

This Opinion Is Not a
Precedent of the TTAB

Mailed: May 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fidelity National Information Services, Inc.

Application Serial No. 87006159

David M. Kelly and Sara Copeland Parker of Kelly IP, LLP
for Fidelity National Information Services, Inc.

Charles Hiser, Trademark Examining Attorney, Law Office 130,
John Lincoski, Managing Attorney.

Before Thurmon, Deputy Chief Administrative Trademark Judge, Bergsman and
Ritchie, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Fidelity National Information Services, Inc. (Applicant) seeks registration on the
Principal Register of the term CARDLESS CASH, in standard character form, for the
goods and services listed below:

Computer software that allows users to withdraw cash
from automatic teller machines using a smartphone or
other mobile device, in International Class 9;

Banking and financial services, namely, automatic teller
machine services and electronic funds transfer services, in
International Class 36;

Cloud computing software featuring software for use in automatic teller machine services, electronic funds transfer services, online banking services, and financial services, namely, electronic funds transfer services; software as a service (SAAS) services featuring software for use in automatic teller machine services, electronic funds transfer services, online banking services, and financial services, namely, electronic funds transfer services, in International Class 42.¹

During the prosecution of the application, Applicant amended its application to seek registration under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).²

The Examining Attorney refused to register the term CARDLESS CASH under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053 and 1127, on the grounds that CARDLESS CASH for the identified goods and services is generic and, in the alternative, that it is merely descriptive under Section 2(e)(1) of the

¹ Serial No. 87006159 filed April 19, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first of use of the mark anywhere and in commerce as of August 2013 for the goods and services in all three classes.

² August 7, 2017 Response to Office Action TSDR 17-18 (“Applicant amends its application to seek registration under Section 2(f) based on a claim of acquired distinctiveness,” and “Applicant submits that the applied-for mark has acquired distinctiveness and is not generic, and requests withdrawal of the refusals and publication of the mark on the Principal Register.”); *id* at TSDR 23 (“Applicant respectfully requests that the Examining Attorney withdraw his refusals of registration, and allow the application to proceed to publication on the Principal Register under Section 2(f).”). *See also* March 6, 2018 Response to Office Action (TSDR 11); May 20, 2019 Response to Office Action (TSDR 8 and 29); September 28, 2019 Request for Reconsideration (4 TTABVue 27). Applicant did not seek registration under Section 2(f) in the alternative. *See* Preliminary Issue below.

Citations to the examination record refer to the USPTO Trademark Status and Document Retrieval system (TSDR) by page number in the downloadable .pdf format.

Trademark Act, 15 U.S.C. § 1052(e)(1), and has not acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

I. Whether CARDLESS CASH is generic?

A generic term “is the common descriptive name of a class of goods or services.” *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). The Examining Attorney has the burden of proving that a term is generic by clear evidence. *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).³ “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term ... to refer to the genus of goods or services in question.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *Marvin Ginn*, 228 USPQ at 530); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015).

The Federal Circuit has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of services at issue? Second, does the relevant public understand the term primarily to refer to that genus of services? *Marvin Ginn*, 228 USPQ at 530. The perception of the relevant public is the chief consideration in determining whether a term is generic. *See Princeton*

³ “Clear evidence” is equivalent to “clear and convincing evidence” which is a heavier burden than preponderance of the evidence. *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1534 (Fed. Cir. 2009) (citing *Am-Pro Protective Agency, Inc. v. U.S.*, 281 F.3d 1234, 1239-40 (Fed. Cir. 2002)).

Vanguard, LLC, 114 USPQ2d at 1833. We may obtain evidence of the public’s understanding of a term from “any competent source, such as consumer surveys, dictionaries, newspapers and other publications.” *Id.* at 1830 (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)). “[A] term can be generic for a genus of ... services if the relevant public ... understands the term to refer to a key aspect of that genus.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016)).

Applicant and the Examining Attorney agree that the identification of goods and services accurately define the genus.⁴ We accept that definition. *See In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration).

We add that, inasmuch as neither the Examining Attorney nor Applicant raised arguments specifically attributed to the different classes in the application, we will not separately address each class of goods or services but rather refer to them collectively as ATM and fund transfer banking services and the software to carry out those services. In doing so, we nevertheless base our analysis and conclusion as to each of the classes on the goods or services as identified.

⁴ Examining Attorney’s Brief (14 TTABVUE 5-6); Applicant’s Brief, p. 8 (12 TTABVUE 12) (“The Examining Attorney correctly defined the genus in question as the Goods and Services.”).

The second part of the *Marvin Ginn* inquiry requires us to consider whether the relevant public understands the term at issue to refer to that genus of services. The relevant public encompasses “actual [and] potential purchasers of . . . goods or services” identified in the application or registration. *Loglan Inst. Inc. v. Logical Language Grp. Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (citation omitted); *Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). The relevant public includes ordinary consumers who avail themselves of ATM and fund transfer banking services and the software to carry out those services, as well as, banks, credit unions, and other providers of ATM services, and competitors who provide those goods and services.

We now turn to the manner in which the relevant consumers perceive the term CARDLESS CASH when used in connection with ATM and fund transfer banking services and the software to carry out those goods or services.⁵ At the outset, the Examining Attorney contends that each of the constituent terms of CARDLESS CASH is generic when used in connection with ATM and fund transfer banking services and the software to carry out those services and that each term retains its generic meaning in the composite term.⁶

The terms individually point to the mark as a whole being generic as the term “cardless” is generic for services that specifically do not require a card when a card is normally necessary and cash is generic for goods and services that

⁵ For ease of reference, we have highlighted generic references to “cardless cash” in the evidence discussed herein.

⁶ Examining Attorney’s Brief (14 TTABVUE 6-7).

deal specifically with the withdraw of cash from banking institutions, the key feature of the goods and services.⁷

We start with the definitions of the components of the subject matter sought to be registered, CARDLESS CASH because dictionary definitions are probative of how the public perceives the combination as CARDLESS CASH. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1537 (Fed. Cir. 2009) (“the Board satisfied its evidentiary burden, by demonstrating that the separate terms ‘hotel’ and ‘.com’ in combination have a meaning identical to the common meaning of the separate components”); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514*9 (TTAB 2019).

•THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (ahdictionary.com) defines “Cash,” inter alia, as “Money in the form of bills or coins; currency.”⁸

•THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE defines “Card,” inter alia, as “A flat, usually rectangular pieces of stiff paper, cardboard, or plastic, especially: ... A credit card ... A magnetic card ...”⁹

•Merriam-Webster.com defines “– less” as “destitute of: not having.”¹⁰

When used in connection with ATM and fund transfer banking services and the software to carry out those goods or services, the proposed mark as a whole, CARDLESS CASH, means access to money without a credit or debit card.

⁷ *Id.* at TTABVUE 7.

⁸ March 28, 2018 Office Action (TSDR 15).

⁹ *Id.* at TSDR 21.

¹⁰ *Id.* at TSDR 20.

