

ADMINISTRATIVE PANEL DECISION

Wanda Films, S.L. v. 张霖 (Zhang Lin), 万达电影股份有限公司
(wandadianyinggufenyouxiangongsi)
Case No. D2024-2526

1. The Parties

The Complainant is Wanda Films, S.L., Spain, represented by Sabatellini & Associats, S.L.P., Spain.

The Respondent is 张霖 (Zhang Lin), 万达电影股份有限公司 (wandadianyinggufenyouxiangongsi), China, represented by Schellenberg Wittmer Ltd., Switzerland.

2. The Domain Name and Registrar

The disputed domain name <wandafilm.com> is registered with DNSPod, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 20, 2024. On June 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 26, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On June 26, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On June 27, 2024, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not submit any submissions on the language of the proceeding.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in Chinese and English of the Complaint, and the proceeding commenced on July 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 22, 2024. On July 15, 2024, the Respondent sent an email to the Center requesting a four-day extension. On July 15, 2024, the Center granted the four-day extension to the Respondent in accordance with the paragraph 5(b) of the Rules, and the due date for Response was extended to July 26, 2024. The Response was filed in English with the Center July 26, 2024.

The Center appointed Sebastian M.W. Hughes, Iris Quadrio, and Roger Staub as panelists in this matter on August 16, 2024. The Panel finds that it was properly constituted. Each member of 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.

Noting the Response is filed in English, the Panel considers that the Parties have effectively agreed on English to be the language of the proceeding. Therefore, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

4. Factual Background

A. Complainant

The Complainant is a company incorporated in Spain in 1992, specialising in the production and distribution of Spanish, Latin American, and European films for the Spanish speaking market, under the trade mark WANDA FILMS (the “Trade Mark”).

The Complainant is the owner of three registrations for the Trade Mark in Spain, the earliest (word mark) registration No. M1745034, with a registration date of April 16, 1994.

The Complainant is also the owner of the domain names <wandafilms.com> and <wandavision.com>, registered on July 4, 2002 and July 26, 2002, respectively, and each resolved to the same Spanish language website promoting the Complainant’s business (the “Complainant’s Website”).

The Complainant is also the owner of the domain name <wandavision.es>, registered on February 28, 2024, and which is not, at the date of this Decision, resolved to any active website.

B. Respondent

The Respondent is a company incorporated in China in 2005, listed on the Shenzhen Stock Exchange since 2015, and operating under the name Wanda Film (万达电影) since 2017.

The Respondent is part of the Dalian Wanda Group, a large Chinese corporate group established in 1988, and is the one of the largest cinema operators in China. The Respondent is authorised by the Dalian Wanda Group to use the Wanda Film name and trade mark in respect of its cinema and film investment, production and distribution business.

Prior to its name change, in 2017, to Wanda Film Holding Company Limited (万达电影股份有限公司), the Respondent operated its Chinese language website to promote its business at “www.wandacinemas.com”; and, since 2017, it has used the disputed domain name to promote its business via the same, Chinese language website targeting the Chinese speaking market, at “www.wandafilm.com” (the “Respondent’s Website”).

The Respondent’s two applications filed in 2022 to register the trade mark WANDA FILM in China have been refused by the Chinese Trade Marks Office. The Respondent has filed a pending application to review the second of its trade mark applications, which is still pending. However, the Panel notes the China National Intellectual Property Administration’s website shows that the Respondent has two valid registrations in

China for the trade mark WANDA – registration No. 5249869 , with a registration date of July 14, 2009; and registration No. 11389926 , with a registration date of June 14, 2014.

C. The Disputed Domain Name

The disputed domain name was registered on September 28, 2005.

D. Use of the Disputed Domain Name

The disputed domain name is used to promote the Respondent's business via the Respondent's Website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- (i) The Respondent is using the disputed domain name in an attempt to tarnish the goodwill of the Trade Mark for the purpose of creating confusion among users and to take advantage of the prestige acquired by the Complainant; and
- (ii) The Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's Website, creating the likelihood of confusion with the Trade Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website or the services listed on the Respondent's Website.

