

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77717320
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	035
DESCRIPTION	
Employee administration services provided via the internet, namely, forecasting, budgeting, scheduling and reporting of employee work transactions	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	035
TRACKED TEXT DESCRIPTION	
Employee administration services provided via the internet, namely, forecasting, budgeting, scheduling and reporting of employee work transactions; <u>Employee administration services via the internet, namely, forecasting, budgeting, scheduling, and reporting the completion and the duration of employee work transactions</u>	
FINAL DESCRIPTION	
Employee administration services via the internet, namely, forecasting, budgeting, scheduling, and reporting the completion and the duration of employee work transactions	
FILING BASIS	Section 1(b)
ADDITIONAL STATEMENTS SECTION	
MISCELLANEOUS STATEMENT	Please see the attached Remarks.
MISCELLANEOUS FILE NAME(S)	
ORIGINAL PDF FILE	mis-4535358-152548384 . 80010008Remarks.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\777\173\77717320 \xml1\RFR0002.JPG

	<u>\\TICRS\EXPORT16\IMAGEOUT16\777\173\77717320 \xml1\RFR0003.JPG</u>
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SIGNATURE SECTION	
RESPONSE SIGNATURE	/John C. Linderman/
SIGNATORY'S NAME	John C. Linderman
SIGNATORY'S POSITION	Attorney of Record
SIGNATORY'S PHONE NUMBER	860-549-5290
DATE SIGNED	07/16/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Jul 16 15:28:35 EDT 2012
TEAS STAMP	USPTO/RFR-4.53.53.58-2012 0716152835249585-77717320 -490c683f5ab4fbd1117c8470 c7524a245-N/A-N/A-2012071 6152548384090

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77717320** has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for Employee administration services provided via the internet, namely, forecasting, budgeting, scheduling and reporting of employee work transactions

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use

through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Employee administration services provided via the internet, namely, forecasting, budgeting, scheduling and reporting of employee work transactions;~~ Employee administration services via the internet, namely, forecasting, budgeting, scheduling, and reporting the completion and the duration of employee work transactions

Class 035 for Employee administration services via the internet, namely, forecasting, budgeting, scheduling, and reporting the completion and the duration of employee work transactions

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

ADDITIONAL STATEMENTS

Miscellaneous Statement

Please see the attached Remarks.

Original PDF file:

[mis-4535358-152548384 . 80010008Remarks.pdf](#)

Converted PDF file(s) (4 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

[Miscellaneous File3](#)

[Miscellaneous File4](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /John C. Linderman/ Date: 07/16/2012

Signatory's Name: John C. Linderman

Signatory's Position: Attorney of Record

Signatory's Phone Number: 860-549-5290

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77717320

Internet Transmission Date: Mon Jul 16 15:28:35 EDT 2012

TEAS Stamp: USPTO/RFR-4.53.53.58-2012071615283524958

5-77717320-490c683f5ab4fbd1117c8470c7524
a245-N/A-N/A-20120716152548384090

U.S. Application No. 77/717,320

Remarks

In the Office Action, the Examining Attorney continues and maintains the refusal to register under Section 2(d) of the Trademark Act as to U.S. Reg. No. 3,394,945 for the mark "EMPOWER." The Examining Attorney has withdrawn the potential additional refusal to register as to prior pending applications designated as U.S. Serial No. 77/653,616 for the mark "EMPOWER BENEFITS" and U.S. Serial No. 76/012,199 for the mark "IMPOWER." Applicant respectfully asserts that the present refusal to register is improper and submits herewith its arguments in favor of registration. Applicant is simultaneously filing a Notice of Appeal.

Applicant has amended its description of services to further distinguish the present mark "EMPOWERWFM" from the cited registration as follows:

"Employee administration services via the internet, namely, forecasting, budgeting, scheduling, and reporting the completion and the duration of employee work transactions" in Class 35.

As an initial matter, Applicant notes that its marks "EMPOWERTAX" (Serial No. 77/717,339) applied for in connection with "wage payroll preparation services provided via the internet, namely, payroll tax determination and compliance for others," and "EMPOWERPAY" (Serial No. 77/717,300) applied for in connection with "employee payroll software for payroll administration and payroll tax calculation" in Class 9 and "on-line payroll services for administration of payroll for others, namely, payroll preparation, payroll processing services, and reporting" in Class 35 have been allowed by the USPTO. Furthermore, Applicant has had an existing registration for the mark "EMPOWER SOFTWARE SOLUTIONS" (Reg. No. 3,886,885) since 2010, which is registered in connection with "employee payroll software for payroll administration and payroll tax calculation" in Class 9 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" in Class 10.

Regarding the refusal to register based on the cited registration, Applicant incorporates by reference its arguments against any potential likelihood of confusion between the present mark "EMPOWERWFM" and the cited registration as set forth in Applicant's Response to Office Action dated January 7, 2010 and in Applicant's Response to the Notice of Suspension dated December 29, 2011.

To summarize, Applicant argued that the marks are entitled to only a narrow scope of protection due to a substantial number of third-party registrations utilizing the term "EMPOWER" in connection with goods and services in the field of human resources, human resources software, and business and management operations services. Notably, this evidence establishes that the consuming public is commonly exposed to third-party use of similar marks on similar goods and services and "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Evidence of third-party use falls under the sixth du Pont factor – the "number and nature of similar marks in use on similar goods." See In re E. I. du Pont de Nemours & Co., 177 USPQ 563, 567 (C.C.P.A. 1973).

Regarding the goods/services, Applicant disputes the Examining Attorney's conclusory assertion that the parties' goods and services are related merely because they pertain to the field of workforce management and human resources, an industry which is growing and becoming increasingly important in the private sector. See *Attachment to Office Action dated January 18, 2012 (Wikipedia article)*.

Rather, there is no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985).

Applicant's services, as amended, include employee administration services provided via the internet, namely, forecasting, budgeting, scheduling and reporting the completion and the duration of employee work transactions in Class 35. These employee administration services do not focus on an individual, but rather have a corporate-wide perspective. On the other hand, the cited registration covers software for individual employee performance evaluation and follow-up, which focuses on the performance of an individual and provides the much more limited service of generating individual performance evaluations. While Applicant's services are geared toward helping business executives make high-level decisions concerning workforce management, budgeting and forecasting, Registrant's software is used by individual employees for the narrow purpose of providing those employees with performance feedback. Thus, the parties' offerings pertain to distinct segments of the workforce management/human resources field and, as such, are not related. Given the distinctions between the parties' offerings and the narrow scope of protection for the marks, confusion is not likely.

Applicant's trade channels are also distinct from Registrant's trade channels. Both Applicant and Registrant sell directly to their targeted consumers. Thus, consumers would deal directly with a sales representative of either Applicant or Registrant, thereby eliminating any possibility of side-by-side offerings. Furthermore, Applicant's services are offered via the internet, where consumers must visit Applicant's website to request a proposal.

Finally, circumstances suggesting care in purchasing may tend to minimize any likelihood of confusion. TMEP 1207.01(d)(vii). Applicant submits herewith an article published in Integrated Solutions For Retailers (January 2012). The article details how one of Applicant's customers, retail giant Home Depot, invested substantial time and resources into selecting a provider to meet its workforce management needs. Home Depot "conducted an extensive RFP for a [workforce management] solution, which included eight vendors." *See id.* Home Depot also conducted a test run of Applicant's products in two of its stores before finally choosing Applicant's product. Home Depot also considered

input from its IT department in its decision because it needed “a solution that would be strong and scalable enough to handle an enormous load....” *See id.*

Thus, consumers interested in purchasing Applicant’s offerings would invest substantial amounts of time and money into procuring those offerings because the products/services are expensive and affect nearly every aspect of the customer’s employee administration services and human resources services. Since Applicant’s services are likely to impact many, if not all, of a company’s internal processes and procedures, the executives and administrators purchasing Applicant’s services do so with care and consideration. Similarly, Registrant’s employee performance evaluation software is likely expensive and must be cross-checked for compliance with a company’s existing IT structure. Thus, the circumstances that surround the purchase of both Applicant’s and Registrant’s offerings suggest that the purchasing public will exercise care in selecting the goods and services, and any potential of consumer confusion is greatly minimized.

In light of the arguments and evidence presented herein, Applicant requests reconsideration and withdrawal of the Section 2(d) refusal to register in view of the ‘945 registration.