

ADMINISTRATIVE PANEL DECISION

University of South Florida Board of Trustees v. David Donofrio
Case No. D2026-3402

1. The Parties

The Complainant is University of South Florida Board of Trustees, United States of America ("United States"), represented by Thomas & LoCicero PL, United States.

The Respondent is David Donofrio, United States, represented by Shutts & Bowen LLP, United States.

2. The Domain Name and Registrar

The disputed domain name <malibuusf.com> is registered with DreamHost, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 31, 2026. On August 4, 2026, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 4, 2026, 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 (DMD Properties Inc. d/b/a Malibu Apartments) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 12, 2026, 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 August 12, 2026.

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 of the Complaint, and the proceedings commenced on August 13, 2026. In accordance with the Rules, paragraph 5, the due date for Response was September 2, 2026. The Response was filed with the Center on September 2, 2026.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on September 7, 2026. 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, established in 1956, is a university with campuses in Tampa and St. Petersburg in the state of Florida, United States. It is the proprietor of several trademarks, including the following:

- United States Trademark No. 3107528 for USF (device mark), registered on June 20, 2006 for goods in class 25; and
- United States Trademark No. 3571245 for USF (word mark), registered on February 10, 2009 for services in class 41.

The Complainant operates its primary website at the domain name <usf.edu>, which it registered in 1986.

The Respondent operates a real-estate rental business in Florida. Among these properties is “Malibu Apartments”, a building located near the University of South Florida and marketed to its students. According to the Response, this building has been in operation for over 20 years.

The disputed domain name was registered on October 27, 2003. At some time prior to the Complaint, it resolved to a website advertising the Respondent’s Malibu Apartment building with the following tagline:

“Modern, Spacious USF Student Apartments. Malibu Apartments is a premier University of South Florida off campus housing community offering contemporary apartments, luxurious amenities, and an unbeatable location.”

According to the Complaint, following the Complainant’s cease-and-desist letter of June 3, 2026, the tagline of the website was amended to the following, which was displayed on the Respondent’s website at the time of this Decision:

“Modern, Spacious Student Apartments. Malibu Apartments is a premier, privately owned, off-campus community near the University of South Florida offering contemporary apartments, luxurious amenities, and an unbeatable location.”

The record contains an e-mail from the Complainant to the Respondent dated June 8, 2026 referencing a telephone conversation between the Parties that reiterated the Complainant’s demands.

The Response indicates that the Complainant’s official student website for off-campus housing (at the domain name <offcampushousing.usf.edu>, which is accessible from the Complainant’s home page) contains a listing for the Respondent’s Malibu Apartments property, with a link to the website to which the disputed domain name resolves. The Panel verified that, at the time of this Decision, this listing was still active.¹

¹ Noting the general powers of a panel articulated in paragraphs 10 and 12 of the Rules, it is commonly accepted that a panel may undertake limited factual research into matters of public record, as the Panel has done in these proceedings. WIPO Overview of WIPO Panel Views on Select UDRP Questions (“[WIPO Overview 3.1](#)”), section 4.8.

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 it is an internationally known university with more than 50,000 students from around the world. It has used the USF mark since at least 1960. This mark is advertised and promoted extensively, including through social media. The disputed domain name contains the USF mark in full, and the use of the disputed domain name makes clear that the Respondent was targeting the Complainant. The addition of the term "Malibu" does not distinguish the mark, because it calls to mind the names of Complainant's apartment-style student housing buildings such as one called "Magnolia".

Recently, two of the Complainant's students were fatally stabbed; one of them at an off-campus property that was also marketed using the Complainant's mark. The Complainant has therefore sought to prevent any confusion arising from the use of its trademarks by private apartment complexes such as the Respondent's.

The Respondent has no rights in the Complainant's mark and is not commonly known by it. The Complainant is concerned that such advertising will foster confusion by suggesting a relationship that does not exist between the Respondent's apartments and the Complainant, and that any lapses at the Respondent's apartments will be attributed to Complainant. The lapse of time does not create implied consent on the part of the Complainant, and any perceived authorization or consent has been explicitly withdrawn by the Complainant in its cease-and-desist letter to the Respondent. The Respondent, by changing the wording on its website after receiving this letter, has acknowledged that its use of "USF" is only to refer to the Complainant. The Respondent also displays the Complainant's trademarks and logo on its social media platforms, including using the Complainant's color scheme and an image of its mascot.

The Respondent continues to use the disputed domain name over the express objections of the Complainant. It is attempting to pass itself off as affiliated with the Complainant when it is not.

The Complainant requests transfer of the disputed domain name.

B. Respondent

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name. The Respondent's arguments may be summarized as follows:

The Respondent's company has owned and operated apartments at the Malibu Apartments complex near the Complainant's Tampa campus for more than 20 years. The Respondent's website clearly identifies the property as an off-campus property. The Parties have peacefully coexisted for the 23 years since the registration of the disputed domain name, demonstrating a lack of confusion. The first element of the disputed domain name is "Malibu", which distinguishes the mark. The Complainant has no trademark rights in the USF mark in connection with apartment rentals.

The Complainant's justification for these proceedings is without merit. The Complainant has advertised the Respondent's property on its student website for at least five years and continues to do so. Additionally, the Complainant continues to advertise the other, unrelated property at which one of the fatal stabbings took place. These tragic events are unrelated to the Respondent.

