

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

PricewaterhouseCoopers LLP

Mark: PROEDGE (Class 42)

Serial No.: 90/087,019

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 Nos. 5109610 and 3901397 for PROEDGE. As set forth below, Applicant respectfully submits that PROEDGE does not pose a likelihood of confusion with aforementioned registered trademarks. 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 Marks.

The Examining Attorney has suspended Applicant's application for PROEDGE on the grounds that it may be confusingly similar to U.S. Registration No. 5109610 for PROEDGE (the

“ProEdge Mark”), owned by ProEdge, LLC, and U.S. Registration No. 3901397 (the “Zodiac Mark”), owned by Zodiac Pool Systems LLC (“Zodiac”). Applicant has elected to submit arguments to illustrate why there is no potential conflict between its mark and the aforementioned registered marks.

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 ProEdge Mark and Zodiac 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 ProEdge Mark and Zodiac 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 ProEdge, LLC Services Are Offered in the Legal Services Field.

The ProEdge Mark is registered in Class 42 for “Providing temporary use of a web-based software application for use in billing, timekeeping, and client management for legal services.”

The ProEdge, LLC services are expressly described as a software application in the field of legal services, specifically for use by attorneys, paralegals and legal assistants in billing, timekeeping, and client management. When viewed in light of these legal services, the ProEdge Mark has a particular commercial impression, as “PRO” in the mark is suggestive of legal professionals. (See Exhibit A, https://en.wikipedia.org/wiki/Legal_profession.) When viewed in the context of ProEdge, LLC’s industry, the mark PROEDGE calls to mind legal professional services as an aspect of a software application. 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. The Zodiac Services Are Offered in the Construction and Project Management Field.

The Zodiac Mark is registered in Class 42 for “Providing temporary use of non-downloadable computer software for construction and project management, namely, software for tracking, managing, editing, monitoring, maintaining and sharing information and data in the field of construction and project management; providing temporary use of non-downloadable computer software for tracking sales leads and contact information, vendor information, contractor and subcontractor information, job scheduling, job status, job records, work orders, contacts, equipment, costs, warranties, and accounting in connection with construction and project management, and training manuals sold in connection therewith.”

The Zodiac services are expressly described as a software application in the field of construction and project management. When viewed in light of these construction and project management-related services, the Zodiac Mark has a particular commercial impression, as “PRO” in the mark suggests “project” management. (See Exhibit B, <https://www.oxfordreference.com/view/10.1093/oi/authority.20110803100349325>.) This meaning will also be clear in the context of the entity who will use the mark—Zodiac Pool Systems LLC. The registrant signals by its name that it is in the pool construction field, and the use of “PRO” in its mark signals that it offers software services relating to construction project management, specifically “tracking, managing, editing, monitoring, maintaining and sharing information and data” and “tracking sales leads and contact information, vendor information, contractor and subcontractor information, job scheduling, job status, job records, work orders, contacts, equipment, costs, warranties, and accounting.”

When viewed in the context of Zodiac’s industry, the mark PROEDGE calls to mind construction project management services as an aspect of a software application. This meaning and commercial impression will be readily apparent to consumers encountering the mark in the context in which it will be used, as outlined by the services in the registration.

3. 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 42 for “Providing an online learning platform featuring non-downloadable software for professionals and organizations to engage in training, education, curricula, demonstrations, tutorials, presentations, videos, educational discussions, interactive learning content, activities, and testing of technologies related to accounting, consulting, auditing, and tax services.” Applicant’s services are in the field of providing software for companies and their employees to learn about and obtain training in various technologies as related to accounting, consulting, auditing, and tax services. 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 both ProEdge, LLC and Zodiac. In Applicant’s mark, when used in the technology business enterprise field in connection with software 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 C, <https://dictionary.cambridge.org/us/dictionary/english/professional> (defining the noun “professional” as “a person who has the type of job that needs a high level of education and training.”); *see also* Exhibit D, <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 a software platform that educates and trains general professionals to use technology solutions in a corporate environment.

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 attorneys in law firms or construction project managers. The “professionals” in PwC’s spheres may be, for example, consultants, accountants, financial analysts, technologists, or other corporate professionals—different from the attorneys, paralegals, and legal assistants targeted by the ProEdge Mark and from the construction project managers targeted by the Zodiac Mark.

As reflected by Applicant’s and the registrants’ 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 registrants are distinguishable. Therefore, despite the fact that the marks are identical in appearance, Applicant’s mark and the registrants’ marks 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, ProEdge, LLC and Zodiac offer different services under their marks, as is apparent in the application and registrations,

respectively. 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 . . .”).

