was no aim of fraudulently taking money from those third parties. Respondent states he was made aware that there was a family relationship between his affiliates, partners and clients, but he was not made aware of any licensed or restrictive uses of the "Rothschilds" name. Thus, Respondent believed he was acting in good faith, without any intention of wrongdoing. Therefore, the Domain Name was not registered in bad faith, and there have been no malicious attempts to impersonate Complainant and its group.

Respondent feels that he has been under scrutiny and duress because of these proceedings. Respondent requests that this matter be resolved in a fair manner with understanding, and without further damage to Respondent's character and business activities. Respondent states he has received no compensation for any activities related to the Domain Name, and instead is out of pocket for time and money. Respondent invested his time, money and efforts in a business venture, but nothing has been bought, sold or traded. Respondent claims he has caused no damages to Complainant, but merely bought the Domain Name to invest his technical services and does not want to be caught up in any sort of family matter that he does not understand.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

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

A. Identical or Confusingly Similar

The Panel determines that Complainant has demonstrated rights in its well-established ROTHSCILD and ROTHSCILD & CO trademarks, through both extensive registration and widespread use in connection with its longstanding financial services business. See *N.M. Rothschild & Sons Limited v. Domain Administrator, PrivacyGuardian.org / Albert Rothschild*, WIPO Case No. [D2018-0652](#) ("The Complainant's ROT[H]SCHILD trademark is distinctive in the sector of banking and financial services, and has been in use for two hundred years to distinguish the Complainant's services from those of other financial institutions").

The Panel further finds that the Domain Name is confusingly similar to Complainant's ROTHSCILD mark. The Domain Name incorporates the ROTHSCILD mark in its entirety, notably with the placement of this mark in the dominant position at the beginning of the relevant Domain Name, followed by the letter "s" and the word "management". The addition of the letter "s" and the word "management" does not prevent a finding of confusing similarity in this case. Numerous UDRP decisions make clear that the addition of other terms does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.7 ("where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."); see also *N. M. Rothschild & Sons Limited v. Domain Administrator, PrivacyGuardian.org / Albert Rothschild*, WIPO Case

No. [D2018-0652](#) (regarding the domain name <rothschildglobaladvisory.com>, the panel held the “mark is incorporated in the disputed domain name in its entirety and as its first and most prominent part. The addition of generic terms [...] does not prevent a finding of confusing similarity”); *NM Rothschild & Sons Limited v. Corporate Internet Design Limited and Michael Decker*, WIPO Case No. [D2001-0854](#) (addition of the word “bank” does not prevent the domain names <rothschilds-bank.com> and <rothschilds-bank.net> from being confusingly similar to the ROTHSCILD marks).

In conclusion, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. Accordingly, Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, Complainant must prove that Respondent has no rights or legitimate interests in respect of the Domain Name. A complainant is normally required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the respondent carries the burden of production of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Here, the Panel finds that Complainant has made out a *prima facie* case. Complainant has indicated that Respondent has no rights or legitimate interests in the confusingly similar Domain Name because it fully incorporates Complainant’s well-established ROTHSCILD trademark; that Respondent has no legitimate interests when the Domain Name falsely suggests affiliation with the trademark owner; that Complainant has not authorized, licensed, or otherwise permitted Respondent to use the ROTHSCILD trademark; that Complainant does not have any type of business relationship with Respondent; that Respondent is not commonly known by the Domain Name; that Respondent is not making any legitimate noncommercial or fair use of the Domain Name; and that instead the Domain Name was used on a website purportedly offering “diversified investments” and designed to attract consumers who might associate it with Complainant’s business.

In response, Respondent claims that he is associated with two individuals who were his “partners, affiliates and clients” and who bear the last name “Rothschild”. He alleges that he registered the Domain Name in pursuit of their collective business activities, and that one of the individuals was even a family relative of the Rothschild family associated with Complainant. He has submitted what appears to be a copy of a contract between himself and one of these individuals relating to artist management services, but the Panel cannot see how this agreement serves to justify the registration of the Domain Name. Further, he has also submitted what appear to be records of “chat” messages between himself and these two individuals, which, if authentic, indicate that they were aware of the dispute concerning the Domain Name. However, neither of them has submitted a statement or affidavit in this case to confirm (i) their relationship with Respondent, (ii) that they authorized Respondent to register the Domain Name using their family name, or (iii) that they had obtained permission from Complainant to use a Domain Name incorporating the ROTHSCILD trademark for business activities, some of which Respondent acknowledges are closely related to and compete with Complainant’s business activities.

The crux of Respondent’s submission is that he asserts he acted in good faith and with no malice, and that he was not made aware of any existing trademarks restrictions relating to use of the Rothschild family name. However, Respondent, as the registrant of the Domain Name, cannot disclaim responsibility for checking whether the Domain Name infringed on the trademark rights of a third party, or whether he was otherwise authorized to register the Domain Name, which is confusingly similar to the ROTHSCILD mark, for use providing services, some of which are similar to those offered by Complainant. Moreover, Respondent appears to be confused about the role of the Registrar – the Registrar has no policing function in relation to character strings that a third party may wish to register as a domain name. This is the duty of the domain name registrant – in this case, that duty was on Respondent. Therefore, in balancing the rights of Complainant in its well-established ROTHSCILD mark, and the right of Respondent to choose freely a

domain name, the Panel concludes that Respondent has impermissibly taken advantage of Complainant's interests in its ROTHSCCHILD mark.

Accordingly, for all of the above reasons, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been adequately rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Names in bad faith. [WIPO Overview 3.0](#), section 3.1, states "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

For the reasons discussed under this and the preceding heading, the Panel considers that Respondent's conduct in this case constitutes bad faith registration and use of the Domain Name within the meaning of paragraph 4(a)(iii) of the Policy. It is evident that Respondent was aware of Complainant and its ROTHSCCHILD trademark when registering the Domain Name. Complainant contends that the Domain Name has been registered and is being used in bad faith by attempting to impersonate Complainant and its group. The Panel finds that Respondent, by registering and using the Domain Name, was effectively impersonating Complainant, or giving the wrong impression that he (and/or his two colleagues) were authorized by or affiliated with Complainant, when in fact he (and they) were not. The website linked to the Domain Name, which Respondent described as a development mock-up, purported to offer services related to "diversified investments", which Respondent acknowledges overlapped with Complainant's financial services. The Panel considers that the Domain Name – confusingly similar to Complainant's ROTHSCCHILD mark – is such that users are likely to consider that Respondent's services would be sponsored or sanctioned by, or affiliated or connected with, Complainant in some manner, when they are not.

Given all of the facts and circumstances of this case, whether or not Respondent's motives were for eventually commercially exploiting Complainant's ROTHSCCHILD mark, the Panel determines that Respondent's registration and use of the Domain Name amounts to bad faith use within the ambit of the Policy. Respondent may wish to work with two individuals whose family name is Rothschild and to provide services related to Complainant's financial services; however, Respondent cannot ignore Complainant's longstanding trademark rights when doing so, particularly if the objective is to provide similar or competing services to those offered by Complainant.

In conclusion, the Panel determines that, for all of the above reasons Complainant has satisfied 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 Domain Name, <rothschildsmanagement.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: January 16, 2023