The Respondent concedes that it is not known by the Complainant's mark. Its use of USF in the disputed domain name is to inform prospective residents of the relative location of the apartment complex to the Complainant's university campus. The Complainant's USF mark in the disputed domain name is a geographic designation, and not used as a source identifier for any goods or services. The Respondent's

website makes it clear that there is no affiliation with the Complainant. The Respondent considers this to be fair use, and that the Complainant's advertising of the Respondent's website is the only condition creating an impression of endorsement by the Complainant.

The Respondent has never sought to sell the disputed domain name to the Complainant nor to divert students away from the Complainant. The Complainant advertises the Respondent and offers links to the Respondent's website. The Respondent offers no credible explanation for its 23-year delay in bringing this Complaint.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

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

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a 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 it deems applicable".

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 Select UDRP Questions ("[WIPO Overview 3.1](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.1](#), section 1.2.1.

The entirety of the Complainant's USF 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 3.1](#), section 1.7.

Although the addition of other terms (here, "malibu") may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.1](#), section 1.8.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a number of circumstances which, without limitation, may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy. To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under UDRP paragraph 4(c) include the following:

- (i) before any notice 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; 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 trademark 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 trademark or service mark at issue.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that 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 3.1](#), section 2.1.

Additionally, the Panel notes that the Complainant's delay in bringing proceedings does not, in itself, bar the Complainant from filing the case nor from potentially prevailing on the merits. [WIPO Overview 3.1](#), section 4.17.

While Panels have generally declined to specifically adopt concepts such as laches or its equivalent in UDRP cases, indeed any equitable defenses, [WIPO Overview 3.1](#), section 4.17 states that "in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay". See, for example, WIPO Case No. [D2021-2409](#), *Walbro Engine Management, LLC v. Registration Private, Domains By Proxy, LLC / Shahrokh Gabbaypour, Express Fuel Pumps* (<walbrofuelpumps.com>, denied).

At the outset, the Panel notes that disputed domain name reflects the entirety of the Complainant's USF mark, preceded by the term "malibu". The Respondent concedes that it is not known by the Complainant's mark. Further, it is not in dispute that the Respondent is engaged in a commercial enterprise. Under these circumstances, the Panel finds that the Complaint has made out a prima facie case for the Respondent to rebut.

The Respondent argues that the Complainant was aware of the Respondent and its use of the disputed domain name for at least five, and possibly up to 20 years. Additionally, the Respondent states that its website, both before and after amendment, clearly stated that "Malibu Apartments" is off-campus housing, which under any reasonable construction indicates a lack of affiliation with the Complainant. On this basis, the Respondent claims rights and legitimate interests in the disputed domain name.

According to UDRP practice, panels tend to assess claimed respondent rights or legitimate interests in the present, i.e. with a view to the circumstances prevailing at the time of filing of the Complaint. [WIPO Overview 3.1](#), section 2.11.

The Panel notes that the record indicates that, prior to filing the Complaint, the Complainant had notified the Respondent in writing of its opposition to the Respondent's use of its mark in the disputed domain name, and that it disavowed any past express or implied consent to such use.

This Panel therefore concludes that, by the time that the Complaint was filed, the Complainant's notification, coupled with the Respondent's acknowledgment that it is not known by the disputed domain name, leads to a finding that the Respondent has no rights or legitimate interests in the disputed domain name at the relevant time, which is the present.

Accordingly, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy contains two requirements that apply conjunctively. A complainant must show both that the disputed domain name has been registered in bad faith and also that it is being used in bad faith. The former requires a demonstration that the Respondent knew, or should have known of the Complainant and/or the Complainant's trademark at the time when it registered or acquired the disputed domain name and that it registered the disputed domain name with a bad faith intention targeting the Complainant and/or its mark.

The disputed domain name was registered on October 27, 2003, prior to the first registration of the Complainant's USF marks. The Panel notes that this trademark registration, which claims a date of first use by the Complainant in 1960, was filed on July 15, 2003, predating the registration of the disputed domain name.

According to UDRP practice, where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. There is an exception to that general proposition, where the facts of the case establish that the respondent's intent in registering the disputed domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights. See [WIPO Overview 3.1](#), sections 3.8.1 and 3.8.2.

From the available evidence and the Respondent's own admission, the Panel finds that the Respondent was subjectively aware of the Complainant at the time it registered the disputed domain name and thereafter. What the record does not conclusively establish is whether the 2003 registration of the disputed domain name was in bad faith within the meaning of the Policy.

The UDRP does not burden the Complainant with a duty to monitor the use of its marks by domain name registrants. However, the record also does not provide a clear answer to the question of whether, in 2003 and prior to the first registration of the Complainant's trademark (which, the Panel notes, was a device mark limited to clothing in class 25), the Respondent had acted in bad faith by incorporating the USF mark in a domain name related to different services offered to the Complainant's students. Due to the length of time elapsed and resulting limitations in the record as to the Complainant's rights, and the Respondent's knowledge and intent, at the time of registration, the record leaves these and other questions unanswered.

Having reviewed the record, the Panel is unable to conclude that the available evidence sufficiently supports a finding of bad faith registration and use of the disputed domain name in this case.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: October 12, 2026