B. Respondent

The Respondent contends that the Complainant has failed to satisfy each of the requisite elements under the Policy.

Notably, the Respondent contends that:

- (i) As the Complainant's three registrations for the Trade Mark are restricted to Spain, whereas the Respondent is domiciled in China and operates the Respondent's Website exclusively in Chinese, the Complainant cannot assert any of its rights in the Trade Mark in relation to the disputed domain name, under the Policy;
- (ii) The Respondent was not aware of the Complainant, its business and the Trade Mark until the commencement of this proceeding;
- (iii) The Complainant's Website is only available in Spanish and targets only the Spanish speaking market;
- (iv) The Respondent is domiciled in China and targets the Chinese market, and the Respondent's Website is only available in Chinese; and
- (v) Although the Complainant and the Respondent offer similar services, they do so in different parts of the world and in different languages.

6. Discussion and Findings

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 trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. It is also well-established that the jurisdiction where the Complainant's trade mark is registered is not a relevant consideration in respect of the first element, although it may be relevant to the second and third elements. [WIPO Overview 3.0](#), section 1.1.2.

The Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

Disregarding the letter "s", the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The Panel finds that, before notice to the Respondent of the dispute, the Respondent has used the disputed domain name in connection with a bona fide offering of services. [WIPO Overview 3.0](#), section 2.2.

The Panel also finds that the Respondent has been commonly known by the disputed domain name. [WIPO Overview 3.0](#), section 2.3.

The Panel further notes that the Respondent has valid registered trade mark rights for the trade mark WANDA in China.

The Panel finds the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

The evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's Trade Mark.

The Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking ("RDNH") or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute RDNH. For an RDNH finding to be made, it is not necessary for a respondent to seek such finding or prove the presence of conduct constituting RDNH. [WIPO Overview 3.0](#), section 4.16.

The Panel considers that, in all the circumstances, the Complainant, being legally represented, ought to be held to a higher standard. [WIPO Overview 3.0](#), section 4.16.

This is a proceeding in which, on the facts, the Complainant and its legal representatives ought to have recognised it would not be possible to establish both the second and third elements under the Policy.

First, the Complainant operates exclusively in the Spanish speaking market, possesses registrations for the Trade Mark in Spain only, and does not have any operations in China.

Secondly, the Respondent operates exclusively in the Chinese speaking market, and does not have any operations in Spain or in the Spanish speaking market.

Thirdly, the Complainant was aware of the Respondent's long standing use of the Wanda Film name and mark in the Chinese speaking market since 2017. In the Complaint, the Complainant referred to (and sought to rely upon):

(i) Evidence from the Respondent's Website demonstrating that it was established in 2005, formerly known as Wanda Cinema Line, listed on the Shenzhen Stock Market in 2015, and officially changed its name to Wanda Film in 2017; and

(ii) Evidence from Wayback Machine archives again demonstrating the Respondent's name and business and its use of the name Wanda Film in the Chinese market since 2017.

In light of the Complainant's clear knowledge of the Respondent's rights or legitimate interests in the disputed domain name ([WIPO Overview 3.0](#), section 4.16), the contentions made by the Complainant in the Complaint as set out in Section 5.A. above – namely, that (i) the Respondent “is using the domain name [...] to tarnish the goodwill of the Complainant's trademarks or service marks for the purpose of creating confusion among users and to take advantage of the prestige acquired by the Complainant”; and (ii) “the Respondent activates its website [...] to take advantage of the visibility that the Complainant already has and to make users believe that the services provided have the same business origin [...]” – are entirely devoid of merit.

7. Decision

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at RDNH.

/Sebastian M.W. Hughes/

Sebastian M.W. Hughes

Presiding Panelist

/Iris Quadrio/

Iris Quadrio

Panelist

/Roger Staub/

Roger Staub

Panelist

Date: August 31, 2024