

MARK: GUARANTEED BILL PAYMENTS

SERIAL NO.: 88367823

APPLICANT: Billgo, Inc.

IC: 36 - Merchant services, namely, payment transaction processing services; Electronic payment services involving electronic processing and subsequent transmission of bill payment data; Providing an internet website portal in the field of financial transaction and payment processing services; Providing electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check and electronic payments; Electronic payment services involving electronic processing and subsequent transmission of bill payment data; Providing API-based transfers, namely, electronic funds transfer; Application service provider featuring application programming interface (API) software for providing electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check, and electronic payments

In an Office Action dated June 6, 2019, (“Office Action”) the Examining Attorney refused registration under Section 2(e)(1), alleging is refused because the applied-for mark merely describes a feature of applicant’s services. Applicant submits that its mark GUARANTEED BILL PAYMENTS is not descriptive of a feature of

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(“the identified goods” or “Applicant’s goods”). A proper test for descriptiveness under §2(e)(1) is whether Applicant’s mark immediately conveys to consumers the nature of Applicant’s goods, or whether consumers must use “imagination, thought, and perception” to draw that conclusion. *Stix Products Inc. v. United Merchants and Manufacturers Inc.* 295 F. Supp. 479,488 (S.D.N.Y. 1968). To be characterized as “merely descriptive” a mark must

“immediately convey to one seeing or hearing it the thought of appellant’s goods/services.” *In re Bed and Breakfast Registry*, 791 F.2d 157,159 (Fed. Cir 1986).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely descriptive is to consider the term in relation to the goods for which registration is sought, the context in which the term is used or is intended to be used, and the possible significance that the term is likely to have on the average purchaser encountering the goods in the marketplace. See *In re Abcor Development Corp.*, 588 F.2d 811,200 USPQ 215 (CCPA 1978); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); and *In re Bright-Crest, Ltd*, 204 USPQ 591 (TTAB 1979).

Suggestive marks, on the other hand, are those that, when applied to the goods at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods. See *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the goods to be registrable. See TMEP§1209.01(a)



GUARANTEED BILL PAYMENTS IS A VALID, DISTINGUISHABLE TRADEMARK FOR PROVIDING ELECTRONIC PAYMENT SERVICES



The mark GUARANTEED BILL PAYMENTS is a distinguishable composite that identifies only Applicant's goods. The first component of Applicant's mark, "GUARANTEED," means "a promise or assurance." (See <https://www.dictionary.com/browse/guaranteed>, (last visited Dec. 12, 2019) a copy of which is attached hereto as **Exhibit A**). "GUARANTEED," is a broad, general term that would be perceived by consumers to mean a promise as related to bill payments. At best, it suggests that the services are backed up by a promise. The term GUARANTEED BILL PAYMENTS does not immediately conjure up electronic platforms to facilitate payments. Rather, to make such a stretch a consumer would require to exercise a considerable amount of imagination. Broad, general terms that require the consumer to exercise imagination have been found to be registerable. *In re Hutchinson Technology, Inc.*, 852 F.2d 552,554 (Fed. Cir. 1988), held that "technology" was not directly descriptive when used as a mark for electronic and mechanical computer components because it was a broad, general term which included many categories of goods and was too vague to convey an immediate idea of the nature of the particular goods.


Contrary to the Trademark Office's position, the direct meaning of the mark is an "assured bill payment," not "financial services and the provision of software related to merchant services in the nature of payment processing, transmission of bill payment data, as well as other related services, which are offered with the promise or protection of a guarantee by applicant." The Trademark Office has provided no evidence establishing that "guaranteed" "bill," or payments has anything to do with electronic facilitation of bill payments. Applicant's mark is suggestive - the mark is intended to connote an impression that the services are backed by an

assurance. But to get to the underlying service (e.g., an electronic platform), a consumer would require more information. That is, the Trademark Office has not provided any evidence showing that the mark literally means electronic services related to bill payments.

