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U.S. Application Serial No. 87006159

Mark: CARDLESS CASH

Correspondence Address:
DAVID M KELLY

KELLY IP LLP

1300 19TH STREET NW

WASHINGTON, DC 20036

Applicant: Fidelity National Information Services, ETC.

Reference/Docket No. 120.0840

Correspondence Email Address:

docketing@kelly-ip.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

This is an appeal from the Examining Attorney's final refusal to register Fidelity National Information Services, Inc. (hereinafter "Applicant") mark, CARDLESS CASH, in International Classes 9, 36, and 42 for software, banking services and online software services under Sections 1, 2, 3 & 45 of the Trademark Act on the grounds that the mark is generic for the goods and services and in the alternative the application was refused under Section 2(e)(1) of the Trademark Act for being merely descriptive of

the goods in which Applicant's evidence of acquired distinctiveness under Section 2(f) was found to be insufficient. It is respectfully requested that these refusals be affirmed.

FACTS

On April, 19, 2016, Applicant filed an application under Section 1(a) to register the mark CARDLESS CASH on the Supplemental Register for "Computer software that allows users to withdraw cash from automatic teller machines using a smartphone or other mobile devices" in International Class 9, "Banking and financial services, namely, automatic teller machine services and electronic funds transfer services" in International Class 36, and "Cloud computing software featuring software for use in automatic teller machine services, electronic funds transfer services, banking services, and financial services; software as a service (SAAS) services featuring software for use in automatic teller machine services, electronic funds transfer services, banking services, and financial services" in International Class 42.

On June 8, 2016, the Examining Attorney refused registration under Sections 23(c) of the Lanham Act for the mark being generic for the goods and services and required amendment to the identification of goods and services.

Applicant responded on December 8, 2016 and amended the application to seek registration on the Principal Register. The identification was appropriately amended.

In February 2017, the Examining Attorney issued a new refusal under Section 2(e)(1) of the Lanham Act denying registration on the Principal Register. The Examiner also withdrew the identification requirements and issued a generic advisory to the applicant as the initial refusal under Section 23(c) was no longer appropriate as applicant was no longer seeking registration on the Supplemental Register.

Applicant responded on August 7, 2017 asserting that the mark was capable of being registered on the Principal Register under Section 2(f). The Section 2(f) claim was rejected on September 6, 2017 and examiner withdrew the initial generic refusal under Section 23(c). Applicant submitted more arguments and evidence thereto on March 6th and 13th of 2018.

The Examining Attorney went final on the Sections 2(e)(1) refusal and Section 2(f) refusal on March 29, 2018. Applicant requested reconsideration on September 28, 2018.

On November 20, 2018, the examining attorney issued a new refusal under Sections 1, 2, 3, & 45 of the Act that the term was generic and in the alternative descriptive under Section 2(e)(1) and applicant's Section 2(f) evidence was insufficient. Applicant argued against the finding in May of 2019. The refusals were made final on June 11, 2019 and reconsideration was denied on October 3, 2019.

ISSUES PRESENTED

There are three issues on appeal: 1) whether the applied-for mark is generic for the goods and services in Classes 9, 36, and 42 under Sections 1, 2, 3 & 45 of the Trademark Act, 2) whether, if not generic, the mark is descriptive under Section 2(e)(1) for all classes, and 3) whether Applicant has proven acquired distinctiveness under Section 2(f) of the Trademark Act for all classes if the mark is found to be descriptive.

ARGUMENTS

A. Generic

A generic term is a common name that the relevant public uses or understands primarily as referring to the category or genus of the goods in question. *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782

F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986) ("A mark is generic if its primary significance to the relevant public is the class or category of goods on or in connection with which it is used."); *see* TMEP §1209.01(c). Generic terms are by definition incapable of indicating a particular source of goods and cannot be registered as trademarks. *In re Cordua Rests., Inc.*, 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (quoting *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987)); *see* TMEP §1209.01(c). Registering generic terms "would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Determining whether a mark is generic requires a two-step inquiry:

(1) What is the genus of goods and/or services at issue?

