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

Proceeding	87006159
Applicant	Fidelity National Information Services,
Applied for Mark	CARDLESS CASH
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Fidelity National Information Services, Inc.
Serial Number:	87006159
Filing Date:	April 19, 2016
Mark:	CARDLESS CASH
Examining Atty.:	Charles H. Hiser IV, Esq.
Law Office:	112

Commissioner for Trademarks
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APPEAL BRIEF OF APPLICANT
FIDELITY NATIONAL INFORMATION SERVICES, INC.

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I. INTRODUCTION

Applicant Fidelity National Information Services, Inc. ("FIS") appeals the Examining Attorney's final refusal of registration of FIS's mark CARDLESS CASH (the "Mark" or "CARDLESS CASH") for "computer software that allows users to withdraw cash from automatic teller machines using a smartphone or other mobile device" in Class 9 and "banking and financial services, namely, automatic teller machine services and electronic funds transfer services" in Class 36 (collectively, the "Goods and Services") on the grounds that the Mark is generic for the Goods and Services or, in the alternative, merely descriptive and has not acquired distinctiveness. As detailed below, the Mark is suggestive, or it is merely descriptive (not generic) and has acquired distinctiveness.

First, the Mark is suggestive because it consists of an incongruous combination of two terms—"cash," which is a tangible, physical object, and "cardless," which implies the opposite. This incongruous combination results in a mark that is not merely descriptive, as consumers must use imagination to bridge the gap between CARDLESS CASH and the Goods and Services.

Second, the record evidence does not support the Examining Attorney's position that the Mark is generic. In fact, the vast majority of the evidence relied on by the Examining Attorney are trademark uses and/or refer to FIS or its customers. In addition to evidence of FIS's own use of CARDLESS CASH as a trademark, FIS has submitted 125 examples of use of the Mark that show trademark usage from the media, customers, or the general public and/or point to FIS as the source of the Mark. Because the evidence of record overwhelmingly supports FIS's position that CARDLESS CASH functions as a trademark (84%), the Examining Attorney has failed to meet his burden to show the Mark is generic, especially considering that any doubt must be resolved in FIS's favor.

Finally, even if the Board finds that the Mark is merely descriptive, the substantial evidence of record shows that CARDLESS CASH has acquired distinctiveness based on extensive use, significant advertising and promotion, and massive exposure and commercial success nationwide.

II. STATEMENT OF FACTS

A. FIS and the CARDLESS CASH Mark

FIS is a Fortune 500 company and one of the largest financial technology companies in the U.S. and the world. FIS seeks registration of the mark CARDLESS CASH for the Goods and Services, i.e., software and associated ATM and funds transfer services that allow consumers to make withdrawals at ATMs. FIS sells its CARDLESS CASH software and services to numerous banks, credit unions, and ATM operators and networks around the country, and FIS and its customers have extensively promoted and advertised the Mark nationwide. FIS has enjoyed massive commercial success under the Mark and has processed more than $230 million of ATM withdrawals under the Mark in just the last four years. (May 20, 2019 Response, TSDR pp. 60-61, ¶ 17.)[1] FIS's CARDLESS CASH platform has also garnered extensive unsolicited media coverage from both general news and financial media.

B. Examining Attorney's Refusals of Registration

The Examining Attorney issued six refusals of this application, often taking different and inconsistent positions. In the first refusal, the Examining Attorney refused registration on the ground that CARDLESS CASH is generic, relying on 23 articles showing use of CARDLESS CASH in lowercase letters. (June 8, 2016 Office Action, TSDR pp. 5-28.) However, in its December 8, 2016 Response, FIS established that 17 of the Examining Attorney's 23 articles referred to FIS as the source of CARDLESS CASH Goods and Services and 3 articles were from foreign sources and thus irrelevant, leaving only 3 articles that used lowercase "cardless cash" that did not refer to FIS or its customers. FIS also submitted 45 articles showing trademark use of the Mark (e.g., initial capital letters or all capital letters), making the record evidence at that time 62 pieces of U.S. evidence showing trademark use or referencing FIS or its customers, and only 3 articles that did not. (Dec. 8, 2016 Response, TSDR pp. 35-137.)

Nevertheless, in the second refusal, the Examining Attorney issued an advisory refusal of genericness and formally issued a merely descriptive refusal. (Feb. 7, 2017 Office Action, TSDR pp. 3-4.)

[1] All citations to the TSDR record refer to the documents in .pdf format.

The Examining Attorney submitted 43 screen captures and articles showing use of CARDLESS CASH in lowercase letters or "mixed uses." (Id., pp. 6-105.) Of these, FIS established in its August 7, 2017 Response that 19 reference FIS and/or its customers and 2 were from foreign sources and thus irrelevant. In addition, FIS submitted 44 more screen captures and articles showing trademark use of the Mark. (August 7, 2017 Response, TSDR pp. 50-265.) Thus, the record U.S. evidence after two Office Actions/Responses included 125 screen captures and articles showing trademark use and/or recognition of FIS's CARDLESS CASH Mark, whereas the remaining 25 articles showed "mixed usage" or lowercase uses. FIS also submitted a 2(f) Declaration (the "1st 2(f) Declaration"), attesting to continuous and exclusive use of its CARDLESS CASH Mark at hundreds of thousands of ATMs nationwide; more than 40 banks and major ATM providers as customers providing services under the Mark; and over $50 million of withdrawals under the Mark by mid-2016, among other things. (Id., pp. 14-20.) This evidence translates to massive public exposure to FIS's CARDLESS CASH Mark nationwide for years.

In the third Office Action, the Examining Attorney withdrew the genericness refusal but maintained the descriptiveness refusal. (Sept. 6, 2017 Office Action, TSDR pp. 1-3.) He stated the 1st 2(f) Declaration was insufficient to show acquired distinctiveness because the evidence of record showed mixed uses of trademark and nontrademark use of the Mark such that FIS "has not shown substantially continuous and exclusive use." (Id., p. 3.) FIS submitted a response on March 6, 2018 that included an updated 2(f) Declaration (the "2nd 2(f) Declaration") with additional evidence, including: use of the Mark featured prominently on FIS's software and advertising; eight more examples of articles showing use of the Mark from February 2016 to November 2017; representative examples of promotion of the Mark by FIS's customers; evidence of new bank customers; and $75 million of withdrawals processed through FIS's CARDLESS CASH software and ATM and funds transfer services in 2017 alone. (March 6, 2018 Response, TSDR pp. 9-17.)

The Examining Attorney issued a fourth refusal, making the descriptiveness and acquired distinctiveness refusals final and stating that the sales figures and advertising expenditures in the 2nd 2(f) Declaration were not dispositive because of the mixed trademark and lowercase uses of CARDLESS

CASH. (March 29, 2018 Office Action, TSDR p. 4.) FIS filed a Request for Reconsideration on September 28, 2018, with an updated 2(f) Declaration (the "3rd 2(f) Declaration") providing that FIS had processed $165 million of withdrawals through its CARDLESS CASH software and ATM and funds transfer services in the previous 3½ years; additional examples of FIS's promotional materials prominently displaying the Mark; additional articles showing use of the Mark; evidence of new bank customers; and evidence that some of the largest ATM providers in the U.S. had become CARDLESS CASH customers. (Sept. 28, 2018 Response, TSDR pp. 24-62.)

