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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Empower Software Solutions, Inc.

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Serial Nos. 77717283
77717320
77717331[1]

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John C. Linderman of McCormick Paulding & Huber LLP for Empower Software Solutions, Inc.

Julie Watson, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

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Before Bucher, Kuhlke and Adlin, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On April 20, 2009, applicant, Empower Software Solutions, Inc., filed intent-to-use applications under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register on the Principal Register the following marks (emphasis added):

> Application Serial No. 77717283 for the mark EMPOWER SOFTWARE SOLUTIONS in standard characters with SOFTWARE SOLUTIONS disclaimed for "software for scheduling tasks among personnel, forecasting personnel needs for anticipated tasks, delegating tasks among personnel**, tracking performance of**

[1] Because these proceedings involve the same applicant and present similar issues we are issuing our determination as to each application in a single decision.

> **assigned tasks**, establishing collaboration and coordination among personnel in the performance of tasks, employee time and attendance management, and tax compliance" in International Class 9; "business management services provided via the internet, namely, scheduling tasks among personnel, forecasting personnel needs for anticipated tasks, **delegating tasks among personnel, tracking performance of assigned tasks, establishing collaboration and coordination among personnel in the performance of tasks, employee time and attendance management**, and tax compliance" in International Class 35;
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> Application Serial No. 77717320 for the mark EMPOWERWFM in standard characters for "employee administration services via the internet, namely, forecasting, budgeting, scheduling, and **reporting the completion and the duration of employee work transactions**" in International Class 35; and
>
> Application Serial No. 77717331 for the mark EMPOWERTIME in standard characters for "employee administration services via the internet, namely, setting the duration of tasks for the interaction and collaboration of employees in work transactions, and **collecting, calculating, and reporting the duration of employee work transactions with measured benefits**" in International Class 35.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's marks, when used with its identified goods and services, so resembles the registered mark EMPOWER in standard characters for "computer software, namely, **workforce performance evaluation software which tracks individual employees' progress against a specified set of metrics and measurements**, provides for corrective action based upon those measurements, **generates statistics as to how the personnel base or segment is performing as a unit**, and provides real-time supervisor and

management views of an employee's performance" (emphasis added) in International Class 9[2] as to be likely to cause confusion, mistake or deception.

When the refusals were made final, applicant appealed and requested reconsideration in each application. After the examining attorney denied the requests for reconsideration, the appeals were resumed.

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the Marks

We begin with the *du Pont* factor of the similarities and dissimilarities between applicant's marks EMPOWER SOFTWARE SOLUTIONS, EMPOWERWFM and EMPOWERTIME and registrant's mark EMPOWER. We analyze "the marks in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) *quoting du Pont*, 177 USPQ at 567. We analyze the marks in their entireties; however, it is well settled that one feature of a mark may be more significant than

[2] Registration No. 3394945, issued on March 11, 2008.

another, and it is not improper to give more weight to this dominant feature when evaluating the similarities of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The word EMPOWER is the most prominent portion of applicant's marks. It is the first portion of the marks and the most distinctive. The added wording "SOFTWARE SOLUTIONS" is merely descriptive and appropriately disclaimed in application Serial No. 77717283. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). The lettering WFM in application Serial No. 77717320, stands for "workforce management"[3] and such meaning would certainly be perceived when the mark is used in connection with the recited services. Finally, the word TIME in application Serial No. 77717331, is, at minimum, highly suggestive of the employee time management services encompassed in the recitation of services.[4] Thus, all of the additional wording and letters simply provide "information about [applicant's goods and] services or are terms used generally for such [goods and] services" and the dominant portion of applicant's marks, EMPOWER, comprises the entirety of registrant's mark. Further, in applicant's and registrant's marks, the common element, EMPOWER, has the same connotation; the added meanings to applicant's marks merely indicate the manner

[3] Abbreviation WFM means Workforce Management. www.acronymfinder.com (Final Office Action (January 18, 2012).

[4] "The term 'TIME' is, at best, suggestive of the fact that, for example, Applicant's services are geared toward helping a corporation's decision makers collect information regarding the duration of employee tasks." App. Br. p. 8 (App. Serial No. 77717331).

in which the customer will be empowered (i.e., through a software solution) or what a customer will be empowered to measure or control (i.e., workforce management or time management). Moreover, the added meanings from WFM and TIME are also relevant to registrant's goods and, as such, do not serve to distinguish these EMPOWER marks from registrant's EMPOWER mark.

While the added wording does present some differences in appearance and sound, the overall commercial impression remains the same in view of the dominance of the word EMPOWER in the marks in each application and the relevance in meaning of WFM and TIME in Application Serial Nos. 77717320 and 77717331 to registrant's software. Thus, we find that the similarities outweigh the dissimilarities.

