

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

PricewaterhouseCoopers LLP

Mark: PROEDGE (Class 35)

Serial No.: 90/087,017

Filing Date: November 24, 2020

Trademark Atty: Teague Avent

Law Office: 125

**RESPONSE TO OFFICE ACTION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

This communication is being filed in response to the office action issued November 24, 2020.

**ARGUMENT**

The Examining Attorney has suspended Applicant's application for PROEDGE on the grounds that it may be confusingly similar to U.S. Registration No. 5399303 for PROEDGE. As set forth below, Applicant respectfully submits that PROEDGE does not pose a likelihood of confusion with aforementioned registered trademark. Additionally, the Examining Attorney identified a portion of the description of Applicant's services that is indefinite and must be clarified. Accordingly, Applicant proposes to amend the description of Applicant's services as set forth below.

**I. There is No Likelihood of Confusion with the Registered Mark.**

The Examining Attorney has suspended Applicant's application for PROEDGE on the grounds that it may be confusingly similar to U.S. Registration No. 5399303 for PROEDGE (the "Central Valley Mark"), owned by Central Valley Ag Cooperative ("Central Valley"). Applicant

has elected to submit arguments to illustrate why there is no potential conflict between its mark and the Central Valley Mark.

In evaluating the likelihood of confusion between two marks, the Examining Attorney must both (1) look at the marks themselves for similarities in appearance, sound, connotation, and commercial impression, and (2) compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Based on an analysis of those factors, Applicant respectfully requests the Examining Attorney to reconsider the conclusion that there may be a likelihood of confusion between Applicant's mark and the Central Valley mark. The different commercial impressions of the marks themselves combined with the unrelated services to be offered under each mark in different fields negate any likelihood of confusion between them.

**A. The Marks Have Different Commercial Impressions In Light of their Different Fields of Use.**

Most significantly negating any potential for confusion between Applicant's mark and the Central Valley Mark is the fact that each party's services are offered in different and unrelated fields. When viewed in the contexts of their respective fields, the marks, though identical in appearance, take on diverging meanings and commercial impressions that will be readily apparent to consumers. Different meanings are a key factor in determining whether two marks are confusingly similar. Significantly, in some instances, even identical or closely similar marks will not in fact give rise to a likelihood of confusion because the meaning they convey in each context will point in distinctly different directions. "Such differences of connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used." *Revlon, Inc. v. Jerell, Inc.*, 11 U.S.P.Q.2d 1612, 1616 (S.D.N.Y. 1989) (holding no confusion between THE NINES for cosmetics and INTO THE NINETIES for wearing apparel). Specifically, "differences in connotation can outweigh visual and phonetic similarity." *Coach*

*Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (finding that COACH for luxury leather goods and COACH for educational materials created distinct commercial impressions despite being identical in sound and appearance).

**1. The Central Valley Services Are Offered in the Agricultural Production and Grain Marketing Field.**

The Central Valley Mark is registered in Class 35 for “Business consulting in the agricultural field; business marketing consulting services; grain market analysis; marketing analysis services; marketing consultation in the field of grain and commodity marketing; marketing consulting; providing business marketing information.”

The Central Valley Mark services are expressly described as business consulting services in the field of agriculture and grain marketing. When viewed in light of these agriculture-related services, the Central Valley Mark has a particular commercial impression, as “PRO” in the mark calls to mind agriculture “producers.” (See Exhibit A, [https://en.wikipedia.org/wiki/Producer\\_\(agriculture\)](https://en.wikipedia.org/wiki/Producer_(agriculture)); see also Exhibit B, [https://www.nass.usda.gov/Publications/Highlights/2019/2017Census\\_Farm\\_Producers.pdf](https://www.nass.usda.gov/Publications/Highlights/2019/2017Census_Farm_Producers.pdf).) Additionally, the industry-specific terms “grain market analysis” and “grain and commodity marketing” in the description of Central Valley’s services refer to the practice of using futures contracts to purchase grain and other commodities, which helps farmers hedge against volatile prices. (See Exhibit C, <https://farmlogs.com/education/>; see also Exhibit D, <https://www.cvacoop.com/grain>.) The inclusion of such terms specific to the agriculture industry further demonstrates that the registrant’s services are centered around agriculture production. Furthermore, this meaning is also clear in the context of the entity who uses the mark—Central Valley Ag Cooperative. The registrant signals by its name that it is in the agricultural field, and its use of PRO in its mark signals that it offers consulting services relating to the business of agriculture production.

