

THIS OPINION IS NOT A  
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Mailed:  
June 4, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re I-Site, Inc.*

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Serial No. 77750175

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Carl H. Pierce of Reed Smith LLP for I-Site, Inc.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Zervas, Bergsman and Ritchie, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

I-Site, Inc. (“applicant”) filed an intent-to-use application for the mark **I-Site**, in standard character form, for services ultimately identified as follows:<sup>1</sup>

Marketing, namely, promoting or advertising the goods and services of others; marketing, namely, promoting or advertising software applications for others, in Class 35; and

Design and development of computer software and applications for others; design and development of computer software and applications; design and

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<sup>1</sup> During prosecution, applicant filed an amendment to allege use claiming 1996 as its dates of first anywhere and in commerce for both classes.

development of computer software for portable devices, in Class 42.

The Trademark Examining Attorney refused to register applicant's mark as to the services in Class 42 only under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Specifically, the basis for the refusal is that applicant's use of **I-Site** for the design and development of computer software and applications is likely to cause confusion with the previously registered mark I-SIGHT for, *inter alia*, the following services:

Computer software design for others; technical support services, namely, troubleshooting of computer hardware and software problems via telephone, e-mail and in person; database development services, in Class 42.<sup>2</sup>

#### Preliminary Issues

Applicant attached evidence to its appeal brief that had been previously made of record. Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief (and citing to the attachments, rather than to the record) is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether such attachments are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during trial, requiring more time and effort than would have been necessary if citations were directly to the prosecution record. *See In re Lorillard*

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<sup>2</sup> Registration No. 2681143, issued January 28, 2003; renewed.

*Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011) (attachment to brief of hundreds of pages of exhibits already of record not helpful; instead it would have been helpful to identify, by date of submission and page number in Office's TDR database, the material being referenced in the brief); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475, n.3 (TTAB 2007) (attaching evidence from record is duplicative and unnecessary).

#### Likelihood of Confusion

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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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"). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

- A. The similarity or dissimilarity and nature of the services, the established, likely-to-continue channels of trade and classes of consumers.

The services in the cited registration are set forth below:

Computer software design for others; technical support services, namely, troubleshooting of computer hardware

and software problems via telephone, e-mail and in person; database development services.

Applicant is seeking to register its mark for the services set forth below:

Design and development of computer software and applications for others; design and development of computer software and applications; design and development of computer software for portable devices.

“Computer software design for others” is legally identical to the “design and development of computer software and applications for others.” In the context of likelihood of confusion, it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the application). *See also Research in Motion Limited v. Defining Presence Marketing Group, Inc. et al*, 102 USPQ2d 1187 (TTAB 2012) (“Likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application.”).

Because the services described in the application and the cited registration are in part legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same

channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

B. The number and nature of similar marks in use on similar services (i.e., the strength of the registered mark).

Applicant contends that the cited registration is a weak mark entitled to only a narrow scope of protection or exclusivity of use.<sup>3</sup> In its September 10, 2012 request for reconsideration, applicant submitted printouts for searches for EYESIGHT, I-SIGHT, ISIGHT, ICITE, ICYTE, ISITE, I-SITE, and EYESITE from the Trademark Electronic Search System (TESS) listing the serial number, registration number, mark and status. Without the goods and/or services, the list of marks has little, if any, probative value. *Nat’l Fidelity Life Ins. v. Nat’l Ins. Trust*, 199 USPQ 691, 694 n.5 (TTAB 1978) (list of registrations without goods and services and other relevant information “has no probative value”).

Applicant referenced the following registrations cited by the Trademark Examining Attorney early in the prosecution as potential bars to registration.<sup>4</sup>

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<sup>3</sup> Applicant’s Brief, pp. 9-13 and 16-17.

<sup>4</sup> We did not consider Registration No. 2728551 for the mark EYESIGHT because it was not based on use in commerce.

