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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	HRB ROYALTY, INC.
Applied for Mark	INSTANT MONEY
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IN THE UNITED STATES TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	**HRB Royalty, Inc.**	)	Law Office 111
Serial No.:	**78/788,488**	)	Renee McCray, Esq.
Filing Date:	**January 10, 2006**	)	Examining Attorney
Mark:	**INSTANT MONEY**	)	

APPLICANT'S APPEAL BRIEF

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APPLICANT'S APPEAL BRIEF

I. Introduction

Pursuant to a Notice of Appeal filed April 23, 2007, Applicant has appealed the Trademark Examining Attorney's final refusal to register Applicant's mark INSTANT MONEY for temporary loans in the nature of income tax refund anticipation loans, in International Class 36. The refusal to register was based on the ground that the proposed mark, as used on the specimens of record, does not function as a service mark to indicate the source of the identified services, and is thus not registrable under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127. Applicant respectfully disagrees with the Examining Attorney's classification of the mark as failing to function as a service mark, and as discussed in detail below, believes that INSTANT MONEY does function as a service mark identifying Applicant as the source of the goods, and is shown as such in the specimens provided to the Examining Attorney. Accordingly, the mark INSTANT MONEY is registrable under the provisions of the Trademark Act.

II. Facts

This application was filed on January 10, 2006. An initial Office Action refusing registration of the mark was mailed on May 2, 2006, alleging that the mark failed to function as a service mark "in this case" because, as used on the specimen, it was merely informational matter. Applicant's response to this initial refusal was filed on October 3, 2006, pointing out that the specimen does show the mark as a service mark advertising the services, and also submitting substitute specimens showing additional uses of the mark. A final Office Action refusing registration on the basis that the mark was does not function as a service mark was mailed on October 24, 2006. In response to this final refusal, Applicant filed a Notice of Appeal filed on April 23, 2007. The deadline for filing this brief is June 22, 2007, sixty days from the mailing date of the Notice of Appeal.

III. Applicant's Argument

Summary: Applicant's mark does function as a service mark, and such service mark usage is demonstrated by the specimens of record (the original and the substitutes). The evidence submitted by the Examining Attorney is not persuasive to show that the mark fails to function as a service mark, but instead establishes that the mark <u>does</u> function as a service mark. Thus, the Examining Attorney has not met the burden of establishing that the mark is not registrable on the Principal Register.

A. The Mark Does Function as a Service Mark

The specimen as originally submitted with the application is a promotional advertisement showing the mark INSTANT MONEY used in connection with refund anticipation loan services.

The specimen was mailed to potential customers. The term INSTANT MONEY is identified with a capital I and a capital M, and is used appropriately as an adjective for "refund anticipation loan." The fact that the advertisement indicates that the "INSTANT MONEY refund anticipation loan has been pre-approved" is not merely confirming information regarding loan to customers. Rather, it is an attempt to obtain customers for this service, marketed under the INSTANT MONEY mark. As such, applicant believes that the specimen as originally filed with the application is appropriate, pursuant to §1301.04(b) of the TMEP. The initial capitalization of each of the terms as used in this specimen filed with the application, namely "Instant" and "Money", do create such a separate commercial impression in the INSTANT MONEY mark, particularly in view of the fact that these words are followed by the generic term for the services, "refund anticipation loan."

Substitute specimens were submitted in response to the initial Office Action. The first group of substitute specimens consists of a scanned version of three print advertisements promoting the INSTANT MONEY refund anticipation loan services. The style of these advertisements includes headings with all initial capitalization, including the mark shown as "Instant Money". In keeping with the style of this ad, the generic phrase "Refund Anticipation Loan" in one instance is also used with initial capitalization. However, the information found at the bottom of each of those advertisements includes the mark "Instant Money" used with initial capitalization followed by the uncapitalized phrase "refund anticipation loan", and further defines the phrase "refund anticipation loan" as "RAL."

