

EXPERT DECISION

HOLDING BENJAMIN ET EDMOND DE ROTHSCHILD, PREGNY SOCIETE ANONYME v. KOJI HATAKEYAMA

Case No. DCH2025-0011

1. The Parties

The Claimant is HOLDING BENJAMIN ET EDMOND DE ROTHSCHILD, PREGNY SOCIETE ANONYME, Switzerland, represented by OX Avocats, France.

The Respondent is KOJI HATAKEYAMA, Japan.

2. The Domain Name

The dispute concerns the disputed domain name <banque-privee-edmond-de-rothschild.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2025. On August 12, 2025, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On August 13, 2025, SWITCH transmitted by email to the Center its verification response disclosing the Respondent listed as the holder of the domain name and providing the relevant contact details. The Claimant did not provide an amendment to the Request even after numerous reminders were sent on August 25, 2025, September 1, 2025 and September 4, 2025. The Center verified that the Request satisfied the formal requirements of the Rules of procedure for dispute resolution procedures for “.ch” and “.li” domain names (the “Rules of Procedure”), adopted by SWITCH, on January 1, 2020.

In accordance with the Rules of Procedure, paragraph 14, the Center formally notified the Respondent of the Request, and the Dispute resolution procedure commenced on September 5, 2025. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was September 25, 2025.

The Respondent has neither filed a Response nor expressed his readiness to participate in a Conciliation in accordance with paragraph 15(d) of the Rules of Procedure.

On September 30, 2025, the Center notified the Claimant accordingly, who on the same day made an application for the continuation of the Dispute resolution proceedings in accordance with paragraph 19 of the Rules of procedure, and paid the required fees.

On October 10, 2025, the Center appointed Lorenz Ehrler as Expert in this case. The Expert finds that he was properly appointed. In accordance with Rules of Procedure, paragraph 4, the above Expert has declared his independence of the parties.

4. Factual Background

The Claimant is the holding company of the Edmond de Rothschild group, which is active in the field of financial services. Its best-known group company is the private bank Edmond de Rothschild (Suisse) SA. In Switzerland, the Rothschild name and brand is well-known in relation with private banking.

The Claimant owns the Swiss trademark EDMOND DE ROTHSCHILD, No. 601770, which was registered on June 16, 2010 in classes 35, 36, 38 and 41. The Claimant group's website is operated under the domain name <edmond-de-rothschild.com>.

The disputed domain name, <banque-privée-edmond-de-rothschild.ch> was registered on February 25, 2025 and directs to an inactive webpage.

5. Parties' Contentions

A. The Claimant

The Claimant argues that (i) it has a right in a distinctive sign under the law of Switzerland, (ii) the disputed domain name is confusingly similar to its trademark(s), (iii) the Respondent has no rights or legitimate interests in the disputed domain name, and (iv) that the disputed domain name has been registered and is being used in bad faith. The Claimant requests the transfer of the disputed domain name.

B. The Respondent

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

6. Discussion and Findings

Under paragraph 24(c) of the Rules of Procedure, the Claimant must show that:

- A. The Claimant owns the right in a distinctive sign under the laws of Switzerland; and
- B. The allocation or use of the domain name constitutes a clear infringement of the Claimant's right.

6.1 Applicable Substantive Rules

The Claimant mistakenly argues on the basis of the criteria of the Uniform Domain Name Dispute Resolution Policy (UDRP), in particular by discussing the absence of legitimate rights and the bad faith registration and use of the disputed domain name.

Under the Rules of Procedure, however, it is the Swiss substantive law of distinctive signs that applies to domain names under the Country Code Top Level Domain ("ccTLD") ".ch". This being said, like for cases before state courts, the principle *iura novit curia* also applies under the Rules of Procedure (Jacques de Werra, *Domain-Dispute.ch*, in *125 Jahre Markenhinterlegung*, sic! Sondernummer 2005, p. 157), which

means that the Expert must apply Swiss law to the set of facts submitted by the Claimant, even though the latter does not submit a proper submission under the applicable substantive law.

