



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	<b>HK-2201597</b>
<b>Complainant:</b>	<b>Nio Co., Ltd</b>
<b>Respondent:</b>	<b>Klaus Gasser</b>
<b>Disputed Domain Name(s):</b>	<b>&lt;www.nio-auto.com&gt;</b>

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**1. The Parties and Contested Domain Name**

The Complainant is Nio Co., Ltd, of Suite 115, 569 Anchi Road, Anting Town, Jiading District 201805 Shanghai, People’s Republic of China.

The Respondent is Klaus Gasser, of Romstrasse 136, IT, 39014.

The domain name at issue is <www.nio-auto.com>, registered by Respondent with Promo People Inc., of 5063 North Service Road, Suite 201, Burlington Ontario L7L 5H6, Canada.

**2. Procedural History**

On February 24, 2022, pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) and the Rules for the Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Complainant submitted a Complaint to the Hong Kong Office (“HK Office”) of the ADNDRC (“ADNDRC”). On the same day, the HK Office sent to the Complainant by email an acknowledgment of the receipt of the Complaint and reviewed the format of the Complaint for compliance with the Policy, the Rules and the HK Office Supplemental Rules. The HK Office also notified the Registrar of the Complaint by email. The Registrar replied to the HK Office on the same day.

On February 28, 2022, the HK Office informed the Complainant that the information of the Respondent was incorrect and requested the deficiencies in the Complaint to be rectified. On March 1, 2022, the Complainant submitted a revised Complaint to the HK Office. On March 2, 2022, the HK Office confirmed that the Complaint is in administrative compliance with the Policy. The HK Office forwarded the Complaint to the Respondent and the due date of the Response was March 22, 2022.

On March 3, 2022, the Respondent requested a withdrawal of the Complaint from the HK Office.

On March 4, 2022, the Respondent informed the HK Office that he was willing to transfer the disputed domain name to the Complainant.

On March 8, 2022, the Respondent informed the HK Office that he was willing to transfer the disputed domain name to the Complainant free of charge. On the same day, the Complainant informed the Respondent and the HK Office that it was not willing to settle the dispute.

On March 9, 2022, the HK Office informed the Respondent of the requirements of submitting a Response.

On March 10, 2022, the Respondent asked the HK Office if a Response is still required if the Respondent was willing to transfer the disputed domain name free of charge. The HK Office informed the Respondent that as the Complainant was not agreeable to settlement, the proceeding shall continue and that if the Respondent did not wish to submit a Response, the Panel shall decide the disputed based on the Complaint.

On March 11 to 12 and 14, 2022, the Respondent asked the HK Office and the Complainant whether the Complainant would withdraw the Complaint if the Respondent transferred the disputed domain name free of charge to the Complainant. The Respondent also requested to know who the appointed panelist will be, and how to appoint three panelists to decide the dispute.

On March 14, 2022, the HK Office informed the Respondent that it will proceed to panel appointment unless it receives a notice from the parties that a settlement has been reached or a request from the Complainant to terminate the proceeding. The HK Office emphasized that if the Respondent does not wish to submit a Response, the Panel shall decide the dispute based on the Complaint. If the Respondent wished to have the dispute settled by a three-member panel, the Respondent would have to indicate his preference in the relevant form and make payment of the requisite fees. On the same day, the Respondent repeated his questions to the HK Office.

On March 15, 2022, the HK Office informed the Respondent that it will appoint the Panel after the response period and the parties will be notified of the panelist appointed in due course.

On March 16, 2022, the Respondent informed the HK Office that he would submit further details and the relevant form soon.

On March 21, 2022, the Respondent submitted the Response and documents to the HK Office. On the same day, the HK Office confirmed receipt of the Response.

On March 22, 2022, the HK Office appointed Jonathan Agmon as the sole panelist in this matter.

### **3. Factual background**

The Complainant, Nio Co., Ltd and its associated companies (“NIO”), is a pioneer in China’s premium electric vehicle market. NIO designs, jointly manufactures, and sells smart premium electronic vehicles with technologies in connectivity, autonomous driving and artificial intelligence. NIO’s Chinese name, Weilai, means “blue sky coming” which

according to Complainant reflects its vision and commitment to a more environmentally friendly future. In 2016, NIO developed its first model, the EP9 supercar. On December 16, 2017, NIO launched its first volume manufactured electric vehicle, ES8, to the public at the NIO Day event and began deliveries from June 28, 2018. In December 2018, NIO officially launched the ES6, a high-performance premium electric NUV, and began deliveries in June 2019. NIO also offers comprehensive value-added services and suite of charging solutions to its users, such as, Power Home, Power Swap, Power Mobile and Power Express. NIO sells its vehicles through its own sales network, including NIO Houses and its mobile application. NIO Houses function as showrooms for vehicles and clubhouses for its users. Through extensive use, marketing and promotion of NIO's trademarks, NIO's trademark is well-known worldwide.

