I. Introduction

The Examining Attorney has preliminarily partially refused registration of classes 9 and 42 under Section 2(d) of the Lanham Act based on the Examining Attorney's position that Applicant's use and registration of the mark PRONTO (Application No. 88761291) (the "Mark") is likely to cause confusion with the mark identified in U.S. Registration No. 6010667 for PRONTO (the "Cited Registration"). At the outset, Applicant notes that the Examining Attorney has also raised U.S. Registration No. 4486868 as a basis for refusal under Section 2(d), however, the registrant has failed to submit its required maintenance filing so the registration should be cancelled and removed as a basis for refusal.

As discussed below, Applicant's proposed registration for the Mark is unlikely to cause confusion with the Cited Registration because the shared term "pronto" is conceptually-weak in the field of information technology and computer software related goods and services and the Mark and the Cited Registrations are not confusingly similar overall.

II. Analysis

In making a determination of likelihood of confusion, the Examining Attorney must consider "all of the known circumstances surrounding use of the mark[s]," and "each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases." *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). Nonetheless, the Court in *DuPont* listed a number of factors to consider in determining whether a likelihood of confusion exists between two marks under Section 2(d), of which, the following factors are most relevant to this Office Action response:

1. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; and
2. The number and nature of similar marks in use on similar goods; and

See id. As discussed below, when the above factors are properly considered, Applicant's Mark is unlikely to create confusion with the Cited Registration.

A. The Consumers for Applicant's Software are Vastly Different from Registrant's Software, but both are Sophisticated and Likely to Select Services with Sophistication and Considerable Care.

The issue of whether a likelihood of confusion exists centers around whether people, not goods, are confused. *See In re Amsted Indus., Inc.,* 972 F.2d 1326 (Fed. Cir. 1992). When marks will not be encountered by the same customers in the same channels of trade, the marks are not confusingly similar.

1

Electronic Data Systems Corp. v. EDSA Micro Chip, 23 USPQ2d 1460, 1465 (TTAB 1992). As discussed below, people are unlikely to confuse Applicant's Mark with the Cited Registration because of the types of consumers and nature through which Applicant and the Registrant offer their respective goods and services.

The target consumers and distribution channels for Applicant's goods and services and the goods and services offered under the Cited Registration are so different that confusion is unlikely. As specified in the application for the Mark, the functionality of Applicant's software relates to driver assistance solutions. Consumers of Applicant's software are likely to be professionals in the transportation and shipping industries looking for autonomous vehicle solutions. In contrast, a review of Registrant's website clarifies that it is an enterprise resource planning (ERP) software provider. Attached as Exhibit 1 is a printout of from Registrant's website accessed at https://www.pronto.net/about-pronto-software on September 29, 2020. The consumers of Registrant's software appear to be enterprises looking for a solution to use to collect, store, manage, and interpret data from its business activities. In short, the software solutions provided under the Mark and Cited Marks are so niche and specialized that any overlap in consumers would be incidental; a consumer looking for an ERP provider would not seek out Applicant nor would a consumer looking for an autonomous vehicle software solution seek out Registration.

Indeed the only commonality between Applicant's and Registrant's likely consumers are that each are dissimilar groups of sophisticated and careful consumers. As the TTAB has noted, important and expensive services "which are likely to be purchased only with care and deliberation after investigation to determine their suitability for specific needs," are less likely to be confused than if the marks are used "to identify inexpensive, over-the-counter items likely to be orally requested in retail stores." *In re Software Design, Inc.*, 220 USPQ 662, 663 (TTAB 1983).

Here, none of parties' respective goods or services are impulse buys. Rather, likely consumers of products and services offered under both Applicant's Mark and the Cited Registration are dissimilar groups of sophisticated and careful consumers. The amount of due diligence and attention given to the purchase or adoption of these types of goods and services is a strong barrier against confusion. Such a high level of care prevents a likelihood of confusion about the source of any party's goods and services.