(2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services?

In re Cordua Rests., Inc., 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs*, *Inc.*, 782 F.2d at 990, 228 USPQ at 530); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the goods and services may be defined by Applicant's identification of goods. *See In re Cordua Rests., Inc.*, 823 F.3d at 602, 118 USPQ2d at 1636 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)); *see also In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361, 1363, 92 USPQ2d 1682, 1682, 1684 (Fed. Cir. 2009). In this case, the application identifies the Class 9 goods as "Computer software that allows users to withdraw cash from automatic teller machines using a smartphone or other mobile device," the Class 36 services as "Banking and financial services, namely, automatic teller machine services and electronic

funds transfer services" and the Class 42 services as "Cloud computing software featuring software for use in automatic teller machine services, electronic funds transfer services, online banking services, and financial services, namely, electronic funds transfer services; software as a service (SAAS) services featuring software for use in automatic teller machine services, electronic funds transfer services, online banking services, and financial services, namely, electronic funds transfer services" which adequately defines the genus at issue. Essentially, the genus is ATM and fund transfer banking services and the software to carry out those services.

Regarding the second part of the inquiry, to assess whether a compound term is generic, the evidence of record must show that each of the constituent words is generic, and that when combined, the composite lends no additional meaning to the total combination. *See In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1602-03 (TTAB 2014); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010); TMEP §1209.01(c)(i).

a. Terms Assessed Individually

The term "cardless" is a combination term of the noun "card" and the suffix "–less." "Card" is defined as "a small rectangular piece of plastic issued by a bank, containing personal data in a machine-readable form and used chiefly to obtain cash or credit." *See* March 29, 2018 Office Action TSDR pp. 17-19. The suffix "-less" is defined as "destitute of: not having" *Id* TSDR pp. 14-16. The goods and services in this case are ATM and transferring funds banking services and both the recorded and online software to enable such services; the Class 9 identification specifically notes the software is for "withdraw of cash from automatic teller machines using a smartphone or other mobile device." Thus the identification provided notes that the goods and services are to be used to withdraw cash using something other than a card, the normal means of withdrawing funds from an ATM machine. Furthermore, the specimen of use submitted with the goods and services notes "FIS Cardless Cash gives customers the ability to pre-

order a cash withdrawal at the ATM from their mobile banking app." *See* April 19, 2016 Application TSDR p. 5. This evidence again underscores that the use of a card is not necessary in this case, the retrieval of funds can be done without a card. Thus the term CARDLESS is generic alone for the banking services and associated software based on the definitions of the terms and bolstered by the record.

The term "cash" is defined as "money in coins or notes, as distinct from check, money orders or credit." March 29, 2018 Office Action TSDR pp. 11-13. Again, the services are for banking services including ATMs and the software for enabling such transactions. As noted above, the identification in Class 9 includes software for cash withdrawal. The specimen of use notes that the goods and services "gives customers the ability to pre-order a cash withdraw." *See* April 19, 2016 Application TSDR p. 5. This evidence clearly shows that the applied for goods and services are designed around consumers receiving cash from applicant's ATM services. Therefore, cash would be understood by consumers to be the key feature or main thrust of the goods and services, put differently, they would be using the identified goods and services to receive cash.

The terms individually point to the mark as a whole being generic as the term "cardless" is generic for services that specifically do not require a card when a card is normally necessary and cash is generic for goods and services that deal specifically with the withdraw of cash from banking institutions, the key feature of the goods and services.

b. Terms Assessed Together

"The Board has often held that a term that names the 'central focus' or 'key aspect' of goods and/or services is generic for the goods/service themselves, and the Board's principal reviewing Court has approved this approach." *In Re ActiveVideo Networks, Inc.,* 111 USPQ2d 1581, 1603 (TTAB 2014). *See also Hotels.com L.P.*, 91 USPQ2d at 1533-34 (approving Board's finding that the word "hotels" identifies the "central focus" of online lodging information and reservation services, rendering the mark

HOTELS.COM generic). *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS is generic for publication and communication via the web, and also for consulting services directed to assisting customers in setting up their own websites for such publication and communication); *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS is generic for services of arranging and conducting seminars in the field of business law)."

