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Subject: U.S. TRADEMARK APPLICATION NO. 85878838 - REWARDS AS A SERVICE - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85878838

MARK: REWARDS AS A SERVICE



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## GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

## TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Tango Card, Inc.

## CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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## EXAMINING ATTORNEY'S APPEAL BRIEF

### I. Introduction

Applicant has appealed the trademark examining attorney's final refusal to register the proposed marks as follows:

Serial no. 85878822 REWARDS AS A SERVICE for "Computer services, namely, providing an online non-downloadable Internet-based system application featuring technology enabling users of an application programming interface to integrate a rewards program

into a user's information technology systems, namely, account creation, account funding, catalog management, rewards delivery, and order management and history.”

Serial no. 85878838 REWARDS AS A SERVICE for “Promotional and marketing services, namely, conducting incentive reward programs to promote the sale of products and services of others, associated with an application programming interface to integrate a rewards program into a user's information technology systems.”

The examining attorney refused registration on the Principal Register because the applicant's proposed marks are merely descriptive of the identified services based on Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1).

## **II. Facts**

On March 21 2013, the applicant applied for the two proposed marks REWARDS AS A SERVICE. On June 1, 2013, the examining attorney issued a Section 2(e)(1) refusal because the proposed mark merely describes a feature of applicant's services. On December 10, 2013, the applicant responded by arguing against the descriptiveness refusal. On December 30, 2013, the examining attorney issued a final refusal. The applicant filed a Notice of Appeal and a Request for Reconsideration on February 27, 2014. The examining attorney denied the Request for Reconsideration on March 19, 2014.

The applicant filed its Appeal Briefs on May 16, 2014. Application Serial No. 85878838 was forwarded to the examining attorney on May 21, 2014. Application Serial No. 85878822 was forwarded to the examining attorney on June 4, 2014. On June 23, 2014, the examining attorney filed a Motion to Consolidate, which was granted. This appeal ensues.

## **III. Issue on Appeal**

The sole issue on appeal is whether or not the applicant's proposed mark REWARDS AS A SERVICE is descriptive for promotional and marketing services and for providing an online non-downloadable system application, both of which feature the provision of rewards programs.

## **IV. Overview and Arguments Regarding Section 2(e)(1) Refusal**

### **a. Overview of Section 2(e)(1) Law**

A mark is merely descriptive if “it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant's] goods or services.” *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b); see *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)).

Determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

#### **b. Why Applicant's Mark Was Held to be Descriptive**

The examining attorney found the proposed mark REWARDS AS A SERVICE to be descriptive of the applicant's services because the combination of the two main terms in the mark describes the main feature of the applicant's services. The terms are defined as follows:

REWARDS: Something given or received in recompense for worthy behavior

SERVICE: Work done for others as an occupation or business.

(See definitions from the online version of the American Heritage Dictionary at <http://education.yahoo.com>, attached on pages 21-25 of the July 1, 2013 office action.)

Generally, if the individual components of a mark retain their descriptive meaning in relation to the services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); see, e.g., *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording "is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression"); *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1086 (TTAB 2012) (holding CENTER OF SCIENCE AND INDUSTRY merely descriptive of operating a museum and conducting workshops, programs, and demonstrations in the field of science); *In re Putman Publ'g Co.*, 39 USPQ2d 2021, 2021-22 (TTAB 1996) (holding FOOD & BEVERAGE ON-LINE merely descriptive of news and information service for the food processing industry).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the services is the combined mark registrable. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's services and do not create a unique, incongruous, or nondescriptive meaning in relation to the services. The identification of services for Class 35 states that the applicant's promotional and marketing services are for "conducting incentive **reward programs**" by using an "application programming interface [API] to integrate a **rewards program** into a user's information technology systems." The identification of

services for Class 42 states that the applicant's system application is used to integrate a **rewards program** into a user's information technology systems."

The applicant is clearly providing a service that features the provision of rewards, as indicated by wording found in its own specimen of use:

"We do **rewards**;"

"**We help you deliver the right reward** at the right time..." and

"With our RaaS API you can elegantly knit a sophisticated **rewards** program into your platform. Create an account, fund an account, manage catalog, send **rewards**, and get order history – all available on demand, real time, and **as a service**."

