

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86746479
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86746479/large
LITERAL ELEMENT	JOBSIGHT
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>According to the Final Office Action "'A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services.' In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP ?1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. In re The Chamber of Commerce of the U.S., 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP ?1209.01(b); see In re Oppedahl & Larson LLP, 373 F.3d at 1173, 71 USPQ2d at 1371." With respect to the prospective mark at issue, the mark does not describe any significant function, attribute, or property of the applicant's goods or services - indeed, the mark likely doesn't even describe any non-significant aspects. The applicant does not contradict that "a 'jobsite' is the place where a construction project takes place." However, the physical location of a particular jobsight has nothing to do with the mark and the related goods/services other than acting as one particular identifier by which particular information may be grouped. Indeed, much of the information aggregated, ordered, and made available;e through the JobSight tool has nothing to do with the job site as a physical location. The identities and associated information of parties like construction lenders, sureties, material suppliers, equipment lessors, and the like are not - as the Office Action states - "some or all of the individuals and companies at work on the 'jobsite.'" These, and other parties, may never set foot on the physical job site. Further, the JobSight tool also aggregates displays information completely unrelated to the physical job site: information related to the sending or receipt of construction notice documents, whether particular parties have "secured" extensions of labor/material on credit, whether liens against the project exist, additional projects that one participant may have with other participants, etc. Building a comprehensive data graph of all project participants necessarily includes all applicable parties, whether physically at the job site or not. Providing identifying information of project participants including both those at the physical location and those who never visit the site at all, is not described by JobSight as one would not expect participants unrelated to the physical site at all to be identified by a mark descriptive of only the physical location. Additionally, though, that aspect is only a small aspect of the goods/services to which the mark applies. As described above, the JobSight goods/service related to the mark function more in the financial security space. Understanding whether project participants are in a "secured" position with relation to extensions of labor or materials on credit is crucial to project management completely irrespective of the job site. The fact that the: 1) identity of parties, 2) security status of parties, 3) identity and date of documents sent or filed by parties, and 4) interconnectedness of parties, among other information none of which is necessarily tied to the physical job site, may be related to a particular project does not render the JobSight mark descriptive. A mark that would perhaps be merely descriptive for the JobSight application/tool would be something like: "Project Overview". The Office Action has conflated "jobsite" with "project" and the two are not congruent. The Office Action notes, seemingly as definitive proof, "In other words, the applicant enables users of its application to monitor all of those at work on the jobsite. Because of this, the wording JOBSIGHT is descriptive.". As shown above, however, this is incorrect. To further specify, the JobSight application is not a project management tool in the general sense of construction project management. The JobSight tool is a visibility and financial risk management tool. Applicant makes no argument to contradict that a "novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term." In this case, JobSight is not an intentional misspelling of job site, but rather a portmanteau of "Job" and "Insight" that happens to be a play on words with relation to the physical job site. While the mark JobSight may be descriptive for a product or service that 1) provides actual/physical job site management (as the Office Action erroneously seems to assume this application does: "Because the applicant's system application helps users to manage all those working on a particular</p>	

construction jobsite"), or 2) for a service tied directly to a physical job site, it is NOT descriptive for an internet based non-downloadable system application for enabling financial risk mitigation through data. Notably, other internet-based systems with names much more descriptive than the JobSight mark have been allowed by this Office. For example, DROPBOX "on-line non-downloadable software for uploading, transferring, downloading, storing, and sharing data . . ." is exactly what that mark is defined as by the dictionary: "a secured receptacle into which items . . . can be deposited." JobSight is an online application for the management of project data - not the management of the job site or necessarily the parties on the job site. Accordingly, the mark is not descriptive and should be allowed.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Nathan Budde/
SIGNATORY'S NAME	Nathan Budde
SIGNATORY'S POSITION	Corporate Secretary
SIGNATORY'S PHONE NUMBER	866-720-5436
DATE SIGNED	08/04/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Thu Aug 04 14:57:38 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XX-20 160804145738660853-867464 79-550dc16d42653b34dfa5b4 2d695aa3cc84a57f8118b8a56 1c72965e5580f8b860-N/A-N/ A-20160804135333279793

