

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

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Mailed: October 5, 2011

**Opposition No. 91198027**  
**(parent case)**

AmeriCareers LLC

v.

Internet Employment Linkage,  
Inc.

**Cancellation No. 92052698**

Internet Employment Linkage,  
Inc.

v.

AmeriCareers LLC

Before Bergsman, Ritchie and Shaw,  
Administrative Trademark Judges.

By the Board:

Opposition No. 91198027

Americareers, LLC ("Americareers") opposes registration of the following two applications filed by Internet Employment Linkage, Inc. d/b/a HigherEdJobs ("IEL"):  
Application Serial No. **77950843**<sup>1</sup> for the mark **HigherEdJobs** (standard characters; acquired distinctiveness under Section

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<sup>1</sup> Application filed March 4, 2010, asserting use of the mark in commerce, and asserting for International Classes 35 and 42 a date of first use and date of first use in commerce of December 10, 1996, and for International Class 41 a date of first use and date of first use in commerce of January 29, 2010.

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2(f) claimed), and Application Serial No. **77950871**<sup>2</sup> for the mark



(acquired distinctiveness under Section 2(f) claimed as to "HIGHEREDJOBS"), both for

personnel placement and recruitment services for academic professionals and faculty; providing an on-line searchable database featuring data related to personnel placement and recruiting services, namely, employment candidate information, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty, in International Class 35;

on-line journals, namely, blogs featuring employment news and discussion, in International Class 41; and

providing temporary use of on-line nondownloadable software and applications for finding jobs for academic professionals and faculty, in International Class 42

asserting that the marks are 1) merely descriptive, and 2) generic.

Cancellation No. 92052698

IEL seeks to cancel Registration No. **3666461**,<sup>3</sup> owned by Americareers for the mark **HIGHER ED SPACE** (standard characters) for

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<sup>2</sup> Application filed March 4, 2010, asserting use of the mark in commerce, and asserting for all classes a date of first use and date of first use in commerce of February 28, 2010.

<sup>3</sup> Registration issued August 11, 2009.

on-line computer services, namely, providing a web-based system and online portal for higher education communities with online directories featuring colleges, graduate schools, courses, scholarships, jobs, news, events, classified ads, virtual community and social networking, in International Class 41

on the grounds of fraud on the USPTO, and priority and likelihood of confusion. IEL asserts ownership of:

Registration No. **2688003**<sup>4</sup> for the mark **HIGHEREDJOBS.COM**

(standard characters; acquired distinctiveness under Section 2(f) claimed), and Registration No. **2781127**<sup>5</sup> for the mark



(acquired distinctiveness under Section 2(f) claimed), both for

personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty, in International Class 35;

as well as Application Serial No. **77950843** and Application Serial No. **77950871**, the two applications opposed in Opposition No. 91198027 (see above).

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<sup>4</sup> Registered February 18, 2003; Section 8 declaration accepted and Section 15 declaration acknowledged on June 13, 2008.

<sup>5</sup> Registered November 11, 2003; Section 8 declaration accepted and Section 15 declaration acknowledged on December 29, 2008.

Americareers denied the salient allegations in the petition to cancel, and counterclaimed for cancellation of IEL's pleaded Registration Nos. 2688003 and 2781127 on the ground that the marks are generic.

Cross-motions for Summary Judgment

Americareers moved for summary judgment on its claim of genericness against IEL's two opposed applications, and on its counterclaim of genericness against IEL's two pleaded registrations. In the alternative, it seeks entry of a disclaimer of "HigherEdJobs.com" in application Serial No. 77950871 and Registration No. 2781127.

IEL responded, and filed a cross-motion seeking summary judgment that the design marks (application Serial No. 77950871 and Registration No. 2781127) are not generic as a whole, and that the alternative relief in the form of a disclaimer is unavailable for Registration No. 2781127 inasmuch as it is incontestable.