The Examining Attorney issued a fifth Office Action, reinstating the previously withdrawn genericness refusal and maintaining the descriptiveness and acquired distinctiveness refusals. (Nov. 20, 2018 Office Action, TSDR pp. 2-4.) FIS filed a response on May 20, 2019, noting that of the 9 screen captures and articles the Examining Attorney had filed to support the genericness refusal, 4 referenced FIS's customers and 1 came from a foreign source, so more than half did not support the refusal. FIS also submitted another 2(f) Declaration (the "4th 2(f) Declaration"),[2] stating that FIS had processed more than $230 million of withdrawals through its CARDLESS CASH platform in the previous four years; providing 12 more articles showing trademark use of the Mark since September 2018; and stating that FIS in 2019 added more than 20,000 new CARDLESS CASH-enabled ATMs across the country. (May 20, 2019 Response, TSDR pp. 27-64.) Thus, the record evidence after five Office Actions/Responses included 152 articles showing trademark use and/or recognition of FIS's CARDLESS CASH Mark, while only 29 articles arguably showed some "mixed use" or lowercase uses.

The Examining Attorney issued a sixth refusal, including 22 screen captures showing use of CARDLESS CASH in lowercase letters. (June 11, 2019 Office Action, TSDR pp. 6-30.) FIS submitted a Request for Reconsideration, noting that 5 of those 22 screen captures were from foreign sources and 12 mentioned FIS and/or its customers, leaving only 5 of the 22 that showed the phrase in lowercase letters.

[2] The 4th 2(f) Declaration summarizes the evidence from FIS's 1st, 2nd, and 3rd 2(f) Declarations, and adds new evidence from the filing of the 3rd 2(f) Declaration to May 20, 2019.

(Sept. 6, 2019 Request for Reconsideration, TSDR pp. 6-11.) FIS also submitted an additional 13 articles showing CARDLESS CASH in a trademark manner. (Id., pp. 17-41.)

In sum, as detailed in the chart below, the record evidence submitted by the Examining Attorney and FIS in six Office Actions/Responses collectively consists of 177 screen captures and articles showing trademark use of CARDLESS CASH and/or referring to FIS or its customers, in contrast to only 34 U.S. screen captures and articles that show lowercase uses and do not reference FIS's Goods and Services, i.e., nearly 84% of the U.S. evidence (i.e., excluding only foreign uses) favors FIS.

Submitted by	**Trademark uses (e.g., upper-case or initial capital letters)**	**Lowercase uses referencing FIS or its customers**	**Lowercase uses not referencing FIS or its customers**	**Foreign uses**
Examining Attorney	13	39	34	11
FIS	125	—	—	—
Total	**138**	**39**	**34**	**11**

III. ARGUMENT

A. CARDLESS CASH Is Suggestive of FIS's Goods and Services

"A suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods." *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1323, 111 USPQ2d 1649 (Fed. Cir. 2014) (internal quotation marks omitted). A mark is suggestive if it "is obviously not the usual or normal manner in which the purpose of [the goods or services] would be described." *In Re Pennwalt Corp.*, 173 USPQ 317, 318 (TTAB Mar. 29, 1972). Additionally, "[i]ncongruity is a strong indication that a mark is suggestive rather than merely descriptive." TMEP § 1209.01(a). As shown below, the CARDLESS CASH Mark is suggestive and inherently protectible because it requires some imagination on the part of consumers to determine the true nature of FIS's Goods and Services.

1. CARDLESS CASH Requires Imagination and Multi-Step Reasoning to Understand the Nature of FIS's Goods and Services

The Board's precedential decision in *In re Southern National Bank of North Carolina* compels registration of the Mark. 219 USPQ 1231 (TTAB 1983). The Board reversed the refusal of the mark MONEY 24 on the ground that it was merely descriptive of applicant's ATM services, holding that "at

most the designation 'MONEY 24' suggests the nature or characteristics of applicant's banking services" because it had an element of "incompleteness" that consumers "must interpret in order to arrive at the conclusion that one has access to his or her money by use of applicant's services on a twenty-four hour-a-day basis." *Id.* at 1231-32. Moreover, the Board held, although ATMs receive and disburse money, the term "money" was not merely descriptive of ATM services because it required a "degree of imagination or perception to determine the nature of the services." *Id.*

The Board reached a similar finding in another precedential decision, *In re TMS Corp. of the Ams.*, 200 USPQ 57 (TTAB 1978), where it reversed the refusal of the mark THE MONEY SERVICE for "financial services wherein funds are transferred to and from a savings account" as merely descriptive. *Id.* at 57. The Board held that "because the mark 'THE MONEY SERVICE' is composed of commonly used words of the English language, it suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity [and] [t]o effect a readily understood connection between [THE MONEY SERVICE] and [applicant's] services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation." *Id.* at 59.

Like the MONEY 24 mark for ATM services and THE MONEY SERVICE mark for funds transfer services, FIS's Mark for the *identical services* "suggests a number of things, but yet falls short of describing [FIS's] services in any one degree of particularity [and] [t]o effect a readily understood connection between [CARDLESS CASH] and [applicant's goods and] services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation." As the Board noted in *In re Southern Bank*, the word "money" is not merely descriptive of services involving the disbursement of money from ATMs. *See also Money Store v. Harriscorp Fin., Inc.*, 689 F.2d 666, 674 (7th Cir. 1982) (holding MONEY STORE is not merely descriptive of money lending services). By the same reasoning, "CASH," a synonym of "money," when combined with "CARDLESS," is not merely descriptive of FIS's Goods and Services. In other words, consumers may have some vague idea that FIS's Goods and Services have something to do with "cash" and/or "no card," but they will not immediately know that FIS offers computer software for ATMs and ATM and fund transfer services under the Mark.

2. CARDLESS CASH Is an Incongruous Combination and Not the Usual Manner in Which Consumers Would Describe FIS's Goods and Services

The Board has repeatedly held that incongruity in a mark is "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark," and that the concept of mere descriptiveness "should not penalize … somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" TMEP § 1209.01; *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held suggestive for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs").

Here, the combination of CARDLESS with CASH is incongruous because the term "CASH" brings to mind hard or physical currency such as coins or bills, whereas CARDLESS brings to mind the opposite meaning of something that is not a physical card—"no card." While prospective customers encountering the Mark may have some idea of the general nature of FIS's Goods and Services (i.e., something to do with "cash" and "no cards"), they would have to go through a series of mental steps to determine the precise nature of FIS's Goods and Services (i.e., computer software and ATM and electronic funds transfer services), if they even can, because the Mark does not identify them with any degree of particularity. In fact, the unique combination of the terms CARDLESS CASH creates an incongruity of meanings not typically encountered or understood together, namely "no card" and "cash."

Finally, the Mark's suggestiveness is enhanced by the alliteration in CARDLESS CASH, which creates a catchy and unique repetitive sound and commercial impression. *See In Re Golden W. Fin.*, No. SERIAL 78398981, 2006 WL 2414531, at *3 (TTAB Aug. 4, 2006) (holding PICK-A-PAYMENT not merely descriptive of savings and loan services, in part because alliteration "contribute[s] to its distinctive character"). Thus, the Examining Attorney erred in concluding the Mark is not suggestive.

