



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Gerber Childrenswear Inc. v. David Webb**

**Case No. D2007-0317**

#### **1. The Parties**

The Complainant is Gerber Childrenswear Inc., Greenville, South Carolina, United States of America, represented by Kellywood Company, United States of America.

The Respondent is David Webb, Dallas, Texas, United States of America, represented by David M. Dingeman, United States of America.

#### **2. The Domain Name and Registrar**

The disputed domain name <onesie.com> is registered with eNom, the Registrar.

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on March 2, 2007, and in hard copy form, along with accompanying Annexes 1-6, on March 5, 2007.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this

proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 6, 2007, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name: specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on March 7, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name to the extent present in its Whois database, and which confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative and technical contacts. The response also confirmed that eNom is the registrar of that name and stated that: the Policy applied to the disputed domain name, and the name was then held in a “locked” status. The Registrar also indicated, through the response, that: the Respondent has submitted, for court adjudication, to the jurisdiction at the location of the principal office of the Registrar; and the registration agreement is in English.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules, and the Supplemental Rules.

On March 9, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by courier and without the Exhibits by email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, inasmuch as the notification to the Respondent occurred on March 9, 2007, then, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on March 29, 2007, to file its Response with the Center and serve a copy of the Response

on the Complainant.

The Respondent timely filed its Response, in email form on March 29, 2007, and subsequently in hard copy form together with accompanying Annexes A-F.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated April 10, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated April 12, 2007, notified the parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before April 26, 2007.

This dispute concerns one domain name, specifically: <onesie.com>.

The language of this proceeding is English.

#### **4. Factual Background**

As indicated in the Whois registration records provided by the Registrar and also provided by the Complainant in Annex 2 to the Complaint, the Respondent registered the disputed domain name on September 29, 2004.

##### **A. Complainant's ONESIE Marks**

The Complainant owns various US and Canadian trademark registrations for the term "onesies" either in block letters or stylized. For each of its US registrations, the Complainant has provided, in both Annexes 4 and 5 to the Complaint, a copy of the corresponding registration certificate and a hard-copy printout of the associated entry in the Trademark Electronic Search System (TESS) publicly accessible database provided by the United States Patent and Trademark Office (US PTO). In addition, the Complainant has provided, in Annex 6 to the Complaint, a hard-copy printout of the entry for its Canadian registration from the publicly accessible trademark database provided by the Canadian Intellectual Property Office. Pertinent details of the Complainant's US registrations are as follows:

- (1) ONESIES (block letters)  
United States registration 2,549,557; registered: March 19, 2002  
filed: April 27, 2000

This mark was registered for use in connection with "infant's and children's clothing, namely infant wear, underwear, bodysuits, underclothes and undergarments" in international class 25. The entry states that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced as of August 15, 1982.

- (2) ONESIES (stylized)  
United States registration 1,292,981; registered: September 4, 1984  
renewed: September, 30, 2004  
filed: December 6, 1982

This mark was registered for use in connection with “infant’s and children’s underwear” in international class 25. The entry states that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced as of August 18, 1982.

#### **B. The Parties’ Activities**

The Complainant’s line of its ONESIES branded infant and children’s clothing, is shown on its “www.gerberchildrenswear.com” website; hard-copies of the salient pages from that site are provided in Annexes E and F to the Response.

The disputed domain name appears to resolve to a landing page (a hard-copy of which appears in Annex B to the Response) which contains links to various entities that provide clothing for infants and children which directly compete with the Complainant’s product offerings, as well as non-competitive product offerings. The Respondent receives pay-per-click (click through) revenue, from those entities, as a result of user selection of associated links on that page.

### **5. Parties’ Contentions**

#### **A. Complainant**

- (i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name, by virtue of its inclusion of the term “onesie”, is confusingly similar to the Complainant’s ONESIES Marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

- (ii) Rights or Legitimate Interests

The Complainant contends that, for several different reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent registered the disputed domain name long after the Complainant’s mark ONESIES was first registered in September 1984.

