

ADMINISTRATIVE PANEL DECISION

NIO Holding Co., Ltd. v. Sursenso Pty Ltd
Case No. DAU2024-0033

1. The Parties

The Complainant is NIO Holding Co., Ltd., China, represented by ATL Law Offices, Hong Kong, China.

The Respondent is Sursenso Pty Ltd, Australia, represented internally.

2. The Domain Name and Registrar

The disputed domain name <nioauto.au> is registered with Instra Corporation Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2024. On November 8, 2024, the Center transmitted by email to Instra Corporation Pty Ltd. a request for registrar verification in connection with the disputed domain name. On November 11, 2024, Instra Corporation Pty Ltd. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 12, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was December 2, 2024. The Response was filed with the Center on November 25, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on December 9, 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 and its corporate group are based in China where it designs, manufactures and sells electric vehicles and associated autonomous driving and artificial intelligence. Its Chinese name is “Weilai” which, according to the Complaint, means “Blue Sky Coming”.

The Complainant’s first vehicle, the NIO EP9 supercar, was launched in 2016. Its first volume manufactured electric vehicle, the NIO ES8, was launched at the Complainant’s NIO Day event on December 16, 2017 (presumably, in China) and delivery of vehicles to the purchasing public commenced on June 28, 2018. The NIO ES8 followed with a launch in December 2018 and public deliveries commencing in June 2019. Further models followed.

The Complainant promotes its products, amongst other things, from a website at “www.nio.com”. According to this website, the Complainant was founded in 2014 and has sold some 640,000 vehicles. The Complainant’s products have not yet been offered for sale in Australia.

The Complaint claims the Complainant’s NIO trade mark is well known around the world as a result of extensive use, marketing and promotion.

The Complaint includes a list of numerous registered trade marks for NIO around the world. This includes Australian Registered Trade Mark No. 1803593, NIO, which has been registered with effect from October 10, 2016 in respect of a wide range of goods and services in International Classes 7, 9, 12, 14, 25, 35, 36, 37, and 42.

The disputed domain name was registered on November 16, 2022. It has not resolved to an active website.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark 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 or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that the Panel deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s name, trade mark or service mark.

In this case, the Complainant has proven ownership of, amongst others, the Australian registered trade mark for NIO.

In comparing the disputed domain name to this trade mark, all that is required is simply a visual and aural comparison and assessment of the disputed domain name itself to the Complainant's trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of "likelihood of confusion" under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically, and as is appropriate in this case, it is permissible to disregard the country code Top-Level-Domain ("ccTLD"), ".au", as a functional component of the domain naming system. See for example auDA Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDRP Overview 2.0"), section 1.11 and, for example, *CLARINS v. NETLOCAL CONSULTING PTY LTD*, WIPO Case No. [DAU2023-0016](#).

Disregarding the ".au" ccTLD, the disputed domain name consists of the Complainant's registered trade mark and the term "auto". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g. auDA Overview 2.0, sections 1.7.4 and 1.7.6. Apart from anything else, the Complainant's trade mark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark and the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] 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 (not being the offering of domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [the Respondent has] acquired no trade mark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent under this head and an evidential burden will shift to the respondent to rebut that prima facie case. The ultimate burden of proof, however, remains with the Complainant. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#); auDA Overview 2.0, section 2.1.1.

In the present case, the Respondent registered the disputed domain name several years after the Complainant began using its trade mark and also several years after the trade mark was registered.

It is not in dispute between the parties that the Respondent is not part of the Complainant's corporate group and has not been authorised by the Complainant to use the Complainant's trade mark or register the disputed domain name.

The disputed domain name is not derived from the Respondent's formal, legal name nor the name of its contact recorded in the Whois record, James Tang.

There has not been any use of the disputed domain name.

These matters are usually sufficient to raise a prima facie case against the Respondent.

According to the Respondent, the Respondent intends to operate a camera product business under the name "New Innovation Oceania Automatic". Thus, the disputed domain name is comprised of the initials of the first three words of the proposed name and "auto" as an abbreviation for "automatic".

The Respondent claims that the proposed camera product business will focus on innovative automation solutions for Oceania's unique needs such as smart cameras that enhance home security, monitor agricultural fields or oversee industrial sites. The Respondent points out that a user who searches for "arlo auto" will primarily see camera-related results being Arlo brand security cameras which are promoted or recognised for their auto-focusing and tracking features.

The Respondent says that it began building a website for its proposed camera products on March 4, 2023 (before it received notice of the Complaint in November 2024). A screen shot is provided in Annex B.

The Respondent says further that, before registering the disputed domain name, it undertook a search of "Nioauto" on the online Australian Trade Mark Search Service and that search returned "0" (Annex A).

While the truth or otherwise of the Respondent's claims cannot be known in a proceeding such as proceedings under the Policy, on the balance of probabilities, the Panel is not able to accept the Respondent's denials of bad faith.

First, the Panel accepts that NIO is a three letter name or term which can indicate many different people.