B. CARDLESS CASH Is Not Generic

The public's perception of a phrase is the "primary consideration" in determining genericness. *Loglan Inst., Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531 (Fed. Cir.

1992). The Board uses a two-step analysis for this determination: (1) what is the genus in question, and (2) is the applied-for term understood by the relevant public primarily to refer to that genus? *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 207 USPQ 528 (Fed. Cir. 1986). The Examining Attorney bears the burden of showing a term is generic and must make a "substantial showing" that is "based on clear evidence of generic use." *In re Merrill Lynch*, 828 F.2d 1567, 1571, 4 USPQ2d 1141 (Fed. Cir. 1987). Where the record shows a substantial number of trademark uses, evidence of some lowercase uses is insufficient to show a term is generic. *Id.* Additionally, any doubt on genericness must be resolved in favor of FIS. *In re Waverly*, 27 USPQ2d 1620, 1624 (TTAB 1993).

1. Consumers Do Not Understand CARDLESS CASH to Primarily Refer to FIS's Goods and Services

The Examining Attorney correctly defined the genus in question as the Goods and Services (June 11, 2019 Office Action, TSDR p. 3), but he erroneously analyzed the issue of genericness using the "end product" of "cash" as the genus (see Feb. 7, 2017 Office Action, TSDR p. 4) (stating that CARDLESS CASH may be generic because "CASH" is defined as "money in coins or notes, as distinct from checks, money orders, or credit").[3] The Federal Circuit rejected this approach in *In re Seats, Inc.*, in which the Examining Attorney had refused registration of the mark SEATS for ticket reservation services on the ground that the mark "refers to the generic name of the end product of applicant's services." *In re Seats*, 757 F.2d 274, 277 (Fed. Cir. 1985). The Board affirmed, concluding the mark was incapable of serving a trademark function. The Federal Circuit reversed, pointing out the flaw in this argument: SEATS "may be generic in relation to chairs or couches or bleachers," but it is "clearly not generic to reservation

[3] Notably, the Examining Attorney stated he "might agree" that CARDLESS CASH creates a mental step and does not describe the services "if this determination was made in a vacuum." (Feb. 7, 2017 Office Action, TSDR p. 4). But then the Examining Attorney argued that the record evidence showed CARDLESS CASH "is readily used as a term to describe the goods and services the applicant is offering." (Id.) Although the Examining Attorney identified the correct genus in later Office Actions, the refusal to acknowledge that the vast majority of evidence (nearly 84%) shows use and recognition of CARDLESS CASH as a trademark of FIS suggests that "cash" remained the focus of the "genus" analysis.

services." *Id.* The Court held the application of the genericness test to the "end product of applicant's services" rather than the applied-for services was error and reversed the refusal to register. *Id.*[4]

2. The Evidence of Record Identifies FIS and Its Customers As the Source of the Mark

The Examining Attorney submitted evidence from the NEXIS database showing a mixture of uses of "cardless cash." Notably, however, the vast majority of these uses refer to FIS and customers of FIS's Goods and Services. In such cases, "the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers, and third parties." *In re Am. Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006).

Here, the Examining Attorney introduced a total of 86 articles and screen captures (excluding 11 foreign uses). But the majority—52—actually show trademark use and/or recognition of FIS or its customers, and not alleged generic use of the Mark. Additionally, the Examining Attorney failed to rebut FIS's compelling evidence of at least 125 screen captures and articles showing trademark use and recognition of the Mark. In short, the Examining Attorney's evidence fails to prove a "substantial showing" of "clear evidence of generic use" required by the Federal Circuit.

3. Mixed Use Is Not Clear Evidence of Genericness

The few examples of non-trademark use relied upon by the Examining Attorney do not support the genericness refusal. Both the Board and Federal Circuit have repeatedly held that a mixture of trademark and lowercase uses does not establish that a term is generic and, in fact, shows the opposite.

For example, the Federal Circuit reversed the Board's finding that the mark CASH MANAGEMENT ACCOUNT was generic because the evidence showed a mixture of uses. *In re Merrill Lynch*, 828 F.2d at 1571. A NEXIS search revealed trademark uses of CASH MANAGEMENT ACCOUNT and uses of the mark in all lowercase letters both with and without mention of Merrill Lynch. The Federal Circuit held "[t]he mixture of uses . . . does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common

[4] The present appeal presents an even more compelling case than in *In Re Seats* because FIS's Mark is a two-word incongruous combination as opposed to the one-word mark SEATS.

descriptive term for the brokerage services to which Merrill Lynch first applied the term." *Id.* Rather, the Federal Circuit noted that "[t]he evidence before the Board showed recognition in a substantial number of publications that the source of the CASH MANAGEMENT ACCOUNT was the appellant." *Id.* This evidence thus could not support a finding of genericness. *Id.* Similarly, in *In Re Am. Online, Inc.*, 77 USPQ2d 1618, the Board held that the Examining Attorney's evidence did not support a genericness finding where 43 out of 70 articles correctly displayed INSTANT MESSENGER as a trademark and/or identified the applicant as the source.

Moreover, the Examining Attorney "should not place determinative weight" on how third parties in the media choose to represent the mark. *Zimmerman v. Realtors*, 70 USPQ2d 1425, 1434 (TTAB 2004). In *Zimmerman*, the Board reviewed examples of articles that used the mark REALTOR. The Board cautioned against relying solely on "whether or not the journalists and editors involved in these . . . articles use an upper-case or lower-case letter 'R,'" but found it instructive that in 19 out of 26 examples, the mark was used in a trademark manner. *Id.* Similarly, the Examining Attorney here erred in placing determinative weight on 34 examples from the media showing lowercase use of "cardless cash," rather than the 177 examples showing trademark use and/or references to FIS and its customers.

Finally, the Examining Attorney erred in dismissing examples of mixed use from FIS's customers because some of those uses portrayed the Mark in lowercase letters. (Nov. 20, 2018 Office Action, TSDR p. 4.) However, where customers use a mix of trademark and lowercase uses of a mark, the Board will not hold the customers' mistaken uses against the applicant. *In Re Garden Innovations, LLC*, No. 85768319, 2015 WL 3777560, at *6 (May 29, 2015) (non-precedential) (lowercase uses of ROLL OUT FLOWERS by applicant's customer did not weigh against applicant where same web page also had trademark usage). Indeed, even the few uses of the Mark by customers in lowercase letters nonetheless evidences that they understand the terms refer uniquely to FIS and its CARDLESS CASH Goods and Services.

