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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gravity Systems, Inc.

Serial No. 78330413

Erik J. Osterrieder of Schubert Osterrieder & Nickelson
PLLC for Gravity Systems, Inc.

Samuel E. Sharper, Jr., Trademark Examining Attorney, Law
Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Gravity Systems, Inc. has applied to register the mark
GRAVITY SYSTEMS, with the word SYSTEMS disclaimed, for
services which were subsequently identified as follows:

Computer installation and repair,
excluding film and video editing and
compositing; installation of computer
networks and computer systems,
excluding film and video editing and
compositing; maintenance and repair of
computer networks and computer systems,
excluding film and video editing and
compositing; upgrading of computer

hardware, excluding film and video editing and compositing (Class 37); and

Computer consultation, excluding film and video editing and compositing; computer consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others, but excluding film and video editing and compositing; computer diagnostic services, excluding film and video editing, and compositing; computer services, namely, creating and maintaining web sites for others, designing and implementing networks and web pages for others, managing web sites for others, and excluding film and video editing and compositing; computer site design, excluding film and video editing and compositing; computer network design for others, but excluding film and video editing and compositing; customization of computer hardware and software, excluding film and video editing and compositing; installation of computer software, excluding film and video editing and compositing; integration of computer systems and networks, excluding film and video editing and compositing; technical support services, namely, troubleshooting of computer hardware and software problems, but excluding film and video editing and compositing; updating of computer software for others, but excluding film and video editing and compositing; hosting the web sites of others on a computer server for a global computer network, but excluding film and video editing and compositing (Class 42).¹

¹ Application Serial No. 78330413, filed November 19, 2003, and asserting first use with respect to the services in both classes on September 22, 1997 and first use in commerce on September 25, 1997. On November 9, 2005, the Board remanded the application to the Examining Attorney to consider applicant's proposed amendment

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark GRAVITY, previously registered² for the following goods, that if used in connection with applicant's services it is likely to cause confusion or mistake or to deceive:

Computer hardware and software for film and video editing and compositing which includes special effects, character generation, paint and animation, audio editing, audio effects, film and video project management, and post production edit list and shot log import, export, format translation, list manipulation, new list generation, video to film cut list translation, cut list manipulation and export.

When the refusal was made final, applicant appealed. The appeal has been fully briefed; applicant did not request an oral hearing.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set

to the identification of services. On December 7, 2005 the Examining Attorney denied what he characterized as applicant's "request for reconsideration." The Office action included the statement that "The exclusion of goods from the identification of goods does not avoid likelihood of confusion." From this statement, we infer that the Examining Attorney accepted the amendment to the identification, and we have therefore treated the identification as set forth above.

² Registration No. 2727386, issued June 17, 2003.

forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the marks, applicant has argued that they differ in appearance, spelling and pronunciation because applicant's mark contains the additional word SYSTEMS. We are not persuaded by this argument. The word GRAVITY in applicant's mark is identical to the cited mark. Although applicant's mark also contains the word SYSTEMS, the presence of this word is not sufficient to distinguish the marks. The Examining Attorney required a disclaimer of this word, with which applicant complied, because it is descriptive of applicant's services. Because SYSTEMS is descriptive, it is the word GRAVITY in applicant's mark that functions as the stronger source-indicating portion. It is well established that, for rational reasons, more or less weight may be given to a particular feature of a mark.

See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Thus, even though we have compared the marks in their entireties, because the GRAVITY portion of applicant's mark deserves greater weight, we find that the marks are highly similar in appearance and pronunciation, and virtually identical in connotation and commercial impression.

Applicant points to registrations for the marks DELTA and DELTA SYSTEMS by different third parties in an attempt to show that the Office has considered the presence of the word SYSTEMS in a mark to sufficiently distinguish it from other marks that are otherwise identical. However, the issue of likelihood of confusion is determined by considering a number of factors other than the similarities in the marks themselves, most notably, the relatedness of the goods. Thus, we cannot conclude from these registrations that the Examining Attorneys involved believed that the presence or absence of the word SYSTEMS was sufficient to avoid a likelihood of confusion. In any event, it is a well-settled principle that this Board is not bound by the USPTO's allowance of prior registrations, even if they were to have some characteristics similar to the situation before us here. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

As noted above, in addition to the similarity of the marks, the relatedness of the goods and services is a critical factor in the determination of the issue of likelihood of confusion. In support of his position that applicant's identified services and the registrant's goods are related, the Examining Attorney has made of record 43 third-party registrations. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

We must, at this point, make a comment about the Examining Attorney's submissions. As a general rule, it is not necessary to submit such a large number of third-party registrations in order to make a showing that particular goods and/or services are related. In this case, it appears that the Examining Attorney did not even cull through the registrations in order to find those which are particularly persuasive. For example, as Trostel clearly states, to have probative value the registrations must be used in commerce. However, eleven of the registrations submitted by the Examining Attorney were based on foreign registrations, and bear no indication of use in commerce.

Nor has the Examining Attorney identified which registrations cover the same goods as those in the cited registration. Instead, the Examining Attorney has simply made the general statement that these printouts "showed third-party registrations of marks used in connection with the same or similar goods and services as those of applicant and registrant in this case," brief, p. 4, and that they show marks "used in connection with the same or similar goods and services as those of applicant and registrant in this case." Brief, p. 11. However, the goods in the cited registration are specialized computer hardware and software:

Computer hardware and software for film and video editing and compositing which includes special effects, character generation, paint and animation, audio editing, audio effects, film and video project management, and post production edit list and shot log import, export, format translation, list manipulation, new list generation, video to film cut list translation, cut list manipulation and export.

After thoroughly reviewing the goods and services in the 32 registrations which were based on use in commerce, we have been able to identify only a single third-party registration that might possibly be said to include computer software for film and video editing and compositing. (We say "possibly" because no reference to

editing or compositing actually appears in the identification.) The identification of Registration No. 2803016 includes "computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures." This registration also includes, inter alia, "computer software consultation; computer software design for others, consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others."

This single third-party registration which arguably includes the goods and services that are covered by the cited registration and applicant's application is not sufficient to demonstrate that such goods and services are normally offered by companies under a single mark. On the contrary, the fact that the Examining Attorney was able to find only one such third-party registration despite the extensive search he apparently undertook (judging from the number of registrations he submitted) indicates that such goods and services normally are not offered by companies under a single mark.

Moreover, applicant has amended its identification of services to specifically exclude services relating to "film and video editing and compositing," which are the subject

matter of the computer hardware and software of the cited registration. In view thereof, it is not readily apparent how, as the Examining Attorney states, the trade channels for the respective services and goods would be the same. Even if we accept that companies that purchase computer hardware and software for video editing and compositing would also purchase the more general computer installation, repair and consultation services offered by applicant, such companies must be considered sophisticated purchasers. Because such purchasers will know their industry, and because there is no evidence that sellers of specialized hardware and software for video editing and compositing also offer general computer installation, repair and consultation services, these purchasers are not likely to assume that such goods and services emanate from a single source, even if they are offered under similar marks.

In summary, we find that Office has failed to prove that applicant's services are related to the goods identified in the cited registration and we therefore find that, despite the similarity of the marks, the Office has failed to prove that confusion is likely.

Decision: The refusal of registration is reversed.