

ESTTA Tracking number: **ESTTA1011745**

Filing date: **10/28/2019**

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

Proceeding	87472741
Applicant	Blackhawk Network, Inc.
Applied for Mark	VELOCITY B2B
Correspondence Address	JORDAN S WEINSTEIN BARNES & THORNBURG LLP 1717 PENNSYLVANIA AVENUE NW, SUITE 500 WASHINGTON, DC 20006 UNITED STATES Jordan.Weinstein@btlaw.com, Debra.Bondurant@btlaw.com, gcharlton@btlaw.com, docketingtm-dc@btlaw.com, jweinstein@btlaw.com, dbondurant@btlaw.com 202-289-1313
Submission	Applicants Request for Remand and Amendment
Attachments	Blackhawk - VELOCITY B2B - Request to Remand.pdf(844316 bytes )
Filer's Name	Joshua S. Frick
Filer's email	Jordan.Weinstein@btlaw.com, Debra.Bondurant@btlaw.com, docketingtm-dc@btlaw.com, jweinstein@btlaw.com, dbondurant@btlaw.com, jfrick@btlaw.com
Signature	/Joshua S. Frick/
Date	10/28/2019

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

<b>In re the application of:</b>  <b>BLACKHAWK NETWORK, INC.</b>	<b>U.S. Serial No.: 87/472,741</b>  <b>Mark: VELOCITY B2B</b>  <b>Class: 35</b>
--	---

Honorable Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Commissioner:

**REQUEST TO REMAND THE SUBJECT APPLICATION**  
**TO THE EXAMINING ATTORNEY**

Pursuant to TBMP § 1209.04, Applicant hereby requests that Applicant’s application to register the VELOCITY B2B mark (Ser. No. 87/472,741) (the “Subject Application”) be remanded to the Examining Attorney for consideration of a consent agreement Applicant has entered into with the owner (the “Registrant”) of the registration the Examining Attorney cited against the Subject Application.

On September 6, 2018, Applicant filed a Notice of Appeal together with a Request for Reconsideration in response to a final refusal issued by the Examining Attorney on March 6, 2018, in connection with the above-captioned application. The Examining Attorney denied the Request for Reconsideration on September 27, 2018, and the Board issued an Order on October 2, 2018 setting a deadline of December 3, 2018 for Applicant to file its Appeal Brief. The Board granted Applicant’s Request for Extension of Time to March 1, 2019 to complete negotiations for a consent agreement with

Registrant. Applicant subsequently requested, and the Board granted, Applicant's request for further extensions of time to file an appeal brief to October 28, 2019.

Applicant and Registrant have now agreed upon the terms of and executed a consent agreement, whereby Registrant consents to Applicant's registration of the VELOCITY B2B mark. A copy of the Consent Agreement is attached hereto as Exhibit A. Applicant believes that remand of the Subject Application is appropriate so that the Examining Attorney may consider the refusal to register Applicant's VELOCITY B2B mark in light of Registrant's consent to register the mark.

As set forth in the Consent Agreement, Applicant and Registrant are aware of no incidents of confusion arising from the parties' simultaneous use of their marks in connection with their respective services, and believe that no confusion is likely in light of the differences between their respective services, channels of trade, and target consumers for their services (Applicant's services being rendered in connection with a business-to-business gift card management program; Registrant's services being rendered in connection with loyalty services).

Accordingly, as good cause has been shown pursuant to TBMP § 1209.04 for remanding the Subject Application, Applicant respectfully requests that the Board remand the Application to the Examining Attorney for the consideration of the consent agreement between Applicant and Registration.

Respectfully submitted,

**BLACKHAWK NETWORK, INC.**

Date: October 28, 2018

By: Joshua S. Frick/

Jordan S. Weinstein, Esquire

Joshua S. Frick, Esquire

Barnes & Thornburg, LLP

1717 Pennsylvania Avenue, N.W.

Suite 500

Washington, D.C. 20006

(202) 289-1313

(202) 289-1330 (fax)

Email: [docketingtm-dc@btlaw.com](mailto:docketingtm-dc@btlaw.com)

[jweinstein@btlaw.com](mailto:jweinstein@btlaw.com)

[dbondurant@btlaw.com](mailto:dbondurant@btlaw.com)

Counsel for Applicant

# **Exhibit A**

## IN THE UNITED STATES TRADEMARK OFFICE

In re: Blackhawk Network, Inc.  
Serial No. 87472741  
Mark: VELOCITY B2B

### CONSENT TO REGISTRATION AGREEMENT

This consent agreement is by and between Blackhawk Network, Inc., a corporation organized under the laws of Arizona, located at 6220 Stoneridge Mall Road, Pleasanton, California, 94558 ("Blackhawk Network"), and Velocity Frequent Flyer Pty Ltd ACN 601 408 824, a corporation organized under the laws of Australia, located at 56 Edmondstone Road, Bowen Hills, Qld Australia 4006 ("Velocity Frequent Flyer").