Further, the term “GUARENTEE,” and similar variants, is commonly registered in connection with class 36 without any disclaimer required, as shown in the example registrations below:

Mark/Name	Status/Status Date	Full Goods/Services	Owner Information	App. No./Reg. No.
A GUARANTEE OF SERVICES YOU CAN TAKE TO THE BANK	Registered June 17, 2014	(Int'l Class: 36) an underwriting service program in the nature of underwriting warranty programs in the fields of electrical, heating, ventilation, air conditioning and plumbing; a program to underwrite customer satisfaction programs, namely, underwriting warranty programs in the fields of electrical, heating, ventilation, air conditioning and plumbing	Clockwork Ip, LLC (Delaware Limited Liability Company) 12 Greenway Plaza Suite 250 Houston Texas 77046	RN: 4552649 SN: 85843662
BEST RATE MORTGAGE GUARANTEE	Renewed Supplemental Register April 8, 2013	(Int'l Class: 36) financial services; namely, mortgage loan financing services	Midfirst Bank (Oklahoma Corp.) 501 Northwest Grand Boulevard Oklahoma City Oklahoma 73118	RN: 2705588 SN: 76427050
FG GUARANTEE-PLATINUM	Registered 8 & 15 December 24, 2016	(Int'l Class: 36) annuity underwriting; life insurance underwriting	Fidelity & Guaranty Life Insurance Company (Maryland Corp.) 1001 Fleet Street Baltimore Maryland 21202	RN: 4032826 SN: 85239113
FIDELITY & GUARANTY	Registered March 19, 2019	(Int'l Class: 36) Insurance services, namely, underwriting, issuance and administration of life; Life insurance underwriting; Underwriting, issuance and administration of annuities	Fidelity & Guaranty Life Insurance Company (Maryland Corp.) 601 Locust Street, Two Ruan Center Des Moines Iowa 50309	RN: 5704106 SN: 87531255
FIDELITY & GUARANTY and Design 	Registered September 25, 2018	(Int'l Class: 36) Insurance services, namely, underwriting, issuance and administration of life insurance; Life insurance underwriting; Underwriting, issuance and administration of annuities	Fidelity & Guaranty Life Insurance Company (Maryland Corp.) 601 Locust Street Two Ruan Center Des Moines Iowa 50309	RN: 5572150 SN: 87715221
FIDELITY & GUARANTY LIFE and Design 	Registered 8 & 15 April 10, 2017	(Int'l Class: 36) insurance services, namely, underwriting, issuance and administration of life; life insurance underwriting; underwriting, issuance and administration of annuities	Fidelity & Guaranty Life Insurance Company (Maryland Corp.) 1001 Fleet Street Baltimore Maryland 21202	RN: 4095748 SN: 85316848
FIDELITY & GUARANTY LIFE	Registered 8 & 15 April 10, 2017	(Int'l Class: 36) insurance services, namely, underwriting, issuance and administration of life; life insurance underwriting; underwriting, issuance and administration of annuities	Fidelity & Guaranty Life Insurance Company (Maryland Corp.) 1001 Fleet Street	RN: 4095749 SN: 85316853

Mark/Name	Status/Status Date	Full Goods/Services	Owner Information	App. No./Reg. No.
			Baltimore Maryland 21202	
GINNIE MAE OUR GUARANTY MATTERS and Design 	Registered December 17, 2013	(Int'l Class: 36)financial services in the nature of guaranteeing the timely payment of the principal of, and the interest on, certificates of securities that are based on and backed by a pool of government insured mortgage loans	Government National Mortgage Association (United States Corp.)451 7th Street, S.W. Washington District of Columbia 20410	RN: 4449370 SN: 76714028
GROW, GUARANTEE, GIVE	Registered 8 & 15 July 24, 2017	(Int'l Class: 36) financial services, namely, investment management of and distribution of annuities	Ameriprise Financial, Inc. (Delaware Corp.) 5226 Ameriprise Financial Center Minneapolis Minnesota 55474	RN: 3982635 SN: 85063922
GUARANTEE ADVANTAGE UL	Renewed October 11, 2015	(Int'l Class: 36) underwriting and administration of life insurance services, namely the offering of individual universal life insurance products	Metropolitan Life Insurance Company (New York Corp.) 1095 Avenue of the Americas New York New York 10036	RN: 3005889 SN: 78470383
GUARANTEE INSURANCE COMPANY and Design 	Registered June 23, 2015	(Int'l Class: 36) insurance services, namely, insurance agency services, insurance underwriting in the field of workers compensation, insurance brokerage, and insurance consultation services	Guarantee Insurance Group, Inc. (Delaware Corp.) 401 East Las Olas Boulevard, Suite 1540 Ft. Lauderdale Florida 33301	RN: 4761648 SN: 86274398
GUARANTEE OF CONDITION EQUALS GUARANTEE OF VALUE	Registered February 16, 2016	(Int'l Class: 35)advertising, marketing and promotion services in the field of automotive service contracts, extended warranties, and maintenance plans for exterior and interior automotive and marine appearance and repair, including, paintless dent repair, windshield repair and replacement, interior surfaces repair and replacement, exterior surfaces repair and replacement, cosmetic wheel repair and replacement, odor neutralizing and elimination, applying paint, fabric, leather and vinyl sealants, anti-microbial agents(Int'l Class: 36)providing automotive service contracts, extended warranties, and providing pre-paid maintenance plans for motor vehicles and boats for exterior and interior automotive and marine appearance and repair, including, paintless dent repair, windshield repair and replacement, interior surfaces repair and replacement, exterior surfaces repair and replacement, cosmetic wheel repair and replacement, odor neutralizing and elimination, applying paint, fabric, leather and vinyl sealants, anti-microbial agents(Int'l Class: 41)educational instruction and training services for salespeople in the field of automotive service contracts, extended warranties, and maintenance plans for exterior and interior automotive and marine appearance and repair, including, paintless dent repair, windshield repair and replacement, interior surfaces repair and replacement, exterior surfaces repair and replacement, cosmetic wheel repair and replacement, odor neutralizing and elimination, applying paint, fabric, leather and vinyl sealants, anti-microbial agents	Deschepper, Ben (United States Citizen)8604 S. Regent Park Drive Sioux Falls South Dakota 57108	RN: 4900697 SN: 86623496
GUARANTEES MATTER	Renewed March 18, 2018	(Int'l Class: 36) providing a website featuring information on financial services, retirement, insurance, investments and life planning	New York Life Insurance Company (New York Corp.) 51 Madison Avenue New York New York 10010	RN: 3399938 SN: 78860276

Mark/Name	Status/Status Date	Full Goods/Services	Owner Information	App. No./Reg. No.
GUARANTY	Renewed August 20, 2011	(Int'l Class: 36) banking services	Guaranty Bank & Trust, N.A. (United States National Banking Association) 100 W. Arkansas Mount Pleasant Texas 75455	RN: 1654486 SN: 73833055
GUARANTY BANK	Registered 8 Accepted February 6, 2017	(Int'l Class: 36)savings bank services, namely, banking services offered to small businesses in the nature of checking and savings accounts, certificates of deposit, business credit cards, trust services in the nature of investment and trust company services, commercial lending services, namely, merchant payment process services, and issuing payroll service loans; savings bank services offered to consumers, namely, deposit services, providing trustee services and fiduciary representative services, unsecured lending and credit card services; safety deposit box services; auto loan financing; mortgage lending; services related to auto loan financing and mortgage lending, namely, issuing title insurance, appraisal, credit reporting, escrow services, and construction loan disbursement; excluding secondary mortgage banking services, namely, buying, servicing and trading mortgage loans and interests in such loans among third party originators and purchasers, and originating mortgage loans with the assistance of third party brokers wherein such brokers work directly with retail consumers	Guaranty Bank & Trust, N.A. (United States National Banking Association)100 W. Arkansas Mount Pleasant Texas 75455	RN: 3991394 SN: 76170497
GUARANTY PAY	Registered August 20, 2019	(Int'l Class: 36) On-line banking services	Guaranty Bank & Trust, N.A. (United States National Banking Association) 100 W. Arkansas Mount Pleasant Texas 75455	RN: 5838392 SN: 88233687
GUARANTY PAYCHEK	Renewed July 21, 2008	(Int'l Class: 36) banking services	First Citizens Bancshares, Inc. (Delaware Corp.) 4300 Six Forks Road Raleigh North Carolina 27609-5718	RN: 2175347 SN: 75049015
KEYS ON TIME GUARANTEE and Design 	Registered 8 & 15 May 6, 2019	(Int'l Class: 36) mortgage banking; mortgage lending	American Pacific Mortgage Corporation (California Corp.) 3000 Lava Ridge Ct., Suite 200 Roseville California 95661	RN: 4494950 SN: 86039516
LIVE IT. LOVE IT. GUARANTEE	Registered December 9, 2014	(Int'l Class: 36) commercial and residential real estate services, namely, leasing, apartment management, and rental property management	Venterra Realty Management Company Inc. (Nevada Corp.) 38 Leek Crescent, Suite 202 Richmond Hill, Ontario L4b4n8 Canada	RN: 4652699 SN: 86268653
NATIONAL PUBLIC FINANCE GUARANTEE CORPORATION	Registered Supplemental Register 8 Accepted February 1, 2016	(Int'l Class: 36)financial guarantee insurance and reinsurance services, namely, underwriting analysis, risk management, agency, consulting, administration, brokerage, pricing, monitoring, remediation, claims processing, and loss control services in connection with public finance transactions, namely, municipal bonds, government bonds and government project finance transactions, and related financial derivatives; insurance consultation and related financial advisory services; surety services; credit enhancement	National Public Finance Guarantee Corporation (New York Corp.)113 King Street Armonk New York 10504	RN: 3735454 SN: 77669982

Mark/Name	Status/Status Date	Full Goods/Services	Owner Information	App. No./Reg. No.
		services with respect to bonds, notes or other forms of indebtedness		
NO JUNK FEE GUARANTEE	Registered Supplemental Register October 1, 2019	(Int'l Class: 36) Real estate title insurance agency services	Florida's Title Insurance Company (Florida Corp.) 1720 Harrison Street, Ph B Hollywood Florida 33020	RN: 5876088 SN: 88330310
POWER EFFICIENCY GUARANTEE	Registered Supplemental Register November 1, 2016	(Int'l Class: 36) financial services in the field of electricity consumption management	Engie Storage Services Na LLC (Delaware Limited Liability Company) 4151 Burton Drive Santa Clara California 95054	RN: 5075361 SN: 86819860
RENT GUARANTEE	Registered Supplemental Register September 10, 2019	(Int'l Class: 36) Providing information in the field of real estate; Providing real estate listings and real estate information via the Internet; Rent payment services	Liberty Rent Guarantee, LLC (Alabama Limited Liability Company) Po Box 561 Fairhope Alabama 36533	RN: 5859060 SN: 87952801
UNITED GUARANTY'S MI GUIDE	Renewed April 16, 2012	(Int'l Class: 36) providing mortgage insurance product information via the internet	Arch Capital Group (U.S.) Inc. (Delaware Corp.) One Liberty Plaza, 53rd Floor New York New York 10006	RN: 2561708 SN: 76259529
WE MANAGE YOUR GUARANTEE!	Registered October 3, 2017	(Int'l Class: 36) aggregators and servicing management for issuers of certificates of securities that are based on and backed by a pool of government issued mortgage loans, namely, bundling and financial management of certificates of securities that are based on and backed by a pool of government issued mortgage loans	Us Trading LLC (New Jersey Limited Liability Company) 20 Pendleton Ct Medford New Jersey 08055	RN: 5302524 SN: 87024485

(TESS Printouts for the above referenced trademark registrations are attached as **Exhibit B.**)

These marks were also registered on the Principal Register without any Section 2(f) claim, which demonstrates that the marks are inherently distinctive.

As the third-party registrations referenced above for GUARENTEE marks (and variants), Applicant's GUARTENTEE BILL PAYMENTS mark creates a distinctive composite mark that casts a commercial impression as a source identifier for Applicant's services rather than describes a quality, function, purpose, use or ingredient of Applicant's services. For the foregoing reasons, Applicant's mark is not descriptive nor generic. Instead, imagination is required to relate the term "GUARTENTEE" to an electronic platform.

Furthermore, the Trademark Trial and Appeal Board has held that any doubt as to the alleged descriptiveness of a mark must be resolved in the Applicant's favor so that the mark can be published for potential opposition. *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983). Therefore, any doubt as to the reliance on the above-mentioned arguments and evidence should be resolved in favor of the Applicant.

Based on the foregoing, Applicant submits that its Mark is a valid, distinguishable mark that should be promptly approved for publication on the Principal Register.