

ADMINISTRATIVE PANEL DECISION

Rödl Equity Partner Beteiligungs GmbH & Co. KG and
Prof. Dr. Christian Rödl, LL.M. (Columbia University, New York) v. Yu Yang
Case No. DIO2024-0020

1. The Parties

The Complainants are Rödl Equity Partner Beteiligungs GmbH & Co. KG, Germany and Prof. Dr. Christian Rödl, LL.M. (Columbia University, New York), Germany, represented Rödl GmbH Rechtsanwaltsgesellschaft, Germany.

The Respondent is Yu Yang, China.

2. The Domain Name and Registrar

The disputed domain name <roedl.io> (the “Disputed Domain Name”) is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 10, 2024. On July 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 15, 2024, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 16, 2024, 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 July 17, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 July 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 12, 2024.

The Center appointed Mariia Koval as the sole panelist in this matter on August 15, 2024. 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 Rödl Equity Partner Beteiligungs GmbH & Co. KG is a large auditing and consulting firm, which has provided legal, tax, financial and IT consulting for more than 50 years. With headquarters in Germany, the company has more than 106 offices in 48 countries. The Complainant Prof. Dr. Christian Rödl, LL.M (Columbia University, New York) is the managing partner, chairman of the management board and major shareholder of the other Complainant Rödl Equity Partner Beteiligungs GmbH & Co. KG.

The Complainants are the owners of numerous RÖDL & PARTNER, ROEDL & PARTNER, RÖDL and ROEDL trademark registrations (collectively, the "ROEDL Trademarks") in various jurisdictions worldwide, among which are:

- International Trademark Registration No. 801971 for RÖDL & PARTNER, registered on February 25, 2003, in respect of services in classes 35, 36, and 42;
- International Trademark Registration for RÖDL, No. 940658, registered on June 22, 2007, in respect of services in classes 35, 36, and 45;
- German Trademark Registration for ROEDL, No. 302014041341, registered on May 16, 2014, in respect of services in classes 35, 36, and 45.

The Complainants operate numerous domain names identical to, or comprising, the ROEDL Trademarks, for instance, <roedl-partner.com> (registered on December 3, 2007), <roedl-partner.de> (registered on February 20, 2008), <roedl-partner.org> (registered on December 3, 2007), <roedl-partner.net> (registered on March 2, 2009), <roedlpartner.fr> (registered on March 23, 2009), <roedl.com> (registered on June 25, 1997) and <roedl.de> (registered on September 17, 2008). The Complainants also operate pages on various social media platforms.

The Disputed Domain Name was registered on May 9, 2024. As at the dates of filing of the Complaint and this Decision, the Disputed Domain Name resolves to a webpage where it is being offered for sale for USD 2,988.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainants contend that the Disputed Domain Name is identical to the Complainants' ROEDL Trademarks in view of the ROEDL Trademarks are incorporated completely in the Disputed Domain Name.

The Complainants further claim that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following: The Respondent is not in any way connected or affiliated to the Complainants or any of associated corporations. There is no evidence of the Respondent's use of, or preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods or services. Moreover, there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. The Respondent is not commonly known by the Disputed Domain Name or any

variation thereof. The Respondent neither has been authorized by the Complainants to use the ROEDL Trademark, nor is the proprietor of any "ROEDL & PARTNER", "RÖDL & PARTNER", "ROEDL" or "RÖDL" Trademarks.

The Complainants further contend that the Respondent registered and is using the Disputed Domain Name in bad faith in view of the following:

- the Respondent has hidden its identity by using the privacy service;
- the Respondent has registered the Disputed Domain Name in bad faith in the attempt to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainants' ROEDL Trademarks as to the source of the Respondent's website;
- the Respondent's non-use of a website under the Disputed Domain Name does not prevent a finding of bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered or is being used in bad faith.

6.1. Preliminary Issue: Consolidation of Complainants

UDRP¹ panels have articulated principles in accordance with Paragraph 10 of the Rules governing the question of whether a complaint filed by multiple complainants may be brought against one or more respondents. These criteria encompass situations in which: (i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion; and (ii) it would be equitable and procedurally efficient to permit the consolidation. The burden of showing that consolidation is proper falls on the Complainants.

