



ARAB CENTER FOR DISPUTE RESOLUTION
ADMINISTRATIVE PANEL DECISION

Case No. A2021-0021

1. The Parties

The Complainant is Spase, Inc. (Complainant), represented by Sahil Gupta, United States.

The Respondent is Domain Admin/Mrs Jello LLC (Respondent), represented by Steven Lieberman, United States.

2. The Disputed Domain Name and Registrar

The disputed domain name is <spase.com> (the "Domain Name"), registered with:

Enom, LLC.

3. Procedural History

The Complainant has previously filed two similar complaints requesting the transfer of the disputed domain name to him. The previous panels denied this request. The Complainant filed the current Complaint requesting the reconsideration of these prior decisions.

The Complainant submitted this Complaint by email to the Arab Center for Dispute Resolution (the "Center") on January 6, 2021. Under paragraph 4(c) of the Rules and paragraph 5 (II) of the Supplemental Rules, the Center has verified that the Complaint satisfies 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 Arab Center for Dispute Resolution Supplementary Rules (the "Supplemental Rules").

The Center has formally notified the Respondent of the Complaint in accordance with paragraphs 2 and 4 of the Rules, and the administrative proceedings commenced on January 17, 2021. Per paragraph 5 of the Rules, the due date for Response was February 6, 2021.



Having received no response from Respondent, the Center transmitted a Notification of Respondent Default to the Parties

The Center appointed Prof. Hossam El-Saghir as the sole Panelist on February 8, 2021. The Panel was therefore deemed to have been properly constituted on that date. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence as required by the Center to ensure compliance with paragraph 7 of the Rules.

In the absence of a response, the Panel issues its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Supplemental Rules and any rules and principles of law that the Panel deems applicable.

4. Relief Sought

The Complainant requests the transfer of the Domain Name from Respondent to Complainant.

5. Factual Background

The Complainant owns and operates a business in the field of augmented reality services, in which it has been using the mark SPASE since 2019. It has recently begun the application process for the USPTO trademark in the category of augmented reality.

The Respondent registered its domain "spase.com" on February 3, 2005.

This is a refiling case that concerns the same domain name against the same respondent. In the two previous cases (WIPO Case No. D2020-1786 and FORUM Case No. FA2011001921922), the Complainant failed to establish bad faith registration. The Complainant has been denied relief twice, on the ground that spase.com was registered in 2005, about fourteen years prior to the incorporation of the Complainant in 2019.

Both previous Panels also stated that the Complainant had committed Reverse Domain Name Hijacking, i.e. the complaint was brought in bad faith and constituted an abuse of the administrative proceeding. The Complainant states that the reason for refiling the case is that new facts that will enable it to prove bad faith registration have emerged.

6. Parties Contentions:



A. Complainant

The Complainant's relevant contentions can be summarized as follows:

The domain name "spase.com" matches the "spase" common law trademark of Spase, Inc., which currently operates its business at <https://spase.app> and <https://spase.io>. The Complainant argues that previous panel findings support that it has common law trademark rights in "Spase."

The Complainant contends that the Respondent is using spase.com to disseminate malicious computer software or malware and that the use of a domain name for a website that distributes malware cannot be said to constitute a bona fide offering of goods and services, and would harm its reputation.

It also argues that the previous panel (FORUM FA2011001921922) found that the Respondent has no rights in the domain and that the Respondent should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint. It also found that the domain name was used in bad faith. Finally, that previous panels denied relief on the ground that bad faith registration was not established

The Complainant refiles its complaint and presents three arguments for bad faith registration on the ground that new material evidence that was unavailable to the Complainant during the original case is presented.

- 1- Bad faith registration in 2020, by updated privacy shield;
- 2- Bad faith registration in 2005, by malware distribution; and
- 3- Bad faith registration in 2005, by trademark infringement.

It argues that new evidence has emerged after the previous filing to support this claim. These arguments are discussed in turn below.