C. FIS Has Presented Compelling Evidence of Acquired Distinctiveness

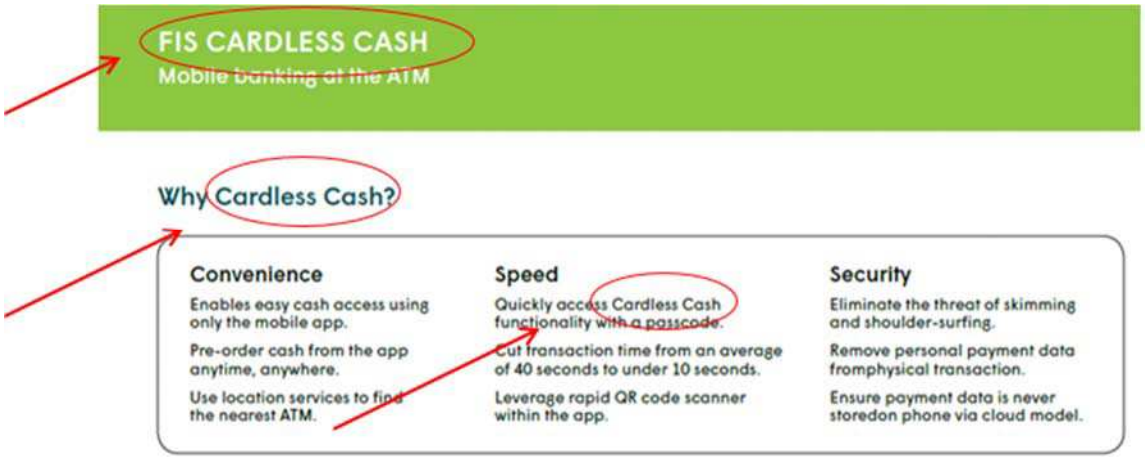
To establish acquired distinctiveness, FIS must show that in the minds of the public, the primary significance of CARDLESS CASH is to identify the source of the Goods and Services. *In re Dial-A-*

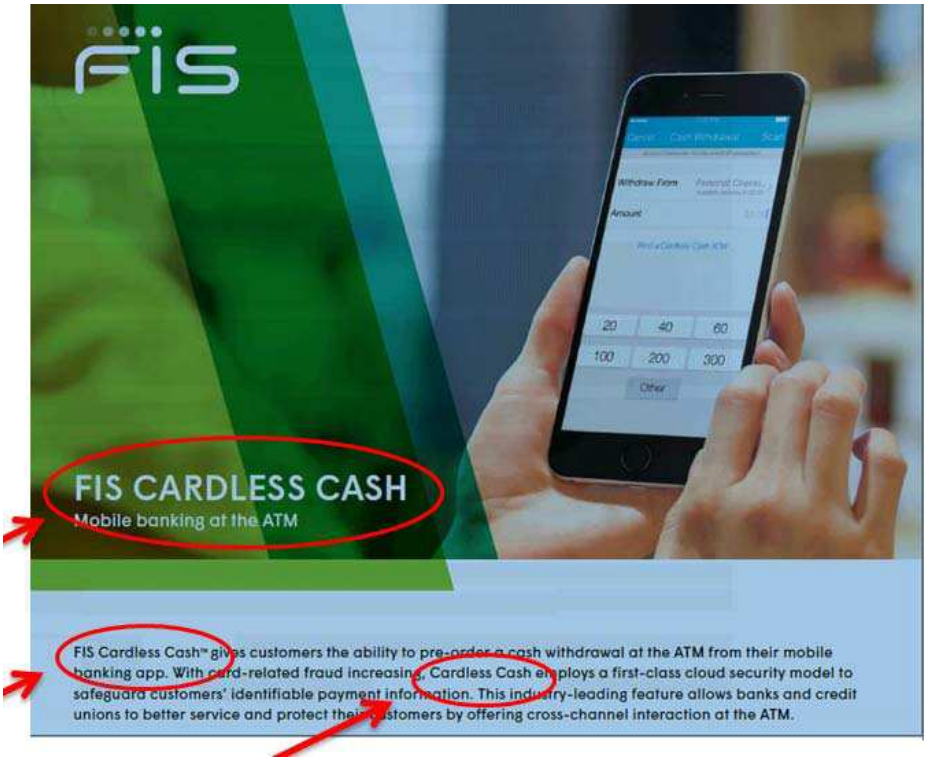
Mattress Operating Corp., 240 F.3d 1341, 1347, 57 USPQ2d 1807 (Fed. Cir. 2001). FIS need only present a prima facie case for registration. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1576, 6 USPQ2d 1001 (Fed. Cir. 1988). Several factors can establish a prima facie case of acquired distinctiveness, including the duration and nature of use, revenues, and other circumstantial evidence. *Id.*

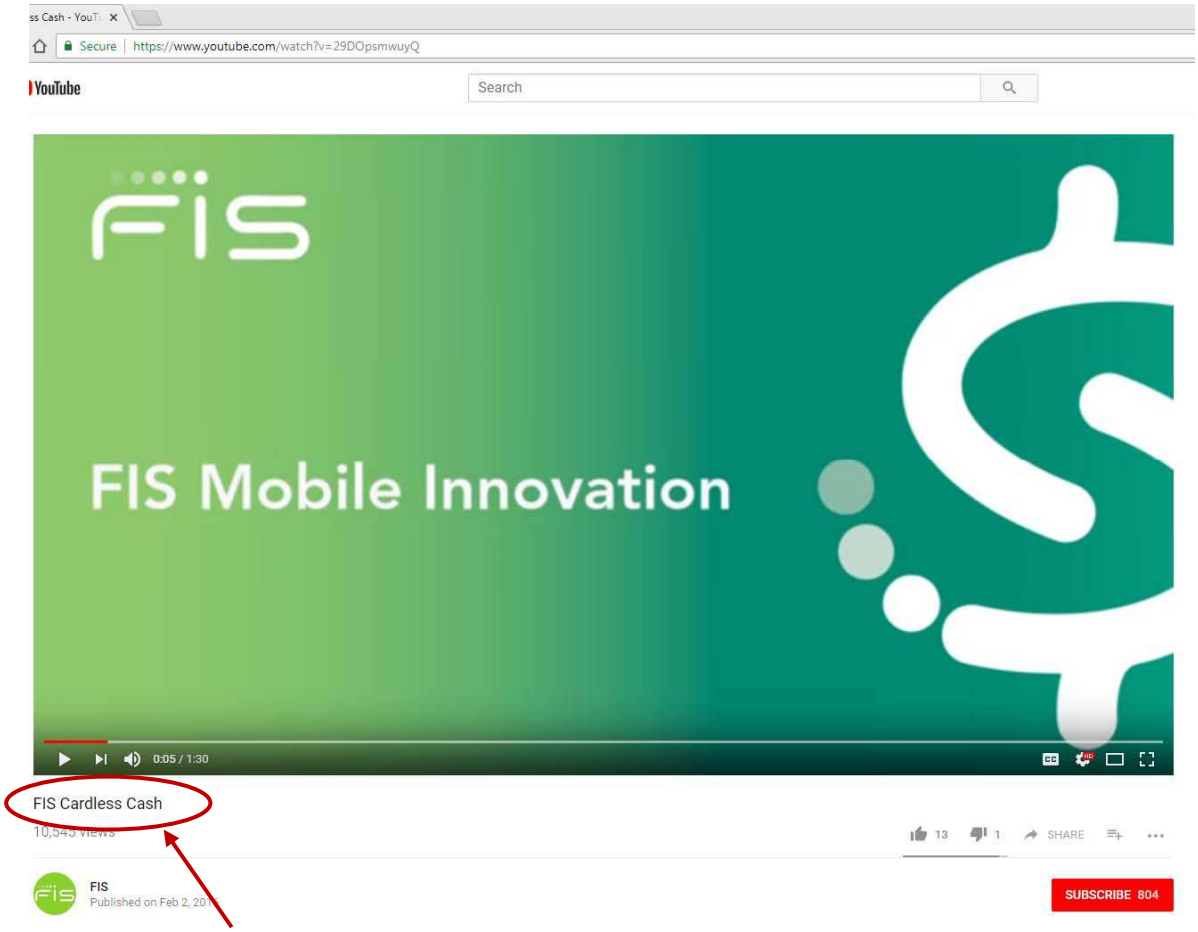
FIS has submitted substantial and compelling evidence of acquired distinctiveness. Initially, FIS has presented evidence that it has continuously and exclusively used the Mark in commerce from August 2013 to May 20, 2019, the date FIS submitted its 4th 2(f) Declaration. It is well settled that the PTO may accept proof of substantially exclusive and continuous use of a mark in commerce for five years "as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce." 15 U.S.C. § 1052(f); TMEP § 1212.05. Although five years of use of the Mark by FIS and its customers can alone be proof that the mark has acquired distinctiveness, FIS's additional evidence summarized below of the widespread consumer reach, substantial commercial success, and significant publicity and promotion of the Mark, further compels such a finding.

FIS's Goods and Services are promoted extensively by FIS and its bank and ATM customers and partners, as shown in the representative examples below:

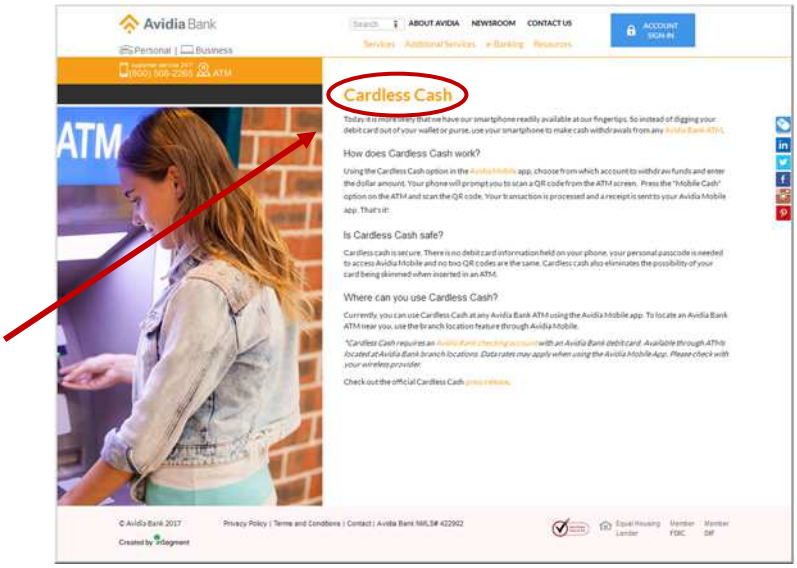
FIS

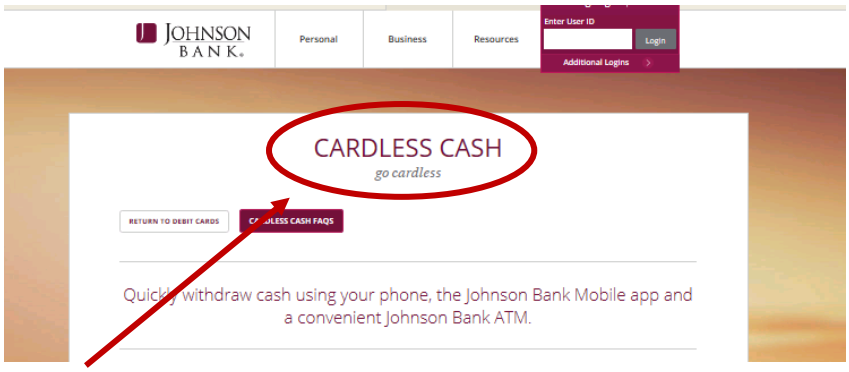


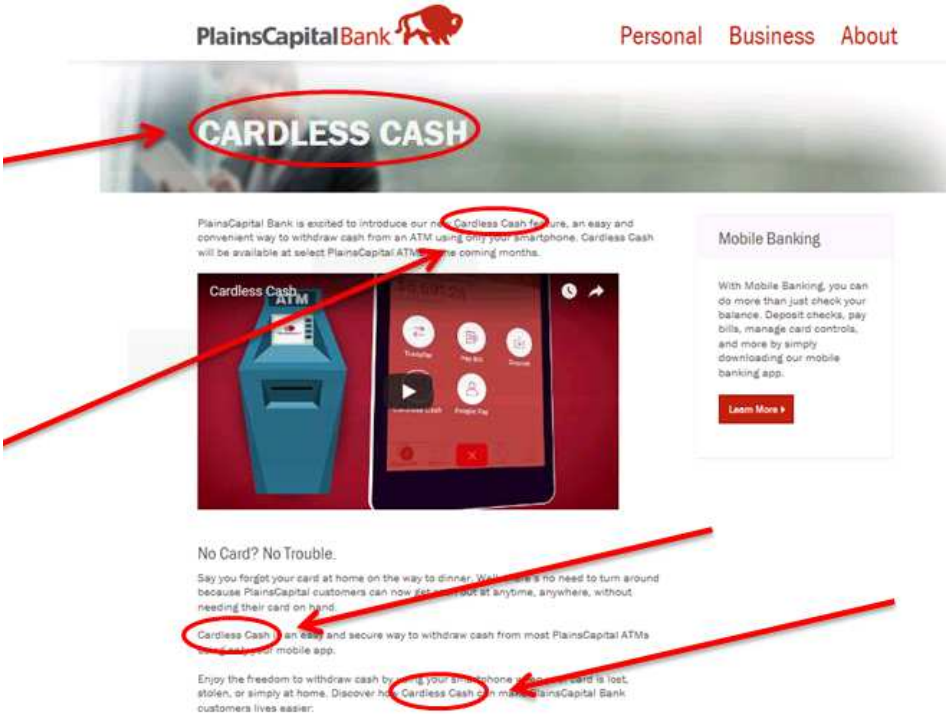

FIS
FIS CARDLESS CASH
Mobile banking at the ATM
FIS Cardless Cash™ gives customers the ability to pre-order a cash withdrawal at the ATM from their mobile banking app. With card-related fraud increasing, Cardless Cash employs a first-class cloud security model to safeguard customers' identifiable payment information. This industry-leading feature allows banks and credit unions to better service and protect their customers by offering cross-channel interaction at the ATM.

