

**This Opinion is Not a
Precedent of the TTAB**

Mailed: May 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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JobDiva, Inc.

v.

Jobvite, Inc.
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Cancellation No. 92050828
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REQUEST FOR RECONSIDERATION
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Daniel I. Schloss of Greenberg Taurig, LLP for JobDiva, Inc.

Martin R. Greenstein of Techmark a Law Corporation for Jobvite, Inc.
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Before Taylor, Mermelstein and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

This case comes before us on Petitioner’s Request for Reconsideration of the Board’s April 16, 2015 Order granting Respondent’s counterclaim cancelling Petitioner’s Registration No. 2851917 for the mark JOBDIVA (typed drawing) for “personnel placement and recruitment,” in Class 35¹ and partially cancelling Registration No. 3013235 for the mark JOBDIVA and design, shown below for

¹ Issued June 8, 2004; renewed.

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“personnel placement and recruitment services; computer services, namely, providing databases featuring recruitment and employment, employment advertising, career information and resources, resume creation, resume transmittals and communication of responses thereto via a global computer network,” in Class 35.²



The Board found, on the counterclaim for cancellation, that Petitioner abandoned its use of the JOBDIVA marks in connection with “personnel placement and recruitment” because Petitioner submitted no evidence to rebut Respondent’s showing that Petitioner has not used its mark in connection with the services, or that Petitioner does not intend to resume such use, and there was nonuse for three consecutive years, constituting *prima facie* evidence of abandonment.

Petitioner argues that the Board made erroneous findings of fact because there is “abundant evidence of record” that shows Petitioner providing the service of “finding and placing people in jobs at other companies or providing personnel staffing services for others.”³ Petitioner renders these services on a software-as-a-service or “SaaS” basis to third parties.⁴ Thus, Petitioner asserts that it renders “personnel placement and recruitment” services.

² Issued November 8, 2005; Section 8 affidavit accepted.

³ 103 TTABVUE 3.

⁴ 103 TTABVUE 4.

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The fact that JobDiva's personnel placement and recruitment services are rendered on a SaaS basis using technology and automated methods does not detract in any way from the essential nature of its services.⁵

Software as a Service (SaaS) leverages software by delivering it over the Internet.⁶

Software as a Service (SaaS) enables businesses to shift their computing applications to the Internet. In the purest sense of the phrase, SaaS shifts the burden of housing and hosting data, and enables users to log in to their application from anywhere, at any time.⁷

SaaS is also known as cloud computing.⁸ Cloud computing is defined as “computing operations carried out on servers that are accessed through the Internet, rather than on one's own personal computers. ...The users pay for the computing as a service rather than owning the machines and software to do it.”⁹ “This enables customers to be able to focus on their core business objectives, and frees them from dedicating resources to support the enterprise application on an ongoing basis.”¹⁰

The issue of whether Petitioner is rendering “personnel placement and recruitment” depends on how Petitioner uses its mark. A term that *only* identifies a

⁵ *Id.*

⁶ **ENCYCLOPEDIA OF EMERGING INDUSTRIES**, p. 828 (2011). The Board may take judicial notice of information from encyclopedias. *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).

⁷ *Id.*

⁸ **DICTIONARY OF COMPUTER AND INTERNET TERMS**, p. 434 (11th ed. 2013). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁹ *Id.*

¹⁰ **ENCYCLOPEDIA OF EMERGING INDUSTRIES**, p. 828.

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computer program does not become a service mark merely because the program is sold or licensed in commerce. Such a mark does not serve to identify a service unless it is also used to identify and distinguish the service itself, as opposed to the program. *In re DSM Pharmaceuticals, Inc.*, 87 USPQ2d 1623 (TTAB 2008) (term that merely identifies computer software used in rendering services does not function as a mark to identify custom manufacturing of pharmaceuticals); *In re Information Builders Inc.*, 213 USPQ 593 (TTAB 1982) (term identifies only a computer program, not the service of installing and providing access to a computer program); *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986) (term that merely identifies computer program used in rendering services does not function as a mark to identify market analysis services). However, it is important to review the record carefully to determine the manner of use of the mark and the impression it is likely to make on purchasers.

[I]n today's commercial context if a customer goes to a company's website and accesses the company's software to conduct some type of business, the company may be rendering a service, even though the service utilizes software. Because of the ... blurring between services and products that has occurred with the development and growth of web-based products and services, it is important to review all the information in the record to understand both how the mark is used and how it will be perceived by potential customers.

In re Ancor Holdings, 79 USPQ2d 1218, 1221 (TTAB 2006) (INFOMINDER found to identify reminder and scheduling services provided via the Internet, and not just software used in rendering the services).

