

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sick AG

Serial No. 85041954

Jerald L. Meyer of The Nath Law Group for Sick AG.¹

Cory Boone, Trademark Examining Attorney, Law Office 104
(Chris Doninger, Managing Attorney).

Before Bucher, Zervas and Shaw, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Sick AG, a German corporation, seeks registration on
the Principal Register of the mark **VISTAL** (*in standard
character format*) for goods identified in the application, as
amended, as follows:

housings for optical sensors used for
measuring distances, positions and angles for
factory automation purposes and safety
applications; housings for photoelectric
sensors used for measuring distances,
positions and angles for factory automation
purposes and safety applications; housings
for magnetic sensors used for measuring
positions of magnetic metals for factory
automation purposes; housings for inductive

¹ We note that the prosecution of this application from the
time of its filing through submission of the appeal briefs was
handled by the Law Office of Deborah E. Lobo.

sensors used for measuring positions of magnetizable metals for factory automation purposes; housings for capacitive sensors used for measuring filling levels and positions of material for factory automation purposes; housings for color sensors used for measuring colors for factory automation purposes; housings for barcode readers used for reading one- and two-dimensional codes and color codes; housings for electronic scanners used for reading one- and two-dimensional codes and color codes; housings for laser scanners used for measuring positions of objects for safety applications and for automation purposes, in International Class 9.²

The Trademark Examining Attorney issued a final refusal to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles **VISTA**, owned by registrant, MDC Max Daetwyler AG, a Swiss corporation, and registered in connection with "optical and/or electric sensor for sensing cells engraved or used in the engraving and printing industries, also in International Class 9,³ as to be likely to cause confusion, to cause mistake or to deceive.

² Application Serial No. 85041954 was filed on May 18, 2010, originally filed under Section 1(b) of the Act, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Applicant later amended the application to delete the Section 1(b) basis and to add a Section 44(e) basis alleging ownership of European Community Trademark Registration No. 009110958, registered November 19, 2010.

³ Registration No. 1973982 issued on May 14, 1996; renewed.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board. Applicant and the Trademark Examining Attorney have fully briefed the issues in this appeal.

We reverse the refusal to register.

Arguments of applicant and the Trademark Examining Attorney

In urging an affirmance of the refusal to register, the Trademark Examining Attorney argues that applicant's addition of a single letter at the end of registrant's mark does not significantly alter the appearance, sound or meaning of the terms; that the applicant's goods are closely-related to the goods in the cited registration inasmuch as applicant's and registrant's complementary goods are used in overlapping industries; that the third-party marks applicant points to are not as similar to the cited mark as is applicant's mark, and the involved goods are less closely related to the registrant's goods than are the applicant's products; and that there is no evidence that the respective goods are expensive or that the respective purchasers are sophisticated or immune from source confusion.

By contrast, in urging registrability, applicant contends that the respective marks are dissimilar as to overall appearance, sound, connotation and commercial

impression; that the registered mark is weak, and entitled to a narrow scope of protection; that the respective goods are different and move in different trade channels; and that the consumers of both products are sophisticated.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *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); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Relationship of the Goods and Trade Channels:

The following screen-print of registrant's website was placed into the record by the Trademark Examining Attorney:

**GRAVOSTAR with
VISTA® II**



- HOME**
- PRINTED ELECTRONICS**
- COLLAGE**
- GRAVOSTAR**
 - About
 - GS 857
 - GS 827
 - VISION Heads
 - tranScribe Engraving
 - CellStar II Microscope
 - Automation
 - Vista II
- CUSTOM SOLUTIONS**
- SERVICE**
- ABOUT US**
- CONTACT**
- Equipment for Sale**

Vista® II Cell Sensing System



The new Vista II Cell Sensing System will help increase productivity on Gravostar engravers. With Vista II, automatic setup is fast and reliable. No longer will surface glare or copper scratches affect the cell measurements. Vista II automatically calculates cell shape, size and the stylus profile for each test cut.

Vista II compensates for stylus problems for more reliable and accurate engraving.

Stylus breakage is detected and the operator is alerted.

Notification when current stylus does not match job requirement.

Stylus tip calibration ensures stylus and shoe are in the correct position.

Optionally, track stylus life with the built-in database.

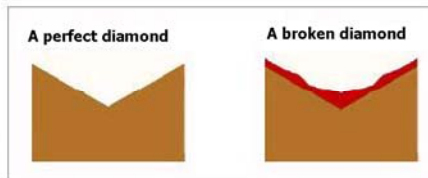
Stylus profiling at the start of every cylinder ensures there will be no stylus errors.

End-of-job test cuts check for broken stylus after engraving.

A cylinder birth certificate includes stylus profile.

Vista II is integral to our latest machine control software, which is packed with productivity enhancements for all levels of automation.

