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Subject: U.S. Trademark Application Serial No. 87069673 - GIGIT - J123 001TM - EXAMINER BRIEF

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U.S. Application Serial No. 87069673

Mark: GIGIT

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Reference/Docket No. J123 001TM

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark GIGIT on the ground that it is merely descriptive within the meaning of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and on the ground that the mark shown in the drawing is not a substantially exact representation of the mark in the specimen, as required by Trademark Act §§1 and 45, 15 U.S.C. §§1051 and 1127.

FACTS

Applicant seeks to register GIGIT in standard character form for:

staff augmentation services, namely, providing information technology (IT) support staff; updating and maintenance of data in computer databases; in International Class 35; and

computer and information technology security services, namely, providing social engineering assessments and assessing and testing the security posture and vulnerability of computer networks and the software applications that run on the networks; computer and information technology security consultation services; Information technology consultation services; information technology and computer network engineering services, namely, designing, configuring, optimizing, and implementing computer networks; computer and information technology support services, namely, help desk services and monitoring the technological functions of computer network systems; data warehousing; installation, repair, updating, and maintenance of computer software; software design and development; Information technology project management services; consulting in the field of information technology project management; IT integration services; computer systems integration services; in International Class 42.

The examining attorney has refused registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the basis of mere descriptiveness, and under Trademark Act §§1 and 45, 15 U.S.C. Sections §§1051 and 1127, on the basis that the applied-for mark shown in the drawing is not a substantially exact representation of the mark in the specimen.

The application was filed on June 13, 2016 under Section 1(b). On April 9, 2018, applicant filed a statement of use for both classes. On May 16, 2018, the examining attorney issued an Office action refusing registration on the basis that the proposed mark is merely descriptive of applicant's services. Made of record with this Office action were definitions of "gig" from www.merriam-webster.com (May 16, 2018 Office Action, TSDR pp. 2-12) and "IT" from <https://techterms.com> (May 16, 2018 Office Action, TSDR p. 13-14). Also made of record was an excerpt from applicant's website, showing the applied-for mark used in a manner so as to convey two terms and indicating that applicant provides IT

professionals and engineers for long and short-term staffing assignments (May 16, 2018 Office Action, TSDR pp. 15-16).

Applicant responded to the refusal on June 22, 2018, and made of record a definition of “gig” from <https://en.oxforddictionaries.com> (June 22, 2018 Office Action, TSDR pp. 6-8) and copies of sixteen third party U.S. trademark registrations containing the term “IT” (July 22, 2018 Office Action, TSDR pp. 10-50). The Section 2(e)(1) refusal as to the mere descriptiveness refusal was made final on August 13, 2019. On February 11, 2019, applicant filed a notice of appeal and request for reconsideration. The request for reconsideration made of record eighteen third party U.S. trademark registrations for marks containing the term “IT” (February 11, 2019 Office Action, TSDR pp. 5-48).

On March 6, 2019, the examining attorney issued an Office action withdrawing the finality of the previous action and continuing the Section 2(e)(1) refusal, and refusing registration additionally on the basis that the applied-for mark in the drawing is not a substantially exact representation of the mark as shown in the specimen. On April 17, 2019, the examining attorney issued an Office action making the refusal to register the applied-for mark final on both bases. Applicant’s appeal was resumed by the Board on April 23, 2019.

ISSUES

- I. THE APPLIED-FOR MARK “GIGIT” IS MERELY DESCRIPTIVE OF A FEATURE/PURPOSE OF APPLICANT’S SERVICES.
- II. THE APPLIED-FOR MARK IN THE DRAWING IS NOT A SUBSTANTIALLY EXACT REPRESENTATION OF THE MARK IN THE SPECIMEN.

ARGUMENTS

- I. THE APPLIED-FOR MARK “GIGIT” IS MERELY DESCRIPTIVE OF A FEATURE/PURPOSE OF APPLICANT’S SERVICES.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

In this case, applicant’s proposed mark GIGIT merely describes the feature/purpose of the services, namely, that the services pertain to the information technology (IT) sector, and that applicant is offering services on a gig, or temporary, basis.

Receipt of the website specimen in the April 9, 2018 statement of use shows the proposed mark depicted as two separate terms, “GIG” and “IT”. On all five pages of the website specimen the proposed mark appears in the upper left of the pages with the word “GIG” presented in black type font and the acronym “IT” in white letters inside an orange circle. Four orange squares form the dot of the “I” in “GIG” and curve toward the orange circle holding the acronym “IT” (April 9, 2018 Statement of Use, TSDR pp. 1-4). The applied-for mark also appears in another form on the first webpage, with the term “GIGIT” presented within other text in all black font with the first “G” in “GIG” capitalized as well as the letters “IT” (April 9, 2018 Statement of Use, TSDR p. 1). These presentations of the proposed mark in

the website specimen clearly show the applied-for mark appearing as two separate terms rather than one term.