Argument 1: Bad faith registration in 2020, by updated privacy shield

Complainant argues that new evidence that was not available on Nov. 24, 2020, the date of the previous filing. On Nov 30, 2020, FORUM served the Complaint to the Respondent. Then on Dec 2, 2020, after the proceeding was initiated the Respondent registered anew and/or updated its WHOIS information with a privacy shield. The Complainant argues that this is not a mere "renewal." If it were, the Expiry Date would have changed to one year after the Updated Date (such Dec 2, 2021), which it has not (Feb 3, 2021). In some cases, the Updated Date could be a change by the registrar. However, Complainant had not received notice from the registrar if and



when it caused the change, even after it requested information on Dec 28, 2020. Therefore, Complainant believes the change in Updated Date is a new registration and privacy shield. Complainant does not know why Respondent would try to change its privacy shield in the middle of an active case, except for illegitimate reasons. Such an attempt may, in certain cases, form part of a broader scenario whereby application of UDRP paragraph 4(b)(iv), read in light of paragraph 4(a)(ii), can support an inference of bad faith registration. Because malware continues to exist on spase.com through Jan 2021, while Respondent is aware of malware and aware of the Complainant's legitimate rights from previous panels, the Respondent has maliciously targeted Complainant during the registration on Dec 2, 2020. This change in Updated Date can be considered a new registration as supported by the finding in *BMEzine.com, LLC. v. Gregory Ricks* WIPO D2008-0882. The Complainant argues that the domain name should therefore be considered as having been registered and being used in bad faith.

Argument 2: Bad faith registration in 2005, by malware distribution

Complainant argues that Avast, McAfee, and Norton Antivirus, label spase.com as a security threat, a security warning, or as explicitly distributing malware, causing irreparable harm to Spase, Inc. and its common law trademark. Malware distribution is criminalized in the United States. This behaviour is so egregious that Respondent's registration harmed all possible website visitors, present and future. Complainant did not exist in 2005; however, as the panel said regarding Policy 4(b) in *United Church Schools Trust v. Global Domain Privacy LLC / Dan Morgan* (WIPO D2015-1585), "The absence of an exact fit does not matter because the circumstances listed in subparagraphs (i) to (iv) are without limitation." Causing malware to be installed on someone else's computer is a criminal offence for which the distributor could face state or federal charges. From WIPO D2015-1585, "There can be no doubt that the use of a domain name to perpetrate a crime would be "use" of that domain name in "bad faith". The Complainant argues that as the Panel has found that the Respondent has no rights or legitimate interests in the disputed domain name, it may be inferred that the disputed domain name was registered and used for that purpose.

The Complainant adds that the Respondent is a cyber-squatter with a pattern of registering and using domains in bad faith: including WIPO D2014-0377, WIPO D2005-0318, WIPO D2005-0639, FORUM FA0511000599041, FORUM FA0503000449421. The registration of spase.com in 2005 is likewise in bad faith. A complainant may use prior adverse UDRP decisions against a respondent in the current proceeding to evidence bad faith registration. See *Fandango, LLC v. 21562719 Ont Ltd, FA1464081* (Forum Nov. 2, 2012) "Respondent's past conduct and UDRP history establishes a pattern of registered domain names in bad faith under Policy 4(b)(ii).". Respondent has also exhibited poor past business dealings and abused the UDRP process with



Lichtman committing perjury in her signed statement, and Respondent attorney, Lieberman, leaking documents during an active case.

Furthermore, the Respondent registered spase.com speculatively with an open mind as to the exploitation of trademark rights. This is supported by precedent in *Camilla vs Jello* (WIPO D2015-1593) (same Respondent) where the panel found that Jello registered the domain in bad faith, even when "Camilla" came into existence after the domain registration: "the disputed domain name was registered speculatively with an open mind as to the exploitation of trademark rights, and has in fact been used to exploit the Complainant's trademark rights. In these circumstances, both bad faith registration and use are demonstrated" (WIPO D2015-1593).

The Complainant, therefore, believes that the domain name should be considered as having been registered and being used in bad faith.