Second, the Complainant contends that the Respondent does not use the term “onesies” as its mark or trade name, hence ostensibly asserting that the Respondent is not commonly known by this term. In that regard, the Respondent’s website, to which the disputed name resolves, contains links to distributors, and to clothing products offered by the Complainant’s competitors.

Third, the Complainant never granted, authorized or consented to the Respondent's use of Complainant's ONESIES Marks, or to registration of a domain name that included any of those marks.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant alleges that the Respondent adopted and used the name with full prior knowledge of the Complainant's prior rights in its ONESIES Marks.

Second, the Complainant alleges that the Respondent is using the name to divert Internet users, who seek the Complainant's ONESIES branded products, away from the Complainant's website and to the Respondent's site instead. Once at the Respondent's site, those users are presented with third-party links to various websites which offer clothing products directly competitive with those then offered by the Complainant. The Complainant contends that the Respondent gains pecuniary compensation through such diversion.

**B. Respondent**

(i) Identical or Confusingly Similar

The Respondent does not dispute that the disputed domain name is identical to the Complainant's ONESIES Marks.

(ii) Rights or Legitimate Interests

In contrast to the Complainant's position, the Respondent contends that, for various reasons, he has rights and legitimate interests in the disputed domain name.

First, the Respondent asserts that the term "onesie" is a generic term and, as such, he merely registered what he believed to be a generic domain name to which no party could claim exclusivity. As such, he established a legitimate interest in the name at the instant he registered it. In that regard, the Respondent claims that he only owns generic domain names. The Respondent, to support his view of the generic nature of the term, provides, in Annex A to the Response, a hard-copy printout of the definition of the term "onesie" as provided by Wikipedia and as being "American English for a bodysuit designed to conceal a diaper when worn". Further, the Respondent points to a search he ran through the Yahoo search engine which yielded approximately 894,00 hits and through the Google search engine which yielded some 1.5 Million hits (listings of the search results giving the top hits appear in hard-copy form in Annexes C and D, respectively, to the Response).

Second, the Respondent claims that he had no prior knowledge of the Complainant's ONESIE Marks when he registered the disputed domain name. Furthermore, the Complainant has not shown any evidence to the contrary or even that the Respondent, in the absence of having any such direct knowledge, should have known of those

marks. Moreover, the Respondent asserts that none of those marks is famous.

Third, the Complainant never provided any notice of a dispute.

Lastly, the Respondent asserts that none of the links presented on its website links to any of the Complainant's competitors, nor has Complainant provided any proof to the contrary. In that regard, the Complainant's own website (see the hard-copy printouts, as noted above, provided in Annexes E and F to the Response) indicates that the Complainant is a wholesaler, not a retailer, of infant clothing.

(iii) Registered and Used in Bad Faith

In contrast to the Complainant's position, the Respondent contends that, for various reasons, he did not register or use the disputed domain name in bad faith.

First, the Respondent claims that he had no prior knowledge, nor was given any notice -- including through a cease and desist letter, that the term "onesie" was a registered trademark prior to having received the Complaint. Nor did the Respondent receive a cease and desist letter from the Complainant prior to its having filed the Complaint.

The Respondent operated his website for three years "as a pay-per-click search engine without dispute". Inasmuch as the Respondent claims that he never heard of the Complainant's prior use of the term "onesies", the Respondent never attempted to profit from "Complainant's alleged use of 'onesies'".

The Respondent contends that he never diverted any customers from the Complainant nor is there any evidence to support this.

Further, the Respondent has never offered to sell the disputed domain name to the Complainant. Moreover, the Respondent is not engaged in the business of selling domain names and has not registered the domain name primarily with any intent to sell or otherwise transfer it to the Complainant.

The Respondent states that he did not register the domain name to prevent the Complainant from reflecting its mark in a corresponding domain name inasmuch as the Complainant already has a website and did not register the domain name <onesie.com> when it was available. Also, the Respondent did not register the domain name primarily to disrupt the business of a competitor, particularly since the Respondent does not sell infant clothing on a wholesale level.

