

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 | 77317019 |
| LAW OFFICE ASSIGNED | LAW OFFICE 110 |
| MARK SECTION (no change) | |
| ARGUMENT(S) | |
| <p>REMARKS</p> <p>The Examining Attorney's Office Action of March 6, 2009 has been received and carefully considered. The Examining Attorney has refused registration of the mark SECURE PUMPPAY on the basis of mere descriptiveness under Section 2(e)(1) of the Trademark Act. In particular, the Examining Attorney alleges that the phrase PUMPPAY describes "an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods." Applicant traverses this determination on the basis that the mark is suggestive and not merely descriptive.</p> <p>The determination regarding the descriptiveness of a designation can only be made by considering it in relation to the specific goods or services for which registration is sought. <i>Remington Prods., Inc. v. North Am. Philips Corp.</i>, 892 F.2d 1576, 13 U.S.P.Q.2d 1444, 1448 (Fed. Cir. 1990). A mark is deemed "merely descriptive only" if the mark, <i>as a whole</i>, immediately conveys information about a feature, function or characteristic of the goods or services identified by the mark. <i>In re Oppendahl & Larson LLP</i>, 373 F.3d 1171, 71 U.S.P.Q.2d 1370, 1371 (Fed. Cir. 2004) (noting "a mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark"); <i>In re Gyulay</i>, 820 F.2d 1216, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987) (holding the mark APPLE PIE was merely descriptive of the potpourri that smelled like apple pie). The word "merely" is to be taken in its ordinary meaning of "only" or "solely" such that when it is considered in connection with the stated goods or services, the mark does nothing more than describe the goods or services. <i>In re Colonial Stores, Inc.</i>, 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1963); <i>In re Quik-Print Copy Shop, Inc.</i>, 616 F. 2d 523, 205 U.S.P.Q. 505 (C.C.P.A. 1980).</p> <p>On the other hand, if some imagination, mental steps, thought or perception is required to determine the nature of the goods or services from the mark, the mark is suggestive and thus</p> | |

registrable. *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). A mature thought, or multi-stage, reasoning process associating the mark to the identified goods or services signals the mark is suggestive and not descriptive. *Id.*

It is well-settled that the burden is on the United States Patent and Trademark Office to make a *prima facie* showing that the mark in question is descriptive from the perspective of purchasers of Applicant's goods and, where doubt exists as to whether a term is descriptive, *such doubt must be resolved in favor of the applicant*. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987).

In the present case, Applicant has applied for registration of the mark SECURE PUMPPAY in connection with the following services:

Debit card, credit card, electronic payment transaction processing services and secure electronic payment transaction processing services; wireless debit card, credit card, and electronic payment transaction processing services and secure electronic payment transaction processing services; secure payment processing solutions, namely, providing electronic processing of debit and credit card transactions and electronic payments via electronic payment systems and software integrated into fuel dispensers, in International Class 36.

Computer software installation services; technical support services, namely, troubleshooting of computer hardware and software problems in electronic payment systems and fuel dispensers, in International Class 42.

Applicant's Mark Is Not "Merely" and "Only" Descriptive

It is clear that the subject mark SECURE PUMPPAY - when considered in its entirety - does not immediately, without speculation or conjecture, convey the nature, quality, characteristics of Applicant's services and the mark is suggestive in nature. The Examining Attorney contends that Applicant's mark describes "a secure payment made at the pump". However, the Examining Attorney is leapfrogging over the multiple objective and necessary steps required to arrive at her determination that Applicant's mark is *merely and only* descriptive of the services it identifies. Applicant provides debit, credit card, and electronic payment transaction processing services. Specifically, Applicant's software and associated services are marketed and sold to **commercial vendors** such as retail stores, convenience stores, and gasoline stations. Applicant will then install the software at the commercial vendor's site and work with the commercial vendor in the processing of electronic transactions made at the vendor's site via Applicant's software and related systems. The commercial vendor's customers may be exposed indirectly to Applicant's services when they fill their car with a tank of gas, and receive the benefit of the vendor's decision to use Applicant's services. But Applicant's trademark does not convey, without conjecture, or significant intellectual steps, any information regarding the Applicant's services being provided to its actual customer, **the commercial vendor**. Even in the Examining Attorney's characterization of the descriptive terms, she can not