Velocity Frequent Flyer is the listed owner of United States Registration No. 3717282 (the "Velocity Frequent Flyer Registration") for the mark VELOCITY for use with:

Business management, organization, operation and supervision of loyalty programs and award programs; incentive award programs in connection with loyalty programs or incentive awards to promote the sale of products and services of others; providing incentive loyalty award programs for customers through the distribution of loyalty cards, stored value cards, loyalty awards points or mileage points for the purpose of promoting and rewarding loyalty; online retail store services featuring air fares, holiday packages, stationery, printed matters; issuing gift certificates as part of an incentive award customer loyalty program which may be redeemed for transportation, travel, food, beverage or accommodation services in International Class 35;

Issuing tokens of value in the nature of stored value voucher cards or mileage points relating to credit cards; issuing tokens of value in the nature of stored value voucher cards or mileage points in relation to customer loyalty programs and incentive award programs; providing electronic processing of stored value cards and other tokens of value, vouchers or points associated with electronic payment services; issuing of stored value cards, tokens of value, vouchers and points as part of an incentive award customer loyalty program which may be redeemed for transportation, travel, food, beverage or accommodation services in International Class 36; and

Travel arrangement services, namely, booking and reservation of travel services for transportation by air, road, or sea; travel services, namely, checking of baggage and passenger check-in services provided with a loyalty or incentive program; car hire services, namely, rental of cars in International Class 39;

(the "Velocity Frequent Flyer Services").

The United States Patent and Trademark Office ("USPTO") cited the Velocity Frequent Flyer Registration against Blackhawk Network's Application Serial No. 87472741 (the "Blackhawk Network Application") for the mark VELOCITY B2B for use with "business

management of gift card programs of others” in International Class 35 (the “Blackhawk Network Services”).

Velocity Frequent Flyer and Blackhawk Network (collectively, “the Parties”) are not aware of any confusion as to the source, sponsorship, or affiliation arising from the simultaneous use of Blackhawk Network’s use of VELOCITY B2B for the Blackhawk Network Services and Velocity Frequent Flyer’s use of VELOCITY for the Velocity Frequent Flyer Services.

Further, the Parties believe there is no likelihood of confusion in their simultaneous registration and use of their respective marks in light of the differences between their respective services, channels of trade and target consumers for their services. For example, Blackhawk Network offers the Blackhawk Network Services in connection with a business-to-business gift card management program. Velocity Frequent Flyer, on the other hand, offers loyalty services.

In addition, the Parties have been using their respective marks at the same time for nearly two years without receiving indications of any instances of confusion, though Blackhawk Network acknowledges Velocity Frequent Flyer’s rights in the mark are senior to those of Blackhawk Network in its mark.

Finally, in the event either of the parties becomes aware of any consumer confusion arising from the concurrent use of the respective marks, such party shall notify the other party, and the parties agree to cooperate to take appropriate actions to avoid such confusion in the future.

In light of the above, Velocity Frequent Flyer hereby consents to Blackhawk Network’s registration of the Blackhawk Network Application.

Accordingly, Blackhawk Network hereby requests that Application Serial No. 87472741 proceed to publication.

This agreement shall inure to the benefit of each party and its successors and assigns. The agreement may be freely assigned along with the rights to its respective marks and registrations by Velocity Frequent Flyer. It may be assigned by Blackhawk Network only (1) to parent, subsidiary, sister or related entities; or (2) with Velocity Frequent Flyer’s prior consent, which shall not be unreasonably withheld.

This agreement cannot be waived, varied, amended or supplemented except by an instrument in writing signed by both Parties.

This agreement may be executed in any number of counterparts each of which when executed will be an original and all the counterparts together will constitute one and the same instrument.

Blackhawk Network shall not challenge, contest, oppose, petition to cancel, interfere with, or take any other action against Velocity Frequent Flyer in connection with Velocity


Frequent Flyer's use, application for registration, or registration of any mark incorporating the term VELOCITY that does not (1) identify the Blackhawk Network Services other than distribution services for gift cards; and (2) include "B2B" or "Business to Business" as a part of the mark; and, if necessary, Blackhawk shall consent to the registration of same.

Velocity Frequent Flyer shall not challenge, contest, oppose, petition to cancel, interfere with, or take any other action against Blackhawk Network in connection with Blackhawk Network's use of VELOCITY B2B in connection with the Blackhawk Network Services in the United States.

Respectfully submitted,

**BLACKHAWK NETWORK, INC.**

Date: 10/4/19

By: 

Name: James S. McDonald  
Title: VP, Litigation & Chief IP Counsel

**VELOCITY FREQUENT FLYER PTY  
LTD ACN 601 408 824**

Date: \_\_\_\_\_

By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_



Frequent Flyer's use, application for registration, or registration of any mark incorporating the term VELOCITY that does not (1) identify the Blackhawk Network Services other than distribution services for gift cards; and (2) include "B2B" or "Business to Business" as a part of the mark; and, if necessary, Blackhawk shall consent to the registration of same.

Velocity Frequent Flyer shall not challenge, contest, oppose, petition to cancel, interfere with, or take any other action against Blackhawk Network in connection with Blackhawk Network's use of VELOCITY B2B in connection with the Blackhawk Network Services in the United States.

Respectfully submitted,

**BLACKHAWK NETWORK, INC.**

Date: \_\_\_\_\_

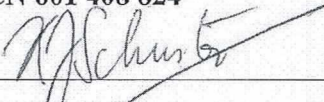
By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

**VELOCITY FREQUENT FLYER PTY  
LTD ACN 601 408 824**

Date: 24/10/19

By: 

Name: KARL SCHUSTER

Title: CEO VELOCITY FREQUENT FLYER