

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: CLIENT GIANT, INC.)
)



Mark:)

Appl. No.: 88/519,971)

Int'l Class: 035; 042; 045)

Reg. Date: July 17, 2019)

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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

Applicant CLIENT GIANT, Inc. ("Applicant") hereby responds to the Office Action mailed on October 6, 2019, as follows:

I.

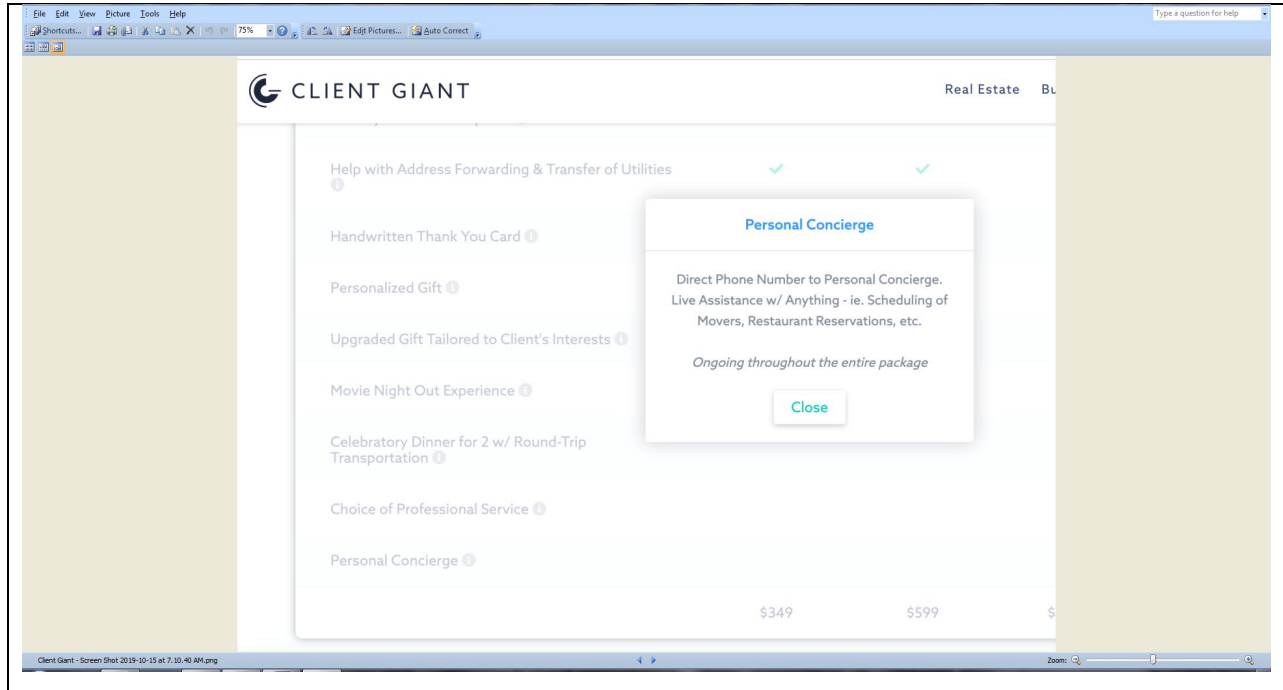
SPECIMEN REFUSAL IN CLASSES 035

In the Office Action, the Examiner stated that:

"[S]pecifically, applicant's services in Class 35 are "providing consumer information and advice in the choice of products and services" However, the website specimen shows services that packages of gifts and services that businesses can purchase for their clients. Nothing on the website provides information or advice about choice of product. Accordingly, the specimen does not show use with the services in International Class 35."

A. CLASS 035 – SUBSTITUTE SPECIMENS

In Response to the Office Action, Applicant submits substitute Class 035 specimens, namely, screenshots of website showing “Customer care concierge support services, namely, providing consumer information and advice in the choice of products and services”. See **Ex. A** – screenshots of website. For the Examiner’s convenience, below are sample screenshots of the substitute specimens:





In the specimens, the CG Logo mark creates a direct association with the covered Classes 035 personal concierge services in the mind of the purchaser. As stated in *In re Republic Nat'l LLC*, 2017 T.T.A.B. LEXIS 77 (T.T.A.B., Feb. 23, 2017),

“Specimens showing the mark used in rendering the identified services need not explicitly refer to those services in order to establish the requisite direct association between the mark and the services, but ‘there must be something which creates in the mind of the purchaser an association between the mark and the service activity.’ *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994).”

While the services need not be stated in the specimens word-for-word, a “sufficient” reference to the services themselves or a general reference to the trade, industry, or field of use is required. See *In re Ralph Mantia, Inc.*, 54 U.S.P.Q.2d 1284, 1286 (T.T.A.B. 2000) (reversing the specimen refusal since the term “design” appeared on applicant’s letterhead stationery, envelope, and business cards and stating “[i]t is not necessary that the specific field of design, *i.e.*, commercial art, also appear [on the specimen.]”); see, also, *In re Chi. Mercantile Exch., Inc.*, 2016 TTAB LEXIS 278 (T.T.A.B., June 13, 2016) (“When appropriate, the Board has been fairly flexible in

accepting service mark specimens.”) (*citing In re Ralph Mantia, Inc., supra*). In the substitute specimen, the CG Logo mark is shown in relation to the identified Class 35 concierge services. Therefore, the substitute specimens show sufficient reference to the services identified in the application.

II.

AMENDMENT TO THE IDENTIFICATION OF SERVICES

Finally, Applicant respectfully adopts the identification of services suggested by the Trademark Examiner as follows (in bold):

International Class 35: Customer care concierge support services, namely, providing **commercial** information and advice **for consumers** in the choice of products and services.

International Class 42: Provision of **online** non-downloadable software application for use in providing customer care concierge support services, namely, providing consumer information and advice in the choice of products and services; Provision of **online** non-downloadable software application for use in providing personal concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs, for use in providing concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs.

III.

CONCLUSION

Registrant believes it has responded to all of the Examining Attorney’s inquiries and respectfully requests that the application be allowed to proceed to registration.