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

Proceeding	91212906
Party	Defendant Cashsquare Inc.
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Attachments	Amended Motion to Amend.021815.pdf(499509 bytes)

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February 18, 2015

OUR FILE
100-2891

Via e-filing through the ESTTA Portal
United States Patent and Trademark Office
Patent and Trademark Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1450

Re: Square, Inc. (Opposer) v. Cashsquare, Inc. (Applicant)
Trademark Application Serial No. 85/827,823
Opposition No. 91212906

To Whom It May Concern:

Yesterday, our office filed Applicant's Motion to Amend Application After Notice of Opposition (the "Motion to Amend") through the ESTTA website portal. Unfortunately, the Motion to Amend contained a minor error requiring correction.

Accordingly, enclosed please find Applicant's Amended Motion to Amend Application After Notice of Opposition, which corrects the error at issue. We apologize for any confusion this may have caused and thank you for your understanding and consideration.

Very truly yours,

Leonard Grayver
for the firm

LG\jlb
Enclosure

cc: Connie L. Ellerbach, Esq., Fenwick & West, 801 California Street, Mountain View, CA 94041 (Attorney for Opposer, Square, Inc.), with enclosure

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

In the Matter of
Trademark Application Serial No. 85/827,823
Published in the Official Gazette: June 11, 2013
Mark: CASHSQUARE

Square, Inc.,	)	
	)	
Opposer,	)	
v.	)	Opposition No. 91212906
	)	
	)	
Cashsquare, Inc.,	)	
	)	
Applicant.	)	
	)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPLICANT'S <u>AMENDED</u> MOTION TO AMEND APPLICATION

AFTER NOTICE OF OPPOSITION

Applicant, Cashsquare, Inc., ("Applicant") brings the foregoing Motion requesting leave to Amend its Trademark Application after notice of Square, Inc.'s (herein, also referred to as the "Opposer") Opposition against the registration of Applicant's trademark of "CASHSQUARE" and its related stylized design (hereinafter, the "Mark"), as show in Application Serial No. 85/827,823 (hereinafter, the "Application") filed on January 21, 2013, and published in the June 11, 2013 issue of the *Official Gazette*:

INTRODUCTION AND FACTUAL BACKGROUND

On January 21, 2013, Applicant filed a 1A "actual use" trademark application relating to the Mark. As stated in the Application, the Mark "consists of a wording 'cashsquare' with a stylized letter 'Q'." The Application sought to register the Mark with the following stylized design: cashsquare.

On June 11, 2013, the Mark was published for opposition. On October 9, 2013, Square, Inc. filed its Notice of Opposition to the Application (hereinafter, the "Opposition") which resulted in commencement of the instant opposition proceeding.

In its Opposition, Square, Inc. argues, *inter alia*, that "Opposer has used its SQUARE (and design) and Design only marks (collectively, with the SQUARE word mark, 'SQUARE Marks') since 2012" in connection with its "business of designing, manufacturing, marketing, selling, and providing goods and services, including hardware, software, and related services, for use in connection with **credit card, debit card, and prepaid card payments and payment processing on mobile devices and in electronic commerce**." *See* Opposition, p.5, ¶5. (Emphasis added.) Therein, Opposer further argues the Mark "so resembles Opposer's SQUARE Marks" that is has the potential to confuse consumers and may lead consumers to assume "a relationship between Applicant's goods and Opposer's goods and services." *See* Opposition, p.9, ¶20 – p.10, ¶23.

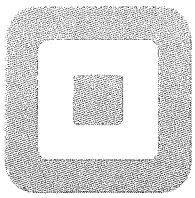
In sum, Square, Inc.'s Opposition to the Mark is based on the belief that the Mark "incorporates key elements of Opposer's SQUARE Marks, including both the word SQUARE and the distinctive design element of Opposer's marks." *See* Opposition, p.9, ¶22.