The second group of substitute specimen comprise scripts of television and radio advertisements which ran promoting the INSTANT MONEY refund anticipation loan services. These promotions emphasize the INSTANT MONEY mark, using it as a source identifier of the

"refund anticipation loan" services, and show an association between the mark and the services for which the registration is sought, as well as a source association between the services and the applicant or applicant's licensees.

Indeed, even the evidence which was submitted by the Examining Attorney with the final Action directly supports Applicant's position, as the evidence includes several definitions of "refund anticipation loan" as a term of art in the financial industry. It is common for such a generic name for the services not to be included in the mark, as it typically will not assist the mark itself in creating a separate commercial impression. *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989).

As noted by the Board in *In re National Training Center of Lie Detection, Inc.*, 226 USPQ 798 (TTAB 1985), the issue is whether the claimed mark creates a commercial impression separate and apart from the other material on the specimen. There the Board noted that even a laudatory phrase displayed separately from a main trademark functioned as a trademark. In *R.J. Reynolds Tobacco Co. v. Philip Morris, Inc.,* 210 USPQ 34 (TTAB 1981), at p. 41, the Board, citing prior decisions, noted that the size or degree of prominence of a mark is not controlling if, when noticed, the mark is understood as indicating origin of the goods or services.

In the directly analogous issue of mutilation of marks, the TMEP states in §807.12(d) that "[i]n an application under §1 of the Trademark Act, the . . . applicant has some latitude in selecting the mark it wants to register. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen." The determinative factor, thus, is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s) present. See *In re Chemical Dynamics Inc.*, 839 F.2d

1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Raychem Corp.*, *supra*; *In re Sperouleas*, 227 USPQ 166 (TTAB 1985); *In re Volante International Holdings*, 196 USPQ 188 (TTAB 1977); *In re Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1977); *In re Semans*, 193 USPQ 727 (TTAB 1976); *In re Mango Records*, 189 USPQ 126 (TTAB 1975). Applicant's INSTANT MONEY mark clearly makes a separate and distinct commercial impression apart from the rest of the verbiage on the specimens, and as such does function as a service mark.

In another directly analogous situation, the Board has also held marks to create a separate commercial impression suitable for registration, even though they may be presented as an integral part of a composite, relying on the capitalization of the initial and ending letters of the marks. In *In re Dempster Brothers, Inc.*, 132 USPQ 300 (TTAB 1961), each word of the two-word composite mark was held to be capable of being a separate trademark, as the mark "DempsteR DumpsteR" and Design was presented with capital D's and capital R's, even when the beginning D and the ending R were graphically presented in letters which were large enough to form the beginning and ending letter of each word.

As it is entitled to do, Applicant has selected its mark, INSTANT MONEY, and has used it in an appropriate service mark manner in the specimens of record in the present case.

B. The Examiner's Evidence Does Not Show that the Mark Fails to Function as a Service Mark

The Examiner's evidence simply does not show how the mark fails to function as a service

mark. As briefly noted above, the Examiner submitted as evidence in the final Office Action two articles from the internet establishing that the term "refund anticipation loan" is a defined term of art in the financial industry. Applicant does not disagree with this definition. Indeed, that phrase is the noun modified by Applicant's mark in the specimens. However, there is no way in which this 'evidence' begins to establish, or even to suggest, that Applicant's mark INSTANT MONEY fails to function as a service mark.

Instead of relying on evidence, the Examining Attorney makes unsubstantiated conclusory statements in the Action, including "ordinary purchasers, when confronted with the mark, would regard it simply as useful information ... rather than as an indicastor of source"; "[t]here is nothing about the manner in which the wording INSTANT MONEY is depicted that would cause prospective consumers to regard it as a service mark"; and "the proposed mark, INSTANT MONEY, as used on the specimens of record, merely conveys useful information with respect to the nature of the refund anticipation loan and does not function as a service mark or source-indicator". It is further contended by the Examining Attorney that the use of the INSTANT MONEY mark in the context of the phrase "Your Instant Money refund anticipation loan has been pre-approved" is merely informational as an important consideration[s] in deciding whether to apply for a loan. Applicant strongly disagrees with this mischaracterization of its use of its mark. This phrase may, in part, contain information which would help potential consumers decide whether to apply for a loan, namely that the loan is a refund anticipation loan, and that they have been pre-approved. Contrastedly, the mark "Instant Money" is clearly and appropriately used as a modifier or source-indicator of the 'refund anticipation loan' services, and adds no information to the quoted phrase **other than to identify the source of those loans**. It would be no different from an advertisement

that reads "Your VISA refund loan has been preapproved." No one would doubt that VISA is the source identifier.