Evidence accumulated throughout the prosecution shows the use of the term cardless cash used heavily in the industry to describe a "central focus" and/or "key aspect" of specific banking services and the technological means thereof, namely, consumer's ability to use technology – smartphones – to withdraw cash from banking accounts, thus circumventing the need for ATM cards. The evidence is multifaceted and comes from a wide variety of sources. First, there is evidence of widespread generic use of the mark in various print media outlets, thirty two article portions are part of the record. June 8, 2016 Office Action TSDR p. 1 (articles follow refusal); February 7, 2017 Office Action TSDR p. 1 (articles follow refusal); November 20, 2018 Office Action TSDR pp. 13-17. Generic use of the term included, "Win Trust and City National are working on cardless cash ATMs, wherein customers can use their smartphones to withdraw cash from ATMs." June 8, 2016 Office Action TSDR p. 1 (articles follow refusal). "Mercator Advisory Group expected cardless cash access to be one of the top banking trends in 2015, the Tribune reported last year" *Id*. "The Paydiant partnership allows the credit unions to build white-label mobile payment systems that handle transactions, electronic receipts and cardless cash access on point of sale systems, ATMs and shopping carts." *Id*. "Brown says cardless cash sounds kind of cool when he describes it to bankers. But when they see it in action, their reactions are more like: 'Holy crap, that was fast.'" *Id*.

Patents filed by three different parties use the term to denote the type of service being offered by their invention. February 7, 2017 Office Action TSDR pp. 20-22, 93-97. PayPal's patent application was titled "[s]secure cardless cash withdrawal" and the abstract's first sentence included "[m]ethods,

systems, and computer program products for secure cardless cash withdrawal are provided." *Id* p. 20. E Cash Financial's application noted "[t]his invention relates generally to person-to-person funds transfers and more specifically to wholly and partially automated cardless cash transfers." *Id* p. 22. Finally, a Japanese firm applied for "[t]o provide a cardless cash dispensation system and method in which cash can be dispensed without using a cash card in a cash dispenser or the like installed in a financial institution." *Id* p.21.

The financial and bank industry specific journals and information channels as well as more mainstream news channels heavily covered and used the applied for mark generically when introducing the consuming public to the services. *See* February 7, 2017 Office Action TSDR pp. 2-3, 5-12, 28-65, 71-92; March 29, 201 Office Action TSDR pp. 5-10, 20-37; November 20, 2018 Office Action TSDR pp. 2-12, 21-24; June 11, 2019 Office Action TSDR pp. 12, 14-18, 22-24. Specific instances included, "[r]ecently, HalCash North America announced the launch of Pin4, a mobile cardless cash ATM withdrawal solution that provides businesses with a radically better way to engage with their customers through real-time delivery of cash without the need of a debit/credit card or bank account." February 7, 2017 Office Action TSDR p. 2. "Bank of America announced that they will implement the cardless cash withdrawal system in nearly 5,000 of their ATM machines by 2017, and Wells Fargo & Co expecting to have around 40 percent of their ATMs enabled with the feature by the same time." *Id* p. 9. "The option is called 'cardless cash.' Using the bank's smartphone app, customers can set up a withdrawal in advance through their phones." *Id* p. 29. "Cardless cash works by providing you with a unique code that you enter into an ATM to withdraw cash when you don't have your card." March 29, 2018 Office Action TSDR p. 5. "Both Bank of America and JPMorgan Chase also have similar technology in the works, but Wells Fargo's move makes it the first major bank in the US to roll out cardless cash withdrawals at its ATMs." *Id* p. 26.