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PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86746479** JOBSIGHT(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86746479/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

According to the Final Office Action "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. In re The Chamber of Commerce of the U.S., 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see In re Oppedahl & Larson LLP, 373 F.3d at 1173, 71 USPQ2d at 1371." With respect to the prospective mark at issue, the mark does not describe any significant function, attribute, or property of the applicant's goods or services - indeed, the mark likely doesn't even describe any non-significant aspects. The applicant does not contradict that "a 'jobsite' is the place where a construction project takes place." However, the physical location of a particular jobsight has nothing to do with the mark and the related goods/services other than acting as one particular identifier by which particular information may be grouped. Indeed, much of the information aggregated, ordered, and made available;e through the JobSight tool has nothing to do with the job site as a physical location. The identities and associated information of parties like construction lenders, sureties, material suppliers, equipment lessors, and the like are not - as the Office Action states - "some or all of the individuals and companies at work on the 'jobsite.'" These, and other parties, may never set foot on the physical job site. Further, the JobSight tool also aggregates displays information completely unrelated to the physical job site: information related to the sending or receipt of construction notice documents, whether particular parties have "secured" extensions of labor/material on credit, whether liens against the project exist, additional projects that one participant may have with other participants, etc. Building a comprehensive data graph of all project

participants necessarily includes all applicable parties, whether physically at the job site or not. Providing identifying information of project participants including both those at the physical location and those who never visit the site at all, is not described by JobSight as one would not expect participants unrelated to the physical site at all to be identified by a mark descriptive of only the physical location. Additionally, though, that aspect is only a small aspect of the goods/services to which the mark applies. As described above, the JobSight goods/service related to the mark function more in the financial security space. Understanding whether project participants are in a "secured" position with relation to extensions of labor or materials on credit is crucial to project management completely irrespective of the job site. The fact that the: 1) identity of parties, 2) security status of parties, 3) identity and date of documents sent or filed by parties, and 4) interconnectedness of parties, among other information none of which is necessarily tied to the physical job site, may be related to a particular project does not render the JobSight mark descriptive. A mark that would perhaps be merely descriptive for the JobSight application/tool would be something like: "Project Overview". The Office Action has conflated "jobsite" with "project" and the two are not congruent. The Office Action notes, seemingly as definitive proof, "In other words, the applicant enables users of its application to monitor all of those at work on the jobsite. Because of this, the wording JOBSIGHT is descriptive.". As shown above, however, this is incorrect. To further specify, the JobSight application is not a project management tool in the general sense of construction project management. The JobSight tool is a visibility and financial risk management tool. Applicant makes no argument to contradict that a "novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term." In this case, JobSight is not an intentional misspelling of job site, but rather a portmanteau of "Job" and "Insight" that happens to be a play on words with relation to the physical job site. While the mark JobSight may be descriptive for a product or service that 1) provides actual/physical job site management (as the Office Action erroneously seems to assume this application does: "Because the applicant's system application helps users to manage all those working on a particular construction jobsite"), or 2) for a service tied directly to a physical job site, it is NOT descriptive for an internet based non-downloadable system application for enabling financial risk mitigation through data. Notably, other internet-based systems with names much more descriptive than the JobSight mark have been allowed by this Office. For example, DROPBOX "on-line non-downloadable software for uploading, transferring, downloading, storing, and sharing data . . ." is exactly what that mark is defined as by the dictionary: "a secured receptacle into which items . . . can be deposited." JobSight is an online application for the management of project data - not the management of the job site or necessarily the parties on the job site. Accordingly, the mark is not descriptive and should be allowed.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Nathan Budde/ Date: 08/04/2016

Signatory's Name: Nathan Budde

Signatory's Position: Corporate Secretary

Signatory's Phone Number: 866-720-5436

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either: (1) the owner/holder ; or (2) a person(s) with legal authority to bind the owner/holder; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86746479

Internet Transmission Date: Thu Aug 04 14:57:38 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XX-20160804145738660

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