Furthermore, after acknowledging in the Action that the mark is presented in the specimens with initial capitalization, contradictory statements are then made by the Examining Attorney to the effect that "[t]he mark is not set apart nor otherwise distinguishable from the other wording in any meaningful way...", and "there is nothing about the manner in which the mark is portrayed that would indicate that it is a service mark." The mark is clearly set apart and is portrayed appropriately as a mark. It cannot be more simply stated: the initial capitalization makes it readily apparent to and easily recognizable as a mark by the relevant consumer. While the issue may turn on whether the mark would be perceived as a source indicator or merely as informational matter, the evidence of record does not transform the mark into merely informational matter.

The case relied upon in the Action, *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998) is not applicable to the INSTANT MONEY mark of the present application. In that case, the Board held that the mark applied for, "Drive Safely", was likely to be perceived by purchasers as merely an everyday, commonplace safety admonition or slogan, similar to the phrases "Have a nice day", and "Don't worry". Applicant's mark INSTANT MONEY is not a slogan, and is simply not analogous to any of these phrases. It is, instead, a source indicator of Applicant's loan services. It is set off by the initial capitalization, as well as by preceding the recognized term of art identifying the specific services, and is done so in such a way that it has created a commercial impression separate from that of the remainder of the wording in the advertisements. As such, INSTANT MONEY would be recognized by prospective customers as a source identifier. *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985). There simply is nothing in the Examiner's evidence

which even begins to show that the INSTANT MONEY mark fails to function as a service mark.

C. The Burden of Establishing that the Mark Fails to Function as a Service Mark Has Not Been Met

The Examining Attorney has not met the burden of showing that Applicant's mark does not function as a mark, so the application should be approved for publication. *In re National Training Center of Lie Detection, Inc., supra,* 226 USPQ at 799-800. The burden of establishing that the mark fails to function as a service mark in the present case is analogous to the burden of determining whether a mark is merely descriptive or suggestive. It is Board policy to resolve any doubt as to whether a mark is merely descriptive or suggestive in favor of the applicant. *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re American Hospital Supply Corp.*, 219 USPQ 949, 951 (TTAB 1983); *In re LRC Products Ltd.*, 223 USPQ 1250 (TTAB 1984); *In re Gourmet Bakers, Inc.,* 173 USPQ 565 (TTAB 1972); and *In re On Technology Corp,* 41 USPQ 2d 1475 (TTAB 1996). The Examining Attorney has failed to present sufficient and clear evidence to support the contention that the INSTANT MONEY mark fails to function as a service mark. As the requisite burden or proof has not been met, any doubt as to whether the mark properly functions as a service mark should be resolved in favor of the Applicant by allowing publication of the INSTANT MONEY mark for opposition.

IV. Conclusion

For the reasons noted above, it is believed that Applicant has clearly established that the INSTANT MONEY mark does function as a service mark. Consequently, it is respectfully submitted that the Examining Attorney's burden of showing that the mark is unregistrable on the

Principal Register as failing to function as a service mark has not been met. Thus, the mark is properly registrable on the Principal Register.

WHEREFORE, in view of the above comments, Applicant requests that this Board reverse the refusal to register this mark, and pass the application to publication.

One copy of this Brief is filed pursuant to TBMP § 1203.01. It is not believed by Applicant that any additional fees are owed at this time, but the Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 19-0522.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 18, 2007, a copy of the foregoing APPLICANT'S APPEAL BRIEF was served via U.S. mail, postage prepaid on the following:

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