1. The ProEdge, LLC Services are Legal Software Services.

The ProEdge, LLC services are “Providing temporary use of a web-based software application for use in billing, timekeeping, and client management for legal services.” As discussed above, these are *legal* services involving the provision of a software platform to assist law firms with the specific administrative tasks that attorneys and other legal professionals working in law firms must engage in: billing clients for the law firm’s services; tracking the number of hours spent by lawyers and paralegals on client matters or cases; and managing the firm’s administrative and other obligations with respect to its clients. Attorneys are subject to rules of ethics and professional practice on a jurisdiction-by-jurisdiction basis which require them, among other things, to account for their time billed to clients in a particular manner, communicate with clients in a timely fashion and keep them apprised of developments in their cases or matters, and make filing deadlines and court appearances, as applicable. (*See* Exhibit E, https://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/rule_1_5_fees/; *see also* Exhibit F, https://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/rule_1_4_communications/; *see also* Exhibit G, https://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/rule_1_3_diligence/comment_on_rule_1_3/.) Legal billing, legal timekeeping, and legal client management are administrative practices distinct to law firms and the legal profession. The ProEdge, LLC services are specifically providing a software application for particular types of individuals, namely lawyers, paralegals, and legal assistants, to

use in connection with billing, timekeeping, and managing clients in the particular field of the law and primarily in a law firm environment.

2. The Zodiac Services are Construction Project Management Software Services.

The Zodiac services are “Providing temporary use of non-downloadable computer software for construction and project management, namely, software for tracking, managing, editing, monitoring, maintaining and sharing information and data in the field of construction and project management; providing temporary use of non-downloadable computer software for tracking sales leads and contact information, vendor information, contractor and subcontractor information, job scheduling, job status, job records, work orders, contacts, equipment, costs, warranties, and accounting in connection with construction and project management, and training manuals sold in connection therewith.” As discussed above, these are *construction project management* services, including scheduling construction jobs, processing work orders and costs, managing vendors and contractors, and tracking relevant project data. Project management for construction entails overseeing a construction project from beginning to end, ensuring that goals are achieved and constraints such as costs, scheduling, and scope of work are met. (See Exhibit H, https://en.wikipedia.org/wiki/Construction_management.) The types of construction projects that might utilize project management software range from commercial and residential dwellings to industrial construction to infrastructure, and more. (See Exhibit H). The Zodiac services are specifically providing a software platform for particular types of individuals—project managers—to use in the particular field of construction.

3. Applicant’s Services Are Technology Education Software Services and Do Not Relate to the Registrants’ Services.

Applicant’s software services bear no resemblance to the ProEdge, LLC services nor the Zodiac services. Applicant’s software services are specifically to enable companies and business professionals to learn about technology and enhance their technology skills in relation to accounting, consulting, auditing, and tax services. Applicant’s online platform provides

interactive learning content relating to technology for businesses and their employees.

Applicant's software services are educational in nature, and Applicant's platform provides technology training and upskilling opportunities for business professionals and enterprises relating to accounting, consulting, auditing, and tax services.

In comparison to the ProEdge, LLC services, the description of Applicant's services does not include the words "legal services," "billing," "timekeeping," or "client management," and Applicant's services do not relate to the legal field. In comparison to the Zodiac services, the description of Applicant's services does not mention "project management" or "construction" and Applicant's services do not relate to the construction project management field. Rather, Applicant's software services are specifically providing an online platform for businesses and their employees to learn about technology and improve their technology skills as related to accounting, consulting, auditing, and tax services. There is simply no overlap between the ProEdge, LLC legal services, the Zodiac construction project management services, and Applicant's technology education software 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. In contrast, ProEdge, LLC is a legal services software company and Zodiac is a manufacturer and seller of residential and commercial pools and pool equipment and construction project management software related thereto. (*See* Exhibit I, <https://www.proedge360.com/>; *see also* Exhibit J, <https://www.fluidrausa.com/en/company>; *see also* Exhibit K, <https://www.fluidrarewards.com/en/business-tools/proedge-build#>.) No rational consumer would be confused as to the source of Applicant's services.

The fact that Applicant's and the registrants' respective services are unrelated, noncompetitive, and offered in different fields negates any possible likelihood of confusion between their sources.

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

Given their different fields, Applicant's services and the services under the registrants' marks 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 ProEdge Mark and the Zodiac Mark indicate their intended consumers in the descriptions of their services: with respect to ProEdge, attorneys, paralegals, and legal assistants primarily in law firms, and with respect to Zodiac, construction project managers.

In contrast, Applicant's services are offered to corporate business professionals. Contrary to the assertions of the Examining Attorney, Applicant's software services are not unrestricted "as to nature, type, channels of trade, or classes of purchasers," but rather are limited to an "online *learning* platform" for "professionals and organizations" to engage in education and training in the field of "technologies related to accounting, consulting, auditing, and tax services." 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 sources of the registrants' services under their respective marks.

Finally, a further *DuPont* factor also demonstrates no likelihood of confusion: the purchasers of Applicant's and the registrants' 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 the legal services field, construction project management field, and business professional field who are seeking services

related to attorney administrative practices, managing construction builds, or 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 consumer bases of Applicant's services and the registrants' services, and considering the differences in the fields and their channels of trade, there is no potential likelihood of confusion among the marks.

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

The Examining Attorney indicated that the description of the services is indefinite and must be clarified to further specify the nature of the platform and the activities performed. Accordingly, Applicant proposes to revise the description of the services as follows: "Class 42: Providing an online learning platform **in the nature of Software as a service (SaaS)** featuring non-downloadable software for professionals and organizations to engage in training, education, curricula **development, video** demonstrations, tutorials, presentations, videos, educational discussions, interactive learning content, **educational and upskilling** activities, and testing of technologies related to accounting, consulting, auditing, and tax services."

Applicant respectfully submits that the description of Applicant's services, as revised, is not indefinite.

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: