

This Opinion is Not a
Precedent of the TTAB

Mailed: February 24, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Probuild Software Inc.

Serial No. 88009774

Robert DeWitty of DeWitty and Associates, Chtd.
for Probuild Software, Inc.

Leslie L. Richards, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

Before Bergsman, Adlin and Coggins, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Probuild Software Inc. seeks registration of PROBUILD, in standard characters, for “downloadable mobile applications, excluding online applications, for use by small businesses, and service companies to be used for the tasks of estimating, invoicing, expense data recording/accounting, sales data recording/accounting, payable and receivables accounting, billing/payment processing and managing clients” in International Class 9.¹ The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s

¹ Application Serial No. 88009774, filed June 21, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use anywhere on May 15, 2018 and first use in commerce on May 24, 2018.

mark so resembles the previously registered mark PROBUILDER ONLINE, in standard characters (“ONLINE” disclaimed), for “software as a service (SAAS) services featuring software for construction project management” in International Class 42,² that it is likely to cause confusion. After the refusal became final, Applicant appealed and filed its Appeal Brief. Applicant then requested and was granted a remand to amend its identification of goods to that set forth above, but the Examining Attorney maintained the final refusal despite the amendment. Applicant then filed a Supplemental Appeal Brief, the Examining Attorney filed her Appeal Brief and Applicant filed its Reply Brief.

I. Examining Attorney’s Evidentiary Objection

The Examining Attorney’s objection to the new evidence Applicant attached to its Supplemental Appeal Brief is sustained. Trademark Rule 2.142(d) (“The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.”). It is irrelevant that Applicant submitted the evidence “in further support” of its claimed date of first use. 16 TTABVUE 2.³ The point is that Applicant failed to introduce the evidence during prosecution, or even on remand.

² Registration No. 5638854, issued December 25, 2018.

³ Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format.

II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. The Goods and Services, Their Channels of Trade and Classes of Consumers

The goods and services are quite closely related on their face. Applicant’s “downloadable mobile applications,” i.e. “apps,” are a type of software, intended for “service companies” to perform “tasks,” including “estimating, invoicing, expense data recording/accounting, sales data recording/accounting, payable and receivables accounting, billing/payment processing and managing clients.” Registrant provides construction project management software “as a service.”

The Examining Attorney has established that “project management” includes tasks which are the same as, or quite similar to, the “tasks” performed by Applicant’s

apps. In fact, project management is “the planning and organization of the work that a project involves, including deciding how much money and time and how many people are needed.” September 20, 2020 Office Action TSDR 7 (macmillandictionary.com). This is essentially “estimating,” one of the “tasks” performed by Applicant’s apps. Furthermore, “project management software” has “the capacity to help plan, organize, and manage resource tools and develop resource estimates,” and “can manage **estimation and planning**, scheduling, **cost control and budget management**, resource allocation, collaboration software, communication, decision-making, quality management, time management and documentation or administration systems.” *Id.* at 10 (en.wikipedia.org) (emphasis added). These “capacities” are essentially the same as, or quite similar to, the “accounting” functions performed by Applicant’s apps, as there is an obvious relationship between “invoicing, expense data recording/accounting, sales data recording/accounting, payable and receivables accounting” (identified in the involved application) and “cost control and budget management” (functions performed by project management software, which Registrant provides “as a service”).

In any event, the Examining Attorney introduced a number of use-based third-party registrations showing that the same marks are registered in connection with both the type of goods Applicant offers (apps for estimating, invoicing and accounting), and the type of services Registrant offers (software as a service for construction project management). These include:

COMINDWARE TEAM NETWORK (Reg. No. 4822951) is registered for “downloadable mobile applications for use in

collaboration ... business process management, project management⁴, document management and task management ...” and “software as a service (SAAS) services, namely, hosting software for use by others for use in collaboration, business process management, project management, document management and task management”

TRIMBLE CONNECT (Reg. No. 5829303) is registered for “application service provider (ASP) services featuring computer software for business and project planning, collaboration and communication, namely, for... approval workflow of business and project processes, expenses and materials, for procurement of goods and services ...” and “providing temporary use of online nondownloadable cloud computing software for use in the fields of ... project management.”

HOLLIBLU (Reg. No. 5589096) is registered for “computer software in the health and medical industries for tracking of time, tasks, expenses and other project management data ...” and “software as a service (SAAS) services featuring software for enabling communication and sharing of resources among members of an online work team, and for tracking of time, tasks, expenses and other project management data”

CONSULTOVATION (Reg. No. 5569083) is registered for “computer software for online project management, and for monitoring, creating and maintaining records of work performed” and “software as a service (SAAS) services featuring software for enabling communication and sharing of resources expenses and other project management data and for the creation of work diaries, time sheets, invoices, expense reports and project management reports.”



(Reg. No. 5569086) is registered for “computer software for tracking of time, tasks, expenses and other project management data and for the creation of work

⁴ Project management software is broad enough to encompass construction project management software.

diaries, times sheets, invoices, expense reports and project management reports” and “providing temporary use of on-line non-downloadable software for tracking of time, tasks, expenses and other project management data and for the creation of work diaries, time sheets, invoices, expense reports and project management reports.”



