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

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Applicant	Tango Card, Inc.
Applied for Mark	REWARDS AS A SERVICE
Correspondence Address	CHASE LIBBEY 9519 MT VERNON LNDG ALEXANDRIA, VA 22309 UNITED STATES clibbey@tangocard.com
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Filer's Name	Erik M. Pelton
Filer's e-mail	uspto@tm4smallbiz.com
Signature	/ErikMPelton/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 85/878,838

Mark: **Rewards as a Service**

Applicant: Tango Card, Inc.

Examining Attorney: Amy E. Hella
Law Office 110

APPLICANT'S *EX PARTE* APPEAL BRIEF

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Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) 1, 2, 4, 13

COMES NOW Applicant, Tango Card, Inc., and hereby respectfully appeals the Examining Attorney's refusal to register Applicant's standard character REWARDS AS A SERVICE mark in Application Serial No. 85/878,838 ("the Application"). The Examining Attorney's refusal on the grounds that Applicant's REWARDS AS A SERVICE mark is merely descriptive of the applied-for services pursuant to Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), is inappropriate because Applicant's mark conjures "software as a service," is incongruous, and, thus, is suggestive because it fails to immediately describe the applied-for services with the requisite degree of particularity.

PROSECUTION HISTORY

Applicant filed the Application on March 18, 2013, seeking registration on the Principal Register for the mark REWARDS AS A SERVICE in standard characters in connection with "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" in Class 35.

Grounds for Refusal: Merely Descriptive

On July 1, 2013, the Examining Attorney issued a Non-Final Office Action (the "Office Action"), refusing registration under Trademark Act §2(e)(1) on the ground that Applicant's mark is merely descriptive of Applicant's services.

On December 10, 2013, Applicant submitted an office action response (the "OAR"), in which Applicant offered arguments against the refusal to register the mark under Trademark Act §2(e)(1).

On December 30, 2013, the Examining Attorney issued a Final Action (the “FOA”) regarding the refusal under Trademark Act §2(e)(1).

On February 27, 2014, Applicant filed a Request for Reconsideration (the “RFR”), in which Applicant offered additional arguments and evidence against the refusal on the grounds of descriptiveness. Applicant also filed a Notice of Appeal with the Board on February 27, 2014. *See* Docket Doc. 1. The Board acknowledged and instituted the appeal and remanded it to the Examining Attorney for consideration of Applicant’s RFR on the same day. *See* Docket Doc. 2.

On March 19, 2014, the Examining Attorney issued a Reconsideration Letter, in which the final refusal under Trademark Act §2(e)(1) was continued and maintained. *See* Docket Doc. 6. On March 20, 2014, the Board issued an order resuming the appeal and allowing Applicant until May 19, 2014, to file its Appeal Brief. *See* Docket Doc. 7.

SUMMARY OF EVIDENCE

A. Examining Attorney’s Evidence

Office Action of July 1, 2013:

- Google’s Cache of Carepass Developer Portal
- Google’s Cache of Rewards.com
- Google’s Cache of Rewardsden.com
- Definition of “API”
- Definition of “Reward”
- Definition of “Service”

Office Action of December 30, 2013:

- Definition of “Software as a Service”
- TSDR Information for Reg. No. 4,407,836
- TSDR Information for Reg. No. 4,377,866
- TSDR Information for Reg. No. 4,296,683
- TSDR Information for Reg. No. 4,359,451
- TSDR Information for Reg. No. 4,445,316

B. Applicant's Evidence

RFR of February 27, 2014:

Table 1: *“As a Service” Registrations Where No Showing of Acquired Distinctiveness was Needed*

Exhibit A: *Definition of “Software as a service”, Wikipedia,
http://en.wikipedia.org/wiki/Software_as_a_service (accessed Jan. 28, 2014).*

Exhibit B: *Definition of “Reward”, Merriam-Webster's Online Dictionary,
<http://www.merriam-webster.com/dictionary/reward> (accessed Feb. 18, 2014).*

Exhibit C: *Registration Certificates for Federal Trademark Registrations Cited in Table 1.*

ARGUMENT

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the grounds that the mark merely describes Applicant's services. For the following reasons, Applicant respectfully disagrees with the Examining Attorney's finding and requests that the Board reverse the statutory refusal and allow publication of the Application.

I. REWARDS AS A SERVICE Is Suggestive

Applicant seeks registration of the mark REWARDS AS A SERVICE in standard characters for use in connection with "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" in Class 35. According to the Examining Attorney, Applicant's mark merely describes Applicant's recited services because "[t]he applicant is clearly providing a service that features the provision of rewards." FOA. However, Applicant's REWARDS AS A SERVICE mark is not *merely* descriptive of the recited services because it is a clever play on the expression "software as a service" and has an incongruous meaning when read literally. Thus, it does not immediately describe the relevant services with the requisite degree of particularity. Furthermore, numerous registrations incorporating the expression "AS A SERVICE" have been allowed on the principal register without a showing of acquired distinctiveness. *See Table 1*, pp. 8-12.

A mark is merely descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Co. v. Hunting*

World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). *See also In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, to be merely descriptive, the mark must convey such information with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-05 (TTAB 1981). *See also In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

The Board has recognized the fine line between merely descriptive marks and suggestive marks. *Oreck Holdings, LLC, v. Bissell Homecare, Inc.*, Opposition No. 91173831, *21 (TTAB Feb. 16 2010)(HEALTHY HOME VACCUM not merely descriptive of vacuum cleaners) [not precedential]. One may be informed by suggestion as well as by description. *In re Reynolds Metals Company*, 480 F.2d 902, 178 USPQ 296 (CCPA 1973). As the Federal Circuit has stated:

...a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term.

In re Nett Designs, Inc., 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

A. *REWARDS AS A SERVICE Is Suggestive Because It Is a Play on "Software as a Service"*

Applicant's REWARDS AS A SERVICE mark is a clever play on the phrase "software as a service" (also known as "cloud computing"). The phrase "software as a service" is commonly defined as "a software delivery model in which software and associated data are

centrally hosted on the cloud” and accessed via web browser. *See* RFR, Exhibit A. Applicant’s recited services include, among other things, “providing an online non-downloadable Internet-based system application,” which falls into this category. However, Applicant’s mark does not incorporate the phrase “software as a service.” Instead, Applicant replaces the word “software” with “rewards” in order to suggest that Applicant’s cloud-based software helps consumers integrate a program featuring Applicant’s gift card technology into information technology systems. Applicant’s unique spin on the well-known phrase “software as a service” also means that consumers must engage in a multi-stage reasoning process in order to understand how Applicant’s mark relates to Applicant’s services. Applicant’s mark is therefore suggestive and not merely descriptive. *See 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).

B. REWARDS AS A SERVICE Is Suggestive Because it is Incongruous

Incongruity is 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”). The Board has described incongruity in a mark as “one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark,” and has noted that the concept of mere descriptiveness “should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped

without some measure of imagination and ‘mental pause.’” *In re Shutts*, 217 USPQ 363, 364–5 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see also In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although “frank” may be synonymous with “wiener,” and “wurst” is synonymous with “sausage,” the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf. In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of “mouse house,” i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous).

Applicant’s “REWARDS AS A SERVICE” mark has an incongruous meaning that gives it a distinct overall commercial impression. By definition, a “reward” is “money or another kind of payment that is given or received for something that has been done”; in other words, something given to someone in exchange for a *service*. *See* RFR, Exhibit B. Consequently, Applicant’s REWARDS AS A SERVICE mark, when read literally, would be interpreted as self-contradictory, as a form of circular logic, or as if Applicant itself is engaged in the practice of rewarding people. It thus takes multi-stage reasoning for the consumer to realize that Applicant’s mark suggests that Applicant provides a *means for third-parties* to give out rewards in an efficient and effective manner. Consequently, Applicant’s REWARDS AS A SERVICE mark is suggestive, not merely descriptive.

C. AS A SERVICE Is Not Per Se Descriptive

The Examining Attorney cites five registrations, which were found to be descriptive, all featuring a "... descriptive word regarding the services plus the phrase 'AS A SERVICE.'" FOA, p. 4. Although it is not explicitly argued in the FOA, the Examining Attorney presumably offered these registrations as evidence in support of the proposition that the USPTO consistently finds marks containing AS A SERVICE *per se* descriptive, and so it should similarly treat Applicant's REWARDS AS A SERVICE mark. However, a review of TESS indicates that the USPTO has allowed a plethora of trademarks containing the expression "AS A SERVICE" onto the principal register without requiring a showing of acquired distinctiveness. Table 1 below (which was included in Applicant's RFR) lists twenty-seven (27) such marks. *See* RFR, Exhibit C for registration certificates. Note that several of these marks are registered for cloud computing-related services.