NIO owns numerous registered registrations for "NIO" around the world, including the following:

- China Trademark Registration No. 20259651, registered on July 28, 2017;
- China Trademark Registration No. 20259650, registered on July 28, 2017;
- China Trademark Registration No. 20259649, registered on July 28, 2017;
- China Trademark Registration No. 20259648, registered on October 14, 2017; and
- China Trademark Registration No. 20259647, registered on July 28, 2017.

The disputed domain name <www.nio-auto.com> was registered on September 15, 2021 and redirected to a domain <www.nikoolaa.com/de> which resolved to an active website in the German language that appeared to feature the NIO trademark and its goods.

The Respondent appears to be an individual based in Italy.

#### **4. Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions may be summarized as follows:

- i. The Complainant argues that the disputed domain name is identical or confusingly similar to a trademark or service in which the Complainant has rights. The Complainant holds trademark registrations for the NIO marks and the NIO mark is wholly incorporated in the disputed domain name with the addition of a hyphen and the descriptive word "auto".
- ii. The Complainant also argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not authorized or licensed by the Complainant to register domain names incorporating the Complainant's mark. The Respondent is not commonly known by the disputed domain name. The Respondent is not using and has not demonstrated an intent to use the disputed domain name in connection with a *bona fide* offering of goods or services in the course or trade and is not making a legitimate noncommercial or fair use of the disputed domain name without intent to misleadingly divert consumers or tarnish the Complainant's mark for commercial gain.
- iii. The Complainant further argues that the disputed domain name has been registered and is being used in bad faith. The Respondent registered the disputed

domain name with the intention of causing confusion to the public that the Respondent and/or the Respondent's website is related to or authorized by the Complainant and/or the Complainant's website and diverting the traffic of Internet users.

## B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Respondent disputes the legitimacy of the Complainant's Complaint and its annexures and contends that the Complainant does not have the right in the European Union to prohibit use of the trademark "nio".
- ii. The Respondent further argued that a together with Abarfly there were certain negotiations with Complainant in relation to a business venture which was intended to be launched in the future. The venture was meant to sell Complainant's used cars under the disputed domain names.
- iii. The Respondent also stated that the filing of the Complaint was in violation of Article 15 Directive (EU) 2015/2436 dealing with exhaustion of trademark rights.
- iv. The Respondent seeks compensation from the Complainant for the transfer of the disputed domain name. The Respondent states that the compensation must be agreed with his attorney or himself.
- v. The Respondent argues that he asked the Complainant several times to withdraw the Complaint and offered to transfer the disputed domain name free of charge to the Complainant, but the Complainant rejected his offers.

## 5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

### A) Identical / Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has provided evidence of its trademark registrations in China.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The disputed domain name <www.nio-auto.com> incorporates the Complainant's NIO mark in its entirety

(see *Wal-Mart Stores, Inc. v. Kuchora, Kal*, WIPO Case No. D2006-0033; *Hoffmann-La Roche Inc. v. Andrew Miller*, WIPO Case No. D2008-1345).

It is well established that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.8. Here, the addition of the hyphen and descriptive term “auto” does not avoid confusing similarity.

It is also established that the applicable gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid a finding of confusing similarity as the use of a gTLD is technically required to operate a domain name (see *Accor v. Noldc Inc.*, WIPO Case No. D2005-0016; *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. D2006-0451; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *L’Oréal v Tina Smith*, WIPO Case No. D2013-0820; *Titoni AG v Runxin Wang*, WIPO Case No. D2008-0820; and *Alstom v. Itete Peru S.A.*, WIPO Case No. D2009-0877).

The disputed domain name which consists of the Complainant’s NIO mark, addition of the hyphen and descriptive term “auto” and the gTLD “.com” in the Panel’s view does not avoid a finding of confusing similarity with the Complainant’s trademark.

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights and the element under paragraph 4(a)(i) of the Policy is satisfied.

## **B) Rights and Legitimate Interests**

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or legitimate interests in respect of the domain name. Once the complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondent to use the NIO mark (see *OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. D2015-1149; *Sanofi-Aventis v. Abigail Wallace*, WIPO Case No. D2009-0735).

The Complainant also submitted that the Respondent’s use of the disputed domain name redirected to an active website in German language featuring the

Complainant's NIO mark and its goods, "NIO ES8", "NIO ES6", "NIO ET7", "NIO EC6", "NIO POWER" and "NIO ET5", without the Complainant's authorization.

In addition, the evidence submitted by the Complainant shows that the Respondent is also not known by the disputed domain name.