Nevertheless, the presence or absence of CARDLESS CASH in dictionaries is not controlling on the question of whether a term is generic. *See In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581m 1603 (TTAB 2014); *In re Dairimetec, Ltd.*, 169 USPQ 572, 573 (TTAB 1971). *Cf. Princeton Vanguard*, 114 USPQ2d at 1832-33 (“[E]ven in circumstances where the Board finds it useful to consider the public’s understanding of the individual words in a compound term as a first step in its analysis, the Board must then consider available record evidence of the public’s understanding of whether joining those individual words into one lends additional meaning to the mark as a whole.”). Thus, to support his contention that consumers and competitors perceive CARDLESS CASH as a generic term, the Examining Attorney submitted evidence from competitors, three patents and one trademark registration, and numerous examples from the media. The Examining Attorney submitted evidence from four companies, listed below, other than Applicant providing software for ATM and fund transfer services:¹¹

1. HalCash North America (pin4.com) uses the logo reproduced below, which includes the term “cardless cash”:¹²



¹¹ Amanda Burk, Applicant’s Director of Product Marketing, testified that NCR and Wincor Nixdorf are associated with Applicant. Burk Decl. ¶5 attached to the August 7, 2017 Response to Office Action (TSDR 27).

¹² February 7, 2017 Office Action (TSDR 22).

The Examining Attorney submitted a press release by HalCash North America providing the information below:

**PIN4 EXTENDS CARDLESS ATM WITHDRAWALS TO
NON-BANK ATM OPERATORS**

HalCash North America is making its **cardless-cash** ATM service available in four U.S. cities prior to eventual national expansion later this year.

Under the Pin4 moniker, the HalCash North America service enables consumers to securely send cash that recipients can retrieve at participating ATMs without having to insert a card into the cash machine. Recipients also do not need a bank account. The service is live in New York City, Miami, Chicago and Los Angeles.¹³

2. Belatrix (belatrixsf.com)

**Financial Services Innovation with Cardless
Cash¹⁴**

* * *

Helping a financial services company better
engage customers via mobile technology

A leading financial services organization was looking to develop new ways for customers to access their cash from an ATM. Belatrix was tasked with creating a mobile app that would enable a customer to withdraw money from an ATM in less than a few seconds using their phone, not a credit card. With such an open brief from the client, how could we best come up with a solution?

¹³ *Id.* Although the Examining Attorney did not provide a date for above-noted press release, an introduction to another press release or news article attached thereto at TSDR 23 is dated March 12, 2016 and reads “PIN4™ THE FIRST OPEN CARDLESS CASH NETWORK GOES LIVE IN FOUR U.S. CITIES.”

¹⁴ *Id.* at TSDR 32. The website displays a 2015 copyright date. *Id.* at TSDR 36.

Design Thinking and Agile development helped create the solution

* * *

The solution of **cardless cash** was developed via close collaboration with a nearshore development team. ...¹⁵

3. Easy Solutions (easysol.net)

EASY SOLUTIONS

Cardless Cash Withdrawal


No Card, No Problem

Banks now have a secure way to offer customers a **cardless cash** withdrawal option at the ATM. This innovative cardless method permits users to pre-order through the financial institution's mobile application and retrieve the money at participating ATM's.¹⁶

Safely Retrieve Cash from an ATM Without a Card


Step 1

- Download the bank's mobile app.
- Schedule a **cardless cash** transfer within the mobile app.
- Retrieve a one-time-password through a variety of secure channels such as the bank's mobile app, email, or a push notification.



Step 2

- Locate the bank's participating ATM and input the one-time password.



Step 3

- Customers making **cardless cash** withdrawals are protected through Easy Solutions' flexible and multi-layered authentication systems. Other **cardless cash** systems expose users to fraudsters who try to hack into their bank accounts. Easy Solutions products ensure the customer is the only person able to access their own money.
- Banks have the option to authenticate customers through QR codes, biometric technology, push notifications, email or a one time password entered into the bank's mobile app. This process also allows customers to securely obtain cash without experiencing friction.

Cardless Cash Withdrawal Supports Customer Retention

There are 80 million Millennials in the U.S. alone and they are twice as likely to leave their bank for a rival compared to older generations.¹

- Gain customer loyalty by offering this frictionless solution for getting cash quickly
- Expose customers to more financial products and services each time they use the banking app
- Reduce overhead at branches as more customers will turn to the convenience of online banking
- Give customers peace of mind by requiring easy identity authentication at the ATM

¹⁵ *Id.* at TSDR 33.

¹⁶ *Id.* at TSDR 75.

4. Fiserv. (Fiserv.com)

fiserv.

Cardless ATMs – The Evolution of Cash Access

* * *

The opportunity exists to offer **cardless cash** opportunities that address the needs of a broader group of financial institutions and consumers. In particular, smaller financial institutions can offer cardless options that enable them to compete with larger institutions by implementing a solution that features these core components: ...¹⁷

There is also an article posted on the ATM Atom website (atmatom.com) that uses the term CARDLESS CASH generically to describe another company's foray into providing ATM access without a debit or credit card.

Just.Cash An Agnostic, Cardless Withdrawal Option

No Hardware Required

* * *

Global Networks

Using a card, consumers can withdraw cash from almost any ATM via global payment networks, yet there is a lack of network rails enabling customers to withdraw cash via smartphone from the ATMs of any FI of IAD that offers **cardless cash** withdrawals, or from third-party digital wallets such as Apple Pay, Samsung Pay or Android Pay.

A free software application from Miami, Florida-based Just.Cash that works on any manufacturer's ATMs solves the interoperability problem. The Just.Cash app does this by allowing digital wallet providers and FIs to integrate Just.Cash into their mobile platform.

¹⁷ *Id.* at TSDR 77. The website displays a 2017 copyright date. *Id.* at TSDR 79.

Just.Cash acts as a switch, routing cardless withdrawals enabled by ATMs to any issuer that supports Just.Cash. This allows FIs and digital wallet providers to connect ATMs in a single global network and benefit from their own customers' (on-us) and noncustomers' (off-us) transactions. And most importantly, it offers customers ubiquitous cardless mobile access to ATMs.¹⁸

The Examining Attorney submitted two patents and one patent application referring to “cardless cash.”¹⁹

1. Patent 7568615 B2

ELECTRONIC TRANSFER OF HARD CURRENCY

* * *

FIELD OF INVENTION

This invention relates generally to person-to-person and person-to-entity funds transfers and more specifically to wholly and partially automated **cardless cash** transfers.²⁰

2. Patent 9536240 B2

SECURE CARDLESS CASH WITHDRAWAL

ABSTRACT

Methods, systems, and computer program products for secure **cardless cash** withdrawal are provided.²¹

3. Patent Application Publication No. US 2016/0260094

TRANSACTION METHOD AND APPARATUS FOR
CARDLESS CASH WITHDRAWAL

¹⁸ March 29, 2018 Office Action (TSDR 14).

¹⁹ The Examining Attorney submitted an English translation of a Japanese patent application that we have not considered. *Id.* at TSDR 30.

²⁰ *Id.* at TSDR 102. *See also id.* at TSDR 31.

²¹ *Id.* at TSDR 29. *See also id.* at 105.

ABSTRACT

The present invention discloses a transaction method and apparatus for **cardless cash** withdrawal. When having received a **cardless cash** withdrawal reservation request of a user, a first bank server determines whether the reservation request is an interbank **cardless cash** reservation request and satisfies a **cardless cash** withdrawal condition. When the reservation request is the interbank **cardless cash** reservation request and satisfies the **cardless cash** withdrawal condition, a second bank server corresponding to bank identification information in the reservation request is determined, and the second bank server is informed of **cardless cash** withdrawal information, thereby allowing the second bank server to authorize a terminal controlled by same to accept **cardless cash** withdrawal made by the user. The interbank **cardless cash** withdrawal is achieved in order that the user can promptly make a **cardless cash** withdrawal operation at a cash withdrawal terminal that is nearest in an area where the user is located, thereby improving user experience.²²

The Examining Attorney also submitted a copy of Applicant's Registration No. 4582106 (Supplemental Register) for the mark CARDLESS CASH ACCESS, in standard character form, for the goods and services listed below:

Computer software that allows users to withdraw case from automatic teller machines using a smartphone or other mobile device, in Class 9; and

Banking and financial services, namely, automatic teller machine services and electronic transfer services, in Class 36.²³

²² *Id.* at TSDR 106.

²³ March 29, 2018, registered August 5, 2014.

Finally, the Examining Attorney submitted evidence of how the media uses CARDLESS CASH. This is an area of controversy because Applicant contends that the vast majority of the references refer to Applicant, its licensees or associates.

In sum, as detailed in the chart below, the record evidence submitted by the Examining Attorney and [Applicant] in six Office Actions/Responses collectively consists of 177 screen captures and articles showing trademark use of CARDLESS CASH and/or referring to [Applicant] or its customers, in contrast to only 34 U.S. screen captures and articles that show lowercase uses and do not reference [Applicant's] Goods and Services, i.e., nearly 84% of the U.S. evidence (i.e., excluding only foreign uses) favors [Applicant].

Submitted by	Trademark uses (e.g., upper-case or initial capital letters)	Lowercase uses referencing FIS or its customers	Lowercase uses not referencing FIS or its customers	Foreign uses
Examining Attorney	13	39	34	11
FIS	125	—	—	—
Total	138	39	34	11

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We concur that the overwhelming majority of the documents submitted by the Examining Attorney refer to Applicant, Applicant's customers, or Applicant's licensees. Accordingly, we will first discuss the Examining Attorney's evidence that does not refer to Applicant, Applicant's customers, or Applicant's licensees; then we will discuss the Examining Attorney's evidence that Applicant contends refers to Applicant, its licensees or associates; and, finally, we will discuss Applicant's evidence.

²⁴ Applicant's Brief, p. 5 (12 TTABVUE 9). In the table, FIS refers to Applicant.

In his June 8, 2016 Office Action, the Examining Attorney submitted 23 articles retrieved from the LexisNexis database. Applicant's Director of Product Marketing for Digital Finance and Payments testified that 16 of the 23 articles refer to Applicant, Applicant's customers, or Applicant's licensees.²⁵ The excerpts listed below show the unchallenged articles using the term **CARDLESS CASH** in a generic manner:

• PaymentsSource.com (May 31, 2016)

In the future, banks that have their own wallets will be armed with two major advantages. First, they will be able to innovate faster to accommodate customer needs, such as **cardless cash** ATM withdrawals at significantly reduced costs. Second, further innovations, such as cobranding, card consolidation and loyalty/reward schemes will help create richer relationships with customers. The best option for a bank considering a virtual wallet is to work with a technology partner that has domain expertise, allowing for innovations to be tailored in alignment with business strategy and growth objectives.²⁶

• States News Service (April 8, 2016)

The move toward cardless ATMs continues to inch forward, with big banks leading the effort, she said. Were [sic] seeing some interesting extensions of this technology, beyond teeing up the transaction, Willard said. Were [sic] looking at cardless deposits and person-to person pickup at the ATM embedded in **cardless cash** apps.

A major attraction of **cardless cash**? Prevention of skimming, she added.²⁷

²⁵ Burk Decl. ¶2 attached to the December 8, 2016 Office Action (TSDR 38). Ms. Burke missed one exhibit referring to Applicant's customer (TSDR 28). Accordingly, 17 of the 23 articles refer to Applicant, Applicant's customers, or Applicant's licensees.

²⁶ June 8, 2016 Office Action (TSDR 5).

²⁷ *Id.* at TSDR 8.

- Business Wire (June 30, 2015)

NCR Mobile Cash Withdrawal makes the bank's **cardless cash** withdrawal option even faster by using a 2D barcode. Bank of Ningbo customers only need to pre-stage their cash withdrawal amount (up to RMB3,000) by selecting the "Pai Pai Cash" icon on the bank's mobile banking application, a pre-scheduled transaction will then be generated in the application. As soon as the customers arrive at any of the bank's ATMs, they can simply scan the ...²⁸

In his March 29, 2018 Office Action and November 20, 2018 Office Action, the Examining Attorney submitted articles and blogs from the Internet purportedly showing generic use of CARDLESS CASH for ATM transactions and software.²⁹ Again, the Examining Attorney's evidence included documents referring to Applicant, Applicant's customers, and Applicant's licensees.

We attach below a representative sample of articles the Examining Attorney submitted that Applicant contends refers to Applicant, Applicant's customers, or Applicant's licensees:

- The Wichita Eagle (Kansas) (May 25, 2016)

Instead of fumbling for their debit or credit card, "**cardless cash**" transactions have a target completion time of about

²⁸ *Id.* at TSDR 14. Applicant asserts that the Business Wire article is not relevant because it refers to a bank in China. Burk Decl. ¶3 attached to the December 8, 2016 Response to an Office Action (TSDR 39). However, U.S. citizens may read Business Wire articles published in U.S. publications or posted on websites available to readers in the United States. The problem with the Business Wire article is not that its subject is a Chinese bank; the problem is that there is no evidence regarding what U.S. entities publish or post Business Wire articles and how many viewers read them. *See also* Payments Source (June 30, 2015) regarding the same subject matter in a different publication, *Id.* at TSDR 15, and GlobeNewswire (July 31, 2013) reporting on access to cardless cash in the United Kingdom. *Id.* at TSDR 26.

²⁹ March 28, 2018 Office Action (TSDR 9-14 and 24-41); November 20, 2018 Office Action (TSDR 6-28).

10 seconds, said Shane Schoonover, a senior vice president and retail operations manager with the bank.

Fidelity Bank offers Cardless CashNew Fidelity Bank smartphone app lets customers get cash from any Fidelity ATM without a card. (Mike Hutmacher, The Wichita Eagle)

“Our utmost priority is our customers’ security,” Schoonover said. “**Cardless cash** ...[excerpt ends]”³⁰

- Business Wire (April 22, 2016)

Win Trust and City National are working on **cardless cash** ATMs, wherein customers can use their smartphones to withdraw case from ATMs.³¹

- Sarasota Herald Tribune (Florida) (February 1, 2016)

More big banks are embracing the technology allowing customers to conduct ATM transactions with their smartphones.

JPMorgan Chase and Bank of America said last week that they are adapting their automated teller machines so customers can withdraw cash and perform other functions without swiping their cards.

The two big banks join BMO Harris, which rolled out its “**cardless cash**” ATMs in the Sarasota-Manatee area last year.³²

In its December 8, 2016 Response to an Office Action, Applicant submitted copies of 45 articles retrieved from the LexisNexis database purportedly referring to Applicant, Applicant’s customers, or Applicant’s licensees as the source of

³⁰ June 8, 2016 Office Action (TSDR 6).

³¹ *Id.* at TSDR 7.

³² *Id.* at TSDR 9.

CARDLESS CASH products and services. The articles listed below are representative:

- PaymentsSource.com (July 15, 2016)

[Applicant] is working with ATM processing and services provider Payment Alliance International to expand its Cardless Cash program nationally.

Cardless Cash give consumers card-free access through a mobile app and is already supported by 34 U.S. banks. The partnership with PAI would bring the services to more than 70,000 ATMs in a network of large retailers, gas stations and convenience stores.³³

- Targeted News Service (February 11, 2016)

[Applicant] (NYSE: FIS), a global leader in financial services technology, and PayPal (NASDAQ: PYPL) are leading the financial industry with [Applicant] Cardless Cash, a revolutionary capability that allows consumers with a mobile banking app to withdraw money from virtually any ATM. Launched in January 2015, Cardless Cash was the first mobile ATM solution on the market that avoids the plastic debit card. ...

Many more banks across the country are deploying Cardless Cash in 2016, including Popular Community Bank and Oriental Bank.³⁴

- Leominster Champion (Massachusetts) (October 2, 2015)

Hudson-based Avidia Bank, which has a branch in Leominster, is the first financial institution in New England to offer Cardless Cash ATM access, thanks to its partnership with [Applicant], a global leader in banking and payments technology as well as consulting and outsourcing solutions.

Avidia Mobile's Cardless Cash feature will enable consumers to interact with the ATM from the privacy and

³³ December 8, 2016 Response to an Office Action (TSDR 54).

³⁴ *Id.* at TSDR 75.

security of their mobile devices, stage a transaction before stepping up to the ATM and then receive an eReceipt for the transaction on their devices. It's an ongoing effort by the bank to offer the latest in mobile banking innovation to its customer base.³⁵

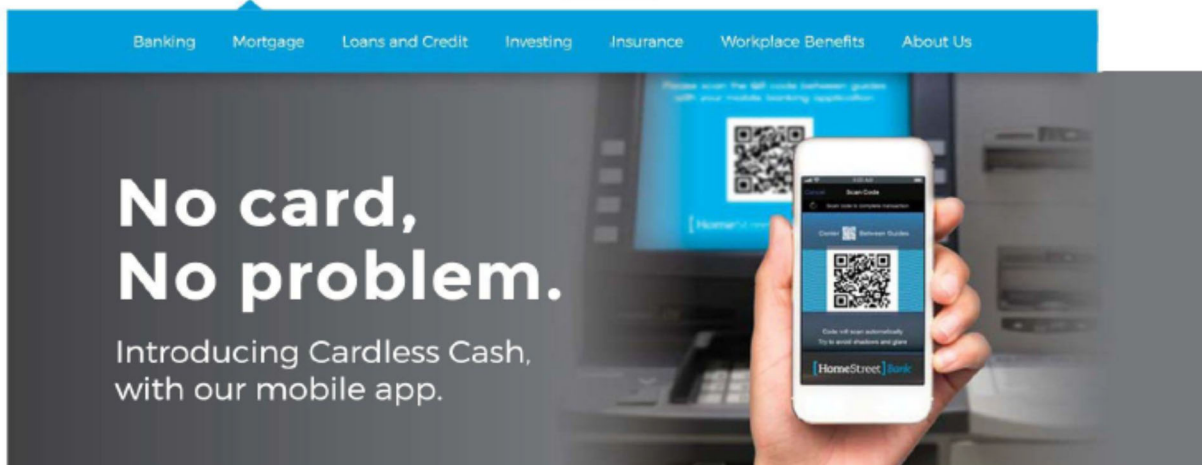
In its August 7, 2017 Response to an Office Action, Applicant submitted 31 examples of articles and blogs posted on the Internet referring to Applicant's CARDLESS CASH platform.³⁶ In its March 6, 2018 Response to an Office Action, September 28, 2018 Request for Reconsideration, and May 20, 2019 Response to an Office Action, Applicant submitted additional examples of articles, blogs and advertisements posted on the Internet referring to Applicant's CARDLESS CASH platform.³⁷ The excerpt from the Homestreet Bank webpage reproduced below is representative:³⁸

³⁵ *Id.* at 82.

³⁶ August 7, 2017 Response to an Office Action (TSDR 60-275).

³⁷ March 6, 2018 Response to an Office Action (TSDR 26-60); September 28, 2018 Request for Reconsideration (4 TTABVUE 71-75); May 20, 2019 Response to an Office Action (TSDR 60-103).

³⁸ March 6, 2018 Response to an Office Action (TSDR 56).



Getting cash from a HomeStreet Bank ATM has never been easier!

With the Cardless Cash feature in the HomeStreet Bank mobile app, you can withdraw money from HomeStreet Bank ATMs using your smartphone.

Cardless Cash is:

- Fast - Set-up cash withdrawal transaction details in advance before arriving at an ATM. No need to insert your card and enter the PIN.
- Secure - Set-up transaction details privately without worrying about your card information and PIN being viewed.
- Convenient - No need to carry a debit card to use the ATM.

Applicant contends that the Examining Attorney's evidentiary showing comprises a mixture of generic or descriptive uses and uses that refer to Applicant, Applicant's customers, or Applicant's licensees and that such a mixed record is not sufficient to meet the USPTO's burden of showing that CARDLESS CASH is generic by clear evidence.³⁹

[T]he vast majority of these uses refer to [Applicant] and customers of [Applicant's] Goods and Services. In such cases, "the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers, and third parties." *In re Am. Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006).

Here, the Examining Attorney introduced a total of 86 articles and screen captures (excluding 11 foreign uses).

³⁹ Applicant's Brief, p. 9 (12 TTABVUE 13).

But the majority—52—actually show trademark use and/or recognition of [Applicant] or its customers, and not alleged generic use of the Mark. Additionally, the Examining Attorney failed to rebut [Applicant's] compelling evidence of at least 125 screen captures and articles showing trademark use and recognition of the Mark. In short, the Examining Attorney's evidence fails to prove a “substantial showing” of “clear evidence of generic use” required by the Federal Circuit.⁴⁰

Applicant relies on *Merrill Lynch* where, like here, the record was voluminous and included “usage in financial publications of the term [CASH MANAGEMENT ACCOUNT], following Merrill Lynch's introduction of the financial system.” *Merrill Lynch*, 4 USPQ2d at 1143. The court there found that the evidence “showed recognition in a substantial number of publications that the source of the CASH MANAGEMENT ACCOUNT was [Merrill Lynch]” and, thus, held that such an evidentiary showing does not make CASH MANAGEMENT ACCOUNT generic. *Id.* at 1143-44.

Applicant also cites *In re Am. Online, Inc.*, 77 USPQ2d 1618 (TTAB 2006), where the Board found that the majority of references in a wide variety of publications refer to applicant and, therefore, held that the USPTO did prove that INSTANT MESSENGER was generic. *Am. Online*, 77 USPQ2d at 1623. In reaching its holding on the case, the Board made the following observation:

We add that the mere fact that a record includes evidence of both proper trademark use and generic use does not necessarily create a mixed record that would overcome an examining attorney's evidence of genericness. Quite simply, it would be fairly easy for a well-heeled applicant to ensure that there were at least some stories that would

⁴⁰ *Id.*

properly use an applicant's mark. However, in this case, the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers, and third parties.