Conversely, Applicant claims no potential for confusion exists since: (1) the Mark bears no substantial resemblance to the Opposer's registered mark; and (2) as set forth in the Application, the goods and services provided by Applicant in connection with the use of its Mark (i.e., software used on mobile phones for interactive entertainment) are completely different that the goods and services provided by Opposer (i.e., hardware and software for processing credit card, debit card, and gift card transactions via mobile devices).

For purposes of reference and comparison, the following is a side-by-side comparison of the Mark and Opposer's registered marks (U.S. Trademark Reg. Nos. 3,917,735 and 3,962,489) upon which its Opposition is based:

Applicant's Mark: **cashsquare** Opposer's registered mark: SQUARE

Opposer further claims that the Mark also infringes on the following two designs of its subsequently designed marks, which are presently the subject of pending Trademark applications (U.S. Trademark Application Serial. Nos. 85/542,833 and 85/542,832):



Square

By the instant Motion, Applicant requests leave to amend the Application to modify it in only one respect: to delete the "dot" from the stylized Q in the Mark as set forth in the Application. For purposes of reference and comparison, the following is a side-by-side comparison of the Mark before and after the proposed amendment:

Before: cashsquare After: cashsquare

The purpose of this Motion is to narrow the scope of the dispute before the Board, without materially altering Applicant's pending Application. Consistent with the limitations and requirements set forth in 37 CFR 2.133, on or about February 9, 2015 counsel for Applicant requested Opposer's consent to the proposed amendment. At that time, counsel for Opposer stated that she did not consent to, and would oppose, the Motion. Nonetheless, at that time the parties agreed and stipulated to extend all Opposition deadlines 60 days to allow sufficient time to file the Motion and have the Board issue a ruling on the Motion.

ARGUMENT

I. The Board Has the Authority to Issue Leave to Amend.

15 U.S.C. 1057(e) provides, in relevant part, that "[u]pon application of the registrant and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: Provided, that the amendment or disclaimer does not alter materially the character of the mark." 15 U.S.C 1057(e).

This authority is further supported by the Code of Federal Regulations ("C.F.R."), which permits an amendment of "the description or drawing" in a trademark application with the approval of this Board (37 C.F.R. 2.133) so long as the "proposed amendment does not materially alter the mark" (37 C.F.R. 2.72).

Indeed, pursuant to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), "[t]he Board, in its discretion, may grant a motion to amend an application or

registration which is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto." TBMP § 514.03 (2014).

Additionally, it is well settled that the Board "liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party or parties," would violate settled law, or would serve no useful purpose. *See* TBMP § 507.02 (2014) and Fed. R. Civ. P. 15(a). *See also*, e.g., *Polaris Indus. v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703 (TTAB 2000); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998).

Accordingly, there can be no dispute that the Board has the authority to issue the requested relief.

II. The Instant Motion Is Timely and is the Subject of a Stipulation of the Parties.

"When a motion to amend an application or registration in substance is made without the consent of the other party or parties, it ordinarily should be made prior to trial, in order to give the other party or parties fair notice thereof[.]" TBMP § 514.03 (2014).

As explained *supra*, on February 10, 2015, the parties hereto agreed to continue all relevant deadlines in this matter 60 days to allow sufficient time for Applicant to file this Motion and to ensure the Board has sufficient time to consider and rule on the Motion. To that end, on February 10, 2015, Opposer filed a Stipulated Motion to Extend Time to Open

Plaintiff Testimony and Subsequent Trial Deadlines (hereinafter, the "Stipulated Motion to Extend").

Under the terms of the Stipulated Motion to Extend, the trial period in this matter does not commence until **April 11, 2015**. Accordingly, the instant Motion is timely.

III. Good Cause Exists to Grant Leave to Amend.

In its Opposition, Opposer claims that the name "CASHSQUARE" is improperly similar to its "SQUARE" word mark. *See* Opposition, p.8, ¶19 ("Applicant's inclusion of the secondary word "CASH" does little to distinguish [Applicant] from Opposer's widely recognized and famous SQUARE mark.").