6.2 Right attached to a Distinctive Sign

The first substantive condition under the Rules of Procedure is that the Claimant must have a right attached to a distinctive sign under the laws of Switzerland.

The Claimant not only puts forward the existence of its Swiss trademark EDMOND DE ROTHSCHILD, No. 601770, but also its company name "HOLDING BENJAMIN ET EDMOND DE ROTHSCHILD, PREGNY SOCIETE ANONYME" registered in Switzerland.

Accordingly, the Expert holds that the first condition under the Rules of Procedure is met.

6.3 Clear Infringement of the Claimant's Right

The infringement of the right attached to a distinctive sign must be 'clearly' apparent from the text of the law or from a recognised interpretation of the law. As emphasised in an expert decision, a decision to transfer or terminate a domain name should only be made if it is clearly justified (*Veolia Environnement SA contre Malte Wiskott*, WIPO Case No. [DCH2004-0010](#)).

While it is obvious that the disputed domain name <banque-privee-edmond-de-rothschild.ch> is highly similar to the Claimant's trademark EDMOND DE ROTHSCHILD, this is not sufficient to admit a trademark infringement. Indeed, under Swiss trademark law, a trademark infringement requires a risk of confusion, which must be the result of the similarity between the Claimant's trademark and the disputed domain name, on the one hand, and the similarity between the products/services claimed by the said trademark and the products/services the disputed domain name is *used for*. Where, as in the case at hand, the domain name resolves to an inactive page, the second above-mentioned condition cannot be met, which is why there is *no clear infringement* of the Claimant's rights based on trademark law (cf. Gallus Joller, Schweiz (.ch) in Bettinger, Handbuch des Domainrechts, Köln/München 2008, CH 90).

Besides the afore-mentioned trademark, the Claimant also owns company name rights and name rights in its company name HOLDING BENJAMIN ET EDMOND DE ROTHSCHILD, PREGNY, société anonyme. Similar to trademark law, company name law requires that a similar sign be *used* as a distinctive sign. Absent such use, the domain name cannot be considered as infringing rights in a company name (Gallus Joller, op. cit., CH 158). The disputed domain name being inactive, the existence of a company name infringement must be denied.

Remains to be examined whether the disputed domain name constitutes an infringement of the Claimant's name rights. It is established that not only individuals, but also legal entities enjoy name rights pursuant to art. 29 Swiss Civil Code (BSK CC-Thévenaz, Art. 29 N 2). It is also recognised that name infringement can take various forms, in particular that of domain names (op. cit., Art. 29 N 23). At last, the protection of name rights is afforded in case legally protectable interests of the name owner are affected, which is the case – according to unanimous court practice and scholarly texts – if there is *a risk of confusion* (Gallus Joller, op. cit., CH 176).

The distinctive elements of the Claimant's company name are "Benjamin et Edmond de Rothschild", while the distinctive elements of the disputed domain name are "Edmond de Rothschild". The disputed domain name thus takes over literally most of the distinctive elements of the company name, namely "Edmond de Rothschild", so that there is no doubt that a risk of confusion exists. The additional elements of either sign, namely "Holding", "Pregny", "société anonyme", "banque privée" and ".ch" are generic or technically necessary and thus unable to change the finding of a risk of confusion.

A particular feature of name protection law is that the *mere registration* of an inactive domain name is a sufficient use of a name to be considered as infringing (Gallus Joller, op. cit., CH 173). In other words, the fact that the disputed domain name is inactive does not prevent an infringement finding.

Based on the above, the Expert reaches the conclusion that the infringement of the claimed right in a distinctive sign clearly result from the wording of the law or from an acknowledged interpretation of the law and from the presented facts and are proven by the evidence submitted.

7. Expert Decision

For the above reasons, in accordance with paragraph 24 of the Rules of Procedure, the Expert orders that the disputed domain name <banque-privee-edmond-de-rothschild.ch> be transferred to the Claimant.

Lorenz Ehrler

Expert

Dated: October 21, 2025