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**THIS DISPOSITION
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Paper No. 16
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Electronic Data Systems Corporation**

Serial No. 75/415,185

Serial No. 75/415,204

L. Joy Griebenow of Electronic Data Systems Corporation for **Electronic Data Systems Corporation**.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 107
(**Thomas Lamone**, Managing Attorney)

Before **Seeherman, Hairston and Bottorff**, Administrative
Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant has filed two applications for registration of the mark NETCONNECT, in typed form, for, respectively, "computer hardware and software integration and migration services for mainframe systems" [\[1\]](#) and "business consulting services relating to computer hardware and software integration and migration for mainframe systems." [\[2\]](#)

The Trademark Examining Attorney has refused registration as to each of the applications, on the ground that applicant's mark NETCONNECT, as applied to the services recited in each of the applications, so resembles the mark NETCONNECT, registered (in typed form) for "distributorship, retail store and mail order catalog and technical consulting services in the field of computers, computer software, computer peripherals, telecommunications and computer networking," [\[3\]](#) as to be likely to cause

confusion, to cause mistake, or to deceive. Trademark Act Section 2(d).

When the refusals were made final, applicant filed a notice of appeal and a request for reconsideration in each case. After the Trademark Examining Attorney rejected the requests for reconsideration, the Board consolidated the two applications for purposes of appeal. Applicant and the Trademark Examining Attorney filed main appeal briefs, and applicant filed a reply brief. Applicant did not request an oral hearing. ^[4]

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that applicant's NETCONNECT mark and the registered mark NETCONNECT are identical in terms of appearance and sound. We also find that they have the same connotation and that they create the same or a similar overall commercial impression. Applicant's argument to the contrary, i.e., that NETCONNECT has one meaning as applied to applicant's services but another meaning as applied to registrant's services, is not persuasive. First, as discussed below, we find that applicant's services and registrant's services in fact are highly similar and related. Second, any possible dissimilarity in the connotation of NETCONNECT as used in connection with the respective services is too slight and subtle to have any dispositive effect on our analysis of the overall commercial impressions created by applicant's mark and registrant's mark. Rather, we find that the overall commercial impression of the mark NETCONNECT, as used in connection with applicant's and registrant's respective services, is essentially identical.

We turn next to a comparison of applicant's and registrant's services. ^[5] It is not necessary that these respective services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be

encountered by the same persons in situations that would give rise, because of the marks used in connection therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's services and the registrant's services that is required to support a finding of likelihood of confusion; where the applicant's mark is identical to the registrant's mark, as it is in this case, there need be only a viable relationship between the respective services in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). On the face of the respective recitations of services, registrant's and applicant's services are highly similar, if not also legally identical. Registrant's broadly defined "technical consulting services in the field of computers and computer software" essentially encompass applicant's "business consulting services relating to computer hardware and software integration and migration for mainframe systems." This overlap is sufficient in itself to support a finding of likelihood of confusion, given the identical nature of the marks. Further evidence of the relationship between applicant's and registrant's recited services is found in applicant's explanation and description of the specific nature of its services (as set forth in the declaration of applicant's employee Glenn Wintrich). Applicant asserts that its computer hardware and software integration and migration services, and its consulting services offered in connection therewith, "enable its customers to inter alia, use graphical interfaces, build Intranets (private computer networks), have access to the Internet, remotely access mainframe data and applications, and exploit the technologies required to engage in electronic commerce..." (Wintrich Decl., ¶ 4.) These functions and features of applicant's services are encompassed within registrant's broadly defined "technical consulting services in the field of ... telecommunications and computer networking." Likewise, registrant's consulting services in the field of "computer software" would encompass those features of

applicant's services which are based on applicant's "expertise in the areas of software programming, including data formats and the translation of those data formats, operating systems of computers, programming language of applications, different microprocessor technology, and capabilities of software applications." (Wintrich Decl., ¶ 7.)

Applicant argues repeatedly and at great length that confusion is unlikely in this case because registrant's actual goods and services relate to the "physical infrastructure" of a computer network system, a subject with which applicant's services have nothing at all to do. Applicant likewise argues that its services and registrant's actual goods and services travel in different trade channels and are marketed to different classes of prospective customers. Applicant bases these contentions on the 1998 product catalog of AMP (a predecessor of registrant's) and on the declaration of its investigator, Mr. Woods, regarding the activities of certain other of the apparent previous owners of the cited registration.

However, our likelihood of confusion determination must be made on the basis of the services as they are set forth in registrant's recitation of services, not on the basis of any extrinsic evidence or argument purporting to establish the exact nature of registrant's actual goods or services. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 639 (Fed. Cir. 1987); *In re Continental Graphics Corporation*, 52 USPQ2d 1374 (TTAB 1999); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). For this reason, applicant's reliance on such extrinsic evidence, i.e., on the AMP catalog and on the declaration of Mr. Woods, is without legal basis. Moreover, this evidence is factually irrelevant. The catalog is not even registrant's catalog; applicant's reliance on it as evidence of the nature of registrant's goods, customers and trade channels, etc., is wholly misplaced. Likewise, Mr. Woods' declaration statements regarding his investigation into the products and services offered by the other previous owners of the registration are irrelevant.

Accordingly, we find that applicant's services, as recited in the application, and registrant's services, as recited in the registration, are sufficiently commercially related that use of the identical mark NETCONNECT in connection therewith is likely to cause confusion.

Likewise, we reject applicant's contention that the parties' respective services are offered in different trade channels and to different classes of purchasers. Neither

applicant's nor registrant's recitation of services includes any limitations as to trade channels or classes of purchasers, and we accordingly must presume that those services are offered in all normal trade channels for such services and to all normal classes of purchasers for such services. *In re Elbaum, supra*. In view of the overlap and otherwise close commercial relationship between applicant's and registrant's respective recited services, we find that applicant's and registrant's respective trade channels and classes of purchasers are similar rather than dissimilar. Applicant also argues that its services and registrant's services are expensive, and that the purchasers of the respective services are careful, sophisticated purchasers. However, aside from applicant's declarant's conclusory statement that the respective services are expensive, there is no evidence in the record, i.e., as to the actual cost of the respective services, from which we might conclude that the services are so expensive that confusion would be unlikely despite the identical nature of the marks and the closely related nature of the services. Likewise, there is no evidence from which we might conclude that applicant's and registrant's respective services typically are not offered by a single source, or that purchasers normally would not expect the respective services to originate from a single source. Thus, even if we assume that purchasers of the respective services are sophisticated in their respective fields, we cannot conclude that they are so sophisticated that they would be immune to source confusion arising from applicant's use of a mark identical to registrant's in connection with services which are closely related to registrant's.

Having carefully considered all of the *du Pont* evidentiary factors as to which evidence has been made of record, we conclude that confusion is likely to result from applicant's use of its mark in connection with its recited services. Moreover, if we had any doubt as to that conclusion (we do not), such doubt would have to be resolved against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.

[1] Serial No. 75/415,204, filed January 8, 1998. The application is based on use in commerce under Trademark Act Section 1(a), and alleges September 18,

1997 as the date of first use of the mark anywhere and first use of the mark in commerce.

[2] Serial No. 75/415,185, filed January 8, 1998. The application is based on use in commerce under Trademark Act Section 1(a), and alleges September 18, 1997 as the date of first use of the mark anywhere and first use of the mark in commerce. As originally filed, the services recited in the application were “business consulting services for mainframe systems.” With its July 21, 1998 notice of appeal and request for reconsideration, applicant requested that the recitation of services be amended to read as set forth in the text of this opinion. The Board remanded the application to the Trademark Examining Attorney for consideration of the request for reconsideration and the proposed amendment. The Trademark Examining Attorney rejected the request for reconsideration, but does not appear to have acted on the requested amendment to the recitation of services. The Board then resumed action on the appeal. Because the Trademark Examining Attorney did not object to the amended recitation of services on remand, we deem him to have accepted the amendment, and we deem the amended recitation of services to be the operative recitation of services for purposes of this appeal. We note, however, that our decision would be the same under either the original or the amended recitation of services.

[3] Registration No. 1,615,223, issued September 25, 1990. Affidavits under Sections 8 and 15 accepted and acknowledged; Section 9 renewal affidavit filed.

[4] The Board suspended the appeal by order dated November 2, 2000, to allow time for determination of whether a Section 9 renewal affidavit (due September 25, 2000) had been filed in connection with the cited Registration No. 1,615,223. Subsequently, the Board received a telephone call from applicant’s counsel notifying the Board that registrant in fact has filed the Section 9 renewal affidavit, and requesting resumption of the appeal. Review of the Office’s records reveals that the Section 9 renewal affidavit was filed on February 2, 2001. In view thereof, and in accordance with applicant’s request, proceedings in this appeal are resumed.

[5] Again, applicant’s services, as recited in its respective applications, are “computer hardware and software integration and migration services for mainframe systems” and “business consulting services relating to computer hardware and software integration and migration for mainframe systems.” Registrant’s services, as recited in the registration, are “distributorship, retail store and mail order catalog and technical consulting services in the field of computers, computer software, computer peripherals, telecommunications and computer networking.”