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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 15  
EJS

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Personnel Data Systems, Inc.

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Serial No. 75/325,141

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Stanley B. Kita of Howson and Howson for Personnel Data  
Systems, Inc.

Heather D. Thompson, Trademark Examining Attorney, Law  
Office 103 (Michael A. Szoke, Managing Attorney).

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Before Seeherman, Wendel and Bucher, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Personnel Data Systems, Inc. has appealed from the  
final refusal of the Trademark Examining Attorney to  
register VISTA as a trademark for "computer software for  
use in human resource management, namely, in maintaining  
personnel and benefits records, and processing payrolls."<sup>1</sup>  
Registration has been refused pursuant to Section 2(d) of

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<sup>1</sup> Application Serial No. 75/325,141, filed July 16, 1997, and  
asserting a bona fide intention to use the mark in commerce.

the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark VISTA/PAY, shown below, and registered for "business services, namely payroll administration services performed for other companies"<sup>2</sup> that, if used on applicant's identified goods, it would be likely to cause confusion or mistake or to deceive.



Applicant filed an appeal brief and a supplemental appeal brief.<sup>3</sup> The Examining Attorney also filed a brief. An oral hearing was not requested.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In reaching our decision herein, we have focused our discussion on

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<sup>2</sup> Registration No. 1,948,407, issued January 16, 1996. The drawing is lined for the color red.

<sup>3</sup> After the filing of applicant's appeal brief the Examining Attorney requested remand because the application had been newly assigned to her, and she wished to supplement the evidence in the case. The request was granted, and the Examining Attorney not only submitted additional evidence, but she withdrew the refusal of registration with respect to Registration No. 1,240,942, which had formed one of the bases for refusal in the final Office action. Applicant was thereupon given an opportunity to file a supplemental appeal brief directed to the new evidence and arguments.

those factors argued by applicant and the Examining Attorney.

In any likelihood of confusion analysis under Section 2(d), two of the most important considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning to a consideration of applicant's goods and the registrant's services, it is true that one is a product and the other a service. However, it is well established that the goods or services of the parties need not be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See **International Telephone & Telegraph Corp.**, 197 USPQ 910 (TTAB 1978).

In this case, the Examining Attorney has made of record third-party registrations that show that a party has adopted a single mark for both payroll services and payroll software.<sup>4</sup> 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).

In addition, the Examining Attorney has made of record a number of excerpts of articles taken from the NEXIS data base which refer to payroll processing companies offering payroll software as well. As a result of these reports, consumers are likely to believe that payroll administration services and payroll software can emanate from the same source.

Applicant argues that the customers for its software are different from the customers of the registrant's services. It is clear from the identification that the

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<sup>4</sup> See, for example, Registrations Nos. 2,176,083 and 2,147,183 for, inter alia, computer software for use in connection with human resources, and payroll, and for payroll preparation services; Registration No. 1,868,786 for, inter alia, software to allow customers to input their own payroll data, transmit the files, and print payroll checks on site or have payroll or personnel reports prepared by a processing center, and payroll processing services.

registrant's payroll administration services are rendered to other companies. However, applicant's identified software would also be utilized by companies having the need for payroll processing and administration. In particular, a company which has used payroll administration services may decide to purchase computer software in order to handle its own payroll processing, or to supplement the services it obtains from a third party. Such a consumer might well believe, if the software were offered under a confusingly similar mark to that under which the payroll administration services were rendered, that the software was an ancillary product emanating from the same source as the services.

This brings us to a consideration of the marks. Applicant's mark is VISTA, while the cited mark is for VISTA/PAY and design. Although there are specific differences in the marks, they do not serve to distinguish them. The design element in the cited mark has a very limited visual effect, because it is a common geometric shape, is relatively small compared to the words, and because, as a non-verbal element, is less likely to be referred or remembered. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). Similarly, the word PAY, which is a descriptive term for the services, is not only

separated from the word VISTA by a slash, but has a lesser visual impression because it is shown in lower case letters as opposed to the upper case lettering of VISTA. Thus, although we have compared the marks in their entireties in assessing the likelihood of confusion, we find that the VISTA portion of the cited mark is the dominant element. See **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, because of the similarities in the appearance, pronunciation and connotation of the marks, they both convey the same commercial impression.

Applicant has argued that VISTA is entitled to a limited scope of protection because it has been registered by third parties. Although applicant has not submitted copies of these registrations,<sup>5</sup> the Examining Attorney did not object to them or otherwise advise applicant of the insufficiency of merely listing them. Accordingly, we have treated them as of record. However, of the three registrations listed by applicant, Office records show that two have been cancelled, and the one remaining registration, No. 1,503,617, is not, as applicant characterizes it, for a "Personal Computer Software

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<sup>5</sup> In general, the Board does not take judicial notice of registrations that reside in the U.S. Patent and Trademark Office, and the submission of a list of registrations is insufficient to make them of record. **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974).

Program." The full identification is "personal computer software program recorded on magnetic media, personal computer hardwired programming circuit board, and personal computer operator's hand control mouse, all for computerized video display enlargement systems for the visually impaired." This specialized computer equipment for the visually impaired is clearly different from applicant's identified payroll processing software and the payroll administration services identified in the cited registration. Moreover, the significance of VISTA in connection with products for the visually impaired is clearly different from the meaning of this word in connection with payroll software and services. Accordingly, we are not persuaded by applicant's argument that the scope of protection of the cited registration should be so limited that it would not extend to the use of VISTA for the computer software identified in applicant's application.

Because of the similarity of the marks, and the related nature of the goods and services, we find that consumers who are aware of the registrant's payroll administration services offered under the mark VISTA/PAY and design are likely to believe, upon seeing the mark

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VISTA on computer software for, inter alia, processing payrolls, that this product emanates from the same source.

Decision: The refusal of registration is affirmed.