

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tribus Services, Inc.  
Serial No.: 88/496,771  
Mark: SCHEDULEPRO  
Class: 9  
OA Date: September 20, 2019  
Examiner: Louis Kolodner (L.O. 122)

**RESPONSE TO  
OFFICE ACTION**

This communication responds to the Office Action issued August 8, 2019 ("Office Action") regarding the application by Tribus Services, Inc. ("Applicant") for registration of the mark SCHEDULEPRO ("Applicant's Mark") in Class 9 ("Application"). The issues raised in the Office Action are: (1) a refusal based on an alleged likelihood of confusion in view of two prior registrations; (2) a requirement to amend the Identification of Goods in Class 9; and (3) a requirement that, to the extent the revised description of goods identifies goods and/or services in multiple classes, Applicant submit an appropriate additional filing fee. Each of these issues is addressed below.

**I. AMENDMENT**

Applicant amends the Identification of Goods and Services in the Application with respect as follows (deleted language shown in ~~strike through~~ and added language shown in **bold, underlined**) (as amended, "Applicant's Goods and Services"):

- ~~**Class 9:** Computer software used to input customer contacts and schedule appointments in the field of utility service industry~~
- **Class 42:** Providing temporary access to non-downloadable computer software used to input customer contacts and schedule appointments in the utility services industry

## II. DISCUSSION

### A. Identification of Goods and Services

The above-referenced amendments to the Application clarify, but do not expand, the identification of goods listed in the Application as filed, and are believed to be acceptable.

### B. No Likelihood of Confusion

The Examining Attorney has refused registration of the Application under Trademark Act Section 2(d) based on an alleged likelihood of confusion with the marks (the “Cited Marks”) listed in the following registrations (the “Cited Registrations”):

- Reg. No. 3355184: SCHEDULEPROS & Design (SCHEDULE disclaimed), covering appointment scheduling services
- Reg. No. 5776418: PROSCHEDULER, covering providing on-line non-downloadable software for remote self-service exam scheduling from any device

Applicant submits that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks.

When evaluating likelihood of confusion, *In re E.I. DuPont de Nemours & Co.* provides a non-exclusive list of thirteen factors, which, when of record, must be considered. 476 F.2d. 1357, 1361; 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). However, not all of the *DuPont* factors are relevant in every case. *Id.* The relevant *DuPont* factors in this case include (1) the strength of the cited mark(s); (2) the similarity or dissimilarity between the parties’ respective marks, (3) the similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use, (4) the number and nature of similar marks in use on similar goods, and (5) consumer sophistication. Each of these factors will be considered below.

1. The Strength of the Cited Marks. Each of the Cited Marks consists of a combination of variations on the literal components SCHEDULE and PRO. As noted by the disclaimer of the term SCHEDULE in Cited Registration No. 3355184, that term is entirely descriptive of

software that performs a scheduling function. Further, the term PRO suggests that the goods and services offered by the owners of the Cited Marks are of a very high quality, sufficient for use by, or at the level of, a professional. Such suggestive terms are typically considered weak, and entitled to a narrow scope of protection. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). The combination of the weak term PRO with the generic term SCHEDULE results in an equally weak overall mark.

Further, the USPTO's records reveal multiple parties with registered marks that combine these two terms. In addition to the two Cited Registrations, Reg. No. 3261166 (copy attached), for the mark EPRO SCHEDULER, covers software for automated scheduling, timekeeping and payroll management. Also, a cursory Internet search reveals several third party uses of scheduling software under marks containing "Schedule" and "Pro":

- PROScheduler (<http://demoschedule.nwpa.net/>)
- Pro Schedule (<https://www.cybermatrix.com/pstestimonials.html>)
- BioProScheduler (<http://www.bioproscheduler.com/>)
- Ministry Scheduler Pro  
(<https://www.rotundasoftware.com/ministryschedulerpro/feedback/webTerminalSurveyResults/24200>)
- ProScheduler (<https://www.capterra.com/p/171644/ProScheduler/>)

These uses (excerpts attached) demonstrate that the combination of "Pro" and "Schedule" is diluted in the scheduling software field, which provides further support for the conclusion that the Cited Marks are only entitled to a narrow scope of protection. *See id.*

## 2. Comparison of The Parties' Marks.

Though Applicant's Mark, SCHEDULEPRO, shares the literal elements SCHEDULE and PRO with the Cited Marks, the Cited Marks each contain significant and important differences. First, the cited SCHEDULEPROS & Design mark contains a significant and distinctive design element:



Second, the shared terms in the other Cited Mark, PROSCHEDULER, are transposed and the term SCHEDULE has been changed to SCHEDULER. In light of the weak and diluted nature of the Cited Marks, these differences contribute to significantly different overall commercial impressions between the marks.

### 3. Comparison of the Parties Goods and Services.

While both Cited Registrations, and the present Application, cover software and services in the scheduling field, there are meaningful differences in the noted goods and services. For example, while Applicant's software and services are focused on customers in the utility industry, the services listed in Cited Registration No. 5776418 focus on remote self-service exam scheduling. Those services clearly target end users (apparently students, according to the specimens submitted during prosecution), which are entirely different from the utility service providers who are the customers of Applicant's software and services.

### 4. Purchaser Sophistication

As noted in the description of goods and services for the Application, Applicant's business focuses on customers in the utility services field. Those customers are sophisticated businesses, and the nature of Applicant's software makes the acquisition and installation process for software like that identified in the Application expensive and iterative. That in turn meaningfully reduces any likelihood of confusion between Applicant's Mark and either of the Cited Marks. *See, e.g., Electronic Design & Sales Inc. v. Electronic Date Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

### **III. CONCLUSION**

Based upon the foregoing, Applicant submits that it has addressed each of the issues raised in the Office Action and respectfully requests that Applicant's Mark be allowed to proceed to publication. If there are any remaining concerns with respect to this Application, please contact the Attorney of Record.