

ESTTA Tracking number: **ESTTA331861**

Filing date: **02/12/2010**

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

Proceeding	91192547
Party	Defendant Perkstreet Financial, Inc.
Correspondence Address	SUSAN M. MULHOLLAND GESMER UPDEGROVE LLP 40 BROAD ST BOSTON, MA 02109-4316 UNITED STATES trademarks@gesmer.com
Submission	Other Motions/Papers
Filer's Name	Susan M. Mulholland
Filer's e-mail	trademarks@gesmer.com
Signature	/sm mulholland/
Date	02/12/2010
Attachments	PERKSTREET - ANSWER.pdf ( 6 pages )(496830 bytes )

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

COUCH/BRAUNSDORF AFFINITY, INC.	)	
	)	
Opposer,	)	
	)	Serial No.: 77/673497, 77/673499
v.	)	Opposition No. 91/192547
	)	
PERKSTREET FINANCIAL, INC.	)	
	)	
	)	
Applicant.	)	

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS  
FOR CANCELLATION OF OPPOSER’S MARKS**

In response to the Notice of Opposition issued by the Board on November 4, 2009, Perkstreet Financial, Inc. (“Applicant”), through its counsel, hereby answers as follows the Opposition of Opposer, Couch/Braunsdorf Affinity, Inc. (“Opposer”).

Applicant responds as follows to the correspondingly numbered Paragraphs of Opposer’s Notice of Opposition:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (1) and therefore denies same.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (2) and therefore denies same.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (3) and therefore denies same.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (4) and therefore denies same.
5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (5) and therefore denies same.

6. Applicant admits that, according to the USPTO records, US Registration Nos. 1,786,961, 2,580,914, 3,210,654, and 3,156,685 appear on the Principal Register; otherwise Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (6) and therefore denies same.

7. Applicant admits that four Certificates of Registration were attached to the Notice of Opposition as Exhibit 1, two of which identify the Opposer as the registrant of record. To the extent the averments of Paragraph (7) are factual allegations, they are denied; to the extent they are Opposer's own legal conclusions, no responsive pleading is required.

8. Applicant notes that 15 U.S.C. § 1065 provides for incontestable status of federally registered trademarks only under certain conditions and that Paragraph (8) fails to identify any federal trademark registrations. Applicant therefore denies the averments in Paragraph (8).

9. Applicant admits that it applied to register the marks PERKSTREET and PERKSTREET FINANCIAL for use in connection with "promoting the goods and services of others by means of the issuance of loyalty rewards cards" and "checking account services; savings and loan services; credit and debit card services; providing cash and other rebates for credit card use as part of a customer loyalty program; mortgage brokerage; mortgage lending; providing financial information; providing a web site featuring personal financial information and financial advice." Otherwise, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph (9) and therefore denies same.

10. Admitted in part; denied in part.

11. Applicant admits that it had constructive knowledge of US Registration Nos. 1,786,961, 2,580,914, 3,210,654, and 3,156,685 at the time Applicant adopted and filed its applications for the marks PERKSTREET and PERKSTREET FINANCIAL.

12. Applicant denies the allegations set forth in Paragraph (12).

13. Applicant denies the allegations set forth in Paragraph (12).

## **AFFIRMATIVE DEFENSES**

Applicant asserts the following affirmative defenses:

### **FIRST AFFIRMATIVE DEFENSE**

14. Applicant states that there is not any likelihood of confusion under Lanham Act §2(d) with respect to its marks and services as set forth in the Applications and Opposer's marks and the services as set forth in Registration Nos. 1,786,961, 2,580,914, 3,210,654, and 3,156,685.

### **SECOND AFFIRMATIVE DEFENSE**

15. Applicant asserts that Opposer cannot establish similarity of the goods or services at issue.

## **COUNTERCLAIM – PETITION FOR CANCELLATION**

Applicant believes that it will be damaged by continued registration of Opposer's Registrations 1,786,961, 2,580,914, 3,210,654, and 3,156,685 for the respective services covered by those Registrations.

