

ESTTA Tracking number: **ESTTA562397**

Filing date: **10/01/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Outsourced Site Services, LLC
Granted to Date of previous extension	10/02/2013
Address	2724 Simpson Street Evanston, IL 60201 UNITED STATES

Attorney information	Andriana Shultz Daly McGuireWoods LLP One James Center 901 East Cary Street Richmond, VA 23219 UNITED STATES adaly@mcguirewoods.com, gspatz@mcguirewoods.com
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Applicant Information

Application No	85792466	Publication date	06/04/2013
Opposition Filing Date	10/01/2013	Opposition Period Ends	10/02/2013
Applicant	Give.com, LLC 2805 Farm Road Alexandria, VA 22302 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2012/02/13 First Use In Commerce: 2012/09/08 All goods and services in the class are opposed, namely: Charitable fundraising services, namely, by providing individuals with the information and opportunity to make monetary donations to their favorite charity
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
Genericness	Trademark Act section 23

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2596573	Application Date	06/02/1999
Registration Date	07/23/2002	Foreign Priority Date	NONE

Word Mark	IGIVE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1998/12/01 First Use In Commerce: 1998/12/01 Charitable fund raising services, namely, hosting an online buyers club wherein donations to selected causes or organizations are generated by buyer member visits to and purchases from vendor members' sites

U.S. Registration No.	2385144	Application Date	04/22/1999
Registration Date	09/12/2000	Foreign Priority Date	NONE
Word Mark	IGIVE.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1998/12/01 First Use In Commerce: 1998/12/01 Charitable fund raising services provided by means of a website wherein a portion of members' purchases is dedicated to designated charities		

Attachments	Notice of Opposition of GIVE.COM.pdf(1335712 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Andriana S. Daly/
Name	Andriana Shultz Daly
Date	10/01/2013

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

In re Application of: Give.com, LLC
Serial No.: 85/792,466
Filed: December 2, 2012
Mark: Give.com
Published: June 4, 2013

OUTSOURCED SITE SERVICES, LLC)
)
Opposer,)
)
v.) **Opposition No.**
)
GIVE.COM, LLC,)
)
Applicant.)

NOTICE OF OPPOSITION

1. Applicant Give.com, LLC (“Applicant”) seeks to register the mark “Give.com” (Serial No. 85/792,466) (the “Give.com Mark”) for “[c]haritable fundraising services, namely, by providing individuals with the information and opportunity to make monetary donations to their favorite charity” in International Class 36, as evidenced by publication of the Give.com Mark on June 4, 2013.

2. Opposer Outsourced Site Services, LLC (“Opposer”), an Illinois limited liability company doing business at 2724 Simpson Street, Evanston, Illinois 60201, would be damaged by registration of the Give.com Mark and therefore opposes registration under 15 U.S.C. § 1063.

3. Pursuant to Trademark Rule 2.102, Opposer obtained extensions of time for filing a Notice of Opposition against registration of the Give.com Mark up to and including October 2, 2013.

Opposer and the iGive Marks

4. In 1997, Opposer launched the charitable fundraising website iGive.com. Through iGive.com, consumers can purchase goods from their favorite retailers and designate charities of their choice to receive donations of the proceeds (*i.e.*, Opposer provides individuals with the information and opportunity to make monetary donations to their favorite charity).
5. More than 1,300 retailers, including but not limited to well-known merchants such as amazon.com, Staples, Best Buy, Lowe's, and Bed Bath & Beyond, and 58,000 charities participate in Opposer's charitable fundraising service.
6. Over the past 15 years, more than 800,000 consumers have used iGive.com to raise a combined total of nearly \$7 million for charity. In 2013 alone, iGive.com shoppers already have raised nearly \$400,000 for charity.
7. Opposer has used the marks "iGive.com" and "iGive" (together, the "iGive Marks") in connection with its novel charitable fundraising service consistently in interstate commerce since 1998. Opposer has expended considerable time, money, and effort in the development, preparation, advertising, and promotion of services under the iGive Marks throughout the United States. The iGive Marks are integral parts of Opposer's business and brand identity.
8. To protect the use made of the iGive Marks in Opposer's business, Opposer has obtained federal trademark registrations for the iGive Marks. (*See* U.S. Registration Nos. 2,596,573 and 2,385,144, attached as Exs. A and B).
9. The iGive Marks are registered in International Class 36 for use in connection with "[c]haritable fund raising services, namely, hosting an online buyers club wherein donations to selected causes or organizations are generated by buyer member visits to and purchases from

vendor members' sites" (U.S. Registration No. 2,596,573) and "[c]haritable fund raising services provided by means of a website wherein a portion of members' purchases is dedicated to designated charities" (U.S. Registration No. 2,385,144).

