

ADMINISTRATIVE PANEL DECISION

Menlo School v. Domain Vault, Domain Vault LLC
Case No. D2023-4870

1. The Parties

Complainant is Menlo School, United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States.

Respondent is Domain Vault, Domain Vault LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <menloschool.com> (the “Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 22, 2023. On November 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on November 28, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 2, 2023.

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 Respondent of the Complaint, and the proceedings commenced on December 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2024. The Response was filed with the Center on January 3, 2024.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on January 16, 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

Complainant was established in 1994 and is a college preparatory school for students in grades six through twelve. Complainant is also the owner and registrant of the domain name <menloschool.org>, registered on October 29, 1996.

Complainant (including predecessor entities) has been using the MENLO and MENLO SCHOOL word mark in connection with its services for nearly 100 years. Complainant's history and usage of the MENLO SCHOOL mark in connection with its predecessor institutions dates back to 1924. By way of background, what is now Menlo School and a portion of its current grounds was initially launched in 1915 as a military school for boys known as the William Warren School. In 1924, the William Warren School was sold to a group of interested parents who sought a fresh identity for the school and formed the Menlo School for boys, dropping the previously existing military program. Three years later, in 1927, the school added a two-year college and became a non-profit institution governed by a newly formed board of trustees. It became known as Menlo School and Menlo College until 1994 when Complainant (Menlo School) was established as an independent entity. Since then, Complainant has been referred to as MENLO SCHOOL or MENLO and has become a leader in private education. The school prides itself on helping students develop positive values and nurtures character development in a supportive environment that upholds high moral and ethical standards.

Complainant owns a registration for its MENLO SCHOOL mark in California indicating the date of first use as December 31, 1994 and the date of registration as August 23, 2023. Complainant ranks among the best private high schools in California, according to Niche.com. As a result of Menlo's School's history and activities in connection with its MENLO SCHOOL mark, numerous people have been exposed to the mark, and the consuming public and the educational industry recognize and associate the MENLO SCHOOL mark with Complainant. Accordingly, the MENLO SCHOOL mark has acquired public recognition and distinctiveness as a source-identifier of educational services offered by Complainant and embodies reputation and goodwill belonging to Complainant.

Respondent registered the Domain Name on September 13, 2004. The Domain Name has been used to monetize traffic and Complainant has provided evidence that it was used recently for downloads that could be malware or adware and for monetization by redirects to various websites that purport to offer educational degree programs (both online degrees and references to educational institutions). Complainant was alerted to the malware on the Domain Name by a student parent at the school who had inadvertently logged onto the website linked to the Domain Name – an error that resulted in the infestation of the parent's computer with malware. In turn, the parent was forced to spend hours and resources attempting to rid his computer of unwanted malware. A copy of a declaration signed by the school parent was submitted in evidence.

5. Parties' Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states it has garnered top rankings in the educational space. For example, Complainant ranks among the best private high schools in California, according to Niche.com. As a result, Complainant submits it is widely recognized. Further, as a result of Complainant's history and activities in connection with its MENLO SCHOOL mark, numerous people have been exposed to the mark, and the consuming public and the educational industry recognize and associate the MENLO SCHOOL mark with Complainant. Accordingly, Complainant maintains the MENLO SCHOOL mark has acquired public recognition and

distinctiveness as a source-identifier of high-quality educational services offered by Complainant and embodies valuable reputation and goodwill belonging exclusively to Complainant. By contrast, Complainant emphasizes that Respondent registered the Domain Name in September 2004, approximately 80 years after Complainant (and its predecessors) began using the MENLO SCHOOL mark.

Complainant contends the Domain Name is identical to Complainant's MENLO SCHOOL mark. Moreover, because the addition of a general top-level domain ("gTLD") such as ".com" and ".org" is irrelevant in the analysis of similarity, the Domain Name is indisputably identical to Complainant's mark as a matter of law under the Policy.

(ii) Rights or legitimate interests

Complainant submits that after registering the Domain Name, Respondent has used it to monetize traffic, and now it is being used for downloads that could be malware or adware and for monetization by redirects to various websites. Complainant contends that since Complainant's adoption and extensive use of the MENLO SCHOOL mark predates Respondent's registration and use of the Domain Name, the burden is on Respondent to establish rights or legitimate interests in the Domain Name. However, where a complainant's mark is identical to the respondent's domain name as in the case here, there can be no rights or legitimate use by a respondent.