Lastly, the Respondent contends, that, as shown by his own website, he is not attempting to create a likelihood of confusion with Complainant's mark ONESIES as to the source, sponsorship, affiliation, or endorsement of its website. In that regard, the Respondent states that his website is a search engine, while the Complainant's website is for a wholesaler of children's clothing.

## **6. Discussion and Findings**

## **A. Trademark Validity issues**

Issues concerning trademark validity, which the Respondent here raises in the context of a lack of registrability owing to genericness of the mark, are clearly not within the purview of any UDRP proceeding and are best left for administrative and/or judicial adjudication. Not only is doing so outside the very limited and focused jurisdiction afforded to ICANN panels under the Policy but moreover the summary and rather abbreviated nature of UDRP proceedings totally precludes the establishment of a fully developed factual record that underlies such a question.

UDRP panels cannot and hence do not assess the validity of any federally registered trademark. Instead, such panels must, of necessity, accord significant deference to decisions of that government body, namely the US PTO, which, in the first instance not only possesses the requisite expertise to assess such issues but also the federal statutory mandate to do so. It is simply not within the purview of any UDRP panel to evaluate and review the judgment of the US PTO on such questions. Moreover, even apart from those jurisdictional concerns but clearly in view of the rather summary and abbreviated nature of UDRP proceedings, UDRP panels are here too grossly ill-equipped to deal with an extensive factual inquiry that typically underlies an invalidity determination. See, e.g., *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet and Marketing Rightway Gate Inc., et al*, NAF Case No. FA 208576 (January 27, 2004); *United States Office of Personnel Mgmt. v. MS Tech. Inc.*, FA 198898 (Nat. Arb. Forum December 9, 2003), and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, WIPO Case No. D2002-0758 (October 4, 2002).

Hence, once the US PTO has made a determination that a mark is registrable, as it has here by issuing a registration to the Complainant for its mark ONESIES, an UDRP panel is not empowered to nor should it disturb that determination.

To the extent the Respondent wishes to challenge the US PTO's determination that any of Complainant's ONESIES Marks have acquired sufficient distinctiveness upon which registration can be based, the Respondent may well have appropriate administrative and/or judicial avenues available to it to do so, such as by filing an action in the US PTO to cancel any of the Complainant's federal registrations or alternatively instituting federal litigation. Absent the Respondent having done so and attained a final ruling that either of the Complainant's federally registered marks is indeed generic and thus not susceptible of registration, this Panel will simply defer, as it must, to the US PTO's determination implicit in its having granted a registration, i.e., that each of the Complainant's ONESIES Marks has acquired sufficient distinctiveness and hence is not generic, and thus qualifies for federal trademark protection and enjoys all the rights afforded thereby.

## **B. Identical or Confusingly Similar**

The Panel finds that the disputed domain name is identical to the Complainant's ONESIES Marks.

From a simple comparison of the name and the mark, no doubt exists nor does the Respondent dispute this -- that the disputed domain name is, for all practical purposes, identical to that mark. The only differences between the name and that

mark are merely the appending of a generic top level domain (gTLD) “.com” to the mark and the deletion of the letter “s” from the end of the mark. Well-established UDRP precedent, including multiple decisions from this Panel, holds that the addition of a gTLD, the deletion of spaces or other such trifling changes are utterly *de minimus*, if not completely irrelevant, in assessing identity/confusing similarity and thus totally ignored. Other changes of slightly more substance, such as adding a short letter of number group or even a generic word, to a mark are, in the vast majority of instances, each grossly insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. See, e.g., *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment., Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Cororation. v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Therefore, the Panel finds that the disputed domain name <onesie.com> sufficiently resembles the Complainant’s ONESIES Marks as to cause confusion; hence, the Complainant has shown identity between the Complainant’s mark and that name under the disputed domain name paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

The Panel believes that the Respondent has not provided any basis that would in the circumstances here legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

There is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. Nor could the Respondent ever become so known, at least in conjunction with offering clothing products identical or similar to those offered by the Complainant under its ONESIE Marks, in light the Complainant’s continuous use of its mark ONESIE for 20 years prior to the September 29, 2004 date on which the Respondent registered the domain name, without infringing on the exclusive trademark rights of the Complainant.