The Complainant further submitted evidence that even if the Respondent is legitimately providing goods or services related to the Complainant's mark in relation to secondhand NIO cars, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name and cites the four principles from *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. D2001-0903:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarks goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent fails the Oki Data test. First, Respondent did not submit that it is selling Respondent's goods under the disputed domain name. In fact, the disputed domain name, when active, was referred to another domain name <nikoolaa.com>, which is under a privacy shield.

Second, even if the <nikoolaa.com> website ("Website") was being operated by the Respondent, the evidence shows that the Respondent did not in fact use the Website to sell Respondent's cars under the NIO mark.

Third, the Website fails to disclose if it has any relationship with Complainant. Registrant stated on the Website that it is "*the first Nio Pre-owned, Independent Car Dealer in the EU*". The text was located next to the promotional photo of the Complainant's ES8 vehicle and it is the Panel's finding that this and other text appearing on the Website fails to accurately disclose the relationship between Respondent and Complainant.

Fourth, the evidence shows that Respondent was trying to "corner the market" in the sense that it brought a business proposal to Complainant after he has obtained the disputed domain name. The record shows that when Complainant refused to Respondent's offers, Complainant offered the Respondent to buy the disputed domain name for an amount which is far greater than his out-of-pocket expense.

In its Response, the Respondent did not provide any evidence to show that he has any rights or interests in the disputed domain name and cited Article 15 Directive (EU) 2015/2436 to argue that his intended operation was legitimate, and he could use the mark "nio" to sell Complainant's used cars. However, this Directive is irrelevant under the Policy and this proceeding, which deals with a very narrow type of disputes relating to domain names.

Based on the above evidence and circumstances, the Respondent is not making a *bona fide* offering of goods or services related to the Complainant's goods or services under the disputed domain name and the Respondent has failed to provide

any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's *prima facie* case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

### **C) Bad Faith**

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (paragraph 4(a)(iii) of the Policy). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant submitted evidence that the disputed domain redirected to an active website in the German language featuring the Complainant's NIO mark and its goods. It is clear that the Respondent was aware of the Complainant at the time of registration of the disputed domain name and specifically targeted the Complainant and its business. The Respondent did not deny these facts. The addition of the descriptive term "auto" in the disputed domain name after the Complainant's NIO mark also indicates that the Respondent was familiar with the Complainant's business in the automobile industry.

It is also up to the Respondent to control the content appearing on the website under the disputed domain name. The Panel therefore takes the view that the Respondent is riding on the reputation of the Complainant and is using the disputed domain name to deliberately attract Internet users to its website for commercial benefit despite not being authorized or licensed by the Complainant. The Respondent is making use of the Complainant's reputation and its goods and services to create a likelihood of confusion with the Complainant's NIO mark and have misled the public to believe that the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location are associated with Complainant, or with its authorization.

The evidence submitted by the Complainant and the correspondence between the parties also shows that the Respondent changed its stance several times before and after the proceedings commenced, which is construed as further indications of bad faith. Prior to commencement of proceeding, the Respondent informed the Complainant that he would only transfer the disputed domain name for a fee and that a third party was willing to pay up to €400,000 for the disputed domain name. This impliedly meant that the Respondent was asking for at least €400,000 in exchange for the transfer of the disputed domain name which led the Complainant to file the Complaint. After the Complaint was issued to the Respondent, the Respondent offered to transfer the disputed domain name for free to the Complainant. However, the Complainant was not agreeable to it and parties did not reach a settlement. The Respondent then submitted a Response and requested for compensation in exchange for the transfer of the disputed domain name.

Although in its Response, the Respondent argued that he requested several times for the Complainant to withdraw the Complaint in exchange for transferring the disputed domain name for free and the Complainant rejected his offers, the Panel notes that

these “offers” were only made after the Complaint was served on the Respondent in contrary to his requests for consideration prior to the proceeding. In any event, this does not obviate the fact that the Respondent specifically targeted the Complainant, its NIO mark and its goodwill and attempted to extort an exorbitant amount from the Complainant for the transfer of the disputed domain name after unsuccessfully negotiating a trademark license from the Complainant to use their NIO mark.

Further, Respondent moved this Panel for the award of compensation for the transfer of the disputed domain name. Under the Policy this Panel does not have jurisdiction to award costs nor compensation of any sort, unlike national courts. Therefore, Respondent’s request is improper and is denied. Respondent may pursue such claims in the appropriate forum.

Based on the above circumstances and totality of evidence presented to the Panel, including the confusing similarity between the disputed domain name and the Complainant’s NIO mark, the Respondent’s bad faith conduct, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith, and accordingly, paragraph 4(a)(iii) of the Policy is satisfied.

## 6. Decision

For the foregoing reasons, in accordance with paragraphs 4(1) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <www.nio-auto.com> be transferred to the Complainant.



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Jonathan Agmon  
Panelists

Dated: April 5, 2022