Mark	Reg. No.	Goods and/or Services
ISITE	2352200	Computer programs for site selection and trade area demographic analysis for the commercial real estate industry; computer mapping software for locating and displaying site and market characteristics for the commercial real estate industry
ISITE and I SITE and design	2753458 2922103	User interface software for medical informatics systems, namely, software to permit a use to retrieve, display and browse medical images and information
ICYTE and  ICYTE and design	3653871  3706743	Computer software for searching, compiling, notating, tagging, indexing and organizing information on computer networks; computer software for creating indexes of web sites; computer software for collaboration involving the review of textual and graphic materials; computer software for publishing annotations to text and graphic context accessed electronically; mouse pads
RSP I-SITE and	3146608  3146609	Computer software for capturing, storing, accessing and displaying building floor plans and building information for use by firefighters, police and other emergency personnel  Providing temporary use of on-line non-downloadable software for capturing, storing, accessing and displaying building floor plans and building information for use by firefighters, police and other emergency personnel.
ISITE	3148108	Providing online non-downloadable project management software for use in the management and administration of government contracts.
iSight	3146199	Computer hardware, namely, camera requiring use of a personal computer for taking still and moving pictures

Applicant also submitted a copy of the following registration:<sup>5</sup>

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<sup>5</sup> With respect to the copies of applications submitted by applicant, a pending application is incompetent to prove anything other than the fact that it was filed. *See Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981) (“Introduction of the record of a pending application is competent to prove only the filing thereof.”); *Merritt Foods Co. v.*

Mark	Reg. No.	Goods and/or Services
ICYTE	3976295	Computer services, namely, providing nondownloadable software interfaces over a network to index, annotate, tag and comment upon webpages and other electronically stored information; ... <sup>6</sup>

The third-party registrations relied on by applicant are not evidence that those marks have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the bases of minute differences. The probative value of third-party trademarks depends entirely upon their usage. *E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 192 USPQ 289, 294 (2d Cir. 1976) (“The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers.”). As the Court pointed out in *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (C.C.P.A. 1967), “the existence of these registrations is not evidence of what happens in the market place or that customers are familiar with their use.” Where, as here, the “record includes no evidence about the extent of [third-party]

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*Americana Submarine*, 209 USPQ 591, 594 (TTAB 1980). Further, with respect to the copies of cancelled and expired registrations submitted by applicant, a cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007); *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”).

<sup>6</sup> Same owner as Registration Nos. 3653871 and 3706743 noted above.

uses ... [t]he probative value of this evidence is thus minimal.” *See also Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given *any* weight”). Applicant, in its brief, did not make the distinction between third-party registrations and third-party use.<sup>7</sup>

Nevertheless, third-party registrations may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive of goods and services.

The word “sight” is defined, *inter alia*, as follows:

1. the power or faculty of seeing; perception of objects by use of the eyes; vision.
2. an act, fact, or instance of seeing. ...
5. mental perception or regard; judgment.<sup>8</sup>

“Site” is defined, *inter alia*, as follows:

- 2 a: the place, scene or point of an occurrence or event ...
- b: one or more Internet addresses at which an individual or organization provides information to others<sup>9</sup>

“Cyte” is defined as a “cell <leukocyte>.”<sup>10</sup>

The letter “I” as a prefix generally stands for “Internet.”<sup>11</sup>

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<sup>7</sup> Applicant’s Brief, pp. 9-10.

<sup>8</sup> **THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (UNABRIDGED)**, p. 1778 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>9</sup> *Merriam-Webster Dictionary* (m-w.com) attached applicant’s September 10, 2012 response to Office action, Exhibit N.

<sup>10</sup> *Merriam-Webster Dictionary* (m-w.com) attached applicant’s September 10, 2012 response to Office action, Exhibit M.

The third-party registrations suggest that the marks in the third-party registration refer to Internet sites. For example,

1. ISITE for “computer programs for site selection and trade area demographic analysis for the commercial real estate industry” (Registration No. 2352200) suggests an Internet site for property site analysis with “Site” referring to both an Internet location and a physical location. *See also* RSP I-SITE for “computer software for capturing, storing, accessing and displaying building floor plans and building information for use by firefighters, police and other emergency personnel” (Registration Nos. 3146608 and 3146609);

2. ISITE for “user interface software for medical informatics systems, namely, software to permit a use to retrieve, display and browse medical images and information” (Registration 2753458 and 2922103) suggests an Internet site;

3. ISITE for “providing online non-downloadable project management software for use in the management and administration of government contracts” (Registration No. (3148108) suggests an Internet site; and

4. ICYTE for “computer software for searching, compiling, notating, tagging, indexing and organizing information on computer networks” (Registration Nos. 3976295, 3653871, and 3706743) suggests an Internet site. Registrant appears to have changed the spelling of “site” to “cyte” for marketing.

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<sup>11</sup> *Netlingo.com*, a dictionary of Internet terms, cyber terms and acronyms. The Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

On the other hand, iSight for “computer hardware, namely, camera requiring use of a personal computer for taking still and moving pictures” (Registration No. 3146199) appears to be a double entendre involving “eye sight” for a camera and an Internet site for cameras.