“GIG” is defined by www.merriam-webster.com as “a job usually for a specified time” (May 16, 2018 Office Action, TSDR pp. 2-12). The website www.techterms.com defines the acronym “IT” as follows: “IT Stands for “information Technology,” and is pronounced “I.T.” It refers to anything related to computing technology, such as networking, hardware, software, the Internet, or the people that work with these technologies.’ (May 16, 2018 Office Action, TSDR pp. 13-14).

There is no question that the acronym “IT” identifies a feature of applicant’s services, namely, their field of application. Applicant’s identification of services expressly identifies information technology (IT) as the field of the majority of the services:

Staff augmentation services, namely, providing information technology (IT) support staff; Updating and maintenance of data in computer databases; in International Class 35;

Computer and information technology security services, namely, providing social engineering assessments and assessing and testing the security posture and vulnerability of computer networks and the software applications that run on the networks; Computer and information technology security consultation services; Information technology consultation services; Information technology and computer network engineering services, namely, designing, configuring, optimizing, and implementing computer networks; Computer and information technology support services, namely, help desk services and monitoring the technological functions of computer network systems; Data warehousing; Installation, repair, updating, and maintenance of computer software; Software design and development; Information technology project management services; Consulting in the field of information technology project management; IT integration services; Computer systems integration services; in International Class 42 [underlining added for emphasis].

There is also no question that applicant provides some, and potentially all, of the services on a temporary basis. Both applicant's specimen and the excerpt of applicant's website attached to the May 16, 2018 Office action identify applicant as providing "Staff Augmentation" for "Long and Short-Term Assignments" (April 9, 2018 Statement of Use, TSDR p. 2; May 16, 2018 Office Action, TSDR p. 15).

The proposed mark regarded as a whole directly communicates to consumers the information that applicant is providing staffing and services in the information technology (IT) field, available on a short-term gig basis. Applicant has acknowledged the descriptive nature of its proposed mark in its brief and in one of its responses (July 22, 2018 Applicant Response, TSDR p. 3):

Trademark Examining Attorney argues that the term GIGIT describes a feature/purpose of Applicant's services, namely that Applicant is providing temporary workers for IT gigs. While Applicant does not dispute that this is a descriptive meaning of Applicant's GIGIT mark when used in connection with its services, Applicant's mark also features a non-descriptive second meaning that makes it a double entendre [underlining added for emphasis].

Applicant does not dispute the descriptive nature of "GIG" and "IT" with respect to its services, but argues that the Section 2(e)(1) mere descriptiveness refusal is improper in that the proposed mark GIGIT would be perceived as a double entendre. A "double entendre" is an expression that has a double connotation or significance as applied to the goods and/or services. TMEP §1213.05(c); *see In re Colonial Stores Inc.*, 394 F.2d 549, 552-53, 157 USPQ 382, 384-85 (C.C.P.A. 1968) (finding SUGAR & SPICE a double entendre and not descriptive for bakery products because it evokes the nursery rhyme "sugar and spice and everything nice").

As applicant correctly argues, a mark that comprises a “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods and/or services. TMEP §1213.05(c). However, as pointed out to applicant, the multiple meanings that make an expression a “double entendre” must be well-recognized by the public and readily apparent from the mark itself. See *In re Calphalon Corp.*, 122 USPQ2d 1153, 1163-64 (TTAB 2017) (quoting TMEP §1213.05(c)) (finding SHARPIN not a double entendre in relation to cutlery knife blocks with built-in sharpeners and affirming descriptiveness refusal); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE not a double entendre in relation to wines and affirming disclaimer of ROUGE); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470-71 (TTAB 2005) (finding THE GREATEST BAR not a double entendre in relation to restaurant and bar services and affirming descriptiveness refusal).

Applicant argues that the applied-for mark GIGIT would be perceived by consumers as meaning the ability to temporarily fill a staff need, i.e., “gig it,” with “gig” functioning as a verb and use of the pronoun “it” evoking not just information technology but also operating as a pronoun. According to applicant, it is common wordplay among marks in the information technology field to use the term “IT” as indicating both information technology and the pronoun “it”. In support of this claim, applicant has made of record a number of third party registrations including the term “IT” for information technology goods and services. At issue, however, is not whether the term “IT” can in some circumstances also function as a double entendre, but whether consumers in this particular case will perceive the use of “IT” as used with the other matter in applicant’s proposed mark as indicating anything other than information technology.