Table 1. "As a Service" Regs. Where No Showing of Acquired Distinctiveness was Needed

Mark	Reg. No.	Goods/Services
WEATHER AS A SERVICE	4024044	<u>Class 42</u> : providing weather information services
CONVERSION AS A SERVICE	4363272	<u>Class 35</u> : Advertising and marketing consultancy; Advertising and marketing services, namely, promoting the goods and services of others; Advertising, marketing and promotion services
Office as a Service	4438822	<u>Class 35</u> : Providing office support functions and staff services, namely, secretary and bookkeeping services; Personalized phone answering services <u>Class 38</u> : Video, audio, and web conferencing services; Personalized fax and voice electronic mail services; web messaging and web site forwarding services; Virtual PBX dialing service; Electronic transmission of voice signals, data, facsimiles, images, and information via a global computer network; Secure email services

Mark	Reg. No.	Goods/Services
Offshorent, Offshore Center As A Service	4387273	<u>Class 35</u> : Business process outsourcing services in the field of back office operations; Outsourcing in the field of software development
VALUATION AS A SERVICE	4343243	<u>Class 36</u> : business valuation services; business valuation services utilizing online business valuation software; information regarding business valuation <u>Class 42</u> : providing online temporary use of non-downloadable software used in performing business valuations
CLASSROOM AS A SERVICE	4104231	<u>Class 42</u> : Software as a service (SAAS) services featuring interactive software for conducting IT training and educational demonstrations; computer consultation in the nature of installation, maintenance and repair of the aforementioned software
DISCOUNTS-AS-A-SERVICE	4335475	<u>Class 36</u> : Accounts payable discount management services, namely, consulting, processing and administration of a system enabling purchasers to obtain discounts on accounts payable; Procurement discount opportunity services, namely, consulting regarding implementation of dynamic discounting terms; Accounts payable financing services for third parties; Factoring agency services <u>Class 42</u> : Providing temporary use of non-downloadable computer software enabling purchasers to obtain discounts on accounts payable over computer networks, intranets and the internet
LEADERSHIP AS A SERVICE	4318294	<u>Class 42</u> : Consulting in the field of information technology
SELLING AS A SERVICE	4227616	<u>Class 35</u> : Sales promotion for others; sales promotion services
TRAINING AS A SERVICE	4223358	<u>Class 42</u> : Consulting in the field of information technology
INSIGHT AS A SERVICE	4175298	<u>Class 35</u> : Personnel management consulting
Solutions in the Cloud Delivered as a Service.	4097828	<u>Class 42</u> : Technical support services, namely, remote administration and management of in-house and hosted datacenter devices, databases and software applications
INNOVATION AS A SERVICE	4093130	<u>Class 35</u> : Business consulting services, namely, providing assistance in development of business strategies, innovation and idea management, and collaborative problem solving

Mark	Reg. No.	Goods/Services
Revenue as a Service	4005089	<p><u>Class 9</u>: Computer software for controlling and managing patient medical information; Computer software that provides web-based access to applications and services through a web operating system or portal interface</p> <p><u>Class 35</u>: Medical billing outsourcing services; Medical billing support services</p>
Rules as a Service	3935884	<p><u>Class 42</u>: Software as a service (SAAS) services, namely, hosting software for use by others for use in business intelligence for business decision making, business rules management, and application integration</p>
SEARCH AS A SERVICE	3903841	<p><u>Class 35</u>: Employment counseling and recruiting; Executive recruiting services; Professional staffing and recruiting services</p>
VSAAS VIRTUAL SOFTWARE AS A SERVICE	3895555	<p><u>Class 42</u>: Application service provider services featuring virtual machine operating system software; application service provider, namely, hosting computer software applications of others</p>
CXO as a service	3872566	<p><u>Class 35</u>: Business consulting services</p>
ARCHITECTURE AS A SERVICE	3847256	<p><u>Class 42</u>: information technology consultation; technology consultation in the field of fractional architecture; consulting in the field of information technology including providing others with project teams and specialists for an allotted number of consultation hours, utilizing and providing consultants on a fractional basis depending on their skill specialty, and providing others with IT specialists often offered on a subscription basis</p>
Recruiting As A Service	3647398	<p><u>Class 35</u>: Job and personnel placement; Job placement; Organizing and conducting job fairs</p>