When viewed in the context of Central Valley’s industry, the mark PROEDGE calls to mind agricultural *production* as an aspect of business consulting services. This meaning and

commercial impression will be readily apparent to consumers encountering the mark in the context in which it will be used, as delineated by the services in the registration.

**2. Applicant's Services Are Offered in the Technology Business Enterprise Field.**

Applicant's services, on the other hand, are shown on their face to be in the field of professional business services. Applicant's mark is in Class 35 for "Business consulting services in the field of conducting initiatives that enables citizen- and business-led innovation through accelerated development of lightweight technology solutions using a robust, standardized, and integrated development methodology; technology consulting services in the field of emerging technology." Applicant's consulting services are in the field of enabling companies and their employees to innovate and develop technology for their enterprises. These services are offered in a professional business setting. When used in connection with these services and in this field, the term PRO in Applicant's mark has a vastly different commercial impression from PRO as used by Central Valley. In Applicant's mark, when used in the technology business enterprise field in connection with consulting services, PRO suggests professionals in the corporate workforce generally, in the sense of a "professional" who undergoes education and training and adheres to professional standards of practice. (See Exhibit E, <https://dictionary.cambridge.org/us/dictionary/english/professional> (defining "professional" as "a person who has the type of job that needs a high level of education and training."); see also Exhibit F, <https://en.wikipedia.org/wiki/Professional> (describing the professional practice and ethics standards to which some professionals are subject).) Thus, when used in the context of Applicant's field, PROEDGE calls to mind *professional* development of technology solutions as an aspect of business consulting services.

This meaning will be readily apparent to consumers not only based on the services offered by Applicant, as indicated in its application, but also based on the identity of Applicant, PricewaterhouseCoopers ("PwC"). PwC is an international, widely known professional services firm. Any consumer seeing PwC using the word PRO to offer services will know that PwC is

referring to professionals in business enterprises, as opposed to agricultural producers. The “professionals” in PwC’s spheres may be, for example, consultants, accountants, financial analysts, technologists, or other corporate professionals —different from the “producers” targeted by the Central Valley Mark: farmers, agricultural producers, and agronomists.

As reflected by Applicant’s and Central Valley’s different services, the nature of the different entities that will use these marks, and the different consumers to which the services are offered, the respective fields of use of Applicant and the registrant are distinguishable. Therefore, despite the fact that the marks are identical in appearance, Applicant’s mark and the Central Valley Mark have different commercial impressions in light of their different fields of use.

**B. The Services Offered Under Each Mark Are Unrelated.**

In addition to operating in unrelated fields, Applicant and Central Valley offer different services under their marks, as is apparent in the application and registration, respectively. The Central Valley services are “Business consulting in the agricultural field; business marketing consulting services; grain market analysis; marketing analysis services; marketing consultation in the field of grain and commodity marketing; marketing consulting; providing business marketing information.” The registrant’s consulting and analytical services are centered on agricultural production and grain marketing, rather than business consulting and marketing more generally. Moreover, as discussed above, the terms “grain market analysis” and “grain and commodity marketing” refer to the industry practice of using futures contracts to purchase grain and other commodities, which is used by farmers to hedge against volatile prices. *See Exhibit C; see also Exhibit D.*) This further demonstrates that the registrant’s marketing services are centered around agriculture production, and not general business marketing.