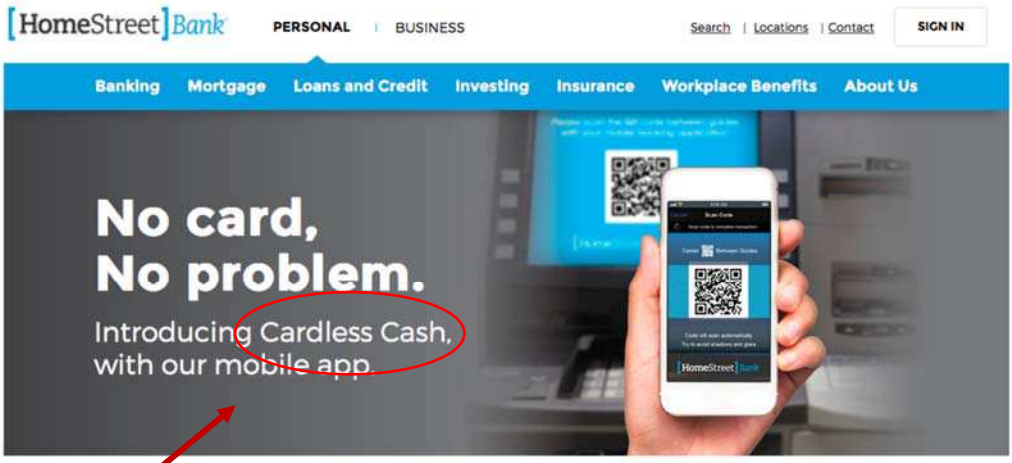

Secure | https://www.youtube.com/watch?v=29DOpsmwuyQ
YouTube
Search
FIS
FIS Mobile Innovation
0:05 / 1:30
FIS Cardless Cash
SHARE
FIS
SUBSCRIBE 804

FIS's Bank Customers





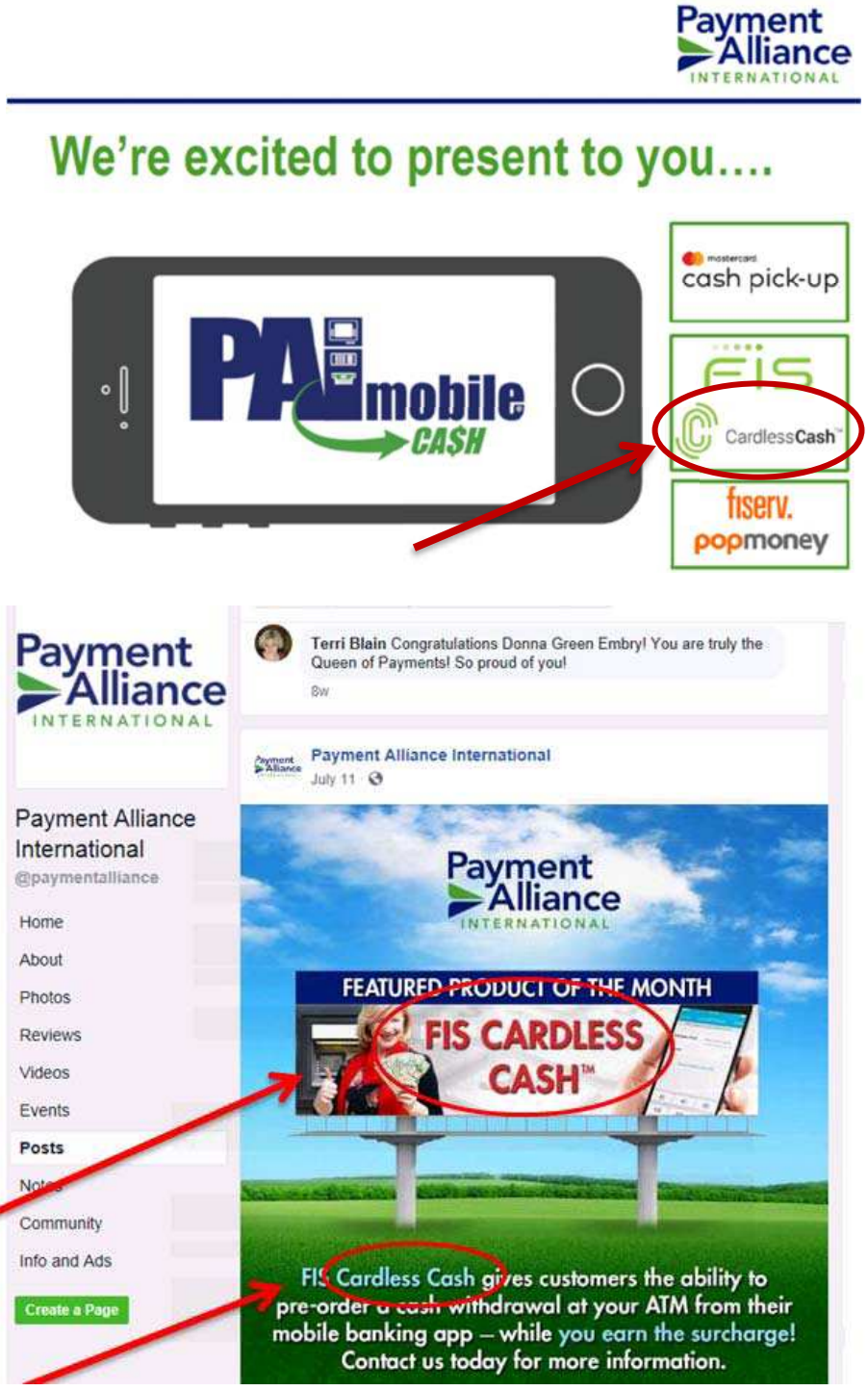




Getting cash from a HomeStreet Bank ATM has never been easier!

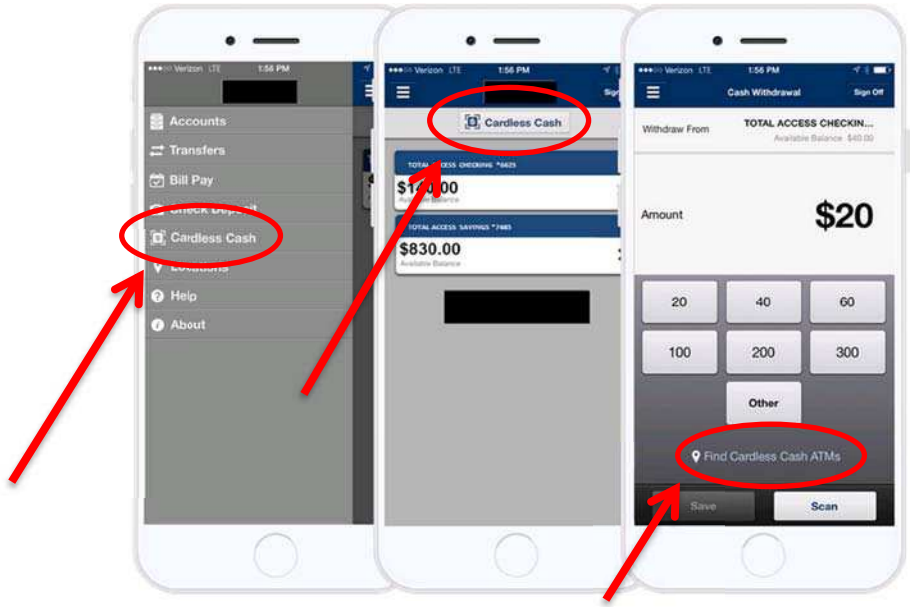
With the Cardless Cash feature in the HomeStreet Bank mobile app, you can withdraw money from HomeStreet Bank ATMs using your smartphone.