10. Opposer's trademark registrations for the iGive Marks are incontestable, the iGive.com Mark having been registered since 2000, and the iGive Mark having been registered since 2002.

11. By virtue of the long, exclusive, and continuous use of the distinctive iGive Marks for charitable fundraising services, Opposer's services have become well and favorably known to the general consuming public. Indeed, national media outlets such as the Washington Post, CNBC, the Today Show, TIME Magazine, the Huffington Post, ABC, and U.S. News & World Report have featured Opposer's charitable fundraising services offered under the iGive Marks. Thus, the iGive Marks have come to represent valuable symbols of Opposer's goodwill.

Applicant and the Give.com Mark

12. Applicant purportedly uses the Give.com Mark in connection with "[c]haritable fundraising services, namely, by providing individuals with the information and opportunity to make monetary donations to their favorite charity."

13. Accordingly, Applicant is purportedly using the Give.com Mark in connection with services that are identical to or, at a minimum, substantially related to, the services offered by Opposer under the iGive Marks—namely, "[c]haritable fund raising services."

14. Moreover, the Give.com Mark, as applied for, is nearly identical to the iGive Marks that Opposer has used for the past 15 years. Indeed, Applicant's Give.com Mark is subsumed in Opposer's iGive Marks in its entirety—including using the same sentence-case

capitalization. The only difference is that Applicant has dropped the lowercase “i” from the beginning of Opposer’s iGive Marks.

15. There is no issue as to priority, as Opposer and its predecessors in interest have used the incontestable iGive Marks continuously in interstate commerce in connection with their charitable fund raising services since 1998—nearly 15 years before Applicant purportedly first used and applied to register the Give.com Mark.

FIRST GROUND FOR OPPOSITION
Likelihood of Confusion

16. Paragraphs 1 through 15 are incorporated and made a part of this Ground for Opposition.

17. The Give.com Mark and the iGive Marks are substantially similar. The only difference between the marks is that Applicant dropped the “i” from the beginning of Opposer’s iGive Marks and, with respect to Opposer’s iGive Mark, added “.com.” Phonetically, Applicant’s deletion of the letter “i” makes little to no difference, as the word “Give” receives primary emphasis in Opposer’s iGive Marks. Moreover, the marks remain substantially similar in meaning, as the Applicant and Opposer both use the word “Give” to refer to charitable giving.

18. The services for which Applicant seeks to register the Give.com Mark are identical to or, at the very least, substantially related to the services provided under the iGive Marks by Opposer and its predecessors-in-interest.

19. Because of the similarity between the Give.com Mark and Opposer’s iGive Marks, and between the parties’ services, consumers and the general public are likely to be confused, mistaken, or deceived as to the origin and sponsorship of Applicant’s services, and are likely to be misled into believing that Applicant’s services offered under the Give.com Mark are

provided by, or are in some other way directly or indirectly associated with Opposer and its affiliates and licensees to the damage of Opposer and its reputation.

20. Opposer has no control over the nature or quality of Applicant's services. In the event of false association, any defects, objections, or faults found with Applicant's services could inflict serious injury upon Opposer and its reputation.

SECOND GROUND FOR OPPOSITION

Lack of Distinctiveness

21. Paragraphs 1 through 20 are incorporated and made a part of this Ground for Opposition.

22. Applicant's Give.com Mark is generic and/or descriptive under Section 2(e) of the Lanham Act. Accordingly, the Give.com Mark is *per se* unregistrable and/or unregistrable absent a showing of secondary meaning.

23. The American Heritage Dictionary defines "give," which has been used since before the year 900, to mean, *inter alia*, "[t]o make gifts or donations." *The American Heritage Dictionary of the English Language* 744 (4th ed. 2009); *see also* <http://dictionary.reference.com/browse/give>. The word is commonly used and understood by the general public to have this same meaning.

24. Applicant seeks to register the Give.com Mark for use in connection with charitable fundraising services—*i.e.*, "monetary donations to . . . charity." U.S. Application No. 85/792,466. Thus, Applicant seeks to use the word "give" as a descriptive term for its services for giving money to charity.

25. The word "give" is not now, and never has been, exclusively identified with Applicant or Applicant's services. Applicant's Give.com Mark therefore does not and cannot distinguish Applicant's services from those of Opposer, or any other party that chooses to offer

charitable fundraising services by using a mark that incorporates the word “give” in such a generic and/or descriptive manner.

26. Opposer would be damaged by registration of Applicant’s Give.com Mark because, if registered, Applicant could use that mark to limit Opposer’s ability to use “give” in its descriptive sense in connection with giving monetary donations to charity.

27. If Applicant is permitted to register the Give.com Mark, Applicant would gain at least a *prima facie* exclusive right to use of that mark. Such registration would continue to damage Opposer.

28. For all of these reasons, Applicant should not be permitted to monopolize the descriptive term “give” for use in connection with giving money to charity.

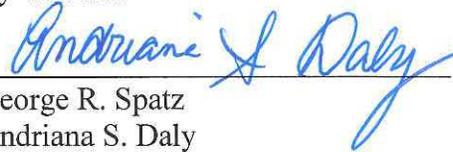
WHEREFORE, Opposer prays that Application Serial No. 85/792,466 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained.

Dated: October 1, 2013

Respectfully submitted,

OUTSOURCED SITE SERVICES, LLC

By Counsel



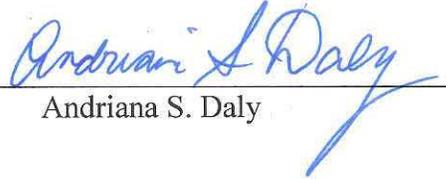
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Counsel for Outsourced Site Services, LLC

Electronically Filed via ESTTA: October 1, 2013

CERTIFICATE OF SERVICE

I certify that on October 1, 2013, a copy of this Notice of Opposition was mailed, first class, postage prepaid to Applicant Give.com, LLC, at 2805 Farm Road, Alexandria, VA 22302-2405.



Andriana S. Daly

EXHIBIT A

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,596,573

United States Patent and Trademark Office

Registered July 23, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

iGive

IGIVE.COM, INC. (DELAWARE CORPORATION)
1890 MAPLE STREET, #130
EVANSTON, IL 60201

FIRST USE 12-1-1998; IN COMMERCE 12-1-1998.

FOR: CHARITABLE FUND RAISING SERVICES,
NAMELY, HOSTING AN ONLINE BUYERS CLUB
WHEREIN DONATIONS TO SELECTED CAUSES
OR ORGANIZATIONS ARE GENERATED BY BUY-
ER MEMBER VISITS TO AND PURCHASES FROM
VENDOR MEMBERS' SITES, IN CLASS 36 (U.S. CLS.
100, 101 AND 102).

OWNER OF U.S. REG. NOS. 2,180,721 AND
2,180,723.

SER. NO. 75-719,322, FILED 6-2-1999.

BARBARA A. LOUGHRAN, EXAMINING ATTOR-
NEY

EXHIBIT B

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,385,144

United States Patent and Trademark Office

Registered Sep. 12, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

IGIVE.COM

IGIVE.COM, INC. (DELAWARE CORPORATION)
1890 MAPLE STREET, #130
EVANSTON, IL 60201

CATED TO DESIGNATED CHARITIES, IN CLASS 36
(U.S. CLS. 100, 101 AND 102).
FIRST USE 12-1-1998; IN COMMERCE 12-1-1998.

FOR: CHARITABLE FUND RAISING SERVICES
PROVIDED BY MEANS OF A WEBSITE WHEREIN
A PORTION OF MEMBERS' PURCHASES IS DEDI-

SER. NO. 75-689,747, FILED 4-22-1999.
MICHELLE SWAIN, EXAMINING ATTORNEY