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

Proceeding	85878838
Applicant	Tango Card, Inc.
Applied for Mark	REWARDS AS A SERVICE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial Nos. 85/878,822 and 85/878,838

Mark: **Rewards as a Service**

Applicant: Erik M. Pelton and Associates, PLLC

Examining Attorney: Amy E. Hella
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APPLICANT'S *EX PARTE* REPLY BRIEF

COMES NOW Applicant, Tango Card, Inc., and hereby submits this Reply in response to the Examining Attorney's brief filed August 3, 2014. Applicant has appealed the Examining Attorney's refusal to register Applicant's REWARDS AS A SERVICE mark on the grounds that the mark is merely descriptive of the applied-for services pursuant to Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1).

ARGUMENT

I. REWARDS AS A SERVICE Is A Suggestive And Incongruous Play On “Software As A Service”

A mark is merely descriptive if it *immediately* describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), *see also Nautilus Group, Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1342-43 (Fed. Cir. 2004) (noting that all suggestiveness requires is “imagination or *any type of multistage reasoning* to understand the mark's significance”) (emphasis added).

Incongruity is also a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase “theater-in-the-round” created an incongruity because applicant's tennis facilities are not at all analogous to those used in a “theater-in-the-round”).

Like the TENNIS IN THE ROUND mark in *In re Tennis*, Applicant's REWARDS AS A SERVICE mark transforms a well-known phrase and creates an incongruous meaning.

Applicant's mark is a clever play on the phrase "software as a service," where the term "software" has been replaced with the term "rewards." "Software as a service" is a phrase commonly known to refer to "a software delivery model in which software and associated data are centrally hosted on the cloud," and accessed via a web browser. *See* RFR, Exhibit A. However, Applicant's play on "software as a service" is not immediately apparent, but instead requires a multistage reasoning to be understood. When consumers encounter Applicant's REWARDS AS A SERVICE mark, they must engage in a multi-step process to comprehend its meaning: consumers must encounter Applicant's mark, recognize the words "AS A SERVICE;" realize that "AS A SERVICE" comes from the well-known phrase "software as a service;" understand that "software" has been replaced with REWARDS; and conclude that Applicant's REWARDS AS A SERVICE mark is a play on words based on the well known phrase "software as a service." Therefore, Applicant's REWARDS AS A SERVICE mark is suggestive and not merely descriptive.

Furthermore, the term "rewards" in Applicant's REWARDS AS A SERVICE mark, means "money or another kind of payment that is given or received for something that has been done." *See* RFR, Exhibit B. Consequently, Applicant's REWARDS AS A SERVICE mark, when read literally, would be interpreted as if Applicant itself is engaged in the practice of rewarding people. This is not the case here; Applicant provides a *means* for *third-parties* to give out rewards in an efficient and effective manner. This odd usage of the term "rewards" contributes to the multi-stage reasoning required for consumers to understand how Applicant's mark relates to Applicant's services. Additionally, Applicant has noted that numerous other creative "_____ AS A SERVICE" marks have been registered on the principal register. *See* Applicant's Appeal Briefs, Table 1. Consequently, Applicant's REWARDS AS A SERVICE mark is suggestive rather than merely descriptive.

II. REWARDS AS A SERVICE Is Not A Commonly-Used Or Industry Term

The Examining Attorney maintains that third-parties use the term “rewards as a service” to describe reward services offered to others. *See* Examining Attorney’s Appeal Brief at p. 3. However, the three examples provided by the Examining Attorney show the phrase “rewards as a service” used as part of larger sentences, to describe the benefits those parties offer to their members, or other interested parties. For example, the excerpt below from Attachment 6, states “rewards as a service” as part of a larger sentence:

Description of 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. Please visit our website often via www.Rewards.com to browse our specially designed pages, and earn as many Rewards as you can. All rewards are subject to the terms and conditions as outlined here and may be updated from time to time with or without notice.

See Office Action of July 1, 2013. Note that the Examining Attorney has provided a total of just three examples, which hardly demonstrates common usage.¹

In contrast, Applicant uses its REWARDS AS A SERVICE as a standalone phrase, does not offer rewards, and instead provides the means for third-parties to give out rewards. Therefore, there is no evidence of record that Applicant’s REWARDS AS A SERVICE mark is a commonly-known, or industry term.

III. THIRD-PARTY REGISTRATIONS Are Probative Evidence On The Issue Of Descriptiveness

The Examining Attorney states that “the fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue of descriptiveness” and “an applied for mark that is merely descriptive does not become registrable simply because other

¹ Applicant believes some of these uses may be infringing its mark, rather than used in a descriptive manner. Following this proceeding Applicant may contact any such infringers.

seemingly similar marks appear on the register.” *See* Examining Attorney’s Appeal Brief at p. 4. Applicant does not argue that third-party registrations are conclusive on the issue of descriptiveness. However, just because these third-party registrations are not conclusive does not mean that they are not relevant or probative on the issue of registrability. The register reflects the reality that consumers are exposed to at least twenty-seven (27) use-based registrations containing the expression “AS A SERVICE.” These third-party registrations demonstrate that the USPTO does not have a clear policy on refusing registration of marks similar to Applicant’s mark as merely descriptive.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act § 2(e)(1) and allow the Application to proceed to publication.

Dated this 11th day of August, 2014.

Respectfully submitted,



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