Here, there is no reason to believe that consumers would perceive applicant's proposed mark in its entirety as a double entendre. Examination of applicant's specimen does not show any attempt to highlight a double entendre sense for the term GIGIT. There is no other evidence of record demonstrating the common or even a single use of the phrase "gig it" as indicating using temporary staff to fill a need, with the term "gig" operating as a verb and the term "IT" indicating both information technology and the pronoun "it." While not every component of a double entendre must have a double meaning, the components when viewed together do, and "gig it" with the meaning ascribed by applicant makes little sense. The third party registrations applicant has made of record do not demonstrate an Office determination that anytime the term "IT" appears in a mark involving information technology the entire mark will be treated as a double entendre, but at most indicate only that some marks for information technology goods and services can use the single term "IT" in a double entendre sense. Here, there is simply not any persuasive evidence of record supporting any readily apparent meaning for GIGIT as used in connection with applicant's services apart from its merely descriptive meaning.

II. THE APPLIED-FOR MARK IN THE DRAWING DOES NOT SHOW A SUBSTANTIALLY EXACT REPRESENTATION OF THE MARK IN THE SPECIMEN.

Trademark Act §§ 1 and 45, 15 U.S.C. §§1051 and 1127; 37 C.F.R. §§2.34(a)(1)(iv), §2.51(a)-(b) and 2.56(a), requires applicant to provide a drawing of the applied-for mark that is a "substantially exact representation" of the mark in use in commerce as shown in the specimen. When an applied-for mark is a compound mark, as here, the display of the mark in the specimen must be considered in determining whether a substantially exact drawing would show the applied-for mark as one word or two. See TMEP

§807.12(e). The nature of the compound mark must also be considered in determining whether applicant has the option of amending the drawing so that the mark in the drawing matches the mark in the specimen, or whether such amendment would be a material alteration and submission of a substitute specimen is required. See TMEP §807.12(e).

Applicant's drawing displays the mark GIGIT as one word in standard character form. The specimen submitted with the statement of use, however, displays the applied-for mark with color, capitalization and design elements emphasizing that the term is to be perceived as two separately distinct words, "GIG" and "IT", each with a defined and descriptive meaning with respect to the services. Applicant's specimen consists of five pages of a website excerpt advertising the services: on all five of the pages, the mark GIGIT is displayed prominently in the upper left of the page (April 9, 2018 Statement of Use, TSDR pp. 2-6). The "GIG" portion of the mark is represented in black type font with the acronym "IT" portion appearing in white letters inside an orange circle. The letter "G" at the beginning of "GIG" and the letter "IT" are capitalized. The spacing between "GIG" and "IT" is slightly wider than the spacing between the other letters due to the circle element. In this particular presentation, the coloring, capitalization and design elements of the display all create a mark which would be perceived as two terms. A second type of presentation of the proposed mark occurs in the specimen on the first webpage within the text describing the staff augmentation services (April 9, 2018 Statement of Use, TSDR p. 2). In this display, the proposed mark appears in all in black font with the first "G" in "GIG" and the letters "IT" capitalized and the rest in lowercase. In this second presentation, the capitalization used within the applied-for mark creates the impression of two separate words having a descriptive meaning with respect to the services, presented in compound form.

Applicant's standard character drawing showing the applied-for mark as one word thus does not adequately represent the mark as it appears in the specimen. The term GIGIT shown as one word in standard character form can be perceived as a coined term without any meaning. When the same letters are used in the manner shown in applicant's specimen, they clearly represent two separate words directly conveying to consumers the information that applicant's services pertain to the information technology (IT) field and involve work gigs. The Board has previously held in an analogous situation that a mark may not be registered in standard character form as one term where the display in the specimen creates a different commercial impression. See *In re Morton Norwich Prods., Inc.*, 221 USPQ 1023, 1023 (TTAB 1983) (LABID not registrable without a special form drawing because the specimen showed the letter "a" in smaller lettering with a diacritical accent that set off the "BID" portion of the mark, and the word "BID" had an accepted meaning as applied to drug prescriptions, i.e., "twice a day"). Applicant's use of color, capitalization and design accomplishes the same function of creating two words within one as the diacritical accent and smaller size of the letter "a" in *In re Morton*, with these display choices emphasizing the embedded descriptive meanings in these marks.

In this case, the applied-for mark in the drawing and the mark as used in the specimen are not substantially exact representations of each other because the mark in the specimen makes use of color, capitalization, and design elements, singularly or together, to create an uncommon or "special" commercial impression that differs from the commercial impression created by the presentation of GIGIT as one word in standard character form. In the first instance, the presentation of GIGIT as one word in standard character form potentially creates the impression of an arbitrary term. In the second instance, the presentation of GIGIT as two words or a compound term comprising two words conveys descriptive information to consumers regarding the services. The impression created by the applied-for

mark in the drawing and the mark as displayed in the specimen therefore differs significantly and materially. Applicant has failed to provide a drawing of the applied-for mark which is a substantially exact representation of the mark as used in the specimen and in commerce, as required by Trademark Act §§1 and 45.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark is merely descriptive of the services, and on the basis of §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the applied-for mark shown in the specimen of use is not a substantially exact representation of the mark in the drawing, should be affirmed.

Respectfully submitted,

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