**AMERICAREERS' MOTION TO STRIKE**

Americareers moved to strike matters submitted by IEL with its response and cross-motion. It seeks to strike: 1) Exhibit 6 (IEL customer testimonials from its website) to the declaration of Andrew Hibel, alleging that IEL intentionally changed the wording "HigherEdJobs.com" in said testimonials to "HigherEdJobs;" and 2) the declaration of

Eric Zack on the basis that IEL did not disclose him in its initial disclosures for either proceeding.

The motion to strike is denied. Regarding IEL's customer testimonials, IEL responds that between 2009 and 2010 it updated its marketing and website materials from "HigherEdJobs.com" to "HigherEdJobs," and that it has begun to return the testimonials to their original form. In any event, IEL offered the testimonials to support its assertion that customers in academia know IEL as a trusted source for employment-related services in higher education; such assertion is unaffected or negligibly affected by a minimal change in the wording by which customers know IEL from "HigherEdJobs.com" to "HigherEdJobs."

Regarding the Zack declaration, Americareers moved for summary judgment only one week after the parties exchanged initial disclosures, IEL did not unequivocally refuse to disclose Zack or refuse to supplement its initial disclosures, and Americareers has delineated no specific substantive basis on which the Board should discredit the declaration.<sup>6</sup> Fed. R. Civ. P. 26(a)(1) does not obligate a party to disclose the name of every witness that may have discoverable information about its claim or defense, but

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<sup>6</sup> To the extent that IEL believes that Mr. Zack has discoverable information that it may use to support its claims or defenses at trial, it must serve a supplemental initial disclosure. See Fed. R. Civ. P. 26(a)(1); TBMP § 401.02 (3d ed. 2011),

merely witnesses having discoverable information that it may use to support its claims or defenses. *See Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 n.1 (TTAB 2009). Moreover, exclusion of the declaration would not alter our conclusion regarding the merits of the cross-motions for summary judgment.

Finally, Americareers requests the Board's review of the matter that IEL redacted in its cross-motion, namely, a portion of Paragraph 26 to the Hibel declaration. Americareers acknowledges that, as a pro se party, provisions of the Board's standard protective order preclude it from viewing matter designated as commercially sensitive.

The redacted matter is objectively commercially sensitive information, and IEL's redaction was not improper or unreasonable, undertaken to shield Americareers from merely confidential information, or undertaken to circumvent Trademark Rules 2.27(d) and (e). Moreover, the two sentences at issue are the only matter that IEL filed under seal; thus, the redaction is minimal and judicious. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011). Finally, the Board's consideration or exclusion thereof does not alter its ruling herein.

**CROSS-MOTIONS FOR SUMMARY JUDGMENT**

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and

that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c).

Each party carries the burden of proof on its respective motion. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the cross-motions, the function of the Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. See TBMP § 528.01 (3d ed. 2011), and cases cited therein.

Americareers' motion

To prevail on its motion with respect to each of IEL's challenged marks, Americareers must demonstrate that it has standing, and that there is no genuine dispute that the mark refers to the class, genus or category of services in connection with which it is used.<sup>7</sup> See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test

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for determining whether a mark is generic is its primary significance to the relevant public. See Trademark Act §14(3); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). The primary significance of the mark to the relevant public is analyzed by determining

[f]irst, what is the category or class of the goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

*H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*,  
228 USPQ at 530.

A determination of the public's understanding of a mark is based on consideration of the mark as a whole. See *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836-37 (Fed. Cir. 1999). If each constituent word is generic, the combination is generic if the entire formulation does not add any meaning to the otherwise generic mark. See *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009). Evidence of the relevant public's understanding of the mark can be obtained from any competent source, including dictionaries, newspapers, magazines, trade journals and other publications. See *In re*

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<sup>7</sup> The parties' standing to assert their respective claims and counterclaims is not disputed.

*Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

Americareers argues that "higher ed jobs" is a category of jobs in higher education and that IEL's services are rendered in the field of higher education. It submitted the declaration of its President, Dan Ouyang, which introduces the dictionary definitions of "ed" (*n. Informal Education; driver's ed; adult ed.*), "higher education" (*n. Education beyond the secondary level, especially education at the college or university level*), and "job" (*noun 1. Activity pursued as a livelihood, career, employment, occupation. See business*). The declaration also introduces, *inter alia*, current as well as several previous pages from IEL's website showing uses of "higher ed jobs" and "Higher Education Jobs, Jobs in Higher Education - HigherEdJobs.com" for providing job information; third-party websites that use "higher ed jobs" or "higher education jobs" as a category of jobs in higher education; third party websites that use "HigherEdJobs.com," "HigherEdJobs" and similar wording in their URL web addresses; third party websites that use "higher ed jobs" and "higher ed job" to refer to employment or related information or service providers.

IEL argues that the design elements of its marks in Registration No. 2781127 and application Serial No. 77950871 are distinctive. It further argues that Americareers failed to identify either the genus of services, or the relevant public,

at issue with respect to any of IEL's marks, and that these are material issues for trial.<sup>8</sup> With respect to the third-party uses submitted by Americareers, IEL asserts that many, such as uses of "higherredjobs.com" as domain names or otherwise, are potentially infringing uses against which IEL has taken or is taking corrective policing action; that many third parties mistakenly use "Higher Ed Jobs" (with spacing) to identify IEL; and that uses of "higher ed jobs" in a non-trademark sense to describe employment in higher education are permissible uses and do not indicate genericness of IEL's marks when used in connection with IEL's services. It further asserts that many third-party uses are by non-competitors and are for services

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<sup>8</sup> IEL offers that the genus of services is:  
providing online services in the nature of personnel placement and recruitment services, job search services and related software for posting employment opportunities, reviewing candidate information and searching for employment opportunities, as well as employment-related information and blogs for academic professionals and faculty in the field of post-secondary education,

and that the relevant public is:  
employers in the field of post-secondary education and academic professionals and faculty seeking jobs in post-secondary education. (brief, p. 5)

In its reply, Americareers states that the genus of services is "jobs and career information and services in higher education" (reply brief, p. 2), and that the relevant public "includes employers in higher education institutions (i.e. colleges and universities), job seekers interested in working in colleges and universities, and others who may be interested in higher education jobs and career information in general" (reply brief, p. 3).

Thus, it appears that the parties dispute considerations directly relevant to the test to be applied, as well as (as discussed further below) the reliability of and value of the evidence submitted on summary judgment and the factual conclusions that can be drawn therefrom.

unrelated to those offered by IEL, and that many are outside the United States. IEL argues that it has used its marks since 1996, that it has claimed acquired distinctiveness (the sufficiency of which Americareers does not dispute), and that the marks are recognized by the relevant public, which includes its own competitors, "as a trusted source for employment-related services in the field of higher education" (brief, p. 14).

IEL submitted the declaration of COO and Co-Founder Andrew Hibel, stating, *inter alia*, that IEL offers a variety of services, that those in academia recognize IEL as a trusted source for employment-related services in the field of higher education, and that many of the third-party uses of "higher ed" and "higher education" offered by Americareers are not use by competitors and offer services different from those provided by IEL. The Hibel declaration also introduces excerpts from 75 customer testimonials (Hibel Decl, Exh. 6). IEL also submitted the declaration of Eric Zack, former Director of a competitor of IEL, stating, *inter alia*, that IEL and its competitors do not provide "higher ed jobs," that they do not identify themselves as a "higheredjobs.com" or a "higher ed jobs dot-com," and that the wording does not name a specific type of job or job services in the higher education field.

After reviewing the parties' arguments and submissions, and viewing the evidence in the light most favorable to IEL

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as the nonmoving party, with respect to the word marks in Registration No. 2688003 (HIGHEREDJOBS.COM) and application Serial No. 77950843 (HigherEdJobs), the Board finds that genuine disputes of material fact exist as to the genus of the services, the relevant public for those services and whether the relevant public perceives HigherEdJobs and/or HigherEdJobs.com as a generic term.

Inasmuch as Americareers has not met its burden of establishing that there is no genuine dispute of material fact that the challenged marks are generic, its motion for summary judgment is denied.

IