

ESTTA Tracking number: **ESTTA668936**

Filing date: **04/27/2015**

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

Proceeding	86190311
Applicant	Ledwick Enterprises, LLC
Applied for Mark	CREATIVE GIG
Correspondence Address	Matthew H. Swyers The Trademark Company 344 Maple Ave. W., PMB 151 Vienna, VA 22180 UNITED STATES admin@thetrademarkcompany.com
Submission	Appeal Brief
Attachments	BRIEF OF THE APPLICANTcreativegig.pdf(276868 bytes) creativegigExhibit1.pdf(156641 bytes) creativegigExhibit2.pdf(793530 bytes) creativegigExhibit3.pdf(152514 bytes) creativegigExhibit4.pdf(218917 bytes)
Filer's Name	Matthew H. Swyers
Filer's e-mail	mswyers@thetrademarkcompany.com
Signature	/Matthew H. Swyers/
Date	04/27/2015

TABLE OF CONTENTS

	Page No.s
Table of Authorities.....	3
Introduction.....	5
Statement of the Case.....	4
I. No likelihood of Consumer Confusion	
a. Standard For a Determination of Likelihood Of Confusion.....	6
b. Dissimilarities Between the Respective Marks.....	8
c. Dissimilarities Between the Marks’ Respective Services.....	10
d. Dissimilarities Between the Trade and Marketing Channels for the Marks.....	11
e. Dissimilarities in Buyers to Whom Sales Are Made.....	12
II. Mark is Suggestive Rather than “Merely Descriptive”	
a. Standard for “Merely Descriptive” Refusal.....	13
b. Degree of Imagination	19
c. Competitors need and current use.....	21
III. Conclusion.....	21

TABLE OF AUTHORITIES

CASES:

<i>Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank</i> , 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987)	7
<i>Equine Technologies Inc. v. Equitechnology Inc.</i> 68 F.3d 542 (1st Cir. 1995).....	16
<i>Ex Parte Club Aluminum Products Co.</i> 105 USPQ 44 (Commissioner 1955).....	17
<i>First Savings Bank F.S.B. v. First Bank System Inc.</i> , 101 F.3d at 645, 40 USPQ2d 1865, 1870 (10th Cir. 1996)	6
<i>General Mills, Inc. v. Kellogg Co.</i> , 824 F.2d 622, 3 USPQ2d 1442 (8th Cir. 1987).....	9
<i>Hewlett-Packard Co. v. Packard Press Inc.</i> , 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).....	7
<i>In re Abcor Development Corp.</i> , 588 F.2d 811, 813, 200 USPQ 215, 217(CCPA 1978).....	14
<i>In re Bed & Breakfast Registry</i> , 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986).....	13
<i>In re Bright-Crest, Ltd.</i> , 204 USPQ 591 (TTAB 1979).....	14
<i>In re Decombe</i> , 9 USPQ2d 1812 (TTAB 1988).....	8
<i>In re Dixie Restaurants Inc.</i> , 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).....	6
<i>In re E.I. du Pont DeNemours & Co.</i> , 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).....	6
<i>In re Gyulay</i> , 820 F.2d 1216, 3 USPQ2d 1009(Fed.Cir.1987).....	13
<i>In re Jump Designs, LLC</i> , 80 USPQ2d 1370, 1374 (TTAB 2006)	11
<i>In re MetPath Inc.</i> , 223 USPQ 88 (TTAB 1984).....	14
<i>In re Quik-Print Copy Shops Inc.</i> ,616 F.2d 523, 205 U.S.P.Q. 505, 507 (CCPA 1980).....	14
<i>In re Ralston Purina Company</i> , 191 U.S.P.Q. 237, 238 (TTAB 1976).....	15
<i>In re Shell Oil Co.</i> , 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).....	7
<i>In re Tennis in the Round, Inc.</i> 199 U.S.P.Q. 496, 498 (TTAB 1978).....	16
<i>In re Pellerin Milnor Corp.</i> , 221 USPQ 558 (TTAB 1983).....	8
<i>Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.</i> 205 F.2d 921, 925 (1953).....	17
<i>J & J Snack Foods Corp. v. McDonald’s Corp.</i> , 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991)....	7
<i>Local Trademarks, Inc. v. Handy Boys Inc.</i> , 16 USPQ2d 1156 (TTAB 1990).....	8

<i>Luigino's Inc. v. Stouffer Corp.</i> , 50 USPQ2d 1047.....	7
<i>Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.</i> , 875 F.2d 1026, 10 USPQ2d 1961 (2d Cir. 1989)....	7
<i>The Money Store v. Harris Corp. Finance, Inc.</i> 216 U.S.P.Q. 11, 18 (Cir. 1982).....	15
<i>Octocom Systems Inc. v. Houston Computer Services Inc.</i> , 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990)....	7
<i>Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> , 396 F.3d 1369, USPQ2d 1689 (Fed. Cir. 2005).....	9
<i>Paula Payne Products Co. v. Johnson Publishing Co.</i> , 473 F.2d 901, 177 USPQ 76 (CCPA1973).....	8
<i>Quartz Radiation Corp. v. Comm/Scope Co.</i> , 1 USPQ2d 1668 (TTAB 1986).....	8
<i>Shen Manufacturing Co. v. Ritz Hotel Ltd.</i> , 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004).....	8
<i>Universal Money Centers, Inc. v. American Tel. & Tel. Co.</i> , 22 F.3d 1527, (30 USPQ2d 1930 (10th Cir. 1994).....	7
<i>Worthington Foods, Inc. v. Kellogg Co.</i> 732 F. Supp. 1417, 1435 (S.D. Ohio 1990).....	17
OTHER AUTHORITIES:	
TMEP § 1207.01(a)(i).....	8
TMEP § 1207.01(a)(iii).....	8
TMEP § 1207.01(d)(vii).....	8
TMEP § 1209.01(b).....	13
15 USC 1052(e)(1).....	13

INTRODUCTION

COMES NOW the Applicant, Ledwick Enterprises, LLC (hereinafter "Applicant"), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant's argument that its mark should be registered.

STATEMENT OF THE CASE

The original application for the mark CREATIVE GIG was filed by the Applicant on February 11, 2014, in connection with services identified as "operating on-line marketplace for hiring creative professionals in a contract basis" in International Class 035, and received Serial Number 86190311.

On May 21, 2014, the Examining Attorney issued an office action, identifying three issues as the bases for refusing the application: first, under section 2(d) of the Trademark Act, that there was a likelihood of consumer confusion between the proposed mark and previously registered marks GIG (Registration Number 4220143) and GIGS (Registration Number 4270491); second, that the proposed mark was merely descriptive of the Applicant's services; and third, that exclusive use of the term GIG was not disclaimed in the application. November 6, 2014, Applicant, by counsel, filed a response to the May 21, 2014 office action, including an amendment of the application to disclaim the exclusive right to use the term "GIG".

On November 24, 2014, the Examining Attorney made final the refusals under sections 2(d) and 2(e)(1). The instant appeal now timely follows.

ARGUMENT

I. No likelihood of Consumer Confusion

The Examining Attorney refused registration of the mark on the basis that, if registered, the Applicant's mark would create a likelihood of confusion with two standard character marks, GIG (Registration Number 4220143) and GIGS (Registration Number 4270491).

Applicant respectfully disagrees with the Examining Attorney's decision as more fully set forth below.

A. The Standard for a Determination of a Likelihood of Confusion

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing;
- (5) the number and nature of similar marks in use on similar services; and
- (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

Id.

The Examining Attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the

examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston ComputergoodsInc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). *See generally* TMEP § 1207.01(a)(iii).

If the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are similar confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is respectfully submitted that confusion is not likely to exist should Applicant's service mark be permitted to register despite the existence of the cited registration.

B. Dissimilarity Between the Respective Marks

The Examining Attorney refused registration of the Applicant's proposed mark CREATIVE GIG on the basis that, if registered, the Applicant's mark would create a likelihood

of confusion with two standard character marks, GIG (Registration Number 4220143) and GIGS (Registration Number 4270491) (hereinafter, Registrant's marks).

Without disputing that the Applicant's mark and the Registrant's marks contain the common literal element GIG, the Applicant respectfully points out that the use of identical words or terms does not automatically mean that the marks are similar. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 USPQ2d 1442 (8th Cir. 1987). The Examining Attorney must evaluate the mark's appearance as a whole rather than only analyzing a single literal element when determining whether the marks are similar in appearance.

With respect to the overall appearance of the Registrant's marks and the Applicant's mark, it is likely that a consumer encountering the mark would view the term GIG or GIGS as distinct from the proposed mark of CREATIVE GIG. The inclusion of the additional word CREATIVE is the feature which is likely to be seen as dominant by the average consumer. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). As such, the consumer would be likely to view the Registrant's marks and the Applicant's marks as distinct from a visual perspective, based on the difference in the first words.

Moreover, even if the common literal element of the Registrant's marks and the Applicant's mark were a sufficient basis for a finding that the marks are similar in appearance, similarity in appearance is only one of the six du Pont factors, and therefore not conclusive with regard to the ultimate issue of potential consumer confusion.

Specifically, the marks have distinct characteristics from an auditory perspective, since the inclusion of the word CREATIVE lends the proposed mark an additional three syllables when compared to either of the Registrant's marks.

The commercial impressions of the Registrant's marks are distinct from that of the proposed marks as well. The marks GIG and GIGS have multiple potential meanings, and the average consumer could interpret the mark as a reference to a wide range of things, as demonstrated by the disambiguation page from Wikipedia excerpted here as Exhibit 1. *See* Exhibit 1.

To explore the potential meanings of the word briefly, GIG may be short for gigabyte, may refer to a thing that twirls (as a whirly-gig), a knife used by professional wrestlers to cut themselves, or as a term used by musicians to mean a musical engagement, performance, or set. Excerpts from online dictionaries and an online etymology website are attached here as Exhibits 2-4. *See* Exhibits 2-4.

The word GIG by itself is open to all of the above interpretations, and more. Being monosyllabic, the commercial impression created by the word GIG is tough, sharply defined by the use of the two hard "g"s, and severe. The proposed mark, CREATIVE GIG adds an additional element which consumers associate with artistry, imagination, non-traditional thinking, and a lighthearted attitude.

C. Dissimilarity Between the Marks' Respective Services

As pointed out by the Examining Attorney, the question of likelihood of confusion is determined 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. However, evaluating extrinsic evidence of actual use is necessary in this case for the purpose of clarifying where the points of similarity or difference between the Registrant's services and those of the Applicant. As the Examining Attorney noted in the office action of November 24, 2014, the Registration for the blocking marks has "no restrictions as to nature, type, channels of trade, or classes of purchaser"

and thus is interpreted to encompass “all services of the type described”. The registration itself identifies the services it provides as “operating on-line marketplaces for sellers of goods and/or services.” Even without examining any extrinsic evidence, the points of divergence between this description and the services offered by the applicant are apparent.

Without any additional information, the case cited by the Examining Attorney, *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)(citing *In Re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)) offers guidance, indicating that channels of trade should be presumed to be the normal channels of trade for such products. As such, the sellers of goods and/or services should be interpreted to be the general public. “Goods and /or services” is a broad enough term to encompass a great many categories, such as cars, used furniture, childcare, apparel, psychics, and bicycle repair. It is so broad, in fact, that it can only accurately be interpreted to refer to “goods and/or services of general interest to the average person without restrictions as to content”.

In contrast, this is not the type of online marketplace which would offer specialized information and networking for creative professionals seeking to be hired on a contract basis, as is that of the Applicant. The Applicant’s specialized service is specifically not targeted to the general public, but rather to professionals in a variety of creative fields who have been successful enough in their careers to have established themselves as freelancers.

It is respectfully submitted that there is little, if any, relation between the services of the Applicant and the services found in the cited mark and, as such, this *du Pont* factor favors a finding of an absence of a likelihood of confusion.

D. Dissimilarities Between the Trade and Marketing Channels for the Marks

If the services in question are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are similar, confusion is not likely. Applicant's specialized marketplace for creative professionals is not likely to be confused with a website offering general "goods and services". Also, the description of the Registrant's services as "operating an online marketplace for the sellers of goods and services" indicates that the target audience for the Registrant's website would be potential purchasers of general goods or services.

In contrast, the Applicant's description of services offered is targeted at allowing creative professionals to advertise their skills via the online marketplace to individuals or business with specific needs relating to visual art, design, the performing arts, and a range of other specialized skill sets.

As such, it is respectfully submitted that Applicant's services travel in a channel of trade wholly diverse from those which would be expected for the services of the cited mark. Moreover, the Applicant's channel of trade and marketing for its services are completely distinct from the services of the cited mark, it is submitted that the Applicant's services would not be encountered by the same persons in situations that would create the incorrect assumption that such services originate from the same source and, accordingly, this *du Pont* factor also favors registration of the Applicant's mark.

E. Dissimilarities in Buyers to Whom Sales are Made

Individuals seeking to purchase goods or services online are likely to be highly sophisticated consumers, and to the extent that they are sophisticated in the level of research and thought involved prior to making a purchasing decision, they are likely to be seeking lower prices than

are available in traditional stores or from traditional retailers. In contrast, the individuals and business who would be viewing the Applicant's website in order to hire a creative professional for a specific job, while also sophisticated, are likely to have larger budgets and be willing to invest large amounts of money in order to obtain a high quality product. While a buyer's sophistication is not conclusive that there will be no consumer confusion, evidence of thoughtful consideration of various factors prior to making a purchasing decision tends to minimize the likelihood that confusion will occur.

As such, it is submitted that this *du Pont* factor also favors registration of the Applicant's mark.

II. The Mark is Suggestive rather than "Merely Descriptive"

The Examining Attorney refused registration based upon a finding that the mark is merely descriptive of the Applicant's services. Insofar as Applicant's proposed mark is not merely descriptive of the services identified in the application, Applicant respectfully submits that there is no basis to maintain the instant refusal and that registration of the Applicant's mark is appropriate.

A. The Standard for a "Merely Descriptive" Refusal

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. TMEP § 1209. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (CCPA 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP § 1209.01(b)(*emphasis added*). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *Id. See also In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173,

71 USPQ2d1370, 1371 (Fed. Cir. 2004) ("A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services," citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010.

To be characterized as “descriptive,” a mark must immediately convey knowledge of the ingredients, qualities or characteristics of the goods or services. *In re Quik-Print Copy Shops Inc.*, 616 F.2d 523, 205 U.S.P.Q. 505, 507 (CCPA 1980) (emphasis added). In the context of the Lanham Act, “merely” descriptive means “only” descriptive. *Id.* at n. 7. Moreover, the mark must give some reasonably accurate or tolerably distinct knowledge of the essence of the service. If the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. See J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11:19 (Ed. 2000); *The Money Store v. Harris Corp. Finance, Inc.* 216 USPQ11, 18 (Cir. 1982) (“‘THE MONEY STORE’ conveys the idea of a commercial establishment whose service involves supplying money. The term does not, however, necessarily convey ‘the essence of the business, money lending.... Some imagination and perception are therefore required to identify the precise nature of the services’”); *In re Ralston Purina Company*, 191 USPQ 237, 238 (TTAB. 1976) (The term SUPER is not used to describe any real or specific item or characteristic or quality, but merely to connote a vague desirable characteristic or quality and therefore it need not be disclaimed from RALSTON SUPER SLUSH).

In determining whether a particular mark is merely descriptive of a product, a reviewing court must consider the mark in its entirety, with a view toward “what the purchasing public would think when confronted with the mark as a whole.” *In re Hutchinson Technology Inc.* 852

F,2d 552, 552-54 (Fed. Cir. 1988). To the extent that there may be doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, it is commonly accepted practice to resolve any doubt in the applicant's favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

Applicant respectfully submits that the instant mark is suggestive of the Applicant's services and not merely descriptive as contended by the examining attorney.

If a consumer has to exercise "mature thought or follow a multi-stage reasoning process" to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *In re Tennis in the Round, Inc.* 199 USPQ 496, 498 (TTAB 1978) ("This association of applicant's mark with the phrase 'theater-in-the-round' creates an incongruity...", thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.). *See also, Blisscraft of Hollywood v. United Plastics Co.* 294 F.2d. 694, 131 USPQ 55 (2d. Cir. 1961) (POLY PITCHER not merely descriptive of polyethylene pitchers; suggestive of Molly Pitcher of Revolutionary time); *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products; suggestive of nursery rhyme); *Douglas Laboratories Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), *cert. denied* 347 U.S. 968, 101 USPQ 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 U.S.P.Q. 610 (CCPA 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and, *Colgate-Palmolive Co. v. House for Men, Inc.* 143 USPQ 159 (TTAB 1964) (finding RAPID-SHAVE for shaving cream suggestive, not descriptive).

In *Equine Technologies Inc. v. Equitechnology Inc.* 68 F.3d 542 (1st Cir. 1995), the court was required to determine whether the mark EQUINE TECHNOLOGIES was descriptive or suggestive when used in connection with high-tech hoof pads for horses. The court cited authorities indicating that the hallmark of the descriptive term is a specific identification of the marked good. *Id.* at 544. In holding the mark EQUINE TECHNOLOGIES suggestive rather than descriptive, the court noted that while there is no dispute that the term “equine” is descriptive of horses, the question is whether the mark, in its entirety, is merely descriptive of the plaintiff’s product — hoof pads for horses. *Id.* at 545. In this case, the court found that the mark itself does not convey information about the plaintiff’s products or its intended consumers. Rather, it requires imagination to connect the term “Equine Technologies” to hoof care products in general, and to the plaintiff’s product in particular.