Argument 3: Bad faith registration in 2005, by trademark infringement

The Complainant argues that the Respondent registered spase.com in 2005, which infringed on an active trademark at the time for "Spase" by Geotech Computer Systems, Inc. (USPTO Serial number 75686740, Registration number 2340935) Geotech owned this trademark from 2000-2007. Furthermore, Complainant makes a case for Respondent's wilful blindness against the third-party "Spase" trademark holder in 2005. Because spase.com was registered on Feb 3, 2005, Geotech could not register the domain after such date. Under Policy 4(b)(ii), "you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct;" Respondent has demonstrated a pattern of bad faith conduct (Argument 2), and Geotech could not possibly reflect "Spase" in spase.com after the registration, proving the registration in bad faith.

B. The Respondent

The Respondent failed to submit a Response in this proceeding.

7. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

(i) the disputed domain name is identical or confusingly similar to a trademark 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 names; and

(iii) the disputed domain name is registered and is being used in bad faith.

To succeed Complainant must prove each of these three elements.

These elements are discussed in turn below.

The Respondent failed to submit a response. This entitles the Panel to accept the Complainant's reasonable allegations stated in the complaint. The Panel shall apply paragraphs 5(f), 14(a) and 15(a) of the Rules to the present facts. It shall draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. However, the Panel may deny relief if it finds that the complainant's arguments are mere conclusory or unsubstantiated. See FORUM Case No. FA 2011001921922.

A- Identical or 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 shown that it owns common law rights in the mark "SPASE" and uses the mark since 2019. The Complainant has also shown that it has recently begun the application process for USPTO trademark in the category of augmented reality; therefore, the Panel has no doubt that the Complainant has common law rights in the mark SPASE.

It is established that the Respondent's disputed domain name integrates the Complainant's trademark "spase" in its entirety, as a dominant element of the domain name, with additional generic Top-Level Domain (gTLD) ".com " that does not sufficiently serve to distinguish or differentiate the disputed domain name from the trademark in which the Complainant has rights.

Previous UDRP panels have ruled that the mere addition of a non-significant element does not sufficiently differ the domain name from the registered trademark: "The incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark" (Britannia Building Society v. Britannia Fraud Prevention, WIPO Case No. D2001-0505).



Also, the addition of the generic Top-Level Domain (gTLD) ".com" to the disputed domain name typically does not avoid confusing similarity. See, *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No, D2006-0451. Thus, the gTLD ".com" is without legal significance since the use of a gTLD is technically required to operate the domain name, and it does not serve to identify the source of the goods or services provided by the registrant of the domain name.

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademarks in which the Complainant has rights. (ACDR Case No. A2019-0015)

It is noted that the domain name had been registered on February 3, 2005, i.e., 14 years before the Complainant acquired any rights on the mark SPASE. However, this issue is usually disregarded when assessing the first element and be considered on the assessment of the second and/or third element(s).

For the above reasons, the Panel finds that the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B- Rights or Legitimate Interests

According to the Policy and the Rules, the Complainant in domain name disputes, in principle, bears the burden of proof. Panels have, however, recognized that proving the respondent's lack of rights or legitimate interests in a domain name calls for the adaptation of these rules. Proving the lack of rights or legitimate interests amounts to proving a negative factual situation and requires information mostly within the knowledge and control of the respondent. Panels have accordingly established that providing prima facie evidence of the respondent's lack of rights or legitimate interests shifts the burden of proof to the respondent. (ACDR Case No. A2019-0015). The respondent is thus to provide a rebuttal. The respondent's failure to prove having rights or legitimate interests regarding the domain name results in complainant's fulfilment of the second element.

The Complainant alleges that the Respondent possesses no legitimate or lawful interest in holding the domain name spase.com. It claims that the Respondent holds the domain name to disseminate malware and shows that Avast, a leading security provider, reports spase.com as distributing malware, warning visitors from viewing the site. Two other security systems show warnings on spase.com. McAfee and Norton flag spase.com as "Malicious Sites," "High Risk," and "Caution". Such use cannot be said to constitute a bona fide offering of goods and services.



Considering the facts and circumstances of the dispute, the Panel finds that the Complainant provided a prima facie case that the Respondent lacks rights or legitimate interests in the domain name. Therefore, the burden of providing evidence of rights or legitimate interests in the domain name shifts to the Respondent.

The Respondent failed to submit a response in this proceeding. The facts are also devoid of any evidence that the Respondent is commonly known by the Domain Name. Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the domain name.

C- Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

It is clear that Complainant's use of the domain name space.com for malware is the use of the domain in bad faith. See *Twitter, Inc. v. Kiribati Media / Kiribati 200 Media Limited*, FA1502001603444 (Forum Mar. 19, 2015). However, to succeed, the Complainant must prove both registration and use of the domain name in bad faith.



In FORUM Case No. FA2011001921922, the Panel referred to instances in which the Respondent was found to have registered and used domain names not related to this case in bad faith. This suggests a pattern of activity but does not result in the application of Article 4(b)(ii) mentioned earlier to the facts. The fulfilment of the bad faith test under Article 4(b)(ii) requires the Complainant to prove that it was targeted by the respondent's registration of the domain name. This paragraph explicitly provides that the complainant must show "circumstances indicating that the respondent registered that domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name." The current facts do not fulfil this test given that the Domain Name spase.com had been registered fourteen years before the Complainant had any rights in the name SPASE.

In light of the two previous Panel decisions, this Panel finds that Complainant succeeded in proving bad faith use of the disputed domain name, but failed to prove bad faith registration due to the fact that the domain name registered fourteen (14) years before the Complainant had any rights in the name SPASE.

Therefore, the Panel finds that bad faith registration of the domain name is not established.

Refiling Complaints

The Complainant alleges that the reason for refiling the case, which concerns the same domain name and the same respondent, is that new facts have emerged and that will enable him to now succeed in proving bad faith registration under Paragraph 4(a) of the Policy. It presents arguments for bad faith registration on the ground that new material evidence that was unavailable to the complainant during the original case is presented; 1- Bad faith registration in 2020, by updated privacy shield; 2- Bad faith registration in 2005, by malware distribution and; 3- Bad faith registration in 2005, by trademark infringement.

In this third filing, with ACDR, the Complainant argues that a new fact has come to light. This evidence was unavailable to the Complainant during the previous filing. On Dec 2, 2020, after the FORUM proceeding was initiated, Respondent registered anew and/or updated its WHOIS information with a privacy shield. Previous panels have found that changing privacy services constitutes a new registration under the UDRP, with the burden of proof against it falling on the Respondent (WIPO Overview 3.0 (3.9)). This new registration, in combination with malware targeting the Complainant, constitutes bad faith registration in 2020.

In addition, Complainant argues that Avast, McAfee, and Norton Antivirus, label spase.com as a security threat, a security warning, or as explicitly distributing malware, causing irreparable



harm to Spase, Inc. and its common law trademark. Malware distribution is criminal in the United States. Furthermore, Respondent is a cyber-squatter with a pattern of registering and using domains in bad faith: including WIPO D2014-0377, WIPO D2005-0318, WIPO D2005-0639, FORUM FA0511000599041, FORUM FA0503000449421. The registration of spase.com in 2005 is likewise in bad faith.

It also argues that another fact has come to light: Respondent's registration in 2005 infringed on a USPTO trademark for "Spase" (USPTO Serial number 75686740, Registration number 2340935, alive from 2000-2007), constituting bad faith registration in 2005.

The Policy, Rules and Supplemental Rules do not explicitly address whether a prior decision denying transfer of a domain name precludes the complainant from filing a new complaint concerning the same domain name against the same respondent. However, panels have accepted refiled complaints only in highly limited circumstances such as (i) when the complainant establishes that legally relevant developments have occurred since the original UDRP decision, (ii) a breach of natural justice or of due process has objectively occurred, (iii) where serious misconduct in the original case (such as perjured evidence) that influenced the outcome is subsequently identified, (iv) where new material evidence that was reasonably unavailable to the complainant during the original case is presented, or (v) where the case has previously been decided (including termination orders) expressly on a "without prejudice" basis. In the refiled itself, a complainant must clearly indicate the grounds it believes would justify acceptance of the refiled complaint (WIPO overview, 4.18)

The leading cases on refiled complaints are *Grove Broadcasting Co. Ltd. v. Telesystems Communications Limited*, WIPO Case No. D2000-0703 (November 10, 2000), and *Creo Products, Inc. v. Website In Development*, WIPO Case No. D2000-1490 (January 19, 2001). These decisions have been widely followed by other panels.