2

Although the parties both offer software, such are used for entirely different niche purposes and markets, further rendering confusion between the parties' marks unlikely. Courts recognize that distinct product niches within the same general product category can render confusion unlikely, even if the marks are identical or very similar. *See Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.,* 269 F.3d 270 (3d Cir. 2001). In *Checkpoint Systems,* the plaintiff was a manufacturer and distributor of commercial electronic security control systems designed to track the physical location of goods and sold to retailers to prevent merchandise theft. The defendant was a developer and distributor of security "firewall" technology software products. The plaintiff alleged that the defendant's use of the mark "Check Point" on security software products would be likely to create confusion as to the source of the parties' respective goods, since both parties operate in the corporate security industry. The court held, however, that there was no likelihood of confusion as to the source of the parties' respective goods. In so holding, the court stated:

> *Goods may fall under the same general product category but operate in distinct niches. When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that consumers are not likely to assume the products originate from the same mark.… Check Point Software's firewall technology is not intended to prevent theft of merchandise or limit physical access. Its purpose is to prevent third parties from accessing information from unsecure computer lines. Because the products serve different functions, and there is only "minimal overlap" in the product technology, it is unlikely consumers would be confused by the similar marks.*

Id. at 288.

The same is true here. The parties' respective software solutions are entirely different and unrelated and of types that would not typically originate with a common source, rendering confusion unlikely. The only overlap in characteristics of the goods and services provided under the Mark and the Cited Registration is that both have some relationship to software. There is no inherent overlap between ERP software and driver assistance software. In short, due to the niche functionalities of Applicant's and Registrant's respective goods, the distinctions in each mark owner's likely customers make confusion highly unlikely.

B. The Cited Registration is Not Entitled to a Broad Scope of Protection.

The highly suggestive term "pronto" is commonly incorporated into marks used in connection with the information technology and computer software related goods and services in classes 9 and 42

covered by the Cited Registration. As a result, the term "pronto" is diluted and therefore the Cited Registration is not entitled to a broad scope of protection.

The term "pronto" is an adverb meaning "quickly and without delay." Attached as <u>Exhibit 2</u> is a printout of Cambridge Dictionary's definition of "pronto" accessed at

https://dictionary.cambridge.org/us/dictionary/english/pronto on September 29, 2020. A merely descriptive or highly suggestive term is inherently weak and the scope of protection extended to marks incorporating such terms should be so limited as to permit the subsequent use or registration of similar composite marks comprising the same or similar term. Providers of information technology and computer software related goods and services are unquestionably interested their solutions being associated with being provided "quickly" or "without delay." Indeed, the adoption of PRONTO in trademarks covering information technology and computer software related goods and services in classes 9 and 42 is hardly unique to the owner of the Cited Registration, which already coexists with several other registrations for marks incorporating the term "pronto" for information technology and computer software related goods and services that are at least as similar to the goods and services covered in the Cited Registration as those for which Applicant seeks registration for its Mark:

Mark	Reg. No./ App. No.	Owner	Relevant Goods/Services
PRONTO	5059091	Stalker Software Inc. AKA CommuniGate Systems	Class 9: Software for communicating among electronic devices; Software for communicating with electronic devices.
Pronto!	3843475	Stalker Software, Inc.	Class 9: Software for communicating among electronic devices; Software for communicating with electronic devices.
PRONTO	5291701	P&R Dental Strategies, LLC	Class 42: Computer services, namely, providing search platforms to allow users to access profiles of dental provider practice patterns, denial rates and fraud and abuse gaming patterns for determining the likelihood that a dental claim will result in savings if reviewed; Software as a service (SAAS) services featuring software for providing online business intelligence and decision support solutions to the dental industry by combining information from various databases and proprietary algorithms to support the review and prioritization of daily claims volume targeted for clinical review and/or adjudication edits; Software as a service (SAAS) services featuring software for profiling of dental provider practice patterns into a proprietary predictive savings analysis that determines the relative likelihood that a dental claim will result in savings if reviewed; Software as a service (SAAS) services featuring software for providing access to an analytics engine which evaluates a dental payer's daily claims volume in near real-time, predicts which dental claims have the highest probability of delivering savings for the dental payer and which should be sent for utilization review