Finally, there is evidence of industry actors and applicant's competitors using the term to denote their "cardless cash" services. February 7, 2017 Office Action TSDR pp. 5, 13-19, 23-27, 66-70; November

20, 2018 Office Action TSDR pp. 18-20; June 11, 2019 Office Action TSDR pp. 2, 13, 19-21, 25-26. "HalCash North America is making is cardless-cash ATM service available in four U.S. cities prior to eventual national expansion later this year." February 7, 2017 Office Action TSDR p. 13. "Since the inception of the ATM the card has been central, but this could be changing as we see the arrival of 'cardless cash.'" *Id.* p. 15. "Wincor Nixdorf's Transaction Safe supports financial institutions and mobile network operators enabling new cardless cash use cases for omni-channel customer experiences." *Id*. p. 18. "Using Design Thinking, we created innovative new banking solutions, including adding new features such as cardless cash. The cardless cash mobile application can be used by customers, instead of having to use their credit or debit card to quickly access cash" *Id* p. 25. "Banks now have a secure way to offer customers a cardless cash withdrawal option at the ATM. This innovative cardless method permits users to pre-order cash through the financial institution's mobile application and retrieve the money at participating ATMs." *Id* p. 66. "Since the ATM was first introduced nearly 50 years ago, the way people access cash has remained almost unchanged. . . . The opportunity exists to offer cardless cash options that address the needs of a broader group of financial institutions and consumers." *Id* p. 68. "As part of continued efforts to elevate customer convenience through digital transformation, 7-Eleven is pleased to partner with FinTech start-up, soCash, to offer cash withdrawal via the latter's mobile app. This cardless cash withdrawl service has been available to all 7-Eleven stores from 1 June 2018." June 11, 2019 Office Action TSDR p. 23.

Even the uses of the mark with capital lettering within the industry do not show proper trademark use and should not be considered accordingly. For instance MidFirst Bank's webpage lists Cardless Cash as one of their many services including "Online Banking, Mobile Banking App, Bill Pay, Mobile Wallet, and Digital Receipts." *Id* p. 26. This use of the term does no denote trademark use as the mark is use alongside many different generic terms that modern day banks use to describe their online and digital services. The same is true for St. Charles Bank's webpage which lists "Cardless Cash" among

many features included of their accounts alongside “Online bill pay, E-Statements, Remote deposit, and Online & mobile banking”. *Id* p. 13. PlainsCapitalBank uses the mark in a capitalized form beside “Mobile Banking,” which undercuts the idea that consumers would see the mark as a trademark in this instance and not just the capitalization of a generic service offered by this bank in which the bank capitalizes the term. *Id* p. 20.

All evidence assessed together paints a clear picture that cardless cash services are a class of services offered by banks around the country as many of the Applicant’s competitors use the terms “cardless cash” to identify their smartphone-capable ATM banking services and machines. Further, the media uses the terms “cardless cash” to refer to a process of cash withdrawal that does not require an ATM card and consumer’s use the terms “cardless cash” to refer the goods and services more generally. Thus the applicant’s banking services are generic as consumers and the industry use that term to refer to those specific services. Further, the applicant’s software goods and services are generic as well as they are a “key aspect” and/or “central focus” of the banking services, i.e. without the software goods and services the banking services could not function.

When these individual words are combined into one compound term, CARDLESS CASH, the meaning of the compound refers to a service that enables consumers to receive cash from ATM machines without the use of a card but merely the use of a smartphone and a technologically equipped ATM machine. The individual words within the composite term retain their original meaning and no additional meaning is created by their combination. As a result, the relevant public would perceive the mark as a whole to be generic when applied to the relevant goods and services because of the overwhelming use by third party providers, the media and consumers calling their goods and services cardless cash.

c. Response to Applicant’s Arguments Regarding Generic Finding

i. End Result

Applicant argues that the mark cannot be generic because the end result of the services in this case are the receipt of cash which runs afoul of the holding in *In re Seats,* 757 F.2d 274, 277 (Fed. Cir. 1985). The facts in this case are quite different from those presented in *Seats* as the whole process and service in this case is a cardless cash banking service. While it is true that the at the end of the transaction the consumer is going to walk away with cash in hand the specific banking services applied for here are ATM banking services and software for a cash withdraw with a smartphone. Thus, the process for receiving the end result, cardless cash, is what is understood by consumers as the type of services their receiving from their bank unlike the services in *Seats* which consumers did not understand the buying of tickets for a seat to be known as a seat.