Stylus Profiles



Vista II is available for Gravostar HS and Gravostar 827.

Download Brochure

[Vista II Cell Sensing System \(PDF\)](#)

[Vista II Productivity Benefits \(PDF\)](#)

For more information

[Contact us](#) or your Daetwyler sales representative for more information on the new Vista II Cell Sensing System.

Vista is a registered trademark of Daetwyler

Like registrant's identification of goods, this information further demonstrate that registrant is involved in the areas of electroplating, automation, surface finishing, electro mechanic engraving and laser engraving systems for

rotogravure printing. Its **VISTA**-brand sensors are used in precision rotogravure cylinder-making equipment. The market for such specialized goods would be high-quality, high-volume, commercial printing professionals.⁴

Applicant's identification of goods has changed from the time the application was originally filed. After the Office issued a Final Office action under Section 2(d), applicant submitted with its Request for Reconsideration an amendment to the identification of goods, limiting the involved goods from various electronic sensing devices to " housings " for these devices. These robust **VISTAL** brand plastic housings are designed to protect sensors, barcode readers and scanners from physical and chemical elements.

The Trademark Examining Attorney argues that applicant's protective housings are clearly related to the applicant's SICK sensors, scanners and barcode readers for which they are designed. However, even conceding that applicant's housings are related to its own industrial sensors for measuring distances, positions, angles, filling levels and colors in factory automation and safety applications, that does not answer the question of whether

⁴ Final Office action of March 24, 2011, and attached copies of www.daetwyler-usa.com and www.daetwyler-rd.com as accessed by the Trademark Examining Attorney on March 24, 2011.

applicant's **VISTAL** brand plastic *housings* are related to registrant's listed **VISTA** brand *sensors* .

As seen above, registrant provides products and services related to very highly technical and specialized printing equipment. Registrant's websites demonstrate that its involved sensors are marketed as a critical component of registrant's rotogravure cylinder making equipment. Given their specialized nature, registrant's sensors have no utility apart from its commercial printing equipment.

By contrast, applicant's identification of goods refers generally to housings for devices such as scanners, sensors and barcode readers used for a wide variety of factory automation and safety purposes. There is no evidence in the record to show that applicant and registrant are operating in overlapping fields, for example, such as in packaging.

Based on the record before us, we find that the examining attorney has not established that the respective goods are related. Moreover, in light of the differences between these goods, we also find that registrant's specialized sensors do not travel in the same channels of trade as applicant's housings intended for use with its own SICK sensors, scanners and barcode readers.

The marks

We turn then to the *du Pont* factor dealing with the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The cited mark is simply the five-letter, English-language word "Vista." Applicant contends that the addition of the final letter "L" to its **VISTAL** mark transforms an ordinary word into something very different. Inasmuch as the term **VISTAL** is a fanciful term without a common meaning,⁵ applicant argues that prospective purchasers, upon first encountering the word, will form a very different commercial impression than is evoked by the **VISTA** mark.

On the other hand, dismissing this change as nothing more than a "peripheral difference," the Trademark Examining Attorney argues that the strong similarities in sound, appearance, number of syllables and likely inferred meaning taken from applicant's mark will create similar commercial impressions for the respective marks.

⁵ Neither applicant nor the Trademark Examining Attorney has offered a dictionary meaning for this term, nor are we aware of any such entry.

We agree with applicant that these two terms are visually and aurally different enough to create different connotations and different commercial impressions, and this critical *du Pont* factors favors a finding of no likelihood of confusion.

Third-party marks on other sensors

As to the *du Pont* factor focused on the number and nature of similar marks in use on similar goods, applicant submitted for the record the following third-party registrations of other **VISTA** formative marks:

VISTA	for "home and business security systems comprising electrical, mechanical and electronic alarms, fire and smoke detectors, automatic lighting, appliance and timing controls, open and closed circuit monitors, switches and sensors" in International Class 9; ⁶
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VISTASCAPE	for "electro optical surveillance and security systems comprising sensors, namely, video cameras, digital cameras, infrared (IR) detectors, motion detectors, radar transducers, sonar transducers, chemical sensing devices, biological sensing devices, global positioning system (GPS) transponders, radio frequency (RF) transmitters, radio frequency (RF) receivers, and computer hardware and computer software for detecting changes, tracking changes, visualization, and database management for military or industrial uses such as border patrol, harbor patrol, wide area surveillance, or security critical installations such as palaces, oil refineries, factories,
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⁶ Registration No. 1753760 issued on February 23, 1993; renewed.

military installations, prisons and high value assets" in International Class 9;⁷

VistaScape

for "electro optical surveillance and security systems comprising sensors, namely, video cameras, digital cameras, infrared (IR) detectors, motion detectors, radar transducers, sonar transducers, chemical sensing devices, biological sensing devices, global positioning system (GPS) transponders, radio frequency (RF) transmitters, radio frequency (RF) receivers, and computer hardware and computer software for detecting changes, tracking changes, visualization, and database management for military or industrial uses such as border patrol, harbor patrol, wide area surveillance, or security critical installations such as palaces, oil refineries, factories, military installations, prisons and high value assets" in International Class 9;⁸

VISTA SCAN

for, *inter alia*, "computer software for use in operating medical and dental cameras for image acquisition; computer software for use in managing images from image sensors and image plates for medical and dental purposes; software for use in operating scanners for scanning medical and dental X-ray films and image plates; software for archiving digital images; Medical and dental cameras for image acquisition; medical and dental image sensors and image plates; medical and dental scanners for scanning X-ray films and image plates; medical and dental processors for X-ray images; electrical heat sealing machines for fluid tight sealing of bags for medical and dental purposes; unexposed X-ray films and image plates for medical and dental purposes; Pre-recorded CD-ROMs and DVDs featuring medical and dental information for doctor's use" in International Class 9;⁹

VISTAPROBES

for "electric and electronic and micro-mechanical and micro-electromechanical

⁷ Registration No. 2990975 issued on September 6, 2005.

⁸ Registration No. 2990976 issued on September 6, 2005.

⁹ Registration No. 3286544 issued on August 28, 2007.

sensors and probes for non-optical microscopy, namely scanning probe microscopy, for measuring surface topography, height, electrical and magnetic surface properties, potentials and currents" in International Class 9;¹⁰

VISTA*probes*

for "electric and electronic and micro-mechanical and micro-electromechanical sensors and probes for non-optical microscopy, namely scanning probe microscopy, for measuring surface topography, height, electrical and magnetic surface properties, potentials and currents" in International Class 9;¹¹

TAC VISTA

for " ... sensors for use in buildings; ... electronic installations for automation of buildings, namely, ... fire sensors, air flow sensors, air quality sensors, humidity sensors, light sensors, pressure sensors, wet media pressure sensors, air pressure sensors, temperature sensors, ... air velocity sensors, ... electro-mechanical air flow sensors, electro-mechanical air velocity sensors, electro-mechanical fire sensors, electro-mechanical humidity sensors, electro-mechanical pressure sensors, electro-mechanical wet media pressure sensors, electro-mechanical temperature sensors ... for automation of buildings" in International Class 9;¹² and

AQUAVISTA

for "electrical sensor controllers containing computer software used in controlling and managing municipal and industrial water treatment installations" in International Class 9.¹³

However, the Trademark Examining Attorney is correct in noting that even if applicant had shown actual use of these third-party marks, these third-party goods are not closely

¹⁰ Registration No. 3347273 issued on December 4, 2007.

¹¹ Registration No. 3347311 issued on December 4, 2007.

¹² Registration No. 3537167 issued on November 25, 2008.

¹³ Registration No. 3814765 issued on July 6, 2010.

related to registrant's goods. Hence, we cannot conclude that the word "Vista" is weak when used in connection with registrant's specialized goods.

At most, in much the same way as the dictionary entries of record show that the word "vista" has the connotation of "sight" or "view," these registrations show that the word "vista" may be somewhat suggestive as applied to electromechanical and optical sensors, for surveillance, security, medical and industrial uses.

Hence, as to this *du Pont* factor, it is neutral, at best, for applicant.

Conditions in the marketplace:

The evidence placed into the record by the Trademark Examining Attorney corroborates our understanding of the goods drawn from the wording of registrant's identification of goods. Namely, these involve large commercial printing products that are expensive pieces of industrial machinery. Although the literature contains no mention of actual price quotations, given that registrant's website touts the sub-micron positional accuracy on its engineered cylinders, we find that the purchasers of such machines are likely to be sophisticated consumers who would only purchase after careful consideration, and definitely not on impulse. These

sophisticated purchasers are likely to understand that registrant's "Vista II cell sensing technology" is inextricably tied in with registrant's rotogravure cylinder-making equipment.

Similarly, as identified in the instant application, applicant's goods are robust housings for sophisticated electronic devices that will be marketed to the purchasers of applicant's SICK sensors.

Accordingly, given the sophistication of the purchasers of both applicant's and registrant's goods, this *du Pont* factor also weighs in favor of a finding of no likelihood of confusion.

Conclusion

We find no likelihood of confusion herein inasmuch as these goods are not related, would move in separate trade channels to sophisticated purchasers, the marks create different commercial impressions, and the word "vista" appears to be suggestive as applied to electromechanical and optical sensors.

Decision: The refusal to register the mark **VISTAL** for the named goods under Section 2(d) of the Lanham Act is hereby reversed.