

ADMINISTRATIVE PANEL DECISION

Holding Benjamin et Edmond de Rothschild, Pregny Société Anonyme v.
Jonathan Cohen
Case No. DEU2022-0026

1. The Parties

The Complainant is Holding Benjamin et Edmond de Rothschild, Pregny Société Anonyme, Switzerland, represented by OX Avocats, France.

The Respondent is Jonathan Cohen, France.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <edmondderothschild.eu> is the European Registry for Internet Domains ("EURid" or the "Registry"). The Registrar of the disputed domain name is GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 2, 2022. On August 3, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On August 9, 2022, the Registry 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 August 17, 2022 providing the registrant and contact information disclosed by the Registry, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed three amended Complaints on August 18, 2022, August 19, 2022 and September 5, 2022.

The Center verified that the Complaint together with the amended Complaints satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the "ADR Rules") and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the "Supplemental Rules").

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 7, 2022. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was October 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 21, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on October 31, 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 ADR Rules, Paragraph B(5).

The language of the proceeding is English, being the language of the Registration Agreement, as per Paragraph A(3)(a) of the ADR Rules.

4. Factual Background

The Complainant is Holding Benjamin et Edmond de Rothschild, Pregny SA, a Swiss company operating in the field of banking and owning several trademark registrations for EDMOND DE ROTHSCHILD, among which the following ones:

- French Trademark Registration No. 3701735 for EDMOND DE ROTHSCHILD, registered on December 29, 2009;
- International Trademark Registration No. 1046701 for EDMOND DE ROTHSCHILD, registered on June 21, 2010, designating, among other countries, the European Union.

The Complainant provided evidence in support of the above.

The disputed domain name was registered by the Respondent on May 16, 2022, and it currently resolves to an inactive website. When the Complaint was filed, the disputed domain name was redirecting to the Complainant's official website, at "www.edmond-de-rothschild.com".

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is identical to its trademark EDMOND DE ROTHSCHILD.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, nor is the Respondent commonly known by the disputed domain name. The Complainant asserts the Respondent is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name: the disputed domain name redirects Internet users to the Complainant's official website.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark EDMOND DE ROTHSCHILD is distinctive and enjoys reputation. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and it is using it to redirect Internet users to the Complainant's website. The Complainant contends that the configuration of the disputed domain name allows the sending of emails.

B. Respondent

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

6. Discussion and Findings

As stated in paragraph A(1) of the ADR Rules “[the] ADR Rules are applicable to domain name disputes where the domain name has been registered under the .eu Top Level Domain”.

In order to succeed in its Complaint, the Complainant is required under Paragraph B(11)(d)(1) of the ADR Rules to demonstrate the following:

- (i) that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or European Union law; and either
- (ii) that the disputed domain name has been registered by the Respondent without rights or legitimate interests in the name; or
- (iii) that the disputed domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

The Panel finds that the Complainant is the owner of the International Trademark EDMOND DE ROTHSCCHILD, designating the European Union, and that the disputed domain name is identical to trademark EDMOND DE ROTHSCCHILD.

It is well established in decisions under the ADR Rules that the country-code Top-Level Domain (“ccTLD”) “.eu” is typically ignored when assessing the similarity between a trademark and a domain name.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is identical to the Complainant’s trademark, pursuant to Paragraph B(11)(d)(1)(i) of the ADR Rules.

B. Rights or Legitimate Interests

The Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that it has no relationship or association with the Respondent, and has not authorized the Respondent to use or register in a domain name the EDMOND DE ROTHSCCHILD trademark, that the Respondent is not commonly known by the disputed domain name and is not using it in connection with the offering of goods or services, or making a legitimate noncommercial or fair use of it. The disputed domain name was used to redirects Internet users to the Complainant’s official website.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

The Panel could not find any evidence by referring to the examples listed in Paragraph B(11)(e) of the ADR Rules that:

- (i) prior to commencing this proceeding the Respondent has used the disputed domain name in connection with the offering of goods or services or has made demonstrable preparations to do so; or that
- (ii) the Respondent as an undertaking, organization or natural person has been commonly known by the disputed domain name; or that

(iii) the Respondent is making a legitimate and noncommercial or fair use of the disputed domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or European Union law.

On the contrary, the use of the disputed domain name for redirecting Internet users to the Complainant's official website is likely to create confusion with the Complainant's trademark as to the disputed domain name's source, sponsorship, affiliation or endorsement. Furthermore, ADR panels have found that disputed domain names identical to a complainant's trademark carry a high risk of implied affiliation.

The Panel therefore finds that Paragraph B(11)(d)(1)(ii) of the ADR Rules has been satisfied.

C. Registered or Used in Bad Faith

According to Article 21(1) of the Regulation and Paragraph B(11)(d)(1) of the ADR Rules (ii) lack of rights or legitimate interests and (iii) registration or use in bad faith are alternative requirements. The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name and therefore there is no need to consider also the bad faith element.

In any case, the Panel finds that the use of the disputed domain name as described above is an evidence of bad faith registration and use, pursuant to Paragraph B(11)(d)(1)(iii) of the ADR Rules. Moreover, since the MX records attached to the disputed domain name have been activated, noting the nature of the disputed domain name (being it identical to the Complainant's trademark), the Panel deems that there is a risk that the disputed domain name could be used for phishing activities, a very common situation especially in the field of banking services.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <edmondderothschild.eu> be revoked.¹

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: November 9, 2022

¹ The Panel notes that the original Complaint requested the transfer of the disputed domain name. However, the Complainant filed an amended Complaint requesting the revocation of the disputed domain name. As the Complainant Holding Benjamin et Edmond de Rothschild, Pregny SA is located in Switzerland, it does not satisfy the general eligibility criteria for registration of the disputed domain name set out in Article 3 of Regulation (EU) 2019/517. Therefore, the Complainant is not entitled to request the transfer of the disputed domain name.