

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Oral Hearing: October 13, 2005 Mailed: February 1, 2006

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re GSI Commerce Solutions, Inc.<sup>1</sup>

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Serial No. 76370013

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Timothy D. Pecsenty of Blank Rome LLP for Global Sports Interactive, Inc.

Tanya Amos, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).<sup>2</sup>

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Before Hohein, Rogers and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

GSI Commerce Solutions, Inc. has filed an application to register the mark GSI COMMERCE (in standard character form with COMMERCE disclaimed) for services ultimately identified as "internet consulting services, namely,

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<sup>1</sup> We note applicant's change of name from GSI Sports Interactive, Inc. to GSI Commerce Solutions, Inc. recorded at Reel/Frame 2568/0420. Inasmuch as the name change was recorded prior to November 2, 2003, applicant is advised, that absent a request for the name in the application to be changed, the application would register in applicant's former name. See TMEP §§502.02 and 504 (4<sup>th</sup> ed. 2005).

<sup>2</sup> During the course of prosecution, this application was reassigned to the above-noted examining attorney.

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providing assistance to others in developing online retail web sites, namely, providing assistance to others in developing underlying technology platforms that enhance their online retail web site efficiency and functionality" in International Class 42.<sup>3</sup>

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its recited services, so resembles the registered marks GSINET (in standard character form) for "providing multiple-user access to a global computer information network" in International Class 38<sup>4</sup> and



for "telecommunications services, namely, providing multiple user dial-up and dedicated access to the internet" in International Class 38,<sup>5</sup> as to be likely to cause

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<sup>3</sup> Application Serial No. 76370013, filed February 12, 2002, alleging a bona fide intent to use the mark in commerce.

<sup>4</sup> Registration No. 2351372, issued May 23, 2000.

<sup>5</sup> Registration No. 2719396, issued May 27, 2003.

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confusion, mistake or deception. The cited registrations are both owned by Granite State Long Distance, Inc.<sup>6</sup>

When the refusal was made final, applicant appealed and filed a request for reconsideration. Upon the examining attorney's denial of the request for reconsideration, the appeal was resumed. The examining attorney and applicant have filed briefs, and an oral hearing was held. We affirm the refusal to register.

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 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 Co., 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).

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<sup>6</sup> Granite State Long Distance, Inc. claims ownership of Registration No. 2351372 in its Registration No. 2719396.

We turn first to a consideration of the services identified in the application and the cited registrations. It is well settled that goods or services need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods or services themselves, but rather whether purchasers are likely to be confused as to the source of the goods or services. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the registrant's services as they are described in the cited registrations and we cannot read limitations into those services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Thus, if the cited registrations describe services broadly, and there are no limitations as to the nature, type, channels of trade or class of purchasers, it is presumed that the registrations encompass all services within the scope of the description, that they move in all channels of trade normal for those services, and that they are available to all classes of purchasers for the described services. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

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The examining attorney has presented evidence of a relationship between "developing underlying technology platforms that enhance website efficiency and functionality" and "providing multiple user access" through third-party use-based registrations showing that entities have registered a single mark for providing multiple user access to the Internet on the one hand and creating websites for others, providing consulting services in the areas of electronic commerce, or web site hosting on the other hand. See, for example, Reg. Nos. 2768750, 2736152, 2664445, and 2387469. 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 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). In addition, the examining attorney submitted a printout of an excerpt from registrant's website wherein registrant offers both Internet access, web hosting, website design and website development all under its GSINET marks, and a printout of an excerpt from applicant's website wherein applicant describes its services under the GSI COMMERCE mark as website design and development. As applicant stated, while the examining attorney "must consider any goods or

services in the registrant's normal fields of expansion,' the ultimate test is 'whether purchasers would believe the product or service is within the registrant's logical zone of expansion.'" App. Br. p. 21 citing TMEP §1207.01(a)(v). The third-party registrations and website printouts sufficiently demonstrate that applicant's services are within the registrant's "logical zone of expansion." Applicant's counter argument and evidence of third-party registrations with only Internet access services do not effectively rebut the examining attorney's evidence that applicant's and registrant's services are provided under one mark. The fact that many companies only provide one of these services does not negate the fact that many other companies provide both services and consumers are accustomed to such identity of source. In fact, the registrant's website lends further support to that finding, in that, although it only owns a registration for providing Internet access, it apparently also provides website development. Accordingly, based on the evidence of record, we find that the recited services of applicant and registrant are related.

Further, given the absence of any restrictions or limitations in the trade channels in registrant's respective recitations of services, such services would

encompass the applicant's retail market and, because the parties' respective services are related, they are deemed to be marketed in the same trade channels and to the same classes of purchasers.<sup>7</sup> Kangol Ltd. V. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

In view of the above, the du Pont factors of the similarity of the services and the channels of trade favor a finding of likelihood of confusion as to the cited registrations.

