From: Hella, Amy

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To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 85878838 - REWARDS AS A SERVICE - N/A - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 44

Files: 77302315P001OF003.JPG, 77302315P002OF003.JPG, 77302315P003OF003.JPG, 77308720P001OF003.JPG, 77308720P002OF003.JPG, 77308720P003OF003.JPG, 77308739P001OF003.JPG, 77308739P002OF003.JPG, 77308739P003OF003.JPG, 77925571P001OF003.JPG, 77925571P002OF003.JPG, 77925571P003OF003.JPG, 85009372P001OF003.JPG, 85009372P002OF003.JPG, 85009372P003OF003.JPG, 85347833P001OF002.JPG, 85347833P002OF002.JPG, 85555964P001OF003.JPG, 85555964P002OF003.JPG, 85555964P003OF003.JPG, 85560902P001OF003.JPG, 85560902P002OF003.JPG, 85560902P003OF003.JPG, 85625910P001OF003.JPG, 85625910P002OF003.JPG, 85625910P003OF003.JPG, 85651386P001OF003.JPG, 85651386P002OF003.JPG, 85651386P003OF003.JPG, 85679851P001OF003.JPG, 85679851P002OF003.JPG, 85679851P003OF003.JPG, 85755958P001OF002.JPG, 85755958P002OF002.JPG, 85801436P001OF003.JPG, 85801436P002OF003.JPG, 85801436P003OF003.JPG, 85851029P001OF003.JPG, 85851029P002OF003.JPG, 85851029P003OF003.JPG, 85856182P001OF003.JPG, 85856182P002OF003.JPG, 85856182P003OF003.JPG, 85878838.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85878838

MARK: REWARDS AS A SERVICE

CORRESPONDENT ADDRESS:

CHASE LIBBEY

9519 MT VERNON LNDG

ALEXANDRIA, VA 22309

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Tango Card, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

clibbey@tangocard.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/19/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated 12/30/2113 are maintained and continue to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Registration was refused because the applied-for mark merely describes a feature of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

The applicant applied for the mark 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 applicant argued the proposed mark REWARDS AS A SERVICE is "a clever play on the expression "software as a service" and has an incongruous meaning when read literally." The applicant argued that "consumers must engage in a multi-stage reasoning process in order to understand how Applicant's mark relates to Applicant's services." The applicant also argued that its proposed mark is incongruous because it is self-contradictory because its mark literally means "money or another kind of payment that is given or received for something that has been done." The applicant argued many other similar marks have been registered.

The examining attorney is not persuaded.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or 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 King Koil Licensing Co., 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term "BREATHABLE" retained its ordinary dictionary meaning when combined with the term "MATTRESS" and the resulting combination was used in the relevant industry in a descriptive sense); *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").

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or 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. In this case, the applicant is clearly providing a service that features the provision of rewards. For example, the applicant's specimens of use read in part: "We do **rewards**," and "**We help you deliver the right reward** at the right time…" The original specimen of use also reads "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**."

Note also that the term "software as a service" is a generic term for those particular services that it identifies. See the previously attached the definition of "software as a service."

The average consumer would immediately be able to discern what the applicant's services provide by the proposed mark REWARDS AS SERVICE, especially in light of its identified services and its own advertising materials about the services. As such, the applicant's argument of incongruity in comparison to a generic phrase for another type of service (software as a service) is not credible.

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.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Amy E. Hella/

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