In *Ex Parte Club Aluminum Products Co.* 105 USPQ 44 (Commissioner 1955), the mark COOK-N-LOOK was held registerable for transparent glass covers for cooking utensils. The mark was somewhat suggestive of a property the goods might have, but like Applicant’s mark, did not describe the goods per se:

The mark is a compound word mark which describes what one who uses the covers can do, i.e. look into the utensil to see the cooking process, but this does not make the mark descriptive of the covers. The necessity for analysis removes it from the category of mere descriptiveness.

Id.

In *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.* 205 F.2d 921, 925 (Cir. 1953), *cert. denied* 346 U.S. 491 (1953), the court held that STRONGHOLD as applied to ribbed nails was not descriptive, and stated that:

Although the word ‘stronghold’ is suggestive of one of the attributes of plaintiff’s nail with the annular thread, it is not descriptive of a nail, let alone that type of nail. A person unaware of the particular product of the manufacturer, upon seeing

or hearing the name ‘stronghold’ would find it virtually impossible to identify the product to which it might have been applied.

Id.

In *Worthington Foods, Inc. v. Kellogg Co.* 732 F. Supp. 1417, 1435 (S.D. Ohio 1990), the court found that a multi-stage reasoning process was necessary before a consumer could understand the message conveyed by the mark HEARTWISE, that is, food which is healthful for the heart. The court also noted that assuming HEARTWISE meant “wise for one’s heart,” it might refer to a large number of goods or services such as running shoes, a treadmill, a calorie counter, or an Ann Landers newspaper column. The court held that HEARTWISE was a suggestive rather than descriptive mark as the consumer could not directly cull a message concerning the healthful characteristics of the goods simply from looking at the mark.

A brief review of other suggestive marks helps clarify this dichotomy:

(1) SUGAR & SPICE for use on bakery products held suggestive not descriptive. *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

(2) 100 YEAR NITE-LITE for light with life expectancy of 500 years held suggestive not descriptive. *Donsky v. Bandwagon, Inc.* 193 USPQ 336 (D. Mass. 1976).

(3) TENNIS IN THE ROUND held not descriptive of tennis facilities. *In re Tennis in the Round, Inc.* 199 USPQ 496 (TTAB 1978).

(4) RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held suggestive. *Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc.* 561 F.Supp. 1014 (D.R.I. 1983).

(5) UNDERNEATH IT ALL for undergarment products held suggestive in *Maidenform, Inc. v. Munsingwear, Inc.* 195 USPQ 297 (S.D.N.Y. 1977).

(6) CITIBANK for urban banking services held suggestive in *Citibank, N.A. v. Citibanc Group, Inc.* 724 F.2d 1540 (11th Cir. 1984).

(7) CHARRED KEG for bourbon whiskey held suggestive, even though bourbon is an American-type whiskey that is made in part by aging carried out in new

charred oaken containers. *In re Majestic Distilling Co., Inc.* 164 USPQ 386 (CCPA 1970).

(8) LONGTONG for barbecue tongs held suggestive in *Ex parte Nixdorff Krein Mfg Co.*, 115 USPQ 362 (Comm. Pat. 1957).

(9) BRAKLEEN for a brake parts cleaner was suggestive and not descriptive in *C.J. Webb, Inc.* 182 USPQ 63 (TTAB 1974).

(10) DRI-FOOT was held only suggestive of foot deodorant in *In re Pennwalt Corp.* 173 USPQ 317 (TTAB 1972).

(11) CHEW 'N CLEAN was held not to be descriptive for a dentifrice in *In re Colgate-Palmolive Company* 160 USPQ 733 (CCPA 1969).

(12) COPPERTONE was found not descriptive of a suntan preparation in *Douglas Lab Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert denied 347 U.S. 968 (1954).

In the present case, like the trademarks referenced above, the “mental link” between the mark CREATIVE GIG and Applicant’s services as recited in the application is neither immediate nor instantaneous.

The Trademark Trial and Appeal Board has adopted a three-part test to help determine whether a mark is descriptive or suggestive: (1) the degree of imagination necessary to understand the product; (2) a competitor’s need to use the same terms; and (3) competitors’ current use of the same or similar terms. *See No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 U.S.P.Q. 502 (TTAB 1985).

B. Degree of Imagination

Under the degree of imagination test, the greater the number of steps required for a consumer to arrive at a direct description of the product or service from looking at the mark, the more likely it is that the mark would be accurately characterized as “suggestive” rather than “merely descriptive” . *See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (D.C.R.I. 1983). Since there is no instantaneous connection as to the nature of the

services provided by the Applicant, it is far more likely that the mark is suggestive than descriptive. *See Stix Products, Inc. v United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (S.D.N.Y. 1968).

Applicant uses the mark CREATIVE GIG in connection with “operating an online marketplace for hiring creative professionals on a contract basis” in international Class 035.

As discussed elsewhere in this brief, the term GIG is subject to multiple interpretations, so many, in fact, that searching for the word on Wikipedia yields a disambiguation page rather than a single definition. *See Exhibit 1.*

The term “creative” can rightly be identified as a descriptive word modifying the word “gig” in the proposed mark. However, the resultant phrase, CREATIVE GIG is suggestive of the services provided by the Applicant rather than merely descriptive. While it would be possible to interpret the mark as a whole in the way suggested by the Examining Attorney, with the word “gig” meaning “projects for unique or imaginative purposes” this is not the only interpretation possible. In fact, the Examining Attorney’s association of the term “gig” with a musical performance, and the idea of a musical performance with “projects for unique or imaginative purposes”, even outside of the musical context, demonstrates a multi-step process of mature thought or reasoning which a consumer would need to follow to arrive at a description of the service offered by the applicant. The fact that the general idea of “projects for unique or imaginative purposes” is itself several “steps” away from the Applicant’s “online marketplace for hiring creative professionals on a contract basis” is further support for a finding that the proposed mark is suggestive rather than descriptive.

As such, there can be no instantaneous connection as to the nature of the services provided by the Applicant, it is far more accurate to characterize the mark as “suggestive” than

“merely descriptive”. See *Stix Products, Inc. v United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (S.D.N.Y. 1968).

C. Competitor’s Need and Current Use

Next, there is little or no evidence of record to establish the second and third prongs of the instant analysis. With respect to the availability of synonyms, the wide range of meanings for the word GIG yields a similarly wide variety of synonyms for others to use in commerce without being burdened by the inability to use the word itself. Additionally, if the word GIG is determined by the Board to be unique or otherwise irreplaceable with respect to potential future availability of the word, such a finding would support allowing a specialized use of the word, such as Applicant’s proposed use, rather than the broader and undifferentiated use claimed by the Registrant.

In regard to the third prong, although there has been evidence of other use of some of the terms, said evidence is not from competitors to the Applicant in consideration of Applicant’s specific services.

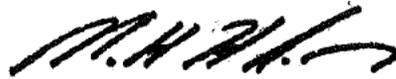
In sum, applying the Trademark Trial and Appeal Board’s test to the refusal at hand, application of the relevant test indicates that the consuming public consumer would not form an immediate impression of the features, functions, qualities or characteristics of the services offered by Applicant by mere sight of the mark.

CONCLUSION

WHEREFORE the Applicant, by counsel, respectfully requests that the refusals under Section 2(d) and Section 2(e)(1) of the Trademark Act of 1946 be reversed and the mark be allowed for publication on the Principal Register.

Respectfully submitted this 27th day of April, 2015

THE TRADEMARK COMPANY, PLLC

A handwritten signature in black ink, appearing to read "M.H. Swyers", written in a cursive style.

Matthew H. Swyers, Esquire
344 Maple Avenue West, PMB 151
Vienna, VA 22180
Tel. (800) 906-8626 x100
Facsimile (270) 477-4574
mswyers@thetrademarkcompany.com





SEARCH >



Games



Word of the Day



Video



Blog: Words at Play



My Faves

Test Your Vocabulary!



48 SCRABBLE words with Q and no U >



"Flesh out" or "flush out"? 10 commonly confused words >



SEARCH >



TAKE THE QUIZ >



Cattywampus, Gardyloo & More



The Opposite of Incurable

Dictionary

SAVE



¹gig

noun | \ˈgɪɡ\

Share



Definition of GIG

: something that whirls or is whirled: as

a *obsolete* : top, whirligig

b : a 3-digit selection in a numbers game

: a person of odd or grotesque appearance



[SUBSCRIBE >](#)