Number and Nature of Similar Marks in Use

Applicant argues that the term EMPOWER is weak and entitled to a limited scope of protection. However, applicant only submitted third-party registrations which are of no probative value for the *du Pont* factor showing a crowded field and relative weakness. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Moreover, as noted by the examining attorney, only two of the registrations for goods/services in the same general field include the word EMPOWER in the marks; the marks in the remaining registrations contain another form of the root word such as EMPOWERED, EMPOWERING and EMPOWERMENT. Further, the two marks that include the word EMPOWER are slogan marks, EMPOWER YOUR PROJECT WORKFORCE and EQUIP,

EMPOWER, ELEVATE, that have different commercial impressions. Finally, applicant's software and services are more distinct from the services or computer software in these third-party registrations than they are from those in the cited registration. Only third-party Reg. No. 3286317 includes arguably similar computer software for workforce management but, as noted above, the mark in this third-party registration, EMPOWER YOUR PROJECT WORKFORCE, has a much different commercial impression as it is perceived as a slogan rather than the word EMPOWER combined with the name of the goods (SOFTWARE SOLUTIONS) or services (WFM) or feature of the services (TIME).

Finally, even if we considered the term EMPOWER to be weak in the context of these goods and services, in view of the closely related goods and services, and highly similar marks, the mark in the cited registration is not so weak that it is not entitled to protection against applicant's marks. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

Relatedness of the Goods and Services/Channels of Trade/Purchasers

We turn to the factors of the relatedness of the goods and services, channels of trade and classes of customers. We base our evaluation on the goods and services as they are identified in the registrations and application. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). It is settled that it is not necessary that the

respective goods and services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods and services themselves, but rather whether they would be confused as to the source of the goods and services. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The goods and services need only be sufficiently related that consumers would be likely to assume, upon encountering the goods and services under similar marks, that the goods and services originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). Finally, it is well established that goods and services may be related. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGGS for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) ("It is clear that consumers would be likely to believe that jewelry on the one hand and retail stores selling jewelry on the other emanate from or are sponsored by the same source if such goods and services are sold under the same or similar marks.").

Applicant's computer software "**tracking performance of assigned tasks**"; and services "**delegating tasks among personnel, tracking performance of assigned tasks, establishing collaboration and coordination among personnel in the performance of tasks, employee time and attendance management"** (application Serial No. 77717283)**; "reporting the completion**

and the duration of employee work transactions" (application Serial No. 77717320)**;** and **collecting, calculating, and reporting the duration of employee work transactions with measured benefits"** (application Serial No. 77717331) and registrant's "**workforce performance evaluation software which tracks individual employees' progress against a specified set of metrics and measurements, [and] generates statistics as to how the personnel base or segment is performing as a unit"** are very similar in that they all monitor and measure employee work productivity. Registrant's software is directed to both individual performance and group performance. As written, applicant's identification for its software and services encompasses monitoring individual and group performance. Thus, on the face of the identifications, what these products and services provide is very similar; they all track employee performance of tasks. It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Applicant argues that:

> Applicant's software and business management services for large-scale workforce management versus Registrant's software for measuring individual employee performance. Applicant's and Registrant's products perform entirely distinct functions. Applicant's software and business management services are used for forecasting personnel needs, delegating tasks among personnel, tracking performance of assigned tasks, establishing collaboration and coordination among personnel, and employee time and attendance management. Thus, it is clear from Applicant's identification of goods and services that Applicant's offerings are used to oversee and manage workforce

> functions of collective groups of employees. Registrant's software provides an entirely distinct function. Registrant's identification of goods reveals that Registrant's software is used for tracking individual employees' progress against a specific set of metrics and provides feedback on those metrics. Thus, as listed in the present application and in the '945 Registration, the parties goods perform distinct functions within the broad workforce management industry. ... Rather, Applicant asserts that there is no per se rule that its goods are related to Registrant's merely because both fall under the broad umbrella of workforce management.[5]

However, applicant's identification does not exclude assessing individual employee task completion as part of assessing a unit's task completion and registrant's software includes assessing a unit's performance. It is not simply that, as identified, the goods and services "fall under the broad umbrella of workforce management." Rather, the identified goods and services are the same subset of the field of workforce management. Applicant does not contest the definition of "workforce management" retrieved from the Wikipedia website that includes the following subsets (emphasis added): "payroll and benefits, HR administration, employee self-service, **time and attendance**, career and succession planning, talent management and/or application tracking, learning management and/or training management, **performance management, forecasting and scheduling, workforce tracking** and emergency assist."[6] As can be seen from the identifications, applicant's and registrant's goods and services are not merely part of the same general field of "workforce management" but rather are directed to

[5] App. Reply Br. pp. 7-8 (App. Ser. No. 77717283).

[6] www.wikipedia.org (Final Office action January 18, 2012).

the same specific functions and both measure individual as well as group performance.

In view of the above, we find applicant's identified goods and services to be closely related registrant's identified goods.