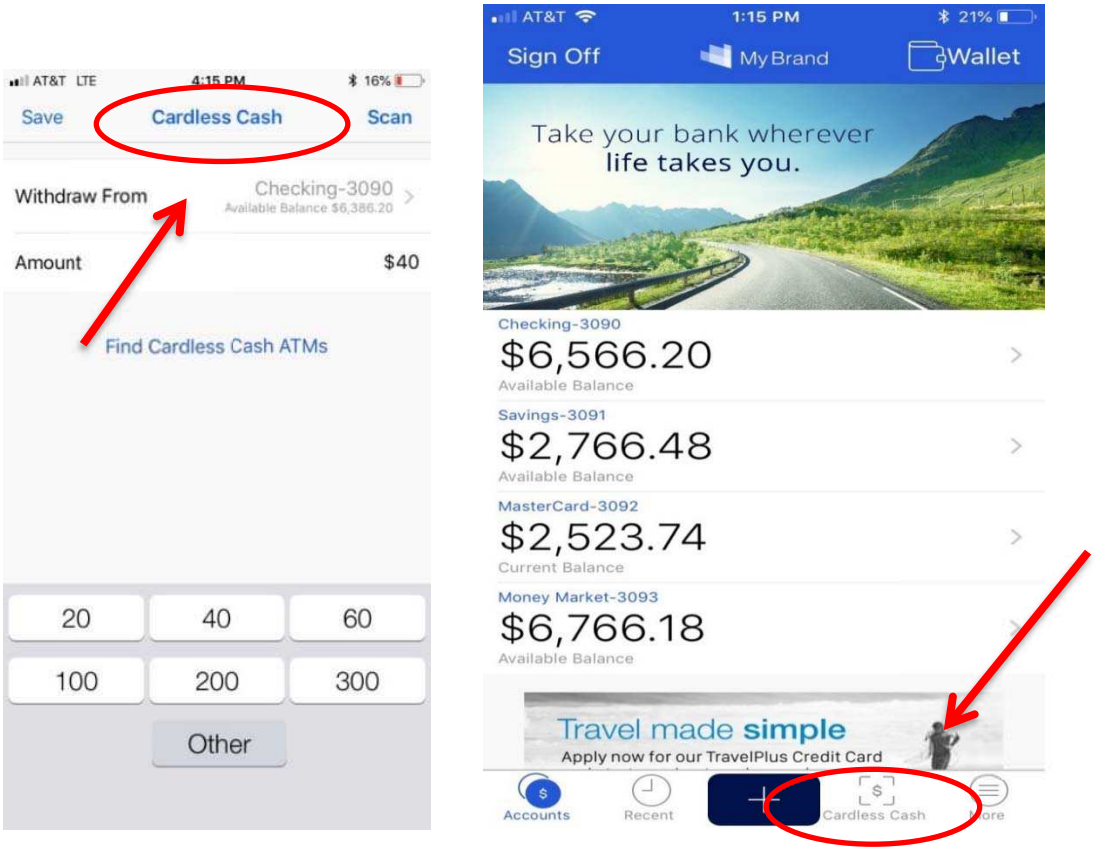
FIS's ATM Customers



(May 20, 2019 Response, 4th 2(f) Declaration, TSDR pp. 29-57, ¶¶ 4-16.)

FIS's CARDLESS CASH software also prominently features the Mark, providing further consumer exposure to the Mark, as shown in the examples below:





(May 20, 2019 Response, 4th 2(f) Decl., TSDR pp. 30-31, ¶ 5.)

The consumer exposure to FIS's CARDLESS CASH platform is extensive. Representative examples of FIS's banking customers using the CARDLESS CASH platform include: BMO Harris Bank, one of the largest banks in the Midwest with 600+ branches and over $110 billion in assets; Wintrust Financial, which operates 15 different branded community banks totaling 160+ locations and more than $27 billion in assets; the Bank of Hawaii, the largest bank in Hawaii with 65+ locations and over $15 billion in assets; Lake City Bank, an Indiana-based bank with 49 locations and $4.7 billion in assets; MidFirst Bank, one of the largest privately owned banks, with more than $14.5 billion in assets and over 70 banking centers and 175 ATMs in Oklahoma, Arizona, and Colorado; Plains Capital Bank, the sixth-largest Texas bank by deposit market share, with 60+ branches and over $10 billion in assets; Johnson Bank, which has 40+ branches in Wisconsin and Arizona; Oklahoma Fidelity Bank, with over $2.1 billion in assets and 20+ offices across the Wichita, Oklahoma City, and Kansas City metro areas; and Gorham

Savings Bank, with 15+ locations in Maine and assets of over $1 billion. (May 20, 2019 Response, 4th 2(f) Decl., TSDR pp. 61-62, ¶¶ 18-20.)

FIS's CARDLESS CASH platform also powers many thousands of ATMs in credit unions, retail stores, gas stations, convenience stores, and other locations nationwide through partnerships with non-bank ATM networks and operators. For example, FIS entered into an agreement with CO-OP Financial Services to bring FIS's CARDLESS CASH platform to its locations, which include approximately 2,000 credit unions and more than 30,000 ATMs throughout the United States. (May 20, 2019 Response, 4th 2(f) Decl., TSDR pp. 53-54, ¶ 13.)

FIS also entered into an agreement with Payment Alliance International ("PAI"), the nation's largest privately held ATM provider, to bring FIS's CARDLESS CASH platform to PAI's thousands of ATMs located at many of the country's largest retailers, gas stations, convenience stores, and more. The map below shows the deployment of FIS's CARDLESS CASH platform with PAI ATMs in countless cities from coast to coast as of August 2018. (May 20, 2019 Response, 4th 2(f) Decl., TSDR p. 54, ¶ 14.)

Cardtronics, the world's largest non-bank ATM owner/operator, has also integrated FIS's CARDLESS CASH platform across 11,000 ATMs. Other non-bank ATM networks and operators with which FIS has entered into agreements include Genmega, Hyosung, and Triton. (May 20, 2019 Response, 4th 2(f) Decl., TSDR p. 58, ¶ 16.)

FIS's CARDLESS CASH platform is available in all 50 states and the District of Columbia and Puerto Rico, including in many of the country's largest cities/metropolitan areas: New York (#1), Los Angeles (#2), Chicago (#3), Phoenix (#5), Philadelphia (#6), San Antonio (#7), San Jose (#10), Jacksonville (#12), San Francisco (#13), Columbus (#14), Indianapolis (#15), Charlotte (#17), Seattle (#18), Washington, DC (#21), Boston (#22), Detroit (#23), Memphis (#25), Oklahoma City (#27), Las Vegas (#28), Louisville (#29), Baltimore (#30), Milwaukee (#31), Albuquerque (#32), Tucson (#33), Miami (#42), Omaha (#44), Minneapolis (#46), Tampa (#52), Honolulu (#55), Lexington (#60), St. Louis (#61), St. Paul (#64), Cincinnati (#65), Orlando (#73), Baton Rouge (#97), Richmond (#98), Spokane (#101), and Birmingham (#104). (May 20, 2019 Response, 4th 2(f) Decl., TSDR pp. 62-63, ¶ 22.)