Id.

Applicant's response in this case to the Examining Attorney's evidentiary showing is impressive as was the applicant's in *Am. Online*. However, unlike the records in *Merrill Lynch* and *Am. Online*, in this appeal, we have unrebutted and unexplained generic use of the term CARDLESS CASH by four other companies to describe their ATM and fund transfer banking services and the software to carry out those services. In addition, the two patents and one patent application that use CARDLESS CASH generically show how the technical people in the field perceive the term. *Cf. In re Int'l Game Tech. Inc.*, 1 USPQ2d 1587, 1588 (TTAB 1986) (excerpts from U.S. utility patents made of record to show that the term "on-demand," in the phrase ON-LINE, ON-DEMAND, had descriptive significance with respect to computers, computer-controlled equipment, or other automated equipment — merely descriptive refusal affirmed). Finally, some the articles using the term CARDLESS CASH in a generic manner refer to large financial institutions and technology companies unrelated to Applicant. Thus, numerous ATM users, other than Applicant's customers and Applicant's licensees, encounter CARDLESS CASH used in a generic manner. For example,

- Business Insider (businessinsider.com) (September 13, 2017)

MasterCard tests **cardless cash** pick-up

MasterCard is testing MasterCard Cash Pick-Up, a mobile cash disbursement service that allows users to access cash from a participating ATM using only a mobile phone.⁴¹

- ATM Marketplace (atmmarketplace.com) (March 15, 2018)

Fifth Third ATMs enabled for **cardless cash** withdrawals

Customers of Fifth Third Bank can now withdraw cash from the bank's ATMs without using a bankcard.⁴²

- Digital Transactions (digitaltransactions.net) (October 10, 2017)

Wells Fargo Launches NFC Cardless Cash ATM Service and other Digital Transactions News briefs from 10/10/17

- Wells Fargo & Co. launched **cardless cash** access at its ATMs using near field communication technology. Consumers using the bank's mobile app hold an NFC-equipped smart phone near an NFC-enabled ATM after opening and authenticating the bank app. The ATM then prompts for a PIN entry to complete the transaction. Wells said approximately 5,000 of its 13,000 ATMs are NFC-equipped, and it expects to update the remainder to the technology by 2019. Since March, it has offered **cardless cash** access using a one-time access code within the Wells Fargo banking app.⁴³

- Samsung Mobile (sammobile.com) (September 29, 2017)⁴⁴

Samsung Pay **cardless cash** withdrawal now supported by Wells Fargo ATMs

⁴¹ March 29, 2018 Office Action (TSDR 10).

⁴² March 29, 2018 Office Action (TSDR 25).

⁴³ March 29, 2018 Office Action (TSDR 28).

⁴⁴ March 29, 2018 Office Action (TSDR 32-33).

Cardless Cash feature for the Citi Mobile App

 by Olga Bolshchikova

Cardless Cash features include: • withdrawing cardless cash when you stand in front of the ATM • withdrawing cardless cash if there is no ATM around you • allowing your family members and friends to withdraw cardless cash from your account

- Mobile Payments Today (mobilepaymentstoday.com) (January 27, 2016)

Chase ATMs in the race to cardless cash

JPMorgan Chase will implement cardless ATM access across its entire fleet this year, according to the New York Post which broke the story.

The news follows a December announcement by Wells Fargo that it would offer **cardless cash**, and an October announcement by Diebold, Inc. and Citibank that the two were testing a cardless ATM concept that uses its scanning for user recognition. Both Wintrust and BMO Harris introduced fleet-wide mobile cash withdrawal in 2015.⁴⁵

- AOL Finance (aol.com) (February 6, 2016)

Bank of America announced that they will implement the **cardless cash** withdrawal system in nearly 5,000 of their ATM machines by 2017, and Wells Fargo & Co. expending to have around 40 percent of their ATM's enabled with the same feature by the same time.⁴⁶

- NewsTalk.com (May 19, 2016)

Cardless cash withdrawals: Google is changing how we take out cash

Google has unveiled another new feature of Android Pay, which gives them the edge over Apple and Samsung Pay.

⁴⁵ March 29, 2018 Office Action (TSDR 41).

⁴⁶ February 7, 2017 Office Action (TSDR 18).

The **cardless cash** withdrawal was unveiled on Wednesday at Google's I/O developers conference.⁴⁷

In addition, there are many references by the media to “cardless cash” using “lower case” letters, which reflects the relevant public’s understanding of the term as a category of goods and services rather than as a brand. *See In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514*9 (TTAB 2019), *citing Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1190 (TTAB 2017). In light of all the evidence of record, we find that there is clear evidence that members of the relevant public primarily use or understand CARDLESS CASH to be generic for ATM and fund transfer banking services and the software to carry out those services, and more specifically to the goods and services identified by Applicant. Therefore, we find that CARDLESS CASH is generic when used in connection with ATM and fund transfer banking services and the software to carry out those services.

For purposes of completeness, we consider the alternative refusal of whether the term CARDLESS CASH for ATM and fund transfer banking services and the software to carry out those services has acquired distinctiveness.

II. Whether Applicant’s use of CARDLESS CASH has acquired distinctiveness?

Despite the facts that Applicant amended its application to register CARDLESS CASE under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), without reservation for ATM and fund transfer banking services and the software to carry out those services, Applicant argues that CARDLESS CASH is suggestive, not

⁴⁷ February 7, 2017 Office Action (TSDR 46).

descriptive and certainly not generic.⁴⁸ As noted in footnote 2, Applicant did not amend its application to seek registration under Section 2(f) in the alternative.

The Examining Attorney, in his brief, contends that Applicant concedes that CARDLESS CASH is merely descriptive because it did not seek to register CARDLESS CASH under the provisions of Section 2(f) in the alternative.⁴⁹ Applicant, in its Reply Brief, did not argue that it sought to register CARDLESS CASH under Section 2(f) in the alternative.

An applicant may argue the merits of an examining attorney's refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1051(e)(1), and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under § 2(f). Unlike the situation in which an applicant initially seeks registration under § 2(f) or amends its application without objection, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. *See In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Prof'l Learning Ctrs., Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986).

In this case, Applicant submitted its Section 2(f) claim without reservation and without claiming in the alternative that the proposed mark is inherently distinctive. Applicant's amendment asserting Section 2(f), made without reservation, is an admission that CARDLESS CASH is not inherently distinctive, and Applicant cannot

⁴⁸ Applicant's Brief, pp. 5-10 (12 TTABVUE 9-14).

⁴⁹ Examining Attorney's Brief (14 TTABVUE 16).

argue otherwise in this appeal. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”); *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact.”). Thus, the only other issue remaining is whether CARDLESS CASH has acquired distinctiveness, not whether it is merely descriptive.