Applicant’s business consulting services bear no resemblance to the Central Valley services. Applicant’s consulting services are specifically to enable companies and business professionals to enhance their technology skills and innovate in the business enterprise field. The description of Applicant’s services does not include the words “agricultural” or “marketing,”

and Applicant's services do not relate to the agricultural industry. Rather, Applicant's PROEDGE consulting services are intended to help businesses and business professionals to improve and harness their technology skills to innovate for their enterprises. Moreover, the evidence cited by the Examining Attorney suggesting that "marketing consulting" and "technology consulting services" are commonly provided by the same entity is not applicable to the actual services provided by Central Valley as set forth in the description of Central Valley's services. Such assertion ignores the fact that Central Valley's marketing and consulting services are not *general* marketing and consulting services, but rather are consulting services specific to the agriculture production industry and "grain marketing." There is simply no overlap between the Central Valley agricultural consulting and grain marketing services and Applicant's technology business consulting services.

Moreover, the "similarity between products focuses on whether the buying public thinks or expects the products to come from the same source." *Sullivan v. CBS Corp.*, 385 F.3d 772, 778 (7th Cir. 2004). As noted above, Applicant (PwC) is an international, widely recognized professional services firm, whereas the registrant (Central Valley) is an agricultural cooperative. No rational consumer would be confused as to the source of Applicant's services.

The fact that Applicant's and Central Valley's respective services are unrelated, noncompetitive, and offered in different fields negates any possible likelihood of confusion between their sources. It is axiomatic that confusion is unlikely even between marks that are identical or similar if the goods and services are different and noncompetitive. *See Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 925 (10th Cir. 1986) ("[V]ery similar marks may not generate confusion as to the source of the products where the products are very different . . . .").

**C. Applicant's and the Registrant's Respective Services Are Offered In Different Channels of Trade.**

Given their different fields, Applicant's services and the services under the Central Valley Mark are unrelated and noncompetitive, and will be offered in different channels of trade.

Goods and services are related when there is “likely to be sufficient overlap of the respective purchasers of the parties’ goods and services to confuse actual and potential purchasers.” *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992). In this instance, the Central Valley Mark indicates its intended consumers in its description of services: farmers, agricultural producers, agronomists, and grain purchasers. In contrast, Applicant’s services are offered to corporate business professionals. There is not likely to be overlap of the respective consumers or in these channels of trade, and thus the services offered by each applicant are unrelated and noncompetitive. This factor dictates that there is no potential likelihood of confusion between the source of Applicant’s services under its mark and source of the Central Valley services under its mark.

Finally, a further *DuPont* factor also demonstrates no likelihood of confusion: the purchasers of Applicant’s and Central Valley’s services are highly sophisticated consumers who purchase with great care. Where purchases reflect careful, sophisticated purchasing versus “impulse” purchases, consumer confusion is less likely. *DuPont*, 476 F.2d at 1361; TMEP § 1207.01(d)(vii) (explaining that where goods are bought in circumstances suggesting care in purchasing, likelihood of confusion is minimized). The professionals in both the agriculture and the business professional fields who are seeking services related to agricultural production or to their corporate technology endeavors, respectively, are sophisticated consumers who are not likely to be confused about the source of these services.

Realistically, there is simply no overlap between the two consumer bases of Applicant’s services and the Central Valley services, and considering the differences in the fields and their channels of trade, there is no potential likelihood of confusion between the marks.

## **II. Applicant Proposes to Amend the Description of the Services.**

The Examining Attorney indicated that the wording “technology consulting services in the field of emerging technology” is indefinite and must be clarified. Accordingly, Applicant proposes to revise the description of the services as follows: “Class 35: Business consulting services in the field of conducting initiatives that enables citizen- and business-led innovation

through accelerated development of lightweight technology solutions using a robust, standardized, and integrated development methodology; **technology consulting services related to technology solutions development in the emerging technology field.**”

Applicant respectfully submits that the description of Applicant’s services, as revised, is not indefinite. As this revision is within International Class 35, it is not necessary for Applicant to add International Class 42 to the application.

#### COMMENTS

It is believed that Applicant has responded to all of the Examining Attorney’s questions and objections and that the application is now in condition to go forward to publication.

If the Examining Attorney has any questions or wishes to discuss any of the information contained herein, so as to expedite matters, the Examining Attorney is requested to telephone the undersigned at \_\_\_\_\_.

Respectfully submitted,

Dated: DATE            By: