UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79242950

MARK: CAS TOKEN

79242950

CORRESPONDENT ADDRESS:
PATENDIBÜROO TURVAJA OÜ
Liivalaia 22
EE-10118 Tallinn
ESTONIA

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APPLICANT: Cashaa Holding OÜ

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

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OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1428236

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. To do so, enter the U.S. application serial number for this application and then select "Documents."   The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. *See* 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:
- Section 2(d) Refusal – Likelihood of Confusion
- Disclaimer Required
- Explanation of Mark's Significance Required
- Legal Entity & Citizenship Required
- Identification of Goods & Services

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

5257638. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Applicant's mark is **CAS TOKEN** for "Software for accessing secure electronic platform for providing electronic commerce services and facilitating financial affairs, in particular trading and arranging of virtual and digital currency" in Class 9 and "Financial affairs, in particular trading and arranging of virtual and digital currency; monetary affairs; financial brokerage services" in Class 36.

Registrant's marks are both **TOKENCASH** for the following, respectively:

Class 9:   Software for use in transactions with retailers merchants and vendors via mobile devices used to process mobile payments; Computer programs and computer software for electronically trading securities; Computer software and firmware for operating system programs; Computer software and firmware for operating system programs; Computer software for communicating with users of hand-held computers; Computer software for creating searchable databases of information and data; Computer software for providing an on-line database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports; Computer software for use in customer relationship management (CRM); Computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface; Computer software, namely, electronic financial platform that accommodates multiple types of payment and debt transactions in an integrated mobile phone, PDA, and web based environment; Computer application software for mobile phones and computers, namely, software for mobile payments; Computer e-commerce software to allow users to perform electronic business transactions via a global computer network; Computer hardware and software system for tracking people, objects and pets using GPS data on a device on the tracked people, objects and pets; Computer operating software; Computer programs and computer software for electronically trading securities; Downloadable software in the nature of a mobile application for use in transactions with retailers merchants and vendors via mobile devices used to process secure mobile payments

Class 36:   Financial services, namely, debt settlement; Financial services, namely, electronic remote check deposit services; Financial services, namely, funding online cash accounts from prepaid cash cards, bank accounts and credit card accounts; Financial services, namely, providing a virtual currency for use by members of an on-line community via a global computer network; Financial services, namely, providing electronic transfer of a virtual currency for use by members of an on-line community via a global computer network; Financial services, namely, providing on-line stored value accounts in an electronic environment; Financial affairs and monetary affairs, namely, financial information, management and analysis services; Financial counseling services, namely, helping others build a better working relationship with their money; Financial custody services, namely, maintaining possession of financial assets for others for financial management purposes; Financial transaction services, namely, providing secure commercial transactions and payment options using a mobile device at a point of sale; Broker-dealer financial services in the field of electronic funds transfer; providing installment payment plans for the purpose of debt consolidation; provision of credit through installment loans, mobile payments and electronic payments; Providing electronic wallets for use in financial transactions; Prepaid services, namely, issuing prepaid credit and debit cards; electronic and non-electronic credit and debit card payment processing services; Electronic financial trading services; Online banking services accessible by means of downloadable mobile applications; Providing financial information services to users engaged in online electronic funds transfer via mobile phones, and websites; Providing an internet website portal in the field of financial transaction and payment processing services; Provision and financial administration of a debit card savings program.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.* , 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); *see In re Inn at St. John's, LLC* , 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.* , 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

<u>Comparison of the Marks</u>

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve*

Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC* , 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

In this case, applicant's mark is **CAS TOKEN** and registrant's marks are **TOKEN CASH**. These marks contain almost identical transposed terms.

Confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g.*, *In re Wine Soc'y of Am. Inc.* , 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design for wine club membership services including the supplying of printed materials likely to be confused with AMERICAN WINE SOCIETY 1967 and design for newsletters, bulletins, and journals); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil).

Therefore, the marks are confusingly similar.

Comparison of the Goods & Services

The compared goods and services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, both applicant and registrant provide financial and currency transaction software in Class 9, and both provide financial and monetary services, particularly in the field of currency, in Class 36, as listed in full in the section above.

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the application uses broad wording to describe its financial software and financial services, which presumably encompasses all goods and services of the type described, including registrant's more narrow financial transaction software, and financial services in a variety of areas, including in the field of fund transfers and transfer of virtual currency. *See, e.g*., *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods and services are legally identical. *See, e.g.*, *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v.Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods and services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant's and registrant's goods and services are related.

Considering all of the above, applicant's mark is refused registration due to a likelihood of confusion with registrant's mark under Section 2(d) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

DISCLAIMER REQUIRED

Applicant must provide a disclaimer of the unregistrable part of the applied-for mark even though the mark as a whole appears to be registrable. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). A disclaimer of an unregistrable part of a mark will not affect the mark's appearance. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 979-80, 144 USPQ 433, 433 (C.C.P.A. 1965).

In this case, applicant must disclaim the wording "TOKEN" because it is not inherently distinctive. This unregistrable term at best is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and services. *See* 15 U.S.C.

§§1213, 1213.03(a).

The attached evidence from the dictionary shows this wording is commonly used in connection with similar goods and services to mean an electronic device or piece of software that serves as proof of identity of a user, so as to access a network. *See* https://www.ahdictionary.com/word/search.html?q=token. Third parties frequently use this to describe a digital asset, or interchangeably with the term "cryptocurrency." *See* https://cryptocurrencyfacts.com/what-is-a-cryptocurrency-token/ (explaining the general definition of and different uses of the term "token" in the cryptocurrency industry). Thus, the wording merely describes applicant's goods and services because applicant's goods and services allow a user to gain access to a software platform for financial transactions, including those for trading and arranging digital and virtual currency.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use "TOKEN" apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this issue using the Trademark Electronic Application System (TEAS), see the Disclaimer webpage.

EXPLANATION OF MARK'S SIGNIFICANCE REQUIRED

To permit proper examination of the application, applicant must explain whether the letters in the mark "CAS" have any significance in the cryptocurrency trade or industry or as applied to applicant's goods and services, or if such letters represent a "term of art" within applicant's industry. *See* 37 C.F.R. §2.61(b); TMEP §814. Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814.

LEGAL ENTITY & CITIZENSHIP REQUIRED

Applicant must specify its form of business or type of legal entity and its national citizenship or foreign country of organization or incorporation. *See* 37 C.F.R. §§2.32(a)(3)(i)-(ii), 7.25(a)-(b); TMEP §§803.03, 803.04, 1904.02(a). This information is required in all U.S. trademark applications, including those filed under Trademark Act Section 66(a) (also known as "requests for extension of protection of international registrations to the United States"). *See* 37 C.F.R. §§2.32(a)(3)(i)-(ii), 7.25(a)-(b); TMEP §§803.03, 803.04, 1904.02(a).

Acceptable entity types include an individual, a partnership, a corporation, a joint venture, or the foreign equivalent. *See* 37 C.F.R. §2.32(a)(3)(i)-(ii); TMEP §§803.03 *et seq.*

If applicant's entity type is an individual, applicant must indicate his or her national citizenship for the record. *See* 37 C.F.R. §2.32(a)(3)(i); TMEP §803.04. If applicant's entity type is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must set forth the foreign country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §§803.03(b)-(c), 803.04. For an association, applicant must also specify whether the association is incorporated or unincorporated, unless the foreign country and the designation or description "association/associazione" appear in Appendix D of the *Trademark Manual of Examining Procedure* (TMEP). TMEP §803.03(c).

If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. *See* TMEP §803.04. To provide this information online via the Trademark Electronic Application System (TEAS) response form, applicant must (1) locate the "Entity Type" heading and select "Other;" (2) locate the "Specify Entity Type" heading and select "Other" under the Foreign Entity option, and enter in the free-text field below both applicant's entity type and the foreign province or geographical region of its organization (e.g., partnership of Victoria); and (3) locate the "State or Country Where Legally Organized" heading and select the appropriate foreign country (e.g., Australia) under the Non-U.S. Entity option. *See id.*

IDENTIFICATION OF GOODS & SERVICES

The identification of goods and services contains wording that is overly-broad and indefinite and must be amended. TMEP §1402.03(a); *see* 37 C.F.R. §2.32(a)(6). The specific issues are set forth below.

Class 9

The wording is overly-broad and indefinite, and must be amended. Specifically, applicant must clarify the nature and type of goods further, such as that the software is a downloadable or recorded computer software platform for electronic commerce services. The suggested amendments are emphasized below.

Class 36

The wording throughout the identification of services is indefinite, and must be amended. Specifically, applicant must further clarify the type, nature, and function of the services. For example, the wording "financial brokerage services" could be amended to "financial brokerage services for cryptocurrency trading" in order to further clarify the function of the brokerage services.   The suggested amendments are emphasized below.

The applicant may adopt the following, if accurate:

Class 9:　　　　*Computer s*oftware *platforms, [specify, e.g., recorded, downloadable],* ~~for accessing secure electronic platform~~ for providing electronic commerce services and facilitating financial affairs, in particular trading and arranging of virtual and digital currency

Class 36:　　　　Financial affairs, in particular *providing and facilitating* trading and arranging of virtual and digital currency *for use by members of an on-line community via a global computer network*; monetary affairs*, namely, [specify services, e.g., financial information, management and analysis services]*; financial brokerage services *for cryptocurrency trading*

Applicant may amend the identification to clarify or limit the goods and services, but not to broaden or expand the goods and services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and services may not later be reinserted. *See* TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual*. *See* TMEP §1402.04.

RESPONSE GUIDELINES

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant's rights, the trademark examining attorney can provide applicant with additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

For this application to proceed further, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see "Responding to Office Actions" and the informational video "Response to Office Action " for more information and tips on responding.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; *see* 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

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