


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK: CONVENE
SERIAL NO.: 88/256,420
FILING DATE: January 10, 2019
APPLICANT: Grant Thornton LLP
EXAMINING ATTORNEY: Sani Khouri
LAW OFFICE: 110

TO: Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO MARCH 27, 2019 OFFICE ACTION


Grant Thornton LLP ("Applicant") submits this response to the Office Action issued on March 27, 2019, concerning the above-referenced application to register CONVENE ("Applicant's Mark"). The Examining Attorney has preliminarily refused registration on the ground that Applicant's Mark may be confusingly similar with two prior registrations of WECONVENE (Reg. No. 5188759) and **C O N  E N E** (Reg. No. 5197700) owned by WeConvene Extel Limited Company (collectively, the "WeConvene Marks") and a prior registration of ECONVENE (Reg. No. 5402903) owned by Transact Communications, LLC (the "Transact Mark"). The WeConvene Marks and Transact Mark are collectively referred to herein as the "Cited Marks."



For the reasons stated below, Applicant respectfully submits that there is no likelihood of confusion with the Cited Marks because the parties' marks are distinct and convey different overall commercial impressions. In addition, the parties' products and services are very different and not related.

I. Applicant's Mark and Registrants' Marks are Sufficiently Distinct in Terms of Appearance, Sound, and Overall Commercial Impression.

Marks must be compared in their entireties to determine if they are similar in terms of appearance, sound, and overall commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). The proper focus in evaluating the similarity of two marks is *not* "on certain prominent features that both parties' marks have in common, to the exclusion of others which cause the parties' marks as a whole to create in the minds of consumers quite different impressions." *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1439 (S.D. Ohio 1990) (citing *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987)). Rather, "[i]t is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof which is important." *Id.*




In addition, the difference in a single letter can be enough to distinguish the marks and eliminate any likelihood of confusion. *See, e.g., Nat'l Distillers Chem. Corp. v. William Grant & Sons, Inc.*, 184 U.S.P.Q. 34 (C.C.P.A. 1974) (finding no likelihood of confusion between DUET and DUVET for alcoholic beverages); *Lever Bros. Co. v. Winzer Co. of Dallas*, 140 U.S.P.Q. 247 (C.C.P.A. 164) (finding no likelihood of confusion between VIM and VIE, both for detergents). For example, in *In re Reach Electronics, Inc.*, the Board held the "one letter difference" between REAC and REACH to be significant due to the fact REACH is visually distinguishable and "does not sound like 'REAC' when spoken." 175 U.S.P.Q. 734, 735 (T.T.A.B. 1972).

In this case, there are a number of differences between the parties' marks and these differences outweigh any purported similarities. Applicant's Mark is simply CONVENE. The cited WeConvene Marks, WECONVENE and **C O N  E N E**, both contain additional distinguishing elements. First, the facts that the registrant adds the prefix "WE" in the

WECONVENE mark and the distinctive  design in the **C O N  E N E** mark are significant because these additions emphasize the "WE"C component of these marks and create marks that, as a whole, are distinct from Applicant's Mark in sight, sound, and commercial impression. Consumers will be able to recognize and readily distinguish these differences. Similarly, the additional "E" prefix in the ECONVENE Mark conveys a different, distinct commercial impression alluding to "electronic," which Applicant's Mark does not so similarly convey.

Moreover, it is well settled that consumers are more likely to focus on and remember the first portion of a mark when encountering the parties' marks in the marketplace. *See In re Leachco, Inc.*, 2017 WL 3773122, at *2 (T.T.A.B. 2017) (reversing the refusal to register CUTIE CRITTERS based on prior CRITTERZZZ registration in part because "the lead term CUTIE [...] distinguishes the cited mark from Applicant's mark visually, aurally, and in meaning.") (non-precedential); *see, also, Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) ("[i]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

Here, both WECONVENE and ECONVENE start with different elements that create an added emphasis on the "WE" and "E" syllables. With respect to the cited mark

C O N  E N E, consumers will be drawn to the distinctive  design element. No such similar dominant elements, syllables, or added emphasis is contained in Applicant's Mark. Thus, consumers will not only remember the letters "WE" or "E," or the  design elements, but they also will focus on those elements as the dominant portions of the Cited Marks when encountering the parties' marks and goods and services in the marketplace. Taking into account

these differences and the fact that the parties' goods and services are different and not related, as discussed in further detail below, consumers are not likely to confuse Applicant's Mark with the Cited Marks.

II. Confusion is Unlikely Because the Parties' Goods and Services are Different and Not Related.

A. The Services Under Applicant's Mark are Unrelated to the Goods and Services under the WeConvene Marks.

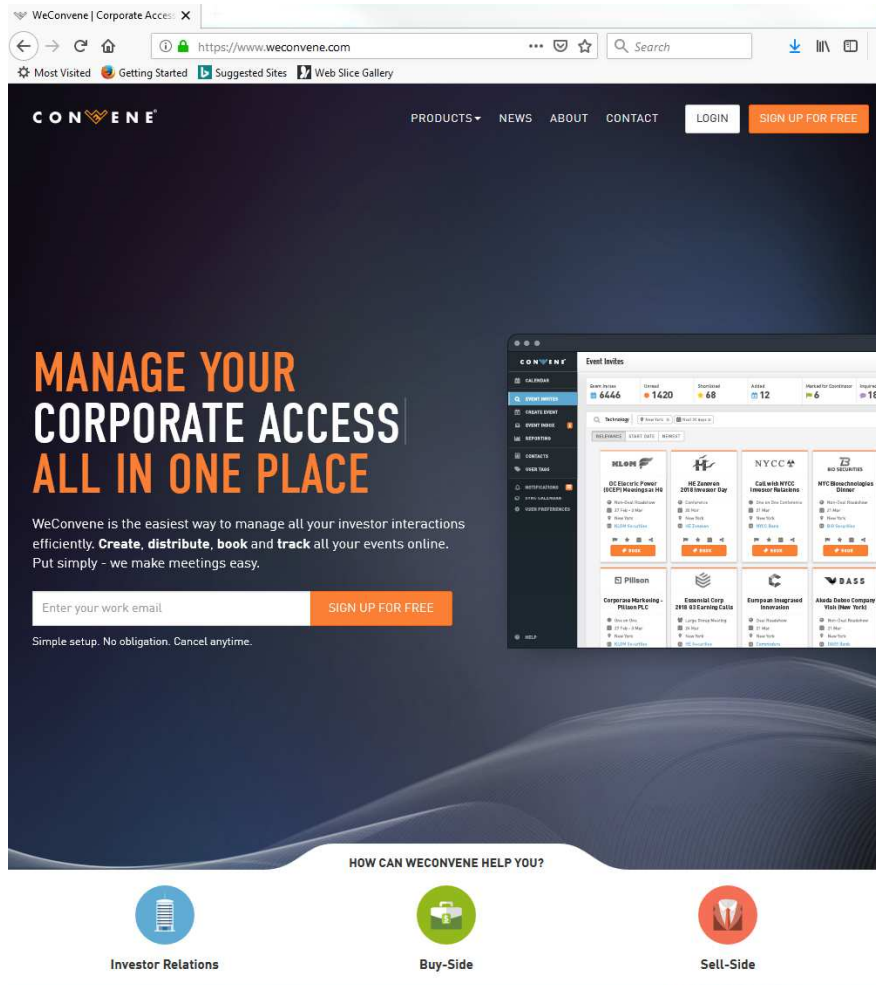
It is well established that even nearly-identical marks do not create a likelihood of consumer confusion if the goods or services are sufficiently different, as they are here. *See, e.g., In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783, 1786 (T.T.A.B. 1993) (no likelihood of confusion between PHOENIX for bulk leather and PHOENIX for leather luggage because the channels of trade and customers are different); *In re Thor Tech.*, 113 U.S.P.Q.2d 1546, 1547 (T.T.A.B. 2015) ("[T]he identity of the marks alone is not sufficient to establish likelihood of confusion in the absence of probative evidence that the goods are related."); *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 U.S.P.Q. 2d 1944 (Fed. Cir. 2006) (no likelihood of confusion between M2 for multimedia applications sold to the music industry and M2 COMMUNICATIONS for interactive multimedia CD-ROMS).

As noted above, the parties' marks are not identical and the differences between the parties' marks outweigh any purported similarities. Furthermore, a likelihood of confusion does not exist because the parties' respective goods and services are different, not competitive, and not related. Applicant's Mark covers "software as a service (SAAS), namely, a web-based software platform for use in project planning and management, document management, and collaborating on shared documents, *all for business auditing purposes*" (emphasis added). By contrast, the WeConvene Marks cover goods and services including "mobile software applications for business organization; computer software for the transmission, recording, reproduction, display,

organization, management, manipulation and review of messages, text, images, files, audio, video and audio-visual content and other data for the facilitation of communications between two or multiple users via computer networks, communication networks."

It is well settled that there is no per se rule that all computer-related goods are related such that there will automatically be a likelihood of confusion between two marks. *See In re Quadram Corp.*, 228 U.S.P.Q. 863 (T.T.A.B. 1985) ("As a result of the veritable explosion of technology in the computer field over the last several years and the almost limitless number of specialized products and specialized uses in this industry, we think that a per se rule relating to source confusion vis-a-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace."). In fact, confusion is even less likely here, considering the differences between the parties' actual use of the marks.

Specifically, the WeConvene Marks are used in connection with investor management software, as shown below:



See generally, Exhibit A, <https://www.weconvene.com/>. The products offered under the WeConvene Marks are different from the SAAS services offered under Applicant's Mark, namely, project planning and document management for business auditing purposes. Therefore, the only similarities between the parties' respective goods and services are that they concern "software," but, as noted above, this lone similarity is not sufficient to show that there is a likelihood of confusion between the marks.

Further, the nature of the parties' respective products and services reveal that their respective consumers are sophisticated. When the relevant purchasers consist of professional or commercial buyers familiar with the field, as in the case here, these consumers are generally knowledgeable enough to eliminate any likelihood of confusion between two marks. See e.g.,

Electr. Design & Sales, Inc. v. Electr. Data Sys. Corp., 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (reversing the Board's finding of a likelihood of confusion between EDS for computer programming services purchased by "experienced corporate officials after significant study and contract negotiation" and E.D.S. for power supplies and battery charges purchased by experienced buyers exercising "significant knowledge and scrutiny" in the purchasing process); *see also, Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991) (finding no likelihood of confusion between for HP and HPM for medical instruments in part due to the sophisticated nature of the products and the fact that the parties' consumers "are highly educated, sophisticated purchasers who know their equipment needs and would be expected to exercise a great deal of care in" selecting the products).

Here, Applicant Grant Thornton is one of the world's leading organizations of independent audit, tax, and advisory firms. Its services, including its intended use of CONVENE for SAAS services for business auditing purposes, are offered to sophisticated business professionals. These services are purchased directly through Grant Thornton by consumers that conduct a high level of scrutiny prior to purchasing Grant Thornton's services, including considering the implementation of these software solutions into highly complex existing business management and auditing compliance procedures. For more information on Grant Thornton, see Exhibit B.

Further, the WeConvene Marks are likely sold to sophisticated consumers as well, namely, professionals seeking to manage investor relations. Again, these consumers likely receive the goods and services offered under the WeConvene Marks directly from the registrant, and conduct a high level of scrutiny when purchasing a software that manages an integral part of their businesses.

Given the sophisticated nature of parties' respective goods and services, which are purchased or utilized under different circumstances, and the high level of sophistication of the parties' prospective consumers, confusion is highly unlikely between Applicant's Mark and the WeConvene Marks.

B. The Services Under Applicant's Mark are Unrelated to the Goods and Services under the Transact Mark.

Similarly, there is no likelihood of confusion between Applicant's Mark and the Transact Mark because Transact's services are different and sold to different types of consumers. Specifically, Transact offers SaaS services for use in school board meetings as shown on its website and the specimen of use filed in support of the underlying application, provided below:

Under ESSA's changes to Title I, how should Title I and Title III work together? [Download our free guide >](#)



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 Intuitive Design Utilize advanced features regardless of tech-saviness or online know-how. Available on desktops, laptops, and tablets.	 Minutes Builder Transcribe notes, actions, and outstanding items into the agenda for easy distribution and reference.	 Agenda Management Create custom agenda templates, include district logos, and mark documents as public or confidential.
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Why eConvene?

School boards are made up of volunteers: eConvene is designed to support decision makers and district staff in spending their time on the most impactful decisions, not managing complicated software.

- **Designed by educators:** eConvene was built by TransACT at the request of a local school board who needed a better solution to managing their meetings.
- **Substantial Savings:** Office materials, administrator workload, and board members' time are all valuable resources. e-Convene puts time back into your week and money back into your budget.
- **Unparalleled Support:** 23 years of supporting operations in the education community. We know that you don't have the time to wait on an answer, and we are there for you in person - every time.

Resources

Transact's services are unrelated to Grant Thornton's complex tax, auditing, and advisory services, and its software services related thereto, and are sold to a different type of consumers (i.e., schools) that are distinguishable from Grant Thornton's business professionals.

The parties' respective consumers also are sophisticated. Whereas Transact's target customers for its ECONVENE services are school boards seeking software to manage and annotate "documents associated with school board meetings", Grant Thornton's CONVENE services are directed to business professionals seeking solutions for "business auditing purposes". The parties' respective services are complex and their respective consumers therefore are likely to carefully scrutinize the respective services prior to purchase. Such sophisticated consumers are not likely to believe that the ECONVENE software associated with school board meetings emanates from the same source as CONVENE SAAS services used for business audits. Thus, given that the parties' respective services are so dissimilar, Applicant's consumers are sophisticated, and the parties' marks are not identical, there is no likelihood of confusion between Applicant's Mark and the Transact Mark.

III. Conclusion

For the reasons stated above, Applicant respectfully asks that the Examining Attorney withdraw the refusal and allow the Application to proceed to publication.

Dated: April 19, 2019

Respectfully submitted,

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EXHIBIT A

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Event Invites	Invited	Accepted	Declined	Not Yet Answered	Accepted	Invited
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DC Electric Power
10CEP Meetings at MS

HE ZEMEN
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NYCC
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Dinner

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The website header features the Grant Thornton logo and a search icon.

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