In the Opposition, Opposer further objects that the stylized "Q" in the Mark has a tendency to mislead and confuse the public into believing "that there is a relationship or affiliation between Applicant and Opposer, when in fact no such relationship exists." *See* Opposition, pgs.8-9, ¶19 ("Applicant [. . .] uses Opposer's distinctive square-within-a-square design in the visual representation [of the Mark.]").

Allowing Applicant to amend its Application ever so minimally -- as fully explained above -- will serve to narrow the scope of the dispute before the Board without materially altering the pending Application. Essentially, the instant dispute centers on the likelihood of confusion between the credit card and payment processing services offered by Opposer (and, more specifically, its "Square Cash" money transfer service, which was launched in October

2013 to allow person-to-person money transfer via e-mail or text message) and Applicant's mobile phone based entertainment and gaming application.

As explained above, the proposed amendment to the Application does not seek to alter, in any way, the description of goods and services offered by Applicant in the Application and, therefore, does not materially alter the character of the mark and/or does not affect the central issue to be decided by the Board in this proceeding. For this reason, good cause exists to grant Applicant's request for leave to amend. *See* TBMP § 514.01 (2014) ("[A] proposed amendment which involves an addition to the identification of goods or services, or which materially alters the character of the subject mark, will not be approved by the Board. However, an otherwise appropriate amendment to an application will ordinarily not be rejected by the Board solely on the basis that the amendment would require republication of the mark.")

Additionally, it is well-settled that a pretrial amendment may be properly permitted, even where an opposer objects, if the proposed amendment serves to limit rather than expand the scope of goods associated with the mark. *See Giant Food, Inc. v. Standard Terry Mills, Inc.,* 229 USPQ 955, 963 (TTAB 1986); *International Harvester Company v. International Telephone and Telegraph Corporation,* 208 USPQ 940, 941 (TTAB 1980) (*held*, amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods identified in application); and TBMP § 514.01 (2014). Here, because the proposed amendments will serve to further eliminate any potential "confusion" between Applicant's Mark and services from those of Opposer, good cause exists to grant the Motion.

IV. The Proposed Amendments Do Not Materially Alter the Original Mark.

The Trademark Manual of Examining Procedure ("TMEP") provides that the test for determining whether an amendment is a material alteration is as follows:

> "The *modified* mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application." *See* TBMP § 807.14. (Emphasis in original.)

Although the test refers to republication, the TMEP specifically states that "[m]aterial alteration is the standard used for evaluating amendments to marks in all phases of prosecution, i.e., before publication, after publication, and after registration" and that the fact of republication "is not necessarily the determining factor." *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211, 1218-19 (TTAB 2000); *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990).

In other words, as succinctly stated in TBMP § 807.14: "Each case must be decided on its own facts, and these general rules are subject to exceptions. **The controlling question is always whether the old and new forms of the mark create essentially the same commercial impression.**" (Emphasis added.)

To answer this "controlling" question, all that is required is a cursory review and comparison of the original Mark and the proposed amended Mark (the "Amended Mark"):

Original Mark: cashsquare Amended Mark: cashsquare

Here, the only change being made to the original Mark is the proposed deletion of the "dot" from the "Q" in the Cashsquare name. Thus, since the proposed Amended Mark maintains all the unique and defining characteristics that constituted the essence and created the distinctive commercial impression conveyed by the original Mark (i.e., identical words, word arrangement, color, overall design, etc.), the prior opinions of this Board suggest this is an appropriate case where leave to amend should be granted.