Complainant claims the Domain Name is not, nor could it be contended to be, a legitimate name or nickname of Respondent, nor is it in any other way identified with or related to any rights or legitimate interest of Respondent. There is no relationship between Complainant and Respondent giving rise to any license, permission, or other right by which Respondent could own or use the Domain Name. Further, Respondent is neither using the Domain Name in connection with a bona fide offering of goods or services, nor making a legitimate noncommercial or fair use of it. Rather, Respondent has registered the Domain Name to trade on the goodwill established in Complainant's MENLO SCHOOL mark by diverting consumers seeking services that are related to Complainant's services to Respondent's competing website for Respondent's malfeasance. Complainant argues as many UDRP panels have made clear, using a confusingly similar domain name to resolve to a website that attempts to pass itself off as the complainant is not a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. In view of the recognition of Complainant's MENLO SCHOOL mark, and the fact Respondent has no rights, there can be no doubt that Respondent registered and is not using the Domain Name for any legitimate noncommercial or fair use purpose, but rather to impersonate Complainant with the ultimate goal of profiting from the popularity of the MENLO SCHOOL mark in search engines. Such use of the Domain Name does not constitute a legitimate, bona fide offering of goods or services.

(iii) Registered and used in bad faith

Complainant contends that Respondent has registered and is using the Domain Name in bad faith for commercial gain and to benefit from the goodwill and notoriety associated with Complainant's MENLO SCHOOL mark. Here, Respondent's bad faith registration of the Domain Name is established by the fact that the Domain Name is identical to Complainant's exact MENLO SCHOOL mark, and was registered well after Complainant started offering its education services. Moreover, Complainant argues Respondent's bad faith is further confirmed by the fact that, as described in detail above and in the supporting declaration of a parent of a student at Complainant's school, Respondent's website is laced with malware. Respondent's malware-infested site has been offered without authorization from Complainant. Respondent's intent to impersonate Complainant and confuse consumers into mistakenly believing Respondent's website is owned by, or somehow affiliated with or approved by, Complainant is indisputable.

Based on the above, Complainant submits it has met the requirements of the Policy by demonstrating not only its own legitimate interest in the MENLO SCHOOL mark, as evidenced by its extensive use of its mark for nearly a century, but also that Respondent's sole use of the Domain Name is to unlawfully profit from its association with Complainant's services and distribute malware. Accordingly, Complainant believes it is entitled to the remedy requested below.

Complainant also contends it should not be barred by the doctrine of laches because it is commonly accepted that this doctrine does not apply under the Policy, and that a delay in acting does not prevent a complainant from recovering a domain name. Moreover, when Complainant first became aware of the issue with the Domain Name, it attempted to contact the owner to resolve the matter. The owner never responded despite numerous attempts by Complainant to contact them. Recently, Complainant became aware that the Domain Name was generating malware, which prompted Complainant to take further action.

B. Respondent

(i) Identical or confusingly similar

Respondent appears to challenge Complainant's trademark rights in the MENLO SCHOOL mark by arguing that although Complainant recently in August 2023 registered its service mark in California, Complainant "asserted in its registration that the name had not been used anywhere before December 1994, being some seventy years after the name was in the public domain." Further, Respondent claims that "to obtain its service mark registration, [Complainant] represented that the purported first use of the mark was only in 1992 [sic], (instead of the true date of at least 1924, which predates the Complainant's existence by decades, and would have defeated the Complainant's service mark registration)." Respondent also states that while Complainant holds a service mark registration, Respondent registered the Domain Name some two decades before Complainant's registration, and that at the time the Domain Name was registered in 2004, the corresponding name, Menlo School, was in the public domain.

Respondent provides no response as to Complainant's contention that the Domain Name is identical to Complainant's MENLO SCHOOL mark.

(ii) Rights or legitimate interests

Respondent does not attempt to address or refute directly Complainant's arguments concerning rights or legitimate interests in respect of the Domain Name. Instead, Respondent focuses on rejecting Complainant contentions concerning alleged bad faith registration and use of the Domain Name, as discussed below.

(iii) Registered and used in bad faith

Respondent submits that, as this Panel is likely aware, pursuant to Section 3.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), where a domain name's registration precedes the accrual of a complainant's purported trademark rights, panels will not normally find bad faith on the part of the respondent. Only in certain very limited cases where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the respondent's private knowledge of a complainant's upcoming registration of trademark rights, have panels found that the respondent had acted in bad faith based upon those very specific, limited circumstances. Respondent asserts those circumstances have no application in this case.

Respondent asserts that at the time that the Domain Name was registered, the name "Menlo School" was not subject to any trademark registration and was in the public domain. Further, the Domain Name was not registered with the intention to interfere with anyone or for any other improper purpose. Complainant's assertion of purported bad faith registration does not fit the circumstances involved here – the Domain Name was registered some two decades before Complainant registered a service mark for the name.