We find that the third-party registrations demonstrate that the mark in the cited registration, I-SIGHT for “computer software design for others”, suggests an Internet site in addition to “eyesight”. This finding is corroborated by the registrant’s website that states “*I-Sight* allows employees or customers and partners to submit issues directly over the web” and “is accessed through any standard web browser connected to the internet or your intranet.”<sup>12</sup>

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, meaning and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the services are in part legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable

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<sup>12</sup> Applicant’s September 10, 2012 response to Office action, Exhibit O.

disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, we are mindful that the test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

I-Site and I-SIGHT are phonetically equivalent. They are also visually similar because they both begin with the letter “I” followed by a hyphen and then the phonetically equivalent words “Site” and “Sight.” As discussed in the previous section of this decision, the marks have the same meaning and engender the same commercial impression (*i.e.*, an Internet site). Even if the differences in the appearance of the marks were noted, the similarities are such that the relevant purchaser could readily assume that related marks are being used by the same or related companies to render the same services.

In view of the foregoing, we find that the marks are similar in appearance, sound, meaning and commercial impression.

D. The degree of consumer care.

Applicant contends that “consumers of [its] respective goods and services may be readily presumed to exercise due care in selecting who they purchase customer satisfaction research from, or who they contract software development from” and that the Trademark Examining Attorney does not offer any evidence to dispute this “factual reality.”<sup>13</sup> While we acknowledge that the relevant consumers for the design and development of computer software will exercise a reasonable degree of care, applicant’s argument would have been more persuasive had it been supported by evidence. In this regard, we note that applicant submitted a declaration from its Chief Executive Officer attesting to the fact that he is unaware of any instances of confusion with the mark in the cited registration.<sup>14</sup> It would have been helpful had applicant’s Chief Executive Officer also attested to the circumstances which describe the increased degree of care exercised by its consumers, as well as the care exercised by consumers of the registrant’s services, if possible. *See Edwards Lifesciences Corp. v. VigiLanze Corp.*, 94 USPQ2d 1399, 1403-1407 and 1413 (TTAB 2010).

We find the degree of care exercised by the relevant consumers weighs slightly in favor of applicant and against finding that there is a likelihood of confusion.

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<sup>13</sup> Applicant’s Brief, p. 21.

<sup>14</sup> Applicant’s September 10, 2012 response to Office action, Exhibit AJ.

E. Lack of instances of actual confusion.

As indicated above, applicant submitted a declaration from its Chief Executive Officer attesting that (1) he has been employed by applicant, or its predecessor-in-interest, since January, 1996, (2) applicant, through its predecessor-in-interest, has been using the mark **I-Site** since January 1996, and (3) he is unaware of any instances of consumer confusion with the mark in the cited registration. Accordingly, applicant argues that “[t]he coexistence of the marks in the marketplace for twelve years clearly demonstrates the absence of a likelihood of confusion.”<sup>15</sup>

The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant’s sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. As to whether there has been sufficient opportunity for confusion to occur, the record contains no indication of the level of sales or advertising by applicant. Further, in this *ex parte* context, we also have no opportunity to hear from registrant about its levels of sales and promotion, or of any incidents of actual confusion brought to registrant’s attention. Presumably limited sales and/or advertising by one or both of these trademark owners over a relatively short period of contemporaneous usage may well explain the lack of evidence of actual confusion.

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<sup>15</sup> Applicant’s Brief, pp. 22-23.

All of these enumerated factors materially reduce the probative value of applicant's argument regarding asserted lack of actual confusion. Therefore, applicant's claim that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). *See also In re General Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992) ("Normally, in the absence of a detailed consent agreement, the registrant has no opportunity to be heard in an ex parte proceeding of this type and the Board, therefore, is not in a position to meaningfully assess whether the claimed period of contemporaneous use has provided ample opportunity for confusion to have arisen.")

F. Balancing the factors.

Because the marks are similar, the services are in part legally identical and the presumption that they are rendered in the same channels of trade and to same classes of consumers, we find that applicant's mark **I-Site** for the "design and development of computer software and applications for others; design and development of computer software and applications; design and development of computer software for portable devices," in Class 42 is likely to cause confusion with the mark I-SIGHT for "computer software design for others; technical support services, namely, troubleshooting of computer hardware and software problems via telephone, e-mail and in person; database development services," in Class 42.

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**Decision:** The refusal to register applicant's services in Class 42 is affirmed. The application will be forwarded for publication for the services in Class 35 in due course.