For example, in *Paris Glove of Canada, Ltd. v. SBC/Sportco Corp.*, 84 USPQ2d 1856, 1862 (TTAB 2007) this Board held that an applicant's request "to change the lay-out of the letters" in its name, and the word arrangement of its name, was not a "material alteration" of the original mark and, as a result, granted the applicant's request to amend the original mark. For purposes of comparison, the following depicts the original "AQUA STOP" mark at issue in the *Paris Glove of Canada* matter, as well as the applicant's then-proposed revised mark:

Original mark: AQUA STOP Revised mark: AQUASTOP

In reaching its conclusion in favor of the applicant, the Board concisely stated as follows:

"We find that, although the displays are not identical, they are substantially the same. Thus, there is no material alteration between the original, registered AQUA STOP rectangular form of the mark which shows the words depicted on two lines, and the semicircular and linear forms which depict the words on one line and, in the case of the semicircular form, as one word. **This is because the commercial impression of the mark is dependent upon the literal terms AQUA STOP and not on the rectangular, semicircular or linear forms of display. The particular stylizations of the semicircular and linear forms simply do not change the essential nature of the rectangular form mark.**" Id. at pgs.14-15. (Emphasis added.)

Here, like in *Paris Glove of Canada*, Applicant's proposed amendments do not change the essential nature or character of the original Mark. The commercial impression conveyed by the original Mark is dependent on the CASHSQUARE name and the overall design of the mark -- the name, the words arrangement, and the essence of the design of the original Mark are all maintained in the Amended Mark. In such cases, the Board customarily finds no material alteration of the original mark and grants applicants leave to amend. *See In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996) (*held*, "NEW YORK JEWELRY OUTLET" not material alteration of "NY JEWELRY OUTLET"); *In re Larios S.A.*, 35 USPQ2d 1214 (TTAB 1995) (*held*, rearrangement of words used in name "VINO DE MALAGA LARIOS" and minor design alteration not material alteration of original name "GRAN VINO MALAGA LARIOS" with similar design); *Visa Int'l Service Ass'n v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983) (*held*, amendment inverting the design portion of the mark held not a material alteration).

In sum, it is disingenuous to argue that an average consumer would note the difference between the Mark and Amended Mark at casual glance. The only change being made is deleting a "dot" from the stylized "Q" in the Cashsquare name -- such a minor amendment is simply not a material alteration of the original Mark. Likewise, it is impossible to argue that granting the Motion would prejudice Opposer in any appreciable way. Accordingly, the Board can and should grant the Applicant's request for leave to amend the Application.

CONCLUSION

For the aforementioned reasons, Applicant respectfully requests the Board grant the instant Motion and grant Applicant leave to amend its Application as set forth herein.

Dated: February 18, 2015

Respectfully Submitted,

Leonard Grayver

Leonard Grayver

Greenberg, Whitcombe, Takeuchi, Gibson & Grayver, LLP

21515 Hawthorne Blvd., Suite 450

Torrance, CA 90503

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 21515 Hawthorne Boulevard, Suite 450, Torrance, California 90503-6531.

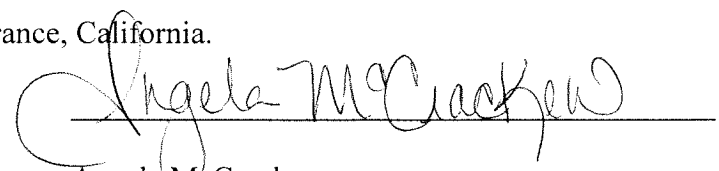
On February 18, 2015, I served the foregoing document(s) described as **APPLICANT'S AMENDED MOTION TO AMEND APPLICATION AFTER NOTICE OF OPPOSITION** on the interested parties in this action by placing a true copy thereof enclosed in a sealed envelope addressed as follows:

Connie L. Ellerbach, Esq.
Fenwick & West
801 California Street
Mountain View, CA 94041
cellerbach@fenwick.com

(X) **BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at Torrance, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after the date of deposit for mailing in affidavit. *CCP §1013(a); Fed. Rule Civ. Proc. 5(b).*

(X) **FEDERAL** I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. *28 U.S.C. §1746.*

Executed on February 18, 2015, at Torrance, California.



Angela McCracken