Mark	Reg. No.	Goods/Services
SATISFACTION AS A SERVICE	3920269	<p><u>Class 42</u>: Application service provider (ASP) featuring software for queuing, handling, logging, recording, monitoring, tracking, supervision, management, routing, disposition and distribution, of telephone calls, facsimile transmissions, e-mails, and web based messages to in-office or at-home workers, parties, callers or customers, for use in the fields of customer service, customer support, inside sales, collections, or direct response marketing; application service provider (ASP) featuring an application software development tool for use in customizing telecommunication service applications, namely, services for the queuing, handling, logging, recording, monitoring, tracking, supervision, management, routing, disposition and distribution of telephone calls, facsimile transmissions, e-mails, and web based message transmissions, for use in the fields of customer service, customer support, inside sales, collections, or direct response marketing</p>
PUBLISHING AS A SERVICE	3664775	<p><u>Class 42</u>: Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information</p>
IDENTITY AS A SERVICE	3781533	<p><u>Class 9</u>: Computer software to control information technology resources, namely, applications and infrastructure, namely, computer systems, operating systems, databases and directories, and related data for information management and security</p> <p><u>Class 42</u>: Computer hardware and software consultation; Computer services, namely, acting as a shared service or provided service for controlling information technology resources and/or managing computer systems for others, namely, applications, infrastructure, namely, computer systems, operating systems, databases and directories, and related data for applications and infrastructure, namely, computer systems, operating systems, databases and directories</p> <p><u>Class 45</u>: Computer security services, namely, monitoring or controlling computer systems for security purposes</p>
Records As A Service	3384153	<p><u>Class 42</u>: Providing online non-downloadable computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information</p>

Mark	Reg. No.	Goods/Services
CONNECTIVITY AS A SERVICE	3550778	<p><u>Class 38</u>: Computer services, namely, providing and managing remote access to networks, personal computers, personal digital assistants, pocket personal computers, mobile phones, and internet tablets</p> <p><u>Class 39</u>: Computer services, namely, storage services for archiving databases, images and other electronic data</p> <p><u>Class 42</u>: Application service provider services, namely, hosting computer application software on a computer server for use by others for remotely accessing local area networks and personal computers; computer services, namely, recovery of computer data; computer services, namely, monitoring, analyzing, supporting, administering and managing computers, computer software applications, computer systems, computer servers and computer networks; providing technical support services, namely, monitoring, analyzing, supporting, administering and managing computers, computer software applications, computer systems, computer servers and computer networks and troubleshooting of computer hardware, computer software and installation problems; computer services, namely hosting and maintaining an online website for others to store content for others</p>
TECHNOLOGY-AS-A-SERVICE	3542404	<p><u>Class 42</u>: Computer technology support services, namely, help desk services; information technology consulting services in the field of identification, support and implementation of computer-based information systems for businesses; computer project management services; computer services, namely, remote management of computer applications for others; computer software design and computer programming of computer software; computer software installation; design, maintenance, development and updating of computer software</p>
Information as a Service	3417466	<p><u>Class 35</u>: Providing business management information in connection with consulting and advisory services in the field of business strategic planning; real estate marketing services in the field of commercial real estate; providing information in the field of marketing and on-line marketing media via the Internet</p>

These registrations clearly demonstrate that the USPTO does not have a clear policy

of refusing registration of marks containing AS A SERVICE as merely descriptive. In fact, these registrations tend to show the opposite – that many “_____ AS A SERVICE” marks are inherently distinctive and entitled to registration on the Principal Register. Accordingly, Applicant’s REWARDS AS A SERVICE mark should be allotted the same protection.

CONCLUSION

In sum, Applicant’s REWARDS AS A SERVICE mark is suggestive and not merely descriptive because the mark has an incongruous meaning and does not immediately describe any function or feature of Applicant’s services with the requisite degree of particularity. Furthermore, the USPTO has allowed numerous “as a service” registrations onto the principal register without a showing of acquired distinctiveness. Finally, any doubt regarding descriptiveness must be resolved in Applicant’s favor. *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994).

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 16th day of May, 2014.

Respectfully submitted,



Erik M. Pelton
ERIK M. PELTON & ASSOCIATES, PLLC
PO Box 100637
Arlington, Virginia 22210
TEL: (703) 525-8009
FAX: (703) 525-8089

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