convey her intended descriptive connection without including additional language and manipulating the mark itself to describe the purported "immediate" connection (i.e. Examining Attorney's statement on page three of the 3/6/09 office action: "the mark describes SECURE PUMP PAYMENT or a secure payment made at the pump"). The Examining Attorney's manipulation of the mark SECURE PUMPPAY to "SECURE PUMP PAYMENT" is too vague to ascertain exactly what the services are, so she is compelled to elaborate further to make her point (i.e. "...or a secure payment made at the pump"). The multiple stages of the Examining Attorney's reasoning process are illustrated in the words of the Examining Attorney's very own office action. It is a clear contradiction. The hallmark of descriptiveness is that the trademark immediately refers to some feature, function, or characteristics of Applicant's products or services. If the Examining Attorney must reach for multiple descriptors and multiple stages of reasoning to establish her link between the mark and the services, immediate descriptiveness is refuted on its face. Moreover, the Examining Attorney has failed to provide even one sample of objective third party use of Applicant's coined phrase PUMPPAY in a descriptive manner. Per well established trademark law, the Examining Attorney has the burden of proof in establishing a mark is descriptive and must give the benefit of the doubt to the Applicant in the assessment of mere descriptiveness issues. The Examining Attorney has failed to meet her burden of proof to establish that Applicant's mark is "merely" and "only" descriptive by (i) ignoring multiple essential steps in connecting Applicant's mark to Applicant's services directed to commercial vendors, and by (ii) providing virtually no evidence of use of Applicant's mark in a descriptive manner. Accordingly, the refusal on the basis of "mere descriptiveness" should be withdrawn.

Applicant's Mark is a Unitary and Suggestive Trademark

Moreover, the Examining Attorney is ignoring the unitary nature of the mark created by the alliteration in Applicant's mark. Pursuant to TMEP Section 1213.05, "a mark or portion of a mark is considered 'unitary' when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portions of the mark is unitary, no disclaimer or descriptive refusal of an element, whether descriptive, generic or otherwise, is required." One form of a unitary mark is a mark with alliterative sound patterns. See TMEP Section 1213.05(e) ("At times a mark will form a unitary whole through a rhyming pattern, use of alliteration, or some other use of sound that creates a distinctive impression. In such a case, the mark is regarded as unitary").

In the present case, the portion of Applicant's mark PUMPPAY is comprised of two terms both beginning with the letter "P". The alliterative association between the portions of Applicant's mark is intentional so that the consumers will remember the source of Applicant's services when they hear the lilting cadence of the repeated "P" sounds in Applicant's mark. The terms PUMP and PAY do not

“merely” or “only” serve to convey some specific feature or function of Applicant's goods and services. These terms were designed to be part of a suggestive, catchy and unitary mark as a whole. Therefore, the composite SECURE PUMPPAY mark is not merely descriptive of Applicant's services since the connection is not immediate. See 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:67 (“[W]hile a descriptive term directly and clearly conveys information about the ingredients, qualities or characteristics of the product or service, the ‘suggestive’ term only indirectly suggests these things.”).

As such, the mere descriptiveness refusal is without merit and the Applicant respectfully request refusal to be withdrawn.

CONCLUSION

Applicant respectfully submits that the mark SECURE PUMPPAY is not merely descriptive because it does not convey an immediate impression of Applicant's services and is instead suggestive. The evidence made of record by the Examining Attorney does not constitute “clear evidence” and is insufficient to create a *prima facie* showing of descriptiveness under Trademark Act Section 2(e)(1) because the evidence provides no clear or convincing evidence that the SECURE PUMPPAY mark when viewed in its entirety is merely descriptive. The evidence made of record by the Examining Attorney does not satisfy the rigorous burden of proof to support a *prima facie* case of descriptiveness. The doubt as to the issue created by the evidence herein submitted by Applicant must be resolved in favor of the Applicant, particularly given that where any doubt may exist with respect to whether a mark is descriptive, the doubt is to be resolved in favor of the Applicant. *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972). Accordingly, Applicant respectfully requests that the refusal under Trademark Act Section 2(e)(1) be withdrawn and that the subject mark be registered on the Principal Register.