ii. FIS Evidence

As applicant notes on page 7 of its brief, "[t]he 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)." In this case the applicant claims that the vast majority of the evidence presented by the examiner refers to the applicant or one of their licensees; regardless of who is behind the uses of the mark of record is the fact that the uses are plainly generic. Just because applicant might be behind the use does not mean that consumers see the mark as a trademark. For instance, "[t]o make the cardless-cash transactions possible on existing ATMs, the Wintrust machines are being outfitted with software from FIS, a technology provider to banks, retailers and payment processors. FIS said Wintrust is the first of its 1,600 mobile banking clients to roll out cardless cash on a widespread basis." June 8, 2016 Office Action TSDR p. 1 (article titled "Phones taking place of cards at bank ATMs"). The quote is exceedingly clear who is behind the services. However, the usage of the terms "cardless cash" within the quote would be understood as referring to an activity and not indicating the source of the services. The same holds true for evidence put forward by the applicant,

"PayPal is expanding its relationship with FIS, helping to power cardless cash for more consumers across the U.S." August 7, 2017 Request for Reconsideration TSDR p. 192. Again, we know the parties but only that they are working together on a generic banking feature for ATMs called cardless cash.

The Board has also ruled in the past that the mere usage of capitalization for a generic term is not enough to show the term as a source identifier, "[a]pplicant's attempt to appropriate this term for itself with the use of initial capitalization on its website is futile." *In Re Mecca Grade Growers, LLC* 125 USPQ2d 1950 (TTAB 2015). Thus, while applicant claims the overwhelming bulk of the evidence presented points to them that does not mean that consumers understand the term to be a source identifier for the applicant's goods and services.

iii. Mixed Use

Applicant's final argument relies on *In Re Merrill Lynch*, 828 F.2d 1567. In that case a mixed usage of the term CASH MANAGEMENT ACCOUNTS was held to not be generic as a matter of clear evidence. The record in this case is not like that in *Merrill Lynch* but rather like the record in *In re Nordic Naturals, Inc*., 755 F.3d 1340 in which there were instances where in the applicant was noted in third party uses as a source there were also plenty of sources that did not recognize the applicant as the source of the goods and/or used the mark in a generic sense. *See generally* February 7, 2017 Office Action TSDR pp. 13-27. Evidence of record includes applicant's competitors use of the mark to describe a new type of banking service and what it means as well as multiple patent applications that clearly use the term to spell out the bounds of their invention. *Id*.

Moreover the use of the mark by journalists and consumers goes to the heart of the question about the ultimate public understanding of the term, what is the ultimate public perception of the mark and in this case the public and the applicant's competitors clearly see the term cardless cash as referring to a specific type of banking ATM service.

Thus, based on the evidence of record, the applied-for mark is generic as used in connection with the goods and services underlying consumers ability to withdraw cash from ATM machines without a card.

B. Descriptive

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an Applicant's goods. TMEP §1209.01(b); *see, e.g.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)). The mark in this case, if not generic for the goods and services underlying cardless cash withdrawn from ATMs, is unquestionably descriptive of the goods and services.

The determination of whether a mark is merely descriptive is made in relation to an Applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Identical to the generic analysis *infra* the test for determining if a compound mark is descriptive weighs whether the individual components of a mark retain their descriptive meaning in relation to the goods and the combination results in a composite mark that is itself descriptive and not registrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB (2002)); TMEP §1209.03(d); Only where the combination of descriptive

terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods 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, the individual components and the composite result are descriptive of Applicant's goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services, in short, cardless cash is a type of banking service and the software applied-for enable that service to take place and the combination of the terms does not alter the descriptive meaning of the mark for all classes of goods and services. Specifically, the Class 36 analysis is the same as before, in that the identification of services here, banking services including ATM services, include a specific type of ATM feature, that being the ability to withdraw cash without using a card. As for Classes 9 and 42, the mark in this case is descriptive of a function of the software as the software "allows users to withdraw cash from automatic teller machines using a smartphone or other mobile device". *See* April 19, 2019 Application TSDR p. 1.

a. Response to Applicant's Arguments

Applicant in this case strenuously argues that the mark in this case is suggestive under two different theories, first, that there is a step in reasoning that would need to be made by consumers and thus the term does not immediately describe the goods and services and that the term is incongruous in combination. However, it is important to start with not only the procedural posture of this case but that of applicant's prior registration for a similar mark and services.

The applicant in this case came in seeking registration on the Supplemental Register. *See* April 19, 2019 Application TSDR p. 1. Thus, from the very beginning of the registration process the applicant admitted that their mark lacked distinctiveness.

Moreover, applicant claimed ownership of Trademark Registration No. 4582106. *See* April 19, 2019 Application TSDR p. 1; March 29, 2018 Office Action TSDR pp. 2-4. In this registration the applicant applied for the mark CARDLESS CASH ACCESS for identical services to those in the application in Classes 9 and 36. That application was filed seeking registration on the Supplemental Register and the mark was published and registered by the Office on the Supplemental Register.

Finally in their filing on August 7, 2017, the applicant amends their application to seek registration on the Principal Register under Section 2(f). This filing is also made without mention of it being made in the alternative; TEMP §1212.02(b) notes, "[f]or procedural purposes, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive and thus, not registerable on the Principal Register absent proof of acquired distinctiveness. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."); *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1403 (TTAB 2018) (noting that a claim of acquired distinctiveness by applicant to overcome a refusal in a prior registration for the same wording in connection with same services "can be viewed as a concession by Applicant that the wording itself is not inherently distinctive for those services"). For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney may rely on this concession alone. Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness." Thus the arguments presented by the applicant as to the distinctive nature of the term are betrayed and in the latter case foreclosed by their procedural postures not once but three times in various filings both in this case and a related case.

However, assuming that these procedural admissions are not enough, the applicant's marks are descriptive apart from their procedural admissions. The applicant cites MONEY 24 and THE MONEY SERIVCE and the outcomes in those cases as a charge for the Board to find the mark suggestive. As an initial matter, the term MONEY is not at issue in this case. Thus cases in which that term was found to be suggestive are not helpful in determining the descriptive nature of the term CASH. Further, in this case the applicant's own description of the software goods specifically notes that cash is a feature or function of the software, it is for cash withdrawal.

As to the argument that the mark is incongruous, 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 Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB (2002)); TMEP §1209.03(d); *see, e.g.*, *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1851 (TTAB 2017) (holding MEDICAL EXTRUSION TECHNOLOGIES merely descriptive of medical extrusion goods produced by employing medical extrusion technologies); *In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes); *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). 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 goods and/or services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services. Specifically, the goods and services are used for cash withdraw using a smartphone. Taking into consideration consumer knowledge that up to

and until this point in time whenever an ATM was used it would require a card, consumer with knowledge of the applicant's new services and what those services entail would understand that the banking services at issue here dispense cash to the user without the need of a card.

Thus, the applied-for mark is descriptive, if not generic, as used in connection with applicant's banking services and associated software goods and services.

C. Proof of Acquired Distinctiveness Has Not Been Met

Applicant argues that their mark is neither generic nor descriptive for the applied-for goods but in the alternative asserts that should the mark be found to be descriptive of the goods that the Applicant has proven the mark registerable under Section 2(f) of the Trademark Act. "Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless "become distinctive of the Applicant's goods in commerce." *Yamaha Int'l Corp. v. Hoshino Gakki Co.* , 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983). An Applicant bears the burden of proving that a mark has acquired distinctiveness under Trademark Act Section 2(f). *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)); TMEP §1212.01.