Respondent argues that Complainant admits the Menlo School name was used by the public for about 100 years. Complainant does not claim that someone else held trademark rights to the name and then purportedly transferred those rights to Respondent. Today, Complainant holds a service mark registration, but Respondent states it registered the Domain Name approximately two decades before Complainant's service mark registration. Citing to the Complaint, Respondent asserts that the name "Menlo School" was used by the public since at least 1924 to describe what was formerly the William Warren School. In September 2004, Respondent registered the Domain Name. Very recently, in August 2023, Complainant

registered a service mark in California for the name “Menlo School”, and asserted in its registration that the name had not been used anywhere before December 1994, being some 70 years after the name was in the public domain.

Respondent argues that Complainant offers no evidence of bad faith. Respondent claims that many institutions are known by names that are in the public domain, and many school supply stores and memorabilia stores use college names that are in the public domain. There is no bad faith in using a domain name for a name that is in the public domain and was not subject to trademark registration. When the Domain Name was registered, a trademark search would have provided no notice of any trademark claim to the name.

Respondent claims Complainant offers no evidence that in the two decades since the Domain Name was registered, there was ever an attempt – or even willingness – to sell the Domain Name, or to interfere with the business of Complainant. While one individual clearly believes that his computer was infected by “malware” and was told by someone that the source was purportedly the Domain Name of Respondent, there is no evidence of that. The party concerned believes that he received a virus from the website linked to the Domain Name, but does not explain how it was determined that a virus purportedly came from that site.

Moreover, Respondent states the Domain Name is parked at a default page which provides computer generated search links that is entirely controlled by the Registrar. To be clear, Respondent has received no money from the Domain Name’s website, and the site is under the exclusive control of the Registrar. The Registrar has to date, refused to remove the links that are generated on the webpage, and has refused to follow the directions of Respondent concerning the site. Respondent states it does not have any control over the content of the Domain Name’s site. This statement can be confirmed at <<https://www.whois.com/whois/menloschool.com>>, which shows the status of the Domain Name as “clientUpdateProhibited”.

Reverse Domain Name Hijacking (RDNH): Respondent asserts that Complainant, without evidence of a bad faith registration, is attempting a sophisticated RDNH. Respondent contends that the name Menlo School has been in the public domain for about 100 years, and that Complainant does not assert that it was assigned a purported trademark held by someone else. Instead, Complainant recently obtained a service mark registration and to obtain its registration, represented that the purported first use of the mark was only in 1992 [sic], instead of the true date of at least 1924, which predates Complainant’s existence by decades, and would have defeated Complainant’s service mark registration.

Respondent contends that having recently obtained a service mark for MENLO SCHOOL, which has been used in the public domain for 100 years, Complainant now turns to this Panel, attempting to take over a Domain Name registered two decades ago. Pursuant to long established UDRP panel decisions as set out in section 3.8 of the [WIPO Overview 3.0](#), the registration of the Domain Name two decades before Complainant’s purported trademark registration precludes a finding of bad faith registration.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

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

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 identical or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.

The Panel finds that Complainant has demonstrated rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. In particular, Complainant owns a trademark registration for its MENLO SCHOOL mark in California, registered in August 2023 and indicating that December 31, 1994 was the date of first use. This first-use date does not imply, as Respondent asserts, that Complainant had somehow declared the name "had not been used anywhere before" that date. Instead, this first-use date coincides with the re-establishment of Complainant in 1994 as an independent entity, separate from Menlo College. As Complainant has explained, before 1994, Complainant's predecessor was a single non-profit institution that operated both Menlo School and Menlo College; in 1994 the two entities were formally separated. Respondent argues the true date of first use of the name Menlo College was at least as early as 1924, which predates Complainant's existence by decades and would have defeated Complainant's service mark registration. As to this point, Complainant has recognized that its predecessor began using the Menlo School name as early as 1924, when the school was renamed from its former name, the William Warren School. In the Panel's view, however, this prior use of the name by Complainant's predecessor does not "defeat[] Complainant's service mark registration," nor has Respondent explained why this would be the case. Nor does the use of the Menlo School name by Complainant since 1994 (or by its predecessor before) without a formal trademark registration mean that the name was therefore in the public domain and merely "used by the public", as assumed by Respondent (again without explanation). Finally, as to Respondent's claim that it registered the Domain Name in 2004 before Complainant had any trademark rights, even assuming that this view is correct (see discussion in section C below, refuting this claim), these circumstances do not affect the Panel's analysis under the first element of the Policy. In this regard, [WIPO Overview 3.0](#), section 1.1.3, states in relevant part that "[t]he fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element." The timing issue is to be addressed in the analysis of the second and third elements.

