

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:



Trademark:

Serial No.: 88315351

Applicant: Capgemini

Examiner: Julie M. Guttadauro

Law Office: 106

**Response to Office Action**

The term INVENT in Applicant's mark suggests to consumers the creative possibilities that are available if they hire Applicant to help them manage their digital capabilities. Consumers see the term INVENT and immediately think of scientific discovery and product design, not Applicant's business and technology consultancy services. Applicant's mark should therefore be allowed to proceed to registration without a disclaimer.

**I. Legal Framework**


The Patent and Trademark Office ("Office") has discretion whether or not to require a disclaimer, but only if the component of an otherwise registerable mark is merely descriptive.<sup>15</sup> U.S.C. 1056; 15 U.S.C. 1052(e)(1); TMEP 1213. A term is merely descriptive if it "forthwith conveys an *immediate* idea of the ingredients, qualities, or characteristics of the goods." *In Re Future Ads, LLC*, 103 U.S.P.Q.2d 1571, 1574 (TTAB 2012) (emphasis added). A determination of whether a trademark is merely descriptive cannot take place in the abstract but in relation to the services identified in the application and the possible significance that the term would have to the average purchaser of the services. *In re ICE Futures U.S., Inc.*, 85 U.S.P.Q.2D 1664, 1665 (TTAB 2008).

A suggestive trademark is inherently distinctive and should be allowed to register. *In Re Future Ads, LLC*, 103 U.S.P.Q.2d at 1574. "Whether a given mark is suggestive or merely

descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods [or services] ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods [or services]'.<sup>16</sup> *Id.*; quoting *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). On the spectrum of distinctiveness, the dividing line between merely descriptive and suggestive is a fine one. *Id.*

The Office bears the burden of establishing a prima facie case in support of its claim that a mark is descriptive. *In Re Future Ads, LLC*, 103 U.S.P.Q 2d at 1574-75.

## II. Argument

The term INVENT in Applicant's mark  is suggestive and not merely descriptive. To consumers, there is no immediate connection or direct "mental leap" between INVENT and Applicant's identified services, and therefore, the term is not merely descriptive. *See Cross Commerce Media, Inc. v. Collective Inc.*, 841 F.3d 155, 162, 120 U.S.P.Q.2d 1517, 1520 (2d Cir. 2016); *citing* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:67 (4th ed.). Instead, the term INVENT suggests to purchasers an intended benefit of Applicant's services; these purchasers are required to employ some mature thought and imagination to determine the attributes of Applicant's services. For this reason, Applicant's INVENT is inherently distinctive. *See Tennis in the Round, Inc.*, 199 U.S.P.Q 496 (TTAB 1978).

### A. "Invent" means "to produce (something,...) for the first time..."

The first definition of "invent" is "to produce (something, such as a useful device or process) for the first time through the use of the imagination or of ingenious thinking and experiment." "To produce" is immediately followed by "something" in parenthesis, i.e. "to produce (something,...). Based on this definition, the verb "invent" is used to describe the creation of

something new, i.e. a new product, process, or scientific discovery. The image that first comes to mind is a scientist sitting in his or her laboratory. In fact, the first sentence provided in the Meriam Dictionary entry is “Thomas Edison invented the phonograph”

B. The term “invent” does not immediately describe Applicant’s business and technology consultancy services

For INVENT to be considered merely descriptive, consumers must immediately identify this term with a quality or characteristic of Applicant’s services. The term INVENT must directly convey to the average purchaser some information about Applicant’s work. Here, Applicant offers business and technology consultancy services, advisory services, and other services related to the management of information systems and information technologies.

Although it is true that Applicant’s services help customers improve their businesses so that these customers can then better create new products and succeed in the marketplace, the term INVENT as used in Applicant’s mark is not a quality or characteristic of Applicant’s services as represented in the Office Action. Rather, the term suggests to purchasers the likely reward that they will receive as a result of Applicant’s work, i.e. Applicant advises its customers on how to implement certain changes to their business network, and as a result Applicant’s customers are able to reinvent themselves and create something new or better.

Average purchasers would not immediately associate the word “invent” with Applicant’s identified services. Instead, these purchasers would have to use imagination to 1) reach a conclusion about the nature of Applicant’s consultancy related services and 2) fully understand how Applicant’s help would ultimately lead to their businesses creating new and profitable products. As a result, the term INVENT in Applicant’s mark is suggestive; Applicant’s entire mark should therefore be allowed to proceed to registration.

C. The Office in the past has correctly understood that “INVENT” is not merely descriptive of consultancy and software services.

The Office agrees that the use of the term INVENT in connection with consultancy and software is not merely descriptive. Just this year, the Office allowed the mark INVENT BEAUTIFULLY to proceed to registration in connection with business management and software consulting services without a disclaimer for INVENT, see Exhibit A. The Office has also allowed the following relevant marks containing INVENT to register without a disclaimer: INVENT, IMPLEMENT, INNOVATE & Design; INVENT MEDICAL & Design; and INVENT ANALYTICS, see Exhibit A.

Similarly, Applicant requests that its entire mark also be allowed to proceed to registration without a disclaimer. As demonstrated above, the term INVENT is suggestive and inherently distinctive.

### **III. Conclusion**

The term INVENT suggests to consumers the creative possibilities that are available if they hire Applicant to help them manage their digital capabilities. Consumers see the term INVENT and immediately think of scientific discovery and product design, not business and technology consultancy services. Applicant’s mark should therefore be allowed to proceed to registration without a disclaimer.