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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Visia Inc.

Serial No. 78565368

John X. Garred of Tucker Ellis & West LLP for Visia Inc.

Judith M. Helfman, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Quinn, Grendel and Bergsman, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark depicted below.¹

¹ Serial No. 78565368, filed on February 11, 2005. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). In the application, 1995 is alleged to be the date of first use of the mark anywhere, and August 15, 1996 is alleged to be the date of first use of the mark in commerce.

Ser. No. 78565368

A description of the mark statement in the application states that "the mark consists of stylized string of letters VISIA."

As amended, the Class 42 recitation of services in the application reads as follows:

Information technology services, namely, designing and implementing web sites for others; hosting the web sites of others on a computer server for a global network; designing graphical user interface software for others; designing software for application database integration for use with Internet and intranet access; providing temporary use of on-line non-downloadable software for application and database integration.

At issue in this appeal are the Trademark Examining Attorney's final refusals to register applicant's mark on the ground that the mark, as applied to the recited services, so resembles two registered marks (owned by the same owner) as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The first cited registration is of the mark **NVISIA** (registered in standard character form), for Class 42 services recited in the registration as "custom application software development of object-oriented corporate computing

solutions for others; object-oriented computer systems integration services for others."²

The second cited registration is of the mark depicted below



for Class 42 services recited in the registration as "custom application software development of object-oriented corporate computing solutions for others; object oriented architecture and computer systems integration services for others."³

Applicant and the Trademark Examining Attorney filed main appeal briefs. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusals to register.

Initially, we reject applicant's contention that, as between applicant and the owner of the cited registrations, applicant has priority of use of its mark. Such priority,

² Registration No. 2957408, issued May 31, 2005.

³ Registration No. 2957411, issued May 31, 2005.

even if established, is irrelevant in this ex parte proceeding. Section 2(d) requires refusal of registration if the applicant's mark so resembles "a mark registered in the Patent and Trademark Office" as to be likely to cause confusion. The marks cited by the Trademark Examining Attorney are registered marks. Applicant's claim of priority is an impermissible collateral attack on the validity of the cited registrations which will not be heard in this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 598, 168 USPQ 278, 280 (CCPA 1971).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation

and overall commercial impression. *Palm Bay Imports, Inc., supra.* 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 goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Initially, we find that VISIA is, on this record, an arbitrary or even coined term as applied to the services at issue. It is the only term in applicant's mark, and is a prominent feature of the cited registered marks (especially the cited design mark, in which VISIA is visually separated from the "N"). The prominent presence of this arbitrary and unusual term in each of the marks weighs heavily in favor of a finding that the marks are similar rather than dissimilar.

In terms of appearance, we find that applicant's mark is similar to each of the cited registered marks. The marks are not identical in appearance, due to the presence of the letter "N" in the cited registered marks and its

absence from applicant's mark, and due to the slightly different stylizations of the marks. However, we find that the cited registered design mark looks very much like applicant's mark in that both marks are depicted in a similarly stylized font. We note especially the similarity in the way the final letter is displayed in each mark, with both marks omitting the horizontal crossbar from the letter "A". As for the cited registered standard character mark, it is settled that its scope of protection extends to all reasonable manners of display. See, e.g., *INB National Bank v. Metrohost*, 22 USPQ2d 1585 (TTAB 1992). We find that one such reasonable manner in which the cited registered mark might be displayed is the stylized manner in which applicant's mark is displayed. This finding is further supported by the fact that registrant already has registered the design version of its mark which displays the mark in a stylization similar to applicant's. Viewing the marks in their entireties, we find that they are similar in terms of appearance.

In terms of sound, we find that the marks are similar. The only difference is the presence of the letter "N" at the start of each of the registered marks, which precludes a finding that the marks are identical in sound. However, we find that when the marks are compared in their

entireties, the fact that each of the marks includes the identically-pronounced term VISIA outweighs any difference in sound arising from the additional syllable "en" in the cited registered marks. Considered in their entireties, the marks are similar in terms of sound.

In terms of connotation, we find that the marks are essentially identical. As noted above, on this record VISIA appears to be an arbitrary or even coined word. To the extent that it has any connotation as applied to the relevant services, that connotation would be the same in both applicant's mark and in the cited registered marks. The additional letter "N" in the cited registered marks does not negate the similarity in connotation which arises from the presence of VISIA in each of the respective marks.

In terms of overall commercial impression, we find that the marks are similar rather than dissimilar. Even assuming that purchasers, with their imperfect recollections, are able to remember and distinguish between the two marks per se, we find that they still are likely to assume that services advertised and rendered under the respective marks originate from the same or a related source. VISIA is an unusual arbitrary or coined term; its arbitrariness as a source indicator is likely to lead

purchasers to assume that its appearance in both marks is due to the existence of a source connection or affiliation.

Comparing the marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that applicant's mark is highly similar to each of the cited registered marks. The first du Pont factor clearly weighs in favor of a finding of likelihood of confusion.

We turn next to the second du Pont factor, which requires us to determine the similarity or dissimilarity of applicant's services, as identified in the application, and the services recited in the cited registrations. It is settled that it is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that

there is an association or connection between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In its brief, applicant's only argument on this issue consists of a mere repetition of the respective services as recited in the application and registrations, followed by the wholly conclusory statement that these services "clearly are not similar enough" to support a finding of likelihood of confusion. We disagree with this unsupported assertion. It is apparent from the respective recitations of services themselves, see *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002), that both applicant's and registrant's services include or involve the designing or developing of application software used in connection with the integration of computer databases, applications and systems.

In addition to this similarity which is apparent on the faces of the recitations, we note that the Trademark Examining Attorney has made of record eleven third-party registrations in which the recitations of services include both the type of services recited in applicant's

application and the type of services recited in the cited registrations. See, e.g., Reg. No. 2847947, in which the Class 42 recitation of services includes, inter alia, "computer object-oriented programming services for others"; "web-based consultation services in the field of computer software design and generation"; "hosting the web sites of others on a computer server for a global computer network"; "computer services, namely, designing and implementing web sites for others"; and "computer consultation services featuring the integration of back-office computer functions." Likewise, the Class 42 recitation of services in Reg. No. 2679753 includes, inter alia, "computer services, namely, computer system integration and consultation"; "computer software design for others"; and "web site design for others."

Based on this evidence, we find that applicant's services as recited in the application are similar to the services recited in each of the cited registrations. The second du Pont factor weighs in favor of a finding of likelihood of confusion.

We likewise find that applicant's and registrant's computer services would be marketed in the same trade channels and to the same classes of purchasers. Nothing in the respective registrations of services indicates

otherwise. The third *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

We are not persuaded by applicant's argument, under the fourth *du Pont* factor, that the purchasers of applicant's and registrant's respective services necessarily are knowledgeable and sophisticated purchasers who would exercise more than an ordinary degree of care in purchasing the services. Even if registrant's "corporate computing solutions" might indicate that registrant's customers are corporations, such corporations obviously would include corporations of all sizes and levels of sophistication. Moreover, applicant's development and hosting of web sites for others are services which would be marketed to and purchased by ordinary consumers and corporations wanting to have a web site. Applicant argues that the services involved herein are "expensive," but has submitted no evidence in support of that contention. In its brief, applicant contends that its services "range in price from approximately, several hundred dollars to tens of thousands of dollars." We do not deem services which might cost only "several hundred dollars" to be especially expensive services, for purposes of the fourth *du Pont* factor. We find that the fourth *du Pont* factor does not

weigh in applicant's favor in this case, but instead weighs in favor of a finding of likelihood of confusion.

Applicant argues that there has been no actual confusion between applicant's mark and registrant's marks despite contemporaneous use of the marks since 2000. There is no evidence in the record to support applicant's claim. In any event, the absence of actual confusion is not of particular probative value in an ex parte case. See *In re Majestic Distilling Co., supra*. We have not heard from registrant on the question, nor can we determine from the record that there has been any significant opportunity for actual confusion to have occurred.

Taking into account all of the evidence as it pertains to the relevant du Pont factors, we conclude that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of this conclusion (and we have none), we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals to register are affirmed.