Mark	Reg. No./ App. No.	Owner	Relevant Goods/Services
PRONTO	4778419	Federal Transit, Inc.	Class 9: Computer application software for smartphones and tablets, namely, software for reserving transportation for chauffeur driven vehicles; Downloadable mobile applications for reserving transportation for chauffeur driven vehicles
PRONTO!	4186635	C3 SoftWorks	Class 9: Computer game software.
PRONTOFORMS	4052215	PRONTOFORMS INC.	Class 42: Providing temporary use of non-downloadable computer software applications for mobile phones and portable devices allowing a user to create and use customized and generic forms; computer software development in the field of mobile applications
PR PRONTO!	5120206	PointRight Inc.	Class 9: Downloadable software for use in the analysis of healthcare data for business purposes and for preparing reports relating thereto; downloadable software for use in the assessment and calculation of patients' re-hospitalization risk from analysis of healthcare data from patients being discharged from hospitals to skilled nursing facilities or to other post-acute settings; downloadable software for use in the assessment and calculation of patients' risk of re-hospitalization and identification and evaluation of post-acute care options with corresponding re-hospitalization risk assessments.
PRONTORX	6050990	KloudScript, Inc.	Class 42: Software as a Service (SAAS) featuring online software for managing patient medical information, enabling prescriber communication with patients, pharmacies and doctors, and enabling patient engagement with prescribers, doctors, and pharmacies.
PRONTO CX	5874658	Pronto CX, Inc.	Class 9: downloadable mobile applications and downloadable computer software in the field of sports and entertainment for facilitating and enabling electronic payment transactions and data transmission for processing closed loop, contactless, cashless electronic payment transactions with NFC tags, electronic transactions for micropayments, electronic mobile payment transactions for mobile wallets, namely, credit and debit cards, prepaid stored value cards, and for processing and tracking sporting and entertainment event ticket sales and mobile tickets sales and ordering; downloadable mobile applications and downloadable computer software in the field of sports and entertainment for venue logistics, namely, user access management and control of entry to sporting and entertainment venues and parking facilities; downloadable mobile applications and downloadable computer software in the field of sports and entertainment for managing data on electronically encoded loyalty and rewards membership cards, club identification cards, membership identification cards, personal identification cards, and encryption, decryption and authentication of identification information for the foregoing; downloadable mobile applications and downloadable computer software in the field of sports and entertainment for facilitating and enabling fan engagement for customer relationship management, accessing and tracking social media accounts, brand amplification via transmission of electronic advertisements, digital marketing and advertising via placement of online advertisements; excluding software for communicating among and with electronic devices and information transmission via electronic communications networks and excluding software in the field of enterprise resource planning. Class 42: Providing temporary use of non-downloadable cloud-based software in the field of sports and entertainment for facilitating and enabling electronic payment transactions and data transmission for processing closed loop, contactless, cashless electronic payment transactions with NFC tags, electronic transactions for micropayments, electronic mobile payment transactions for mobile wallets, namely, credit and debit cards, prepaid stored value cards, and for processing and tracking sporting and entertainment event ticket sales and mobile tickets sales and ordering; providing temporary use of non-downloadable cloud-based software in the field of sports and entertainment for venue logistics, namely, user access management and control of entry to sporting and entertainment venues and parking facilities; providing temporary use of non-downloadable cloud-based software in the field of

Mark	Reg. No./ App. No.	Owner	Relevant Goods/Services
			sports and entertainment for managing data on electronically encoded loyalty and rewards membership cards, club identification cards, membership identification cards, personal identification cards, and encryption, decryption and authentication of identification information for the foregoing; providing temporary use of non-downloadable cloud-based software in the field of sports and entertainment for facilitating and enabling fan engagement for customer relationship management, accessing and tracking social media accounts, brand amplification via transmission of electronic advertisements, digital marketing and advertising via placement of online advertisements; excluding software for communicating among and with electronic devices and information transmission via electronic communications networks and excluding software in the field of enterprise resource planning.