Under Section 2(f) of the Trademark Act, matter that is merely descriptive under Section 2(e)(1) may nonetheless be registered on the Principal Register if it “has become distinctive of the applicant’s goods [or services] in commerce.” Thus, the USPTO may register CARDLESS CASH on the Principal Register if Applicant proves that it has acquired distinctiveness (also known as “secondary meaning”) as used in connection with the Applicant’s services in commerce. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728-30 (Fed. Cir. 2012); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017). Acquired distinctiveness is generally understood to mean an acquired “mental association in buyers’ minds between the alleged mark and a single source of the product.” *Apollo Med. Extrusion Techs.*, 123 USPQ2d at 1848 (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed.,

June 2017 Update)). In this regard, in analyzing above whether CARDLESS CASH is a generic term, we considered all of the evidence touching on the public perception of that term.

An applicant seeking registration of a mark under Section 2(f) bears the ultimate burden of establishing acquired distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (“The applicant ... bears the burden of proving acquired distinctiveness.”) (citation omitted).

A. Degree of Descriptiveness

The initial question before us in our analysis of whether CARDLESS CASH has acquired distinctiveness is the degree of descriptiveness of that term as used in connection with Applicant’s goods and services. *See Royal Crown Cola*, 127 USPQ2d at 1048 (“the Board must make an express finding regarding the degree of the mark’s descriptiveness on the scale ranging from generic to merely descriptive, and it must explain how its assessment of the evidentiary record reflects that finding.”); *Nazon v. Ghiorse*, 119 USPQ2d at 1178, 1187 (TTAB 2016). “[A]pplicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). As the Board has explained:

[T]he greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. The sufficiency of the evidence offered to prove acquired distinctiveness should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks

and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source-indicators.

In re Greenliant Sys. Ltd., 97 USPQ2d at 1085 (internal citations omitted). *See also La. Fish Fry Prods.*, 116 USPQ2d at 1265 (Board has discretion not to accept an applicant's allegation of five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness when the proposed mark is "highly descriptive"); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 SUPQ2d 1056, 1058 (Fed. Cir. 1999) ("[C]onsidering the highly descriptive nature of the proposed mark, [Applicant] has not met its burden to show that the proposed mark has acquired secondary meaning.").

Inasmuch as Applicant contends that CARDLESS CASH is suggestive when used in connection with ATM and fund transfer banking services and the software to carry out those services, it would also contend that CARDLESS CASH is barely merely descriptive in assessing its degree of descriptiveness.⁵⁰ Applicant asserts that CARDLESS CASH is not merely descriptive and, therefore, not highly descriptive, because a potential customer must use multiple step reasoning, thought, imagination or logic to understand the connection between CARDLESS CASH and ATM and fund transfer banking services and the software to carry out those services.⁵¹

"CASH," a synonym of "money," when combined with "CARDLESS," is not merely descriptive of [Applicant's] Goods and Services. In other words, consumers may have

⁵⁰ Applicant's Brief, pp. 5-7 (12 TTABVUE 9-11).

⁵¹ *Id.* at p. 6 (12 TTABVUE 10).

some vague idea that [Applicant's] Goods and Services have something to do with "cash" and/or "no card," but they will not immediately know that [Applicant] offers computer software for ATMs and ATM and fund transfer services under the Mark.⁵²

In addition, Applicant asserts that CARDLESS CASH is an incongruous combination that consumers would not naturally use to describe Applicant's goods and services.

Here, the combination of CARDLESS with CASH is incongruous because the term "CASH" brings to mind hard or physical currency such as coins or bills, whereas CARDLESS brings to mind the opposite meaning of something that is not a physical card—"no card." While prospective customers encountering the Mark may have some idea of the general nature of [Applicant's] Goods and Services (i.e., something to do with "cash" and "no cards"), they would have to go through a series of mental steps to determine the precise nature of [Applicant's] Goods and Services (i.e., computer software and ATM and electronic funds transfer services), if they even can, because the Mark does not identify them with any degree of particularity. In fact, the unique combination of the terms CARDLESS CASH creates an incongruity of meanings not typically encountered or understood together, namely "no card" and "cash."⁵³

Based on the evidence discussed above in connection with the genericness refusal, we find that each of the terms comprising the subject matter that Applicant seeks to register, "Cardless" and "Cash" is highly descriptive of ATM and fund transfer banking services and the software to carry out those services. Moreover, when combined, the record also shows that the composite proposed mark CARDLESS

⁵² *Id.* at p. 6 (12 TTABVUE 10).

⁵³ *Id.* at p. 7 (12 TTABVUE 11).

CASE is at the very least, highly descriptive of those services. *See, e.g., Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (CORN THINS and RICE THINS are highly descriptive); *La. Fish Fry Prods., Ltd.*, 116 SUPQ2d at 1265; *Apollo Med. Extrusion Techs.*, 123 USPQ2d at 1851 (MEDICAL EXTRUSION TECHNOLOGIES is highly descriptive of “polyurethanes in the form of sheets, films, pellets, granules, and tubes for use in the manufacture of medical devices, medical diagnostic devices, artificial vascular grafts, stents, pacemaker leads, artificial heart pump diaphragms, catheters, drug delivery devices, orthopedic and spinal implants, blood glucose monitors, and blood gas analyzers”); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1173 (TTAB 2013) (holding SUPERJAWS merely descriptive for tools). Clearly, no thought or imagination is required to immediately understand that ATM and fund transfer banking services and the software to carry out those services rendered under the mark CARDLESS CASH are just that, card free cash access.

Accordingly, Applicant’s proposed mark CARDLESS CASH is highly descriptive of Applicant’s goods and services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

B. Acquired Distinctiveness

Because we have found that the term CARDLESS CASH is highly descriptive of Applicant’s goods and services, Applicant’s burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See Steelbuilding.com*, 75 USPQ2d at 1424; *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729

(Fed. Cir. 1990); *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1199 (TTAB 2016); *In re Greenliant Sys. Ltd.*, 97 USPQ2d at 1085.

“To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.” *Steelbuilding.com*, 75 USPQ2d at 1422; *see also Coach Servs.*, 101 USPQ2d at 1729. We base our Section 2(f) analysis and determination in this case on all of the evidence considered as a whole, guided by the following factors:

(1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. ... All six factors are to be weighed together in determining the existence of secondary meaning.

In re Snowizard, Inc., 129 USPQ2d 1001, 1005 (TTAB 2018) (quoting *Converse, Inc. v. Int’l Trade Comm’n*, 907 F.3d 1361, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)). *See also Steelbuilding.com*, 75 USPQ2d at 1424; *Cicena Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401, 1406 (Fed. Cir. 1990). On this list, no single fact is determinative. *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) (“Direct evidence [of acquired distinctiveness] includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years

of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers.”).

1. Association of CARDLESS CASH with a particular source by actual purchasers (typically measured by customer surveys).

Applicant did not submit any direct testimony or evidence from actual consumers, nor did it submit a customer survey.

2. Length, degree, and exclusivity of use.

Applicant has used CARDLESS CASH since 2013.⁵⁴ However, as discussed above in our analysis of whether CARDLESS CASH is generic, the Examining Attorney submitted evidence regarding four companies other than Applicant providing software to make ATM and fund transfer services available that use the term “Cardless Cash” to describe their ATM services:

- HalCash North America (pin4.com);⁵⁵
- Belatrix (belatrixsf.com);⁵⁶
- Easy Solutions (easysol.net);⁵⁷ and

⁵⁴ Burk Decl. ¶1 attached to the August 7, 2017 Response to an Office Action (TSDR 24-25); Brown Decl. ¶1 attached to the March 13, 2018 Voluntary Amendment (TSDR 7); Bajaj Decl. ¶2 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 29); Bajaj Decl. ¶2 attached to the May 20, 2019 Response to an Office Action (TSDR 31).