SIGNATURE SECTION

| | |
|--------------------------------|-----------------------------------|
| RESPONSE SIGNATURE | /Michelle A. Massicotte/ |
| SIGNATORY'S NAME | Michelle A. Massicotte |
| SIGNATORY'S POSITION | Attorney of record, MA bar member |
| DATE SIGNED | 09/04/2009 |
| AUTHORIZED SIGNATORY | YES |
| CONCURRENT APPEAL NOTICE FILED | NO |

FILING INFORMATION SECTION

| | |
|-------------|---|
| SUBMIT DATE | Fri Sep 04 15:57:25 EDT 2009 |
| TEAS STAMP | USPTO/RFR-208.255.90.221- 20090904155725672673-7731 7019-4306982f19a7d9c27878 1d63f5a30cbdc88-N/A-N/A-2 0090904155408788349 |

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. **77317019** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

REMARKS

The Examining Attorney's Office Action of March 6, 2009 has been received and carefully considered. The Examining Attorney has refused registration of the mark SECURE PUMPPAY on the basis of mere descriptiveness under Section 2(e)(1) of the Trademark Act. In particular, the Examining Attorney alleges that the phrase PUMPPAY describes "an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods." Applicant traverses this determination on the basis that the mark is suggestive and not merely descriptive.

The determination regarding the descriptiveness of a designation can only be made by considering it in relation to the specific goods or services for which registration is sought. *Remington Prods., Inc. v. North Am. Philips Corp.*, 892 F.2d 1576, 13 U.S.P.Q.2d 1444, 1448 (Fed. Cir. 1990). A mark is deemed "merely descriptive only" if the mark, *as a whole*, immediately conveys information about a feature, function or characteristic of the goods or services identified by the mark. *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 71 U.S.P.Q.2d 1370, 1371 (Fed. Cir. 2004) (noting "a mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark"); *In re Gyulay*, 820 F.2d 1216, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987) (holding the mark APPLE PIE was merely descriptive of the potpourri that smelled like apple pie). The word "merely" is to be taken in its ordinary meaning of "only" or "solely" such that when it is considered in connection with the stated goods or services, the mark does nothing more than describe the goods or services. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1963); *In re Quik-Print*

Copy Shop, Inc., 616 F. 2d 523, 205 U.S.P.Q. 505 (C.C.P.A. 1980).

On the other hand, if some imagination, mental steps, thought or perception is required to determine the nature of the goods or services from the mark, the mark is suggestive and thus registrable. *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). A mature thought, or multi-stage, reasoning process associating the mark to the identified goods or services signals the mark is suggestive and not descriptive. *Id.*

It is well-settled that the burden is on the United States Patent and Trademark Office to make a *prima facie* showing that the mark in question is descriptive from the perspective of purchasers of Applicant's goods and, where doubt exists as to whether a term is descriptive, *such doubt must be resolved in favor of the applicant*. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987).

In the present case, Applicant has applied for registration of the mark SECURE PUMPPAY in connection with the following services:

Debit card, credit card, electronic payment transaction processing services and secure electronic payment transaction processing services; wireless debit card, credit card, and electronic payment transaction processing services and secure electronic payment transaction processing services; secure payment processing solutions, namely, providing electronic processing of debit and credit card transactions and electronic payments via electronic payment systems and software integrated into fuel dispensers, in International Class 36.

Computer software installation services; technical support services, namely, troubleshooting of computer hardware and software problems in electronic payment systems and fuel dispensers, in International Class 42.

Applicant's Mark Is Not "Merely" and "Only" Descriptive

It is clear that the subject mark SECURE PUMPPAY - when considered in its entirety - does not immediately, without speculation or conjecture, convey the nature, quality, characteristics of Applicant's services and the mark is suggestive in nature. The Examining Attorney contends that Applicant's mark describes "a secure payment made at the pump". However, the Examining Attorney is leapfrogging over the multiple objective and necessary steps required to arrive at her determination that Applicant's mark is *merely and only* descriptive of the services it identifies. Applicant provides debit, credit card, and electronic payment transaction processing services. Specifically, Applicant's software and associated services are marketed and sold to *commercial vendors* such as retail stores, convenience stores, and gasoline stations. Applicant will then install the software at the commercial vendor's site and work with the commercial vendor in the processing of electronic transactions made at the vendor's site via Applicant's software and related systems. The commercial vendor's customers may be exposed indirectly to Applicant's services when they fill their car with a tank of gas, and receive the benefit of the vendor's decision to use Applicant's services. But Applicant's trademark does not convey, without conjecture, or significant intellectual steps, any information regarding the Applicant's services being provided to its actual customer, *the commercial vendor*. Even in the Examining Attorney's