We turn now to the first du Pont factor, i.e., whether applicant's mark and registrant's marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under the first du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely

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<sup>7</sup> Applicant's reliance on *In re Shipp*, 4 USPQ2d 1174 (TTAB 1987) is misplaced. As the examining attorney noted, that case involved goods and services that had significantly different consumers in that "the applicant offered laundry and dry cleaning services to the general public, whereas the cited registrant's goods were commercial dry cleaning machine filters, and a variety

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to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of service marks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, the meaning or connotation of a mark must be determined in relationship to the named goods or services. See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987).

We find that applicant's mark is highly similar to the cited marks. The respective marks all begin with the letters GSI. The other wording in the marks is, at a minimum, highly suggestive and not sufficient to distinguish the GSI marks. The NET portion of registrant's marks suggests online or internet services. The dictionary definitions submitted by applicant support this finding:

.net, Abbreviation: network provider ( in Internet addresses);

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of dry cleaning preparations offered to dry cleaning establishment owners and operators." Br. p. 11.

Net, The Internet.  
The American Heritage Dictionary of the English Language:  
Fourth Edition (2000).

Certainly, with regard to registrant's standard character mark, GSI is the dominant portion. Similarly, the COMMERCE portion of applicant's mark has been disclaimed in response to the examining attorney's requirement and applicant concedes that the word COMMERCE "indicates to consumers that the mark GSI COMMERCE is representative of an aspect of retail activity." App. Br. p. 15. Although the appearance of applicant's mark is slightly different from the marks in the cited registrations due to the other words therein, we do not believe that this difference alone creates an overall different commercial impression. In addition, the square design in Registration No. 2719396, although it creates a different appearance, is not so prominent as to outweigh the impression made by the identical abbreviations GSI, which is what consumers will use in referring to the services. In re Dakin's Miniatures Inc., 59 USPQ2d 1593 (TTAB 1999). We agree with the examining attorney that GSI, the first term in the marks, "is most likely to be remembered by consumers." Br. p. 4.

We are not persuaded by applicant's argument that the different elements COMMERCE and NET create a different commercial impression "because electronic commerce and on-line retail activity is very different from dial-up and network connectivity, and consumers certainly know that" (App. Br. p. 15), and that the examining attorney "failed to appreciate that NET and COMMERCE, if used in a descriptive sense, ultimately describe totally different services and generate distinctly different commercial impressions" (App. Br. p. 16). This argument, in fact, supports a finding of likelihood of confusion. Having stated that the words NET and COMMERCE are descriptive terms (i.e., devoid of source identifying significance), applicant is essentially left with the implication that it is the identical common portion GSI which is the element of the marks that has source identifying significance. Applicant argues that the words NET and COMMERCE will direct the consumer to the respective services which are different. Although different, the services are related (as previously explained) and the different descriptive terms in the marks, in this circumstance, may serve to increase the likelihood of confusion. A consumer, accustomed to seeing Internet access providers also provide website development and e-commerce consulting, could

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certainly be confused as to source when presented with these marks, GSINET and GSI COMMERCE.

In addition, applicant's argument that GSI is an "abbreviation used across a wide spectrum of goods and services, such that it is relatively commonplace" (App. Br. p. 18) and thus "'GSI" is not alone likely to be perceived by the purchaser as distinguishing source" (App. Br. p. 19), is unavailing. First, the third-party applications submitted by applicant have no probative value, other than as evidence that the applications were filed. Second, the seven third-party registrations submitted by applicant are for completely different services and, therefore, are not evidence that GSI is a weak term when used in connection with the services in issue in this case. In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988) (third-party registrations can be useful "to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those engaged in a certain field or industry and that said term has less than arbitrary significance with respect to certain goods or services"). Thus, the factor of the similarity of the marks also favors a finding of likelihood of confusion.

Further, we do not accord significant weight to applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the respective marks. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

*Majestic Distilling*, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

Finally, with regard to applicant's contention that this application should be allowed in view of applicant's copending application that has been allowed for publication, it is well settled that prior decisions of other examining attorneys are not binding upon the Office and the Board must decide each case on its own facts and record. In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); In re International Taste Inc., 53 USPQ2d 1604 (TTAB 2000); In re Consolidated Foods Corp., 200 USPQ 477 (TTAB 1978).<sup>8</sup>

In conclusion, we find that because the marks are similar, the services are related, and the channels of trade are the same or overlapping, confusion is likely between applicant's mark and the marks of the cited registrations. Finally, to the extent that any of the points argued by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

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<sup>8</sup> We further note that the mark and services in the allowed application are different from those in the instant application, which may bring up different issues, thus underscoring the soundness of the case law that prior decisions by examining attorneys in another application are not binding.

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**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.