The Panel also determines that entirety of Complainant's MENLO SCHOOL mark is reproduced in the Domain Name, without any modification. Therefore, the Panel determines the Domain Name is identical to Complainant's mark for the purposes of the Policy.

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

B. Rights or Legitimate Interests

Regarding the second element of the Policy, section 2.1 of [WIPO Overview 3.0](#) states, "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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

Here, having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name, while Respondent has not come forward with evidence to demonstrate any rights or legitimate interests. The record indicates that Complainant did not provide Respondent with license or permission to use its MENLO SCHOOL trademark, nor is there any evidence that Respondent commonly known by the name Menlo School or a similar name. Moreover, Respondent does not presently use the Domain Name to offer goods or services, nor is there any indication that it is used for a legitimate noncommercial or fair use. Instead, the evidence submitted indicates the Domain Name resolves to a website with per-per-click links to sites purporting to offer online and other educational degree programs, in competition with Complainant's educational programs. The evidence presented also indicates that the website linked to the Domain Name may be responsible for malware,

although Respondent challenges this contention. In any event, Respondent's key arguments are that the Menlo School name was in the public domain when the Domain Name was registered, and the Domain Name was registered long before Complainant registered its MENLO SCHOOL trademark. Even if the Panel were to accept these contentions, they are not sufficient to establish that Respondent has any rights or legitimate interest with respect to the Domain Name, but instead pertain to the analysis under the third element of the Policy.

Accordingly, based on the available record, 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 requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

Based on the record in this case, the Panel finds that Respondent registered the Domain Name in bad faith and has used it in bad faith to attract Internet users, for commercial gain, by creating a likelihood of confusion with Complainant's mark and services. The Panel addresses below Respondent's several arguments attempting to defend its registration and use of the Domain Name.

First, Respondent's key argument is that at the time the Domain Name was registered, the Menlo School named was in the public domain and not subject to any trademark registration. The Panel observes that while Complainant's trademark was registered in August 2023, Complainant claims a date of first use going back to December 1994, which is 10 years before the Domain Name was registered in 2004. Complainant has provided evidence that it was operating in 1994 under the name Menlo School when it re-established itself as an independent legal entity (i.e., separating itself from Menlo College), while carrying on in the same name as its predecessor and with the same functions. Further, Complainant has provided evidence that it has been maintained but built upon the public recognition and distinctiveness in its MENLO SCHOOL mark since that time as a source-identifier for the educational services offered by Complainant. Furthermore, the Panel observes that Complainant registered its own domain name, <menloschool.org>, in 1996, approximately eight years before Respondent registered the Domain Name. Based on all of the evidence, the Panel concludes that the Menlo School name was not in the public domain in 2004 when the Domain Name was registered, nor has Respondent provided any evidence that its view on this point (and that many other school and college names are also in the public domain) is correct.

Furthermore, the Domain Name is identical to Complainant's MENLO SCHOOL trademark, name, and domain name. The MENLO SCHOOL mark is distinctive not only because Complainant, through its activities over the years, has developed goodwill and reputation, but also because the name does not correspond to a common phrase or word combination. While Respondent has asserted that the Domain Name was not registered with the intention to interfere with anyone or for any improper purpose, Respondent made no attempt at all to explain or justify why it registered the Domain Name in the first place, which is identical to Complainant's trademark, name, and domain name. Given Complainant's long-standing and continuous use of its distinctive MENLO SCHOOL mark and name commencing at least 10 years before the Domain Name was registered, the only logical conclusion is that Respondent targeted Complainant and its MENLO SCHOOL name and mark, when registering the Domain Name. Respondent has provided no other plausible reason for registering this word choice and the Panel can think of no such reason.

Further, while Respondent argues that Complainant offers no evidence of bad faith, this is incorrect. Complainant has offered evidence that the Domain Name resolves to a website displaying pay-per-click links, including links to competitive providers of educational services. Respondent states it has received no money from the Domain Name's website, and that the site is under the exclusive control of the Registrar; however, these points are of no moment – as indicated by section 3.5 of [WIPO Overview 3.0](#), "[p]articularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot

disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.”

Finally, Complainant has also provided sworn evidence that the Domain Name was linked to a website with malware. While Respondent has challenged this contention by questioning the details of the third-party evidence, Respondent offers no reasons to confirm this was not the case – instead, Respondent seems to argue it is not in control of its own Domain Name and the website to which it resolves. These assertions are not sufficient to overcome the evidence provided by Complainant.

Accordingly, for all of the above reasons, the Panel finds that Complainant has established the third element of the Policy.

D. Reverse Domain Name Hijacking

As to Respondent’s assertion that Complainant is attempting a sophisticated RDNH, given the findings under the three elements of the Policy above, this claim has no merit.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <menloschool.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: March 8, 2024