With regard to the channels of trade, because there are no limitations in the identifications in the applications and cited registration, we must presume that they are offered in all ordinary channels of trade and to all ordinary classes of customers for those goods and services. *In re Viterra, Inc.*, 101 USPQ2d at 1908, *quoting Hewlett-Packard Co.*, 62 USPQ2d 1001. Such channels would include "business executives and officers seeking to reduce costs and improve a company's overall performance" and "human resources departments." Based on the identifications, applicant's and registrant's goods and services could be directed to the same market. As noted by the examining attorney, "[r]elying on registrant's identification of goods, it is clear that its software is meant for use by managers and not just individual employees. The identification states in part that the software 'generates statistics as to how the personnel base or segment is performing as a unit and real-time supervisor and management views of an employee's performance.'" [7]

Conditions of Sale

Applicant argues that its consumers are sophisticated and the goods and services are not purchased on impulse. Specifically applicant argues:

> Purchase of the software offered by Applicant is a complex transaction requiring a company wide rollout and compliance check. The consumer would likely sample or test the product prior to purchase

[7] E. A. Br. p. 10 (App. Ser. No. 77717283).

> since the software impacts many of the business' systems such as human resources, workforce management and/or tax compliance. Similarly, Applicant's business management and operations services impact crucial internal tasks such as workforce management, employee time and attendance management, and tax compliance.[8]

The only evidence of record to support a finding that applicant's goods are "expensive, highly technical and not purchased on impulse" consists of an article from a third-party publication. Such evidence is not particularly probative as to the conditions of sale of applicant's goods and services.[9] Moreover, applicant states that the products in the applications are different from the product referenced in the article. While the goods and services as identified are clearly not inexpensive impulse items and would be purchased by consumers with a higher level of knowledge and care, there is nothing in the record to support a finding that the conditions of sale are of such a nature to outweigh the other factors let alone be a dispositive factor. *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1465 (TTAB 1992). As is well established, the fact that purchasers may be sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995).

Applicant relies on the Board's decision in *Calypso Technology v. Calypso Capital Management LP*, 100 USPQ2d 1213 (TTAB 2011). In that case, there was

[8] App. Br. pp. 12-13.

[9] A declaration from applicant explaining the nature of these types of goods and services and the manner in which such goods and services are purchased might have shed light on the relevant conditions of sale.

ample evidence of the type of customer (financial institutions with investment assets of $25 million) and the cost of the software ($1 million dollars). *Id*. at 1222. Moreover, the goods and service in that case did not have the same purpose (computer software/services for core processing and control v. equity investment management and fund services) and were found to be not related. *Id*.

Absence of Actual Confusion

Finally, applicant argues that its prior Registration No. 3886885, issued in 2010, for the mark EMPOWER SOFTWARE SOLUTIONS for "employee payroll software for payroll administration and payroll tax calculation" and "payroll and human resource services, namely, administration of payroll for others, payroll preparation, and payroll processing services; human resource services, namely, human resources management," and the cited registration "have coexisted without any instances of consumer confusion for nearly two years." First, the inquiry here is likelihood of confusion, not actual confusion. *HRL Associates Inc. v. Weiss Associates Inc.*, 12 USPQ2d 1819, 1824 (TTAB 1989) *aff'd*, 14 USPQ2d 1840 (Fed. Cir. 1990). The Court of Appeals for the Federal Circuit has observed, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, especially in an ex parte context." *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205, internal citation omitted. Second, two years is not a long time and there is no evidence as to the amount of use and whether there has been any meaningful opportunity for confusion to occur.

Applicant also points to its other applications that have received approval from the examining attorney for the following marks and services: "EMPOWERTAX for wage payroll preparation services provided via the internet, namely, payroll tax determination and compliance for others" (App. Ser. No. 77717339); EMPOWERPAY for "employee payroll software for payroll administration and payroll tax calculation" (App. Ser. No. 77717300); and EMPOWERHR for "human resource services, namely, human resources consultation, and employee allocation and assignment" (App. Ser. No. 77717293). Applicant comments that it "has difficulty reconciling the differences between the Examining Attorney's decisions in the present Application versus the decisions in the approved applications listed above." App. Br. p. 15 (App. Ser. No. 77717283).

As noted by the Examining Attorney, with regard to the prior registration, we are not bound by prior decisions of examining attorneys. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). In addition, while the goods and services in applicant's prior registration and other applications fall within the field of "workforce management" they are not the same subset, e.g., performance management and workforce tracking, as registrant's software and the goods and services in the subject applications. Thus, the difference here is that the relatedness of the goods and services is closer than in applicant's other registration and applications.

Conclusion

In conclusion, we find that because the goods and services are closely related and the marks are highly similar, confusion is likely between applicant's marks EMPOWER SOFTWARE SOLUTIONS, EMPOWERWFM and EMPOWERTIME on the one hand and the mark EMPOWER in the cited registration on the other.

Decision: The refusals to register based on a likelihood of confusion under Section 2(d) of the Trademark Act are affirmed in each application.