Copies of the registration certificates for these registrations are attached as Exhibit 3.

Each of these already coexisting registrations claims various information technology and computer software related goods and services that are arguably covered by the broad wording "Computer software design, development, consultation, installation and maintenance; information technology services, namely, information technology consultation; planning, design and management of information technology systems" and "computer software design, development, consultation, installation and maintenance services, including in the field of mobile applications; other information technology services, namely, providing information regarding information technology (IT) and the planning and design of information technology systems; computer technological and software consultancy services" reflected in the Cited Registration. However, in each case, the Trademark Office determined such could coexist on the Principal Register with the Cited Registration without confusion in an apparent recognition of the principal that "in a 'crowded' field of look-alike marks, each member of the crowd is relatively 'weak' in its ability to prevent use by others in the crowd." 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11.85 (5th ed. 2017).

The coexistence of the various PRONTO marks that are at least as similar to the Cited Registration as Applicant's Mark demonstrates that consumers regularly encounter information technology and computer software related goods and services offered under branding that incorporates PRONTO and are able to differentiate between these various uses easily. Given the significance of the meaning of "pronto" in the information technology and computer software field, the fact that information technology and computer software consumers regularly encounter various PRONTO marks is not surprising. Indeed, the TTAB recognizes that third-party registrations may suggest a term has descriptive

significance as applied to certain goods or services. TMEP ¶ 1207.01(d)(iii) *and cases cited therein*; *and see In re Box Solutions Corp.,* 79 USPQ2d 1953, 1955 (TTAB 2006) ("[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry"). Thus, it is highly unlikely that consumers would confuse the Cited Registration with Applicant's Mark.

Such widespread use of commonly used elements has been found by the TTAB to minimize the likelihood of confusion that might otherwise result from marks that contain a shared term. For example, in *National Cable Television Association, Inc. vs. American Cinema Editors, Inc.*, the Court recognized that

> *Where a mark is commonly used on numerous types of goods and services by different companies, a term such as PREMIUM, SUN, BLUE RIBBON, NATIONAL, GIANT or AMERICAN, it may be reasonable to infer in some situations that purchasers have been conditioned to expect different sources for specifically different goods or services even though such goods or services might be deemed sufficiently related to be attributable to a single source under an uncommonly used mark. … This is not because of some kind of mechanically applied rule, but because the determination of likelihood of confusion involves, to the extent possible, an evaluation of what happens in a real world setting.*

19 U.S.P.Q.2d 1424 (Fed, Cir. 1991). In the instant case, the term PRONTO is commonly used on various information technology and computer software related goods and services such that consumers have been conditioned, and are able, to distinguish among various PRONTO marks without confusion. The strongly suggestive nature of the term "pronto" (*i.e.,* referring to something being done quickly and without delay) and common use within the information technology and computer software industries evidences that confusion between the Cited Registration and the Mark is unlikely ***in a real world setting***. In short, the Cited Registration cannot bar the registration of every mark that incorporates the term "pronto" used in connection with information technology and computer software related goods and services and Applicant's use of the Mark is unlikely to cause confusion.

III.   Conclusion

Taken singularly, any of the above-described distinctions should be adequate to demonstrate that confusion is unlikely. When these elements are taken together, it is evident that Applicant's Mark is not confusingly similar to the Cited Registration and Applicant's Mark is registrable. In light of the above, Applicant respectfully requests that the Examining Attorney withdraw the refusal and allow Applicant's Mark to proceed to registration.