Indeed, the Respondent points out that there are four registered trade marks on the Australian Register in the names of different people and for very different products. In addition to the Complainant's registered trade mark, these are:

- (1) Australian Registered trade mark No. 1007425, NIO, in the name of Barco N.V. in respect of a range of audio-visual equipment in International Class 9;
- (2) Australian Registered trade mark No. 2204460, NIO, in the name of Osanrae Holdings Pty Ltd in respect of a range of building and building maintenance services in International Class 37; and
- (3) Australian Registered trade mark No. 2208864, NIO, in the name of Niococktails SRL for drink containers and beverages in International Classes 21, 32, and 33.

In addition, the Response includes evidence of a number of companies or business names registered with the Australian Securities and Investments Commission including NIO Agency, NIO Australia (which appears to provide personal care services), NIO Digital, NIO Partners Pty Ltd, Nio Photography and Café Nio.

The disputed domain name is not just the word Nio but a composite expression Nioauto. The Panel also accepts, however, that in some contexts “auto” can be a diminutive or shortening for “automatic” as well as “automobile”.

Secondly, notwithstanding the foregoing, the composite expression is a natural expression making direct reference to the Complainant and its business.

Thirdly, the Respondent’s proposed name of the proposed new business is highly unorthodox and quite ungrammatical according to Australian usages especially for a business which the Respondent claims will be focused on Australia solely.

Fourthly, there are no materials before the Panel showing use of the proposed new name of the proposed new business. The screen shot of the proposed shopping website included in Annex B is in the name of Shopigo Pty Ltd with one team member “Jason T”. It is the barest of template forms. There is no information about products and the store information gives an email address of “shopigoau@” with the domain being the domain of a well known free email service provider, not the disputed domain name.

According to the Australian Securities and Investment Commission’s online Register, both the Respondent and Shopigo Pty Ltd have the same postcode but more precise information is not available.

Fifthly, the Respondent has not provided any explanation of when it adopted this new name or how it derived it.

Sixthly, the Respondent does state that Mr. Tang is not a car enthusiast and cannot be expected to know all car brands when there are, the Respondent says, more than 500 car brands around the world and the Respondent is a comparative newcomer.

The Complainant does claim to be well known all around the world. The Complainant has not provided much evidence to support that claim. Annex 9 includes a media release from its website and two press articles, one from *Forbes* and one from a website “www.everformance.co.uk”. The Complaint also includes evidence showing a Google search of “NIO auto” returns results only relating to it. This search appears to have been conducted in China.

The Respondent accepts, however, that the Complainant and its trade mark have been widely reported in the media but disputes that equates to being widely or commonly known. The Respondent points out that the Complainant has only 3,700 followers on its TikTok account.

Seventhly, the Respondent has demonstrated some degree of sophistication and proficiency by apparently conducting a trade mark search before registering the disputed domain name. However, the search the Respondent conducted was curiously specific. It did not involve a search of NIO, the main distinguishing feature of the disputed domain name. In contrast, while the Respondent’s Google search of “arlo auto” does show results for “Arlo” brand cameras, it is plain from those searches that “Arlo” is the distinctive feature or “brand”.

As O’Callaghan J has ruled recently in *The Practice Pty Ltd v The Practice Business Advisers & Tax Practitioners Pty Ltd* [2024] FCA 1299 at [66] – [73], a search of that kind, avoiding the obvious more general search, is not what a person acting reasonably and diligently would be expected to undertake. Unlike the present situation, his Honour’s decision involved directly overlapping services. However, it provides an indication of what an Australian court will consider in assessing a claim to have adopted a name in good faith.

In that connection, if one conducts a Google search in Australia for either “NIO” or “NIO auto”, the search results returned – at least on the first page – all relate to the Complainant and its brand. The Respondent does criticize the Complainant’s Google search as unfair because, as the Respondent has not launched its website, Google has not indexed the Respondent’s products under its NIO brand. Nonetheless, it seems unlikely that the Respondent would have conducted searches of the Trade Mark Register but not also have undertaken a Google search.

In such a case and accepting that the Respondent claims to be intending to operate in a different field to the Complainant, it would seem very likely that the Respondent would have realised the adoption and use of the disputed domain name would likely cause confusion and attract people (at least initially) to the Respondent’s proposed website in the mistaken belief it was the Complainant’s or in some way associated with it. See for example *Anheuser-Busch Inc v Budejovicky Budvar* [2002] FCA 390; 56 IPR 182 at [199] – [219].

In these circumstances, the Panel is not prepared to find that the Respondent has provided a sufficient basis to establish demonstrable preparations to use the disputed domain name in connection with a good faith offering of goods or services to rebut the Complainant’s prima facie case. The link between the Respondent’s proposed website, which is at best a rudimentary template and used a very different brand name even though apparently created some months after the registration of the disputed domain name, appears far too tenuous to satisfy the requirements of paragraph 4(c)(i) of the Policy.

Accordingly, the Panel finds that the Respondent has not rebutted the prima facie case established by the Complainant. The Complainant has established therefore the second requirement under the Policy also.

C. Registered or Subsequently Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent. In contrast to the Uniform Domain Name Dispute Resolution Policy, the requirements of registration or use are disjunctive. It is necessary for the Complainant to establish only one or the other.

In the circumstances of this case, the reasons leading to the rejection of the Respondent’s claim to have adopted the disputed domain name in connection with a (proposed) good faith offering of goods or services lead also to the conclusion that the Respondent has at least registered the disputed domain name in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <nioauto.au>, transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: December 19, 2024