characterization of the descriptive terms, she can not convey her intended descriptive connection without including additional language and manipulating the mark itself to describe the purported "immediate" connection (i.e. Examining Attorney's statement on page three of the 3/6/09 office action: "the mark describes SECURE PUMP PAYMENT or a secure payment made at the pump"). The Examining Attorney's manipulation of the mark SECURE PUMPPAY to "SECURE PUMP PAYMENT" is too vague to ascertain exactly what the services are, so she is compelled to elaborate further to make her point (i.e. "...or a secure payment made at the pump"). The multiple stages of the Examining Attorney's reasoning process are illustrated in the words of the Examining Attorney's very own office action. It is a clear contradiction. The hallmark of descriptiveness is that the trademark immediately refers to some feature, function, or characteristics of Applicant's products or services. If the Examining Attorney must reach for multiple descriptors and multiple stages of reasoning to establish her link between the mark and the services, immediate descriptiveness is refuted on its face. Moreover, the Examining Attorney has failed to provide even one sample of objective third party use of Applicant's coined phrase PUMPPAY in a descriptive manner. Per well established trademark law, the Examining Attorney has the burden of proof in establishing a mark is descriptive and must give the benefit of the doubt to the Applicant in the assessment of mere descriptiveness issues. The Examining Attorney has failed to meet her burden of proof to establish that Applicant's mark is "merely" and "only" descriptive by (i) ignoring multiple essential steps in connecting Applicant's mark to Applicant's services directed to commercial vendors, and by (ii) providing virtually no evidence of use of Applicant's mark in a descriptive manner. Accordingly, the refusal on the basis of "mere descriptiveness" should be withdrawn.

Applicant's Mark is a Unitary and Suggestive Trademark

Moreover, the Examining Attorney is ignoring the unitary nature of the mark created by the alliteration in Applicant's mark. Pursuant to TMEP Section 1213.05, "a mark or portion of a mark is considered 'unitary' when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portions of the mark is unitary, no disclaimer or descriptive refusal of an element, whether descriptive, generic or otherwise, is required." One form of a unitary mark is a mark with alliterative sound patterns. See TMEP Section 1213.05(e) ("At times a mark will form a unitary whole through a rhyming pattern, use of alliteration, or some other use of sound that creates a distinctive impression. In such a case, the mark is regarded as unitary").

In the present case, the portion of Applicant's mark PUMPPAY is comprised of two terms both beginning with the letter "P". The alliterative association between the portions of Applicant's mark is intentional so that the consumers will remember the source of Applicant's services when they hear the lilting cadence of the repeated "P" sounds in Applicant's mark. The terms PUMP and PAY do not "merely" or "only" serve to convey some specific feature or function of Applicant's goods and services.

These terms were designed to be part of a suggestive, catchy and unitary mark as a whole. Therefore, the composite SECURE PUMPPAY mark is not merely descriptive of Applicant's services since the connection is not immediate. See 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:67 ("[W]hile a descriptive term directly and clearly conveys information about the ingredients, qualities or characteristics of the product or service, the 'suggestive' term only indirectly suggests these things.").

As such, the mere descriptiveness refusal is without merit and the Applicant respectfully requests refusal to be withdrawn.

CONCLUSION

Applicant respectfully submits that the mark SECURE PUMPPAY is not merely descriptive because it does not convey an immediate impression of Applicant's services and is instead suggestive. The evidence made of record by the Examining Attorney does not constitute "clear evidence" and is insufficient to create a *prima facie* showing of descriptiveness under Trademark Act Section 2(e)(1) because the evidence provides no clear or convincing evidence that the SECURE PUMPPAY mark when viewed in its entirety is merely descriptive. The evidence made of record by the Examining Attorney does not satisfy the rigorous burden of proof to support a *prima facie* case of descriptiveness. The doubt as to the issue created by the evidence herein submitted by Applicant must be resolved in favor of the Applicant, particularly given that where any doubt may exist with respect to whether a mark is descriptive, the doubt is to be resolved in favor of the Applicant. *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972). Accordingly, Applicant respectfully requests that the refusal under Trademark Act Section 2(e)(1) be withdrawn and that the subject mark be registered on the Principal Register.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Michelle A. Massicotte/ Date: 09/04/2009

Signatory's Name: Michelle A. Massicotte

Signatory's Position: Attorney of record, MA bar member

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77317019

Internet Transmission Date: Fri Sep 04 15:57:25 EDT 2009

TEAS Stamp: USPTO/RFR-208.255.90.221-200909041557256

72673-77317019-4306982f19a7d9c278781d63f

5a30cbdc88-N/A-N/A-20090904155408788349