There is no evidence of record that the Respondent has used the domain name, since its registration, in any manner other than as an address of his website which contains a pay-per-click search engine. This site, as indicated in the hard-copy printout in Annex B to the Response, lists goods, i.e., “Baby Clothing”, which directly compete with Complainant’s offerings. The unmistakable inference that can be drawn from the listing of such goods on Respondent’s website is that Respondent, apart from his assertions to the contrary, was likely to have known of the Complainant’s clothing carrying the ONESIES Marks at the time the name was registered. While the Respondent may not have known that the Complainant itself was the source of those

goods, there is ample evidence in the record that the Respondent knew, when he registered the disputed domain name, that the term “onesie” was used in conjunction with a specific type of baby clothing. Yet, in spite of that knowledge, the Respondent intentionally registered the domain name and then subsequently used that name, to his own pecuniary advantage, in conjunction with product offerings directly competitive with those of the Complainant.

Such use of a domain name is not valid, hence precluding the Respondent from ever having acquired rights and legitimate interests in the domain name.

Further, no evidence exists that the Complainant has ever authorized the Respondent to utilize its mark ONESIES or any mark confusingly similar thereto in conjunction with the specific goods, i.e., baby and children’s clothing, which the Complainant provides under its ONESIES Marks, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the mark ONESIES or one confusingly similar thereto, in connection with those goods or even those similar thereto, would directly violate the exclusive rights now residing in the Complainant. See, e.g., *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless, cited supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000). Consequently, the Respondent could not legally acquire any public association between it and the mark ONESIE or one similar thereto, at least for the branded goods rendered by the Complainant, and hence could not be commonly known or recognized by that mark and thus could not fall within paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel is not persuaded that the Respondent has any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

#### **D. Registered and Used in Bad Faith**

The Panel believes that the Respondent’s actions constitute bad faith registration and use of the disputed domain name.

Viewing the facts in totality leads this Panel to conclude that the Respondent intentionally registered and used the domain name to cause confusion of Internet

users and thereby opportunistically exploit the Complainant's goodwill in its ONESIES Marks for the Respondent's eventual pecuniary benefit and the Complainant's detriment.

While the Respondent argues that he merely provides a search site and is not a wholesaler of children's clothing and thus, in light of that functional difference, his registration and use of the name were in good faith, the Panel rejects that argument. To this Panel, the proper perspective is not how the parties perceive themselves but rather what Internet users are likely to perceive. Given well-known naming conventions in use on the Internet, where users who seek information on a branded product or service reflexively form a domain name by appending an appropriate gTLD, usually ".com", to a trademark associated with the good or service of interest and then enter the resulting domain name into the browser, it stands to reason that such users who seek information on the Complainant's ONESIES branded baby and children's clothing will, in the first instance, form a domain name <onesie.com> or <onesies.com>. Those users will then enter that name into the browser in order to access a website that provides the desired information. Doing so here will lead those users not to the Complainant's website, but rather to the Respondent's site where links are provided to third-party sites through which competitive clothing is apparently offered. Nothing exists on the Respondent's website which would lead any Internet user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website and the Complainant -- when, in actuality, none exists. Thus, the Respondent's use of the name is highly likely to confuse, if not deceive, Internet users as to the source of the Respondent's baby clothing offerings as emanating from the Complainant -- when apparently they might not.

Hence, the Panel views the Respondent's actions as constituting bad faith registration and use of the disputed domain name <onesie.com> in violation of paragraph 4(a)(iii), and specifically of paragraph 4(b)(iv) of the Policy

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <onesie.com>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: April 24, 2007