Third parties also use the term "rewards as a service" to describe reward services offered to others. For example:

[www.developer.carepass.com](http://www.developer.carepass.com): "Earndit is the leading exercise rewards program that reaches consumers directly. They've recently built an API [application programming interface] to make all of their rewards available outside of Earndit.com for other web or mobile services to be able to offer to their own users. Think of it as a white-label rewards program, or even **Rewards as a Service**. You can view the rewards available to you here." (Page 2 of the July 1, 2013 office action.)

[www.rewards.com](http://www.rewards.com): "Rewards.com is a consumer website for anyone interested in rewards. We maintain this great destination for all things **rewards as a service** for our members, potential members, and other interested parties." (Page 7 of the July 1, 2013 office action.)

[www.rewardsden.com](http://www.rewardsden.com): "A true **Rewards as a Service platform**. Pretio handles all the rewarding, tracking, sourcing, and most importantly fulfillment of the rewards." (Page 18 of the July 1, 2013 office action.)

Based on the applicant's services, the context in which the mark is being used and the significance the mark would have to the average purchaser, it is clear the mark is descriptive.

### c. Applicant's Arguments Regarding Descriptiveness Refusal

The applicant argued the proposed mark REWARDS AS A SERVICE is suggestive because "it is a clever play on the phrase "software as a service." (Pages 5-6 of Applicant's brief.) The applicant argued that its replacement of "software" with "rewards" "means that consumers must engage in a multi-stage reasoning process in order to understand how Applicant's mark relates to Applicant's services." (Page 6 of Applicant's brief.)

The applicant argued its proposed mark is incongruous because the applicant only provides a means for third parties to give rewards and does not actually provide the rewards as a service itself. (Page 7 of Applicant's brief.)

The applicant argued the phrase "AS A SERVICE" is not descriptive because other third party marks containing this phrase have been allowed on the Principal Register without showing acquired distinctiveness. (Page 8 of Applicant's brief.)

#### **d. Examining Attorney's Rebuttal**

The applicant's arguments are not persuasive. As already shown, both the individual components and the composite result are descriptive of applicant's services and do not create a unique, incongruous, or nondescriptive meaning in relation to the services. The applicant is clearly providing a service that features the provision of rewards as evidenced by the applicant's identification of services and supporting specimens of use. Note that the applicant's identification of services states it is "conducting incentive reward programs to promote the sale of products and services of others."

The applicant's argument that it created incongruity by substituting REWARDS for software from the generic phrase "software as a service" is not credible in this particular case.<sup>1</sup> The wording REWARDS AS A SERVICE retains its descriptive significance with no imagination, thought or mental leap required to determine the nature of the applicant's services. When the proposed mark is examined in light of the applicant's identified services, it is clear that the mark is descriptive. The applicant's own advertising materials indicate that they "do rewards" "as a service."

Regarding the existence of other registered marks with similar wording, the fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. See *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. See *In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 ( Fed. Cir. 2001); *In re Lean Line, Inc.*, 229 USPQ 781, 783 (TTAB 1986); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); see *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

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<sup>1</sup> It noted that the term "software as a service" is a generic term for software that is hosted by a service provider at a data center, and the customer accesses the software via a web browser. See the previously attached definition found at <http://www.techopedia.com> on page 2 of the final office action dated December 30, 2013.

While the applicant found evidence of similar marks registered on the Principal Register, the examining attorney found additional similar marks that were held descriptive by the Office. In this case, the evidence of record, which includes the applicant's own usage, clearly show that the proposed mark REWARDS AS A SERVICE is descriptive for services in which the applicant conducts "incentive reward programs to promote the sale of products and services of others" and provides "an online non-downloadable Internet-based system application featuring technology enabling users of an application programming interface to integrate a rewards program into a user's information technology systems."

**e. Conclusion**

In conclusion, the proposed mark describes a main feature of the applicant's services. As such, the proposed mark is descriptive, and applicant's competitors should have the ability to use these words to describe their services. For the foregoing reasons, it is respectfully requested that the Board affirm the refusal to register the proposed mark, REWARDS AS A SERVICE, on the Principal Register under Trademark Act Section 2(e)(1).

Respectfully submitted,

/Amy E. Hella/

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