The ultimate test in determining acquisition of distinctiveness under Section 2(f) is not Applicant's efforts, but Applicant's success in educating the public to associate the claimed mark with a single source. *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1856 (TTAB 2017) (citing *In re Owens-Corning Fiberglass Corp.*, 774 F.2d

1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985); *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1208 (TTAB 2016); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1760-61 (TTAB 1991)); TMEP §1212.06(b). The type and nature of the evidence required to prove acquired distinctiveness changes with the nature of the mark. No amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. *See In re Bongrain Int'l (Am.) Corp.*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs*, *Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1212.02(i). Furthermore, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods would be less likely to believe that it indicates source in any one party. *See In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d at 1018 (citing *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990)). An applicant's evidentiary burden of showing acquired distinctiveness increases with the level of descriptiveness of the mark sought to be registered; a more descriptive term requires more evidence. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1365, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005)).

Applicant's evidence fails to show that the applied-for mark has garnered acquired distinctiveness as their use of the mark in commerce is relatively short in duration, their transaction figures and promotion evidence do not prove consumer perception, and evidence of record used to prove that the mark was generic also proves that there is a sizeable portion of the consuming public that does not see the mark as a source identifier at all, much less a source identifier for the applicant's goods and services.

i. Transactional and Advertising Data

Applicant provided evidence of transaction figures and excerpts of unsolicited advertising for Applicant's goods and services to support the claim that the applied-for mark acquired distinctiveness under Trademark Act Section 2(f). However, this evidence is not dispositive of Applicant's claim. Applicant's extensive transaction figures, use of the mark and unsolicited promotion may demonstrate the commercial success of Applicant's goods and services, but not that relevant consumers view the matter as a mark for these goods. *See In re Boston Beer Co.*, 198 F.3d 1370, 1371-73, 53 USPQ2d 1056, 1057-58 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1132-34 (TTAB 2000). Similarly, Applicant's quoted excerpts are merely indicative of its efforts to develop distinctiveness; not evidence that the mark has acquired distinctiveness. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1757-58 (TTAB 1991). For example, applicant cites millions of dollars have been withdrawn from ATMs using cardless cash. However, that number cannot tell anything about consumer perception of the terms "cardless cash" and whether consumers see it as a source identifier or just a new banking feature that their bank has rolled out for them to use like mobile check deposits or online banking.

ii. Evidence of Generic Usage

As noted above the evidence submitted by the Applicant is not direct evidence of consumer perception. However, even if the Board were to weigh the submitted evidence in Applicant's favor the submitted evidence for the term being generic should be weighed equally against a finding of acquired distinctiveness. The submitted evidence of generic use by applicant and third parties shows that the term has not enjoyed substantial exclusively which weighs against a finding of acquired distinctiveness as many consumers would not see the mark denoting source. *See* Office Action dated June 8, 2016 pages 5-28; Office Action dated February 07, 2017 pages 6-105; Office Action dated March 29, 2018 pages 9-14, 24-41; Office Action dated November 20, 2018 pages 5-27; Office Action dated June 11, 2019 pages 6-30. The attached evidence shows various competitors using the mark as their own. The

evidence also shows use of the mark by licensees in a generic fashion. And the evidence shows how consumers are being educated about the services through media coverage. All of this evidence points to consumers being shown that cardless cash is a type of banking service and not a specific branded banking service and thus their perception of the proposed mark would not be as source-indicating matter.

While the submitted evidence is voluminous, it does not show that consumers have come to see the applied-for mark as a source identifier because the evidence submitted cuts substantially against substantial exclusivity and the applicant's transition figures merely show that the services of the applicant are being used at banks and by consumers but not that consumers see the term CARDLESS CASH as a source identifier for banking services and software goods.

CONCLUSION

In light of the foregoing, it is requested that the final refusal to register the mark pursuant to Sections 1, 2, 3 & 45, of the Lanham Act all be affirmed and if not it is requested that the marks be found to be descriptive under Section 2(e)(1) of the Lanham Act and denied registration on the Principal Register under Section 2(f).

Respectfully submitted,

/Charles Hiser/

Examining Attorney

Law Office 130

(571) 272-7526

Charles.Hiser@uspto.gov

/John Lincoski/

Managing Attorney

Law Office 130

571-272-9436

John.Lincoski@uspto.gov