The commercial success of FIS's CARDLESS CASH software and services mirrors their extensive reach nationwide. The volume of CARDLESS CASH transactions is impressive, with tens of millions of dollars in transactions each year. FIS processed more than $50 million in CARDLESS CASH transactions between early 2015 and mid-2016. In 2017, FIS's transaction volume significantly increased to more than $74 million; in 2018, FIS's transaction volume increased to more than $88 million; and FIS processed more than $20 million in CARDLESS CASH transactions in the first quarter of 2019. Thus, the total amount of CARDLESS CASH transactions has exceeded $230 million in just the four years covered by FIS's 2(f) Declarations. (May 20, 2019 Response, 4th 2(f) Decl., TSDR pp. 60-61, ¶ 17.)

FIS's CARDLESS CASH platform has garnered extensive unsolicited media coverage from general news media as well as financial media, including television coverage, such as on Fox News and CNN. (May 20, 2019 Response, 4th 2(f) Declaration, TSDR pp. 43-44, ¶ 9.) FIS has submitted over 100 articles and screen captures from general news publications, specialized financial media, and numerous websites, such as *Forbes*, *Business Insider*, *The New York Times*, *ATM Marketplace*, and *Retail Banker International*, among many others, that reference the CARDLESS CASH platform in trademark form in connection with FIS and its customers. Excerpts from representative examples are shown below:

- "Here is an example of keeping things simple for customers. What if there was a way to access money from an ATM without your card? Enter **Cardless Cash**, an FIS service that's available in

29 cities across the U.S." Stan Phelps, *Keeping Pace: Four Trends In Banking Customer Experience*, Forbes, May 25, 2016.

- "Earlier this year, Fidelity Information Services (FIS) and Payment Alliance International (PAI) teamed up to bring **Cardless Cash**, which allows users to access ATMs via their mobile devices, to thousands of US locations. . . . Now, mobile banking users at banks including BMO Harris will be able to use their phones to access ATMs." *PayPal and FIS team up for cardless ATMs*, Business Insider, Aug. 24, 2016.

- "FIS, a banking and payments technology company, has added biometric validation technology to its mobile banking application. The technology will allow consumers and businesses using **Cardless Cash** ATM application to bank using fingerprint access instead of two-factor authentication." *FIS adds biometric authentication to card-less ATM banking*, Retail Banker Int'l, Mar. 30, 2015.

- "FIS extends **Cardless Cash** offering . . . Fidelity Information Services (FIS) is partnering with major ATM operator Cardtronics to bring its **Cardless Cash** offering to Cardtronics ATMs." Jaime Toplin, *FIS extends Cardless Cash offering*, Business Insider, July 3, 2017.

- "Today, HomeStreet Bank . . . announced a new **Cardless Cash** feature that allows customers to securely withdraw money from an ATM using just their smartphone." *HomeStreet Bank Announces Cardless Cash Feature for Fast, Secure and Convenient ATM Transactions*, Business Wire, Oct. 12, 2017.

- "FIS and Cardtronics will improve ATM security through combining the FIS **Cardless Cash** functionality with the Cardtronics ATMs across the United States." Tom Groenfeldt, *FIS Mobile Acts As ATM Remote Control To Improve Security*, Forbes, June 29, 2017.

- "HomeStreet has been continuing to expand its branch presence as well as strengthening its digital offerings, including **Cardless Cash** . . . . Launched late last year, the **Cardless Cash** feature enables customers to securely withdraw money from an ATM using just their smartphone." *HomeStreet Bank revamps website*, Global Banking News, Mar. 7, 2018.

- ". . . FIS **Cardless Cash** is coming to ATMs located at many of the nation's largest retailers, gas stations, convenience stores and more, ultimately expanding to a total of 70,000 ATMs in the PAI ATM network. The service will allow you to securely access your funds and authorize the amount you want through your smartphone . . . ." David William, *70,000 ATMs in the U.S Will Soon Allow You to Withdraw Cash with Your Smartphone*, Small Business Trends, Jan. 2, 2019.

(May 20, 2019 Response, 4th 2(f) Decl., TSDR pp. 40-43, ¶ 8.)

FIS's evidence collectively is more than sufficient to show the Mark has acquired distinctiveness. The Board has considered similar years of use with less evidence sufficient to prove acquired distinctiveness. For example, in *In re Mine Safety Appliances Co.*, the Board reversed the refusal of an applicant's claim of acquired distinctiveness for the mark WORKMASK for a "self-contained breathing apparatus," which both the Examining Attorney and the Board considered "highly descriptive." *In re*

Mine Safety Co., 66 USPQ2d 1694, 1695-97 (TTAB 2002). The applicant had based its 2(f) claim on five years of substantially exclusive and continuous use of the WORKMASK mark, and supplemented its claim with examples of materials used to promote the WORKMASK product applicant had distributed to "tens of thousands" of customers, safety catalogs advertising the WORKMASK product distributed "hundreds of thousands" of times over the previous five years, a bulletin applicant has displayed at an annual trade show for six years, and sales revenue of over $10 million in its six years of use. *Id.* at 1697. The Board found persuasive the applicant's argument that $10 million in sales over six years "goes a long way towards making a prima facie showing" of acquired distinctiveness. *Id.* at 1699. Ultimately, the Board found that given the length and manner of applicant's use of the WORKMASK mark, including its sales and distribution of promotional materials, relevant purchasers perceived applicant's WORKMASK mark as identifying and distinguishing the source of applicant's goods. *Id.* at 1700.

This case—with far more extensive use, promotion, and exposure—warrants the same result. FIS has used its Mark in commerce for a similar length of time, and transactions through FIS's CARDLESS CASH platform have surpassed $230 million in just the last four years. As in *In re Mine Safety Appliances*, this massive commercial success is very persuasive evidence of a prima facie showing. Further, FIS's CARDLESS CASH platform has been promoted nationwide by FIS along with its bank customers and ATM partners, alongside unsolicited media coverage of the CARDLESS CASH platform from some of the nation's top publications and networks. All of this evidence shows that hundreds of millions of consumers have been exposed to FIS's CARDLESS CASH mark nationwide for several years. Given FIS's substantially exclusive and continuous use of the Mark in commerce for more than five years, combined with FIS's extensive evidence highlighting the widespread consumer reach, substantial commercial success, and significant publicity and promotion of FIS's CARDLESS CASH platform based on the efforts of FIS and its customers and business partners, consumers have come to associate the Mark with a single source, and the Mark has acquired distinctiveness under Section 2(f).

Finally, the Examining Attorney in the Sept. 6, 2017, March 29, 2018, Nov. 20, 2018, and June 11, 2019 Office Actions erred in concluding that FIS's 2(f) Declarations were insufficient to establish

acquired distinctiveness simply because of "mixed usage." But mixed use of trademark and lowercase uses is not a valid ground to deny a 2(f) claim. For example, in *In re America Online*, 43 out of 70 articles correctly displayed the INSTANT MESSENGER mark. Despite the fact that 39% of the evidence showed lowercase uses, the Board reversed the Examining Attorney's genericness refusal and found the applicant's 2(f) evidence sufficient to establish acquired distinctiveness. 77 USPQ2d at 1625. Here, only about 16% of the record shows lowercase uses. FIS's 2(f) evidence thus is more than sufficient to establish acquired distinctiveness.

IV. CONCLUSION

FIS's Mark is not generic but rather is suggestive. In the alternative, if the Board finds the Mark is descriptive, the Mark has acquired distinctiveness.

FIDELITY NATIONAL INFORMATION SERVICES, INC.

Dated: December 3, 2019

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