The panel in *Grove Broadcasting* reasoned that the new evidence that merit the reconsideration of a prior decision are evidence that could not have been obtained with reasonable diligence at the time of the prior proceeding, provided that they seem to be credible and are likely to significantly affect the outcome. That panel in *Grove Broadcasting* denied the reconsideration of the prior decision on the ground that the complainant had failed to establish that it could not have obtained such evidence at the time of the prior proceeding.

The panel in *Creo Products* approved *Grove Broadcasting* and upheld its reasoning. The panel held that "providing a reasonable degree of protection to successful respondents against unsuccessful



complainants opportunistically seeking re-adjudication of the dispute without justification" should not be compromised and that refiled complaints should be strictly allowed to enable unsuccessful complainants to address injustice in limited circumstances where appropriate. (WIPO Case No. D2000-1490). The panel further held that: (1) the complainant bears the burden of establishing the grounds that justify a refiled complaint; (2) this burden is "high"; and (3) the complainant should unequivocally identify the grounds that justify the reconsideration of a prior decision.

Applying the mentioned principles to the present facts, the Panel finds the Complainant's argument one merits reconsideration. In examining the Complainant's argument, the Panel requested the ACDR Case Manager to contact the registrar "Enom.com" so that it provides the panel with the information necessary to decide whether the mentioned "update" is to be considered a "renewal/update to the registration" or "a new registration the domain" spase.com. The Case manager has accordingly contacted the registrar and forwarded its response to the Panel. The response confirms "that the domain was a renewal (emphasis added) of the current registration. The domain still has an administrative hold during this proceeding."

Establishing bad faith requires the complainant to establish that it was targeted by such registration at the time it was made. The date the panel will consider in assessing bad faith registration is February 3, 2005, i.e. the Creation date of the domain. The Panel does not uphold the Complainant's argument that the Respondent's registration was in bad faith.

It is noted that panels have found that the mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith. (WIPO overview 3.9) The Respondent registered its domain name fourteen years before the Complainant began to use and acquired any rights in the name SPASE. Therefore, there is no evidence that the Respondent targeted the Complainant at the time of registration of the domain name. In addition, eNom confirmed by email to the FORUM on November 25, 2020, that the <spase.com> domain name is registered with eNom, LLC and that Respondent is the current registrant of the name. Moreover, it asserted to the ACDR Case Manager that the mentioned update was a renewal of the current registration. The Panel shall not treat the mere update of the Respondent's WHOIS information as a new registration. The Panel has thus found satisfactory evidence of an unbroken chain of possession. The Complainant has therefore failed to establish that the 2020 registration with the updated privacy shield was in bad faith. The Panel found that the Complainant's argument one is not well established, but with no evidence of abuse of administrative proceedings.

In respect of the Complainant's arguments two and three, the Panel also applies the principles and reasoning of Grove Broadcasting and Creo Products to the current facts. The Policy aims at



providing expeditious resolution of domain name disputes without affecting the Complainant's right to seek national courts. Repeated filing of unsuccessful complaints without presenting new grounds that had not been available before unnecessarily clutters the system and undermines the expeditious resolution of disputes. Following the basic principles and reasoning of Grove Broadcasting and Creo Products and subsequent cases, this panel finds that the complainant had failed to show that it could not have obtained the evidence supporting arguments two and three evidence outlined earlier at the time of the prior proceedings. Therefore, the new evidence cited by the complainant does not justify consideration of the Refiled Complaint. It still has the option to seek relief from the national courts of the Respondent's country, i.e. the US courts.

8. Abuse of Administrative Proceedings

Paragraph 15(e) of the Rules 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 or was brought primarily 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 administrative proceedings."

The mere failure of the Complainant to establish its case does not suffice to establish an abuse of administrative decision findings. The Complainant had no access to the Respondent's registration renewal information due to the updated privacy shield. The current facts do not merit a conclusion that the complaint was brought in bad faith. Thus, there is no evidence of abuse of administrative proceedings.

9. Decision

For the foregoing reasons, the Complaint is denied.

Dated as of February 21, 2021.

Prof. Hossam El-Saghir

Sole Panelist