The Complainants have provided sufficient evidence to support consolidating them. They share a common legal interest and grievance. Specifically:

- the Complainant Prof. Dr. Christian Rödl, LL.M (Columbia University, New York) is the managing partner, chairman of the management board and major shareholder of the other Complainant Rödl Equity Partner Beteiligungs GmbH & Co. KG;
- both Complainants are the owners of the ROEDL Trademarks.

¹ Given the similarities between the .IO Policy and Rules and the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules, the Panel finds UDRP precedent generally to be relevant to this case (except to the extent of relevant differences between the policies, such as the absence of a conjunctive requirement for bad faith). See *IOTA Foundation v. Privacy Service provided by Withheld for Privacy ehf /Super Green*, WIPO Case No. [DIO2022-0001](#).

As such, both of the Complainants have a common legal interest in a relevant right or rights that are affected by the Respondent's conduct regarding registration and use of the Disputed Domain Name, and both of the Complainants are the target of common conduct by the Respondent that has affected their individual legal interests. Further, it is procedurally efficient to consolidate them.

Accordingly, the Panel will consolidate the Complainants and will refer to them as "the Complainant" hereafter.

6.2. Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of the ROEDL Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the Complainant's ROEDL Trademarks are completely reproduced within the Disputed Domain Name in combination with the country-code Top-Level domain ("ccTLD") ".io". Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark. Accordingly, the Disputed Domain Name is identical to the Complainant's ROEDL Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 domain name (although the burden of proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

The Complainant has not authorized, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the ROEDL Trademarks nor is there any other evidence in the file suggesting that the Respondent has or could have rights or legitimate interests in the Disputed Domain Name.

The composition of the Disputed Domain Name – being identical to the mark – carries a high risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#), section 2.5.1). The Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. As at the dates of filing of the Complaint and this Decision, the Disputed Domain Name resolves to a webpage where the Disputed Domain Name is offered for sale for USD 2,988. Therefore, the only use of the Disputed Domain Name is to advertise it for sale. Trading in domain names can constitute a bona fide offering provided it is not undertaken with intent to profit from or abuse trademarks (See, e.g. *X6D Limited v. Telepathy, Inc.*, WIPO Case No. [D2010-1519](#)). The evidence in this proceeding indicates, more likely than not, that the Respondent's intention was to target the Complainant, thus the offering for sale of the Disputed Domain Name cannot constitute a bona fide offering of goods or services conferring rights or legitimate interests.

Moreover, the Respondent did not file any response to the Complaint and did not participate in this proceeding. Prior to the notice of the dispute, the Respondent did not demonstrate any use of the Disputed Domain Name or a trademark corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered or Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration or use of a domain name in bad faith.

In the present case, the Panel comes to the conclusion that the Disputed Domain Name was registered and is being used in bad faith in view of the following: The Complainant obtained the registrations of the ROEDL Trademarks more than 20 years earlier than the Respondent registered the Disputed Domain Name in 2024. Taking into account all circumstances of this case, the Panel finds that the Respondent was very well aware of the Complainant's business and their ROEDL Trademarks when registering the identical Disputed Domain Name that completely incorporates the Complainant's ROEDL Trademarks. The Panel considers it is obvious bad faith that the Respondent deliberately chose the Disputed Domain Name to create a likelihood of confusion with the Complainant's ROEDL Trademarks, so as to create a false association or affiliation with the Complainant.

Moreover, the Disputed Domain Name redirects Internet users to a "for sale" page where the Respondent is attempting to sell the Disputed Domain Name for USD 2,988; an amount that, more likely than not, exceeds the Respondent's out-of-pocket expenses relating to the Disputed Domain Name. In *Trip.com, Inc. v. Daniel Deamone*, WIPO Case No. [D2001-1066](#), the Panel stated: "There is nothing inherently wrongful in the offer or sale of domain names, without more, such as to justify a finding of bad faith under the Policy. However, the fact that domain name registrants may legitimately and in good faith sell domain names does not imply a right in such registrants to sell domain names that are identical or confusingly similar to trademarks or service marks of others without their consent. Although Respondent's offer of the Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy [...] The offering for sale of a domain name, even to a third party, supports bad faith."

In view of the absence of any evidence to the contrary, the Panel finds that the Respondent has incorporated the Complainant's ROEDL Trademarks in the Disputed Domain Name completely, without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the ROEDL Trademarks and infringing upon the Complainant's rights.

In view of the Respondent did not file any response to claim otherwise, 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, <roedl.io> be transferred to the Complainant.

/Mariia Koval/

Mariia Koval

Sole Panelist

Date: August 29, 2024