(Reg. No. 6124271) is registered for “downloadable project management software in the field of roofing” and “software as a service (SAAS) services featuring software for creating and editing serial roof measurements, creating roofing installation and repair estimates, generating roofing material orders, and creating and managing contracts in the roofing industry.”

SIGGA (Reg. No. 5757189) is registered for “downloadable mobile applications for workflow management, asset and materials management, inventory control, plant and field services management, enterprise asset management, analytics, planning and scheduling management, and drone inspections” and “software as a service (SAAS) featuring software for workflow management, asset and materials management, inventory control, plant and field services management, enterprise asset management, analytics, planning and scheduling management, and drone inspections.”

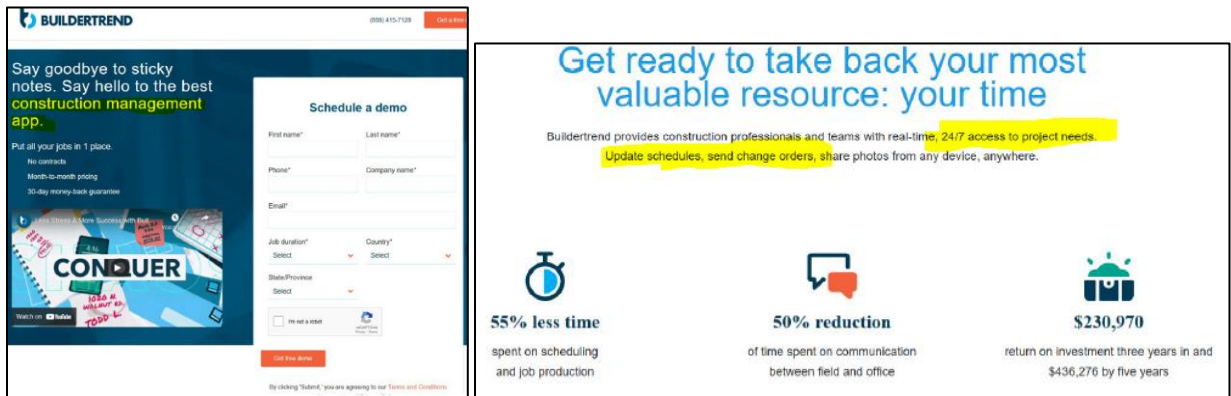


(Reg. No. 5948355) is registered for “downloadable mobile applications for workforce management, workforce administration, and workflow organization” and “software as a service (SAAS) services featuring software for workforce management, workforce administration, and workflow organization.”

September 20, 2020 Office Action TSDR 15-104. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have

some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998).

The Examining Attorney also introduced evidence from third-party Buildertrend, which offers software that performs the tasks identified in the cited registration, as well as those identified in the involved application. Specifically, Buildertrend offers a “construction management app,” which saves time by providing “24/7 access to project needs,” and allowing users to “update schedules” and “send change orders,” as shown below:



September 17, 2021 Denial of Request for Reconsideration after Remand TSDR 4, 5 (highlighting added). Additional Buildertrend evidence establishes that project management software may perform many of the same tasks as Applicant’s apps, including “invoicing,” “managing clients” (or as Buildertrend refers to it “Customer Management”), “payment processing” and “estimates,” as shown below:

https://builder.trend.com/construction-management-app/?source=googleBrand-Exact&bt=524324131006&bk=builder.trend.com&bn=e8&bn=e8&bp=1310301608207&gclid=EAIaIQobChMI9JSmv7SG8wIVqYHCiDwQibEAAAYASAAEgIePPD_BwE18/17/2021 12:19:10 PM



Id. at 7.

Similarly, third party Procore offers a “construction management platform,” apparently available as an app, which performs “project management” tasks, including “project financials,” “invoice management” and other functions performed by Applicant’s identified mobile apps. *Id.* at 9-14. Another third party, Buildxact offers “estimating and construction management software,” establishing that “estimating,” one of the tasks performed by Applicant’s apps, is also performed by construction management software such as Registrant’s. *Id.* at 15. Third party Foundation Software offers “construction accounting software,” as well as “project management software.” *Id.* at 21, 22. This establishes that project management software, such as identified in the cited registration, may be offered by the same source, under the same mark/name, as accounting software, such as Applicant’s apps for “expense data recording/accounting,” “sales data recording/accounting” and “payable and receivables accounting.”

Finally, we should point out that Applicant’s original identification of goods was “downloadable mobile applications for use by small businesses, **contractors** and service companies to be used for the tasks of eliminating, invoicing, **project management**, expense data recording/accounting, sales data recording/accounting,

payable and receivables accounting, billing/payment processing and managing clients” (emphasis added). While Applicant later amended its identification by deleting references to “contractors” and “project management,” in an apparent effort to overcome the refusal of registration, its original identification in this use-based application also tends to indicate that there is a relationship between Applicant’s goods and Registrant’s services. *Cf. Octocom Sys. Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (finding a relationship between the applicant’s “modems” and the opposer’s “computer programs,” holding that the relationship between the goods “is shown,” in part, “by [applicant’s] original application, which indicates [applicant] itself used the mark OCTOCOM for both modems and computer programs”).⁵

In short, the record establishes that there is a relationship between Registrant’s software as a service and Applicant’s software apps because these goods and services perform many of the same tasks, and as identified Applicant’s apps could be used in connection with construction project management. Furthermore, the third party evidence establishes that the channels of trade and classes of consumers for the goods and services overlap, because software such as that identified in the cited registration

⁵ Applicant argues that “[b]y striking ‘construction,’ applicant has indicated that its services will not encompass construction project management.” 6 TTABVue 7-8. Applicant is incorrect. Nothing in the amended identification specifically or explicitly excludes “construction project management.” To the contrary, the tasks (“estimating,” “invoicing,” “accounting” and “managing clients”) and classes of consumers (“small businesses” and “service companies”) listed in the amended identification of goods are consistent with construction project management software. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (“Granting Stone Lion’s application would entitle it to the full scope of services recited therein, and Stone Lion cannot now distance itself from such breadth”).

is sold through the same channels of trade to the same consumers as software such as that identified in the involved application. These factors weigh in favor of finding a likelihood of confusion.

B. The Marks

The marks are quite similar “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Indeed, Applicant’s mark is the essence of Registrant’s mark, and may very well be perceived as a shortened version thereof.

Turning first to meaning and commercial impression, there is little difference between the marks. It is not significant that Applicant’s mark drops the “er” suffix at the end of PROBUILD in Registrant’s mark, because in the context of Registrant’s mark, the “er” suffix merely conveys a person who creates a “probuild,” as opposed to the “probuild” itself. In other words, the term PROBUILDER in Registrant’s mark will likely convey a professional builder, while PROBUILD in Applicant’s mark will likely convey a professional build. Thus, while PROBUILD and PROBUILDER are not synonyms, they both convey the same essential commercial impression – that the offered software/apps relate to professional builds, or perhaps some other type of “build.” The two variations of the same term could very well be perceived as different versions of the same mark, one focused on the “build” itself and the other focused on its “builder.” The bottom line, however, is that consumers will understand that the software provided (whether as a service or as a mobile app) relates to building/construction.

While Registrant's mark includes the term ONLINE, that term does little if anything to change the mark's meaning or commercial impression. Indeed, in the context of Registrant's software "as a service," i.e. provided on the Internet, "online" is at best descriptive, and perhaps generic. December 1, 2020 Office Action TSDR 65 ("online" means "connected to, served by, or available through a system and especially a computer or telecommunications system (such as the Internet)") and 4-64 (third-party registrations in which "ONLINE" is disclaimed for software).⁶ See e.g. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)).

The term PROBUILDER is the more significant, and in fact dominant portion of the cited mark for another reason – it comes first. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) ("The identity of the marks' initial two words is particularly significant because consumers typically notice those words first."); *Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind

⁶ The cited disclaimers of "ONLINE" are evidence that the term is merely descriptive or generic. *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008). See also *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013), *aff'd mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

of a purchaser and remembered.”). Because both the cited mark and Applicant’s mark begin with the distinctive term PROBUILD(ER), the marks look and sound highly similar. The descriptive or generic trailing term ONLINE in Registrant’s mark is relatively insignificant by comparison.

While we have not ignored the relatively minor differences between the marks, we find them to be insignificant when we keep in mind, as we must, that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). In fact, in considering whether consumers are likely to remember the relatively small differences between the marks, we have taken into account: (1) “the fallibility of memory over a period of time;” and (2) that the “average” purchaser “normally retains a general rather than a specific impression of trademarks.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“marks must be considered in light of the fallibility of memory”) (citation, internal quotation marks, and ellipsis omitted); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d*, 972 F.2d 1353 (Fed. Cir. 1992) (“The proper emphasis is thus on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks.”). This factor also weighs in favor of finding a likelihood of confusion.

C. Absence of Actual Confusion

Applicant argues, without supporting evidence, that “even though 3 years have passed since continuous usage of the marks PROBUILD and PROBUILDER ONLINE, there is not one example of confusion on the part of the purchasing public.” 13 TTABVUE 9. Even if we assumed this unsupported allegation to be true, it would not matter in the absence of evidence regarding the extent to which Applicant and Registrant have used their marks for the respective goods and services. For example, we do not know where or to whom Applicant has sold its goods. Therefore, we cannot gauge whether or the extent to which there has been a meaningful opportunity for confusion to occur. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF’s use of the VITTORIO RICCI mark on the merchandise in question in prior years”); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). This factor is neutral.

III. Conclusion

The goods are quite closely related and their channels of trade and classes of consumers overlap. The marks are similar in appearance, sound, meaning and commercial impression because they share and begin with forms of the term PROBUILD. Confusion is likely.

Decision: The refusal to register Applicant’s mark under Section 2(d) of the Trademark Act is affirmed.