As grounds for its Petition to Cancel, Applicant alleges:

16. Opposer alleges ownership of US Registration Nos. 1,786,961, 2,580,914, 3,210,654, and 3,156,685 and has asserted those registrations against registration of Applicant's US Serial Nos. 77/673497 and 77/673499 for the marks PERKSTREET and PERKSTREET FINANCIAL.

### **Count I – The Asserted Marks are Generic**

17. The term "perk" has become known and used by retailers, the general public, and the media as a noun to define awards, benefits, incentives, or bonuses associated with engaging in certain activities. Consequently, "providing volume discounts for consumer products and services" would be perceived by the general public as providing "perks." This term is incapable of source identification with respect to the designated services and is therefore generic and free for all to use to promote their own goods and services related to awards, benefits, incentives, or

bonus programs. The word “perk” is therefore generic of a volume discount award given to consumers in exchange for buying certain products or services.

18. The term “perks cards” has become known and used by retailers, the general public, and the media as the common name for a card by which a consumer may obtain “perks” such awards, benefits, incentives, and bonuses. Consequently, “providing volume discounts for consumer products and services via a magnetically controlled card” would be perceived by the general public as providing “perks” by means of a card that entitles the user to such “perks.” This term is incapable of source identification with respect to the designated services is therefore generic and free for all to use to promote their own goods and services related to awards, benefits, incentives, or bonus programs. The term “perks card” is therefore generic of a volume discount award given to consumers in exchange for buying certain products or services.

**Count II – The Asserted Marks are Merely Descriptive**

20. A term is deemed to be merely descriptive of goods or services if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, or function of the goods or services. The term “perk” immediately conveys the quality, characteristic, feature, or functions of a volume discount award given to consumers in exchange for buying certain products or services and is therefore merely descriptive of those services.

21. The term “perks card” immediately conveys the quality, characteristic, feature, or function of the services, namely, a card by which a consumer may obtain “perks” such awards, benefits, incentives, and bonuses. Consequently, “providing volume discounts for consumer products and services via a magnetically controlled card” would be perceived by the general public as providing “perks” by means of a card that entitles the user to such “perks” and is therefore merely descriptive of those services.

**WHEREFORE**, Applicant/Counterclaim-Petitioner prays that Registration Nos. 1,786,961 and 2,580,914 be cancelled and removed from the Principal Register because the terms “perks” and “perks cards” have become the generic name for the services identified in the

Registrations and that Registration Nos. 3,210,654 and 3,156,685 be cancelled and removed from the Principal Register because the terms “perks” and “perks cards” have become the generic name for the services identified in the Registrations or, alternatively, are merely descriptive of such services.

The Director is hereby authorized to charge the filing fee for this Counterclaim to Deposit Account 122315.

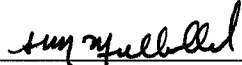
Respectfully Submitted,

PERKSTREET FINANCIAL, INC.

By its attorneys,

Gesmer Updegrave LLP

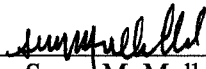
Dated: February 12, 2010

By:   
Susan M. Mulholland  
40 Broad Street  
Boston, MA 02109  
Tel: (617) 350-6800

CERTIFICATE OF ELECTRONIC TRANSMISSION

The undersigned hereby certifies that she this day electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <<http://estta.upsto.gov>> the foregoing *Answer of Applicant and Counterclaim for Cancellation of Opposer's Marks*.

Dated: February 12, 2010


By:   
Susan M. Mulholland  
Attorney for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that she this day, by first-class mail, postage prepaid, served the foregoing *Answer of Applicant and Counterclaims for Cancellation of Opposer's Marks* on Opposer's counsel of record:

Philip A. Jones  
BRINKS HOFER GILSON & LIONE  
445 N. Cityfront Plaza Drive  
Suite 3600  
Chicago, IL 60611-5599

Dated: February 12, 2010

By:   
Susan M. Mulholland  
Attorney for Applicant