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In accordance with the directive in *Ancor Holdings*, we reviewed (and now review again) the evidence regarding Petitioner's use of JOBDIVA as a service mark for "personnel placement and recruitment," paying particular attention to the evidence referenced by Petitioner in the Request for Reconsideration. We looked for evidence that Petitioner was rendering "personnel placement and recruitment services" for others rather than merely providing a software solution for clients to use in performing their "personnel placement and recruitment" activities.

Petitioner confuses the service of providing a software solution for personnel placement and recruitment with actually rendering personnel placement and recruitment services. There is simply no testimony or evidence that supports Petitioner's claim that it is rendering "personnel placement and recruitment" as an activity other than by providing "personnel placement and recruitment" software. The references on Petitioner's web sites show that Petitioner is supplying "personnel placement and recruitment" software, not that Petitioner itself is rendering "personnel placement and recruitment" services for others. Also, the testimony referenced by Petitioner in its Request for Reconsideration is taken out of context and does not support Petitioner's claim that it is rendering "personnel placement and recruitment" services for others separate and apart from providing its software. The references discussed below are illustrative.¹¹

¹¹ While we have not referenced every citation to the record by Petitioner in this decision, we have reviewed the evidence and we find that there is no evidence that shows Petitioner rendering "personal placement and recruitment."

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With respect to Obeid testimony Exhibit No. 2, an excerpt from Petitioner's website used by Petitioner for demonstrations,¹² Diya Obeid, Petitioner's Chief Executive Officer, testified as follows regarding the functionality of the **JobDiva** system:

JobDiva aggregates resumes for its clients, employers, from the job boards . . . they apply to job boards to source candidates and that is usually a manual exercise," but JobDiva can "search the job board's sites and databases for candidates on behalf of employers who are subscribing to these job boards, so it's almost like an outsource function that JobDiva performs in the recruiting process.¹³

However, Exhibit 2 does not provide any evidence that Petitioner renders "personnel placement and recruitment services" other than by providing the software that performs those functions. As noted above, Mr. Obeid during his testimony deposition was discussing the capabilities of Petitioner's *software* not the rendering of "personnel placement and recruitment" services by Petitioner.

Petitioner also references another version of its website introduced through a notice of reliance.¹⁴ In the section regarding "New Job Requisitions," Petitioner's website states that "JobDiva offers a data-rich Job screen that's easy to set up and loaded with unique features designed to minimize administrative work and maximize recruiters' time."¹⁵ From the webpage "Benefit from Ongoing Electronic Sourcing of Candidates" Petitioner, in the Request for Reconsideration, references

¹² 82 TTABVUE 22.

¹³ 82 TTABVUE 25.

¹⁴ 90 TTABVUE.

¹⁵ 90 TTABVUE 31.

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the following quote: “[JobDiva’s] harvesters are constantly sourcing from job boards. They’ll be searching based on your specific criteria of all jobs.”¹⁶ The full text of the webpage is shown below:

9. Benefit from Ongoing Electronic Sourcing of Candidates

When you first open a job and launch a search in JobDiva, you aren’t searching from scratch.

JobDiva’s harvesters have built your company an extensive database of potential candidates who matched prior jobs.

The harvesters are constantly sourcing from job boards. They’ll be searching based on your specific criteria of all jobs.

They’ll also be searching based on ‘evergreen criteria’ – criteria not associated with an open job but instead skills that recruiting managers have set as always relevant to your staffing needs.

Petitioner’s “harvesters” are functions or capabilities of the **JobDiva** software, not activities performed by Petitioner for the purpose of offering “personnel placement and recruitment services” for others. In the webpages about “Job Harvesting,” Petitioner explains that its “harvesters run silently in the background to create a rich database of candidates for your company to draw on.”¹⁷

More than any other Applicant Tracking System, JobDiva automates hunting, sourcing, data maintenance and other tedious aspects of the recruiting workflow, so that your recruiters won’t even notice there is a workflow.

They can now focus exclusively on the industry’s most important activity: speaking to the most suitable candidates, whom JobDiva’s searches produce quickly and

¹⁶ 90 TTABVUE 58.

¹⁷ 90 TTABVUE 80.

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in abundance, so that they can beat the competition again and again.¹⁸

* * *

JobDiva's harvesters scrape resumes which meet that set criteria.

JobDiva then parses the resumes and automatically sets up searchable electronic candidate files.¹⁹

The full text of the website makes clear that Petitioner is referring to the capabilities of its software system used in the field of "personnel placement and recruitment services."

As noted above, there is no testimony or evidence that supports Petitioner's claim that it is rendering "personnel placement and recruitment" as an independent activity distinct from providing its software to others.

Decision: The request for reconsideration is denied.

¹⁸ 90 TTABVUE 82.

¹⁹ 90 TTABVUE 84.