Douglas G. Brown is Applicant’s Group Executive & SVP. Brown Decl. (TSDR 15).

Hitesh Bajaj is Applicant’s Vice Present, mCommerce and New Products. Bajaj Decl. (4 TTABVUE 66).

⁵⁵ February 7, 2017 Office Action (TSDR 22).

⁵⁶ *Id.* at TSDR 32.

⁵⁷ *Id.* at TSDR 75.

- Fiserv. (Fiserv.com).⁵⁸

3. Amount and manner of advertising.

Applicant's witnesses testified, "Applicant advertises and markets its CARDLESS CASH software platform extensively."⁵⁹ It provides promotional materials "to potential customers and technology industry leaders."⁶⁰ Potential customers include banks, credit unions, and ATM operators and networks.⁶¹ Applicant also promotes CARDLESS CASH "on the Internet in the form of videos ... by Applicant, Applicant's banking customers, and Applicant's ATM partners."⁶²

In addition to its own advertising, Applicant's affiliates, partners, and licensees display CARDLESS CASH in connection with the ATM and fund transfer banking services and the software to carry out those services they offer.⁶³ The marketing materials reproduced below are representative:

⁵⁸ *Id.* at TSDR 77.

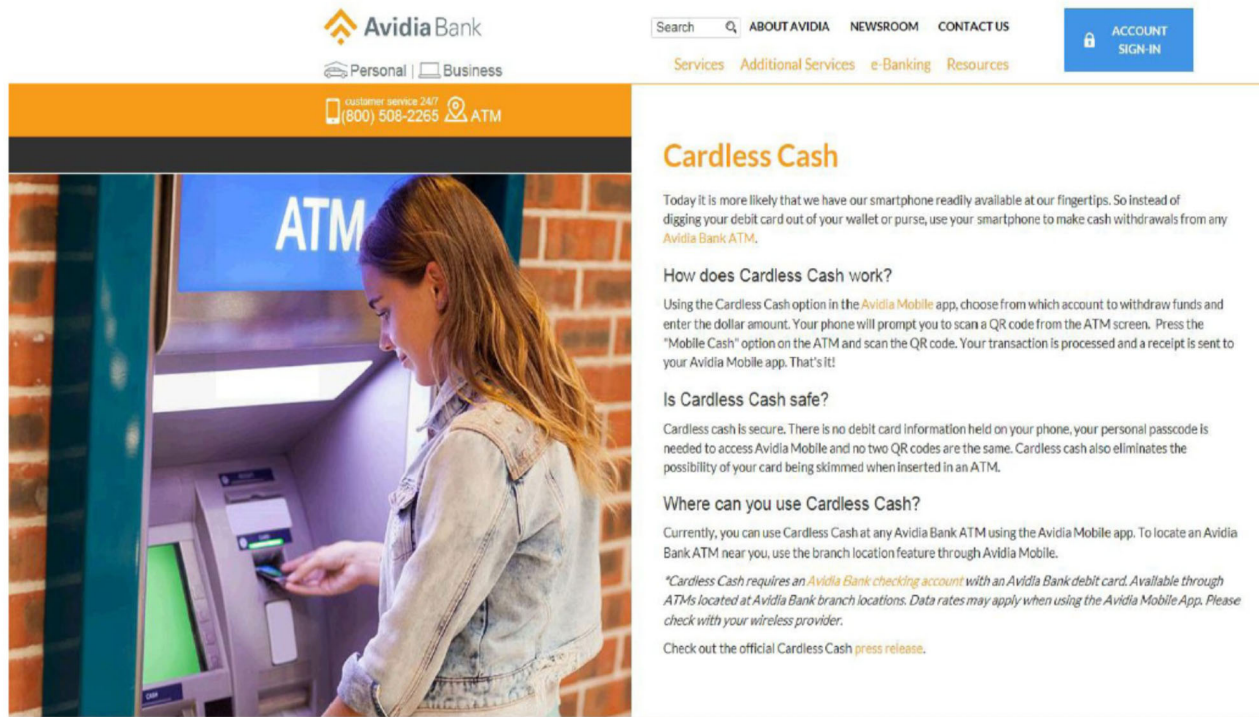
⁵⁹ Bajaj Decl. ¶4 attached to the May 20, 2019 Response to an Office Action (TSDR 31); Bajaj Decl. ¶4 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 29); Brown Decl. ¶3 attached to the March 13, 2018 Voluntary Amendment (TSDR 8); Burk Decl. ¶3 attached to the August 7, 2017 Response to an Office Action (TSDR 25).

⁶⁰ Bajaj Decl. ¶4 attached to the May 20, 2019 Response to an Office Action (TSDR 31); Bajaj Decl. ¶4 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 29); Brown Decl. ¶3 attached to the March 13, 2018 Voluntary Amendment (TSDR 8).

⁶¹ Bajaj Decl. ¶6 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 33).

⁶² Bajaj Decl. ¶6 attached to the May 20, 2019 Response to an Office Action (TSDR 35); Bajaj Decl. ¶7 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 34).

⁶³ Burk Decl. ¶10 and Exhibit C attached to the August 7, 2017 Response to an Office Action (TSDR 28 and 243-275). *See also* Brown Decl. ¶6 attached to the March 13, 2018 Voluntary Amendment (TSDR 11); Bajaj Decl. ¶¶12 and 15 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 47 and 55-56); Bajaj Decl. ¶¶10 and 13 attached to the May 20, 2019 Response to an Office Action (TSDR 48 and 56-57).



The screenshot shows the Avidia Bank website. The header includes the Avidia Bank logo, navigation links for Personal and Business services, a search bar, and links to About Avidia, Newsroom, Contact Us, Services, Additional Services, e-Banking, and Resources. A blue button for Account Sign-In is also present. Below the header, a woman is shown using her smartphone at an ATM. The main content area is titled "Cardless Cash" and explains how the service works: users use the Avidia Mobile app to scan a QR code at the ATM. It also addresses safety concerns, stating that Cardless Cash is secure as it doesn't store card information on the phone. Finally, it lists where the service can be used, noting it's available at Avidia Bank ATMs. A disclaimer at the bottom states that Cardless Cash requires an Avidia Bank checking account with a debit card and that data rates may apply when using the mobile app.

Cardless Cash

Today it is more likely that we have our smartphone readily available at our fingertips. So instead of digging your debit card out of your wallet or purse, use your smartphone to make cash withdrawals from any Avidia Bank ATM.

How does Cardless Cash work?

Using the Cardless Cash option in the Avidia Mobile app, choose from which account to withdraw funds and enter the dollar amount. Your phone will prompt you to scan a QR code from the ATM screen. Press the "Mobile Cash" option on the ATM and scan the QR code. Your transaction is processed and a receipt is sent to your Avidia Mobile app. That's it!

Is Cardless Cash safe?

Cardless cash is secure. There is no debit card information held on your phone, your personal passcode is needed to access Avidia Mobile and no two QR codes are the same. Cardless cash also eliminates the possibility of your card being skimmed when inserted in an ATM.

Where can you use Cardless Cash?

Currently, you can use Cardless Cash at any Avidia Bank ATM using the Avidia Mobile app. To locate an Avidia Bank ATM near you, use the branch location feature through Avidia Mobile.

**Cardless Cash requires an Avidia Bank checking account with an Avidia Bank debit card. Available through ATMs located at Avidia Bank branch locations. Data rates may apply when using the Avidia Mobile App. Please check with your wireless provider.*

Check out the official Cardless Cash [press release](#).

Cardless Cash™



Securely get cash from select ATMs using your mobile device.

Download the App

⁶⁴ Burk Decl. attached to the August 7, 2017 Response to an Office Action (TSDR 244).

⁶⁵ *Id.* at TSDR 246 (Bank of Hawaii).



MidFirst Home / Personal / Online & Mobile Banking

Getting cash from a MidFirst Bank ATM is now easier than ever!

With the MidFirst Bank Mobile App and its Cardless Cash^{*} feature, you can now make a withdrawal using your smartphone.

4. Amount of sales and number of customers.

Applicant has partnered with “major ATM providers, including Diebold Nixdorf, NCR, Payment Alliance International, CO-OP, CardTronics, Genmega, Hyosung, and Triton” to provide its ATM and fund transfer banking services and the software to carry out those services.⁶⁷ Thus, Applicant’s CARDLESS CASH ATM and fund transfer banking services and the software to carry out those services are available in 280,000 ATM locations in “retail, bank, and non-bank spaces,” including:

- 70,000 ATMs operated by Payment Alliance International, the largest privately-held ATM provider in the United States;
- 30,000 ATMs operated by CO-OP for 2,000 participating credit unions;
- 180,000 ATMs operated by CardTronics, the world’s largest non-bank ATM owner/operator; and

⁶⁶ *Id.* at TSDR 257.

⁶⁷ Burk Decl. ¶5 attached to the August 7, 2017 Response to an Office Action (TSDR 27).

- 1,500 ATMs operated by banks.⁶⁸

“By mid-2016, Applicant had processed \$50,000,000 in CARDLESS CASH withdrawals.”⁶⁹ In 2017 alone, Applicant’s licensees and affiliates processed more than \$70,000,000 in transactions,⁷⁰ in 2018, Applicant’s licensees and affiliates processed more than \$88,600,000 in transactions, and, in the first quarter for 2019, they processed over \$20,000,000.⁷¹

More than 49 banks offer Applicant’s CARDLESS CASH ATM and fund transfer banking services and the software to carry out those services including BMO Harris Bank, Peoples Bank, Oriental Bank, Wintrust Financial, Avidia Bank, WSFS, Bank of Hawaii, and Popular Bank.⁷² Thus, the CARDLESS CASH goods and services are available across the United States.⁷³

5. Intentional copying.

Applicant did not present any testimony or other evidence regarding intentional copying.

6. Unsolicited media coverage of the product embodying the mark.

⁶⁸ *Id.* at ¶6 (TSDR 27); Bajaj Decl. ¶¶15-17 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 55-58); Bajaj Decl. ¶¶13-16 attached to the May 20, 2019 Response to an Office Action (TSDR 56-63).

⁶⁹ Burk Decl. ¶7 attached to the August 7, 2017 Response to an Office Action (TSDR 27).

⁷⁰ Brown Decl. ¶8 attached to the March 13, 2018 Voluntary Amendment (TSDR 14).

⁷¹ Bajaj Decl. ¶17 attached to the May 20, 2019 Response to an Office Action (TSDR 63-64).

⁷² Brown Decl. ¶9 attached to the March 13, 2018 Voluntary Amendment (TSDR 14).

⁷³ Burk Decl. ¶9 attached to the August 7, 2017 Response to an Office Action.; Brown Decl. ¶10 attached to the March 13, 2018 Voluntary Amendment (TSDR 14-15); Bajaj Decl. ¶¶18, 24 and 25 attached to the September 28, 2018 Request for Reconsideration (4 TTABVUE 60-62 and 64-65).

As discussed above in our analysis of whether CARDLESS CASH is generic, Applicant's CARDLESS CASH ATM and fund transfer banking services and the software to carry out those services has received extensive media coverage.

In many cases, evidence regarding the amount and manner of advertising, amount of sales and number of customers, and unsolicited media coverage may be sufficient to prove that CARDLESS CASH has acquired distinctiveness. However, in this appeal, because we have evidence of four other companies using the term "Cardless Cash" to describe the ATM services that they render to banks, credit unions and others, Applicant's use of the highly descriptive CARDLESS CASH is not substantially exclusive. Applicant did not submit any testimony or evidence challenging the use of "Cardless Cash" by the four other companies such as protest letters, infringement actions, or evidence that the other companies are no longer using "Cardless Cash" or that such use is insignificant. Despite the testimony of Applicant's witnesses that Applicant's use of CARDLESS CASH has been exclusive,⁷⁴ the un rebutted evidence, discussed above, proves otherwise.

Exclusivity of use examines whether Applicant's use of CARDLESS CASH has been substantially exclusive. *Converse, Inc. v. Int'l Trade Comm'n*, 128 USPQ2d at 1547. While absolute exclusivity is not required, see *L.D. Kitchler Co. v Davoli, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999), the un rebutted, unexplained

⁷⁴ Burk Decl. ¶1 attached to the August 7, 2017 Response to an Office Action (TSDR 24-25); Brown Decl. ¶1 attached to the March 13, 2018 Voluntary Amendment (TSDR 7); Bajaj Decl. ¶2 attached to the September 28, 2018 Request for Reconsideration (4 TTABVue 29); Bajaj Decl. ¶2 attached to the May 20, 2019 Response to an Office Action (TSDR 31).

third-party use of “Cardless Cash” by four competitors is inconsistent with Applicant’s claim of substantially exclusive use of that term and, ultimately, of acquired distinctiveness. *See also Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-941 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (evidence insufficient to establish distinctiveness due to significant and continuous concurrent use of term by competitor such that applicant’s use was not substantially exclusive); *Performance Open Wheel Racing, Inc. v. U.S. Auto Club Inc.* 2019 USPQ2d 208901*9 (TTAB 2019) (testimony that opposer and applicant co-sanctioned races under the mark at issue is probative that Applicant’s use of the mark is not substantially exclusive). *Compare Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 231 USPQ 926, 932 (TTAB 1986), *aff’d*. 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988) where the Board found that the use of guitar head configurations by four competitors that “was like” or “were like” the guitar head configuration at issue were insufficient to rebut applicant’s claim of acquired distinctiveness because they did not evidence “longtime employment of stylized designs merely as ornamental decorations” and there was no “confusing similarity.”

In view of the foregoing, we find that Applicant failed to prove that Applicant’s use of the term CARDLESS CASH is substantially exclusive and, therefore,

Applicant did not prove that the highly descriptive CARDLESS CASH has acquired distinctiveness when used in connection with ATM and fund transfer banking services and the software to carry out those services.

Decision: The refusal to register Applicant's mark CARDLESS CASH on the grounds that it is generic and, in the alternative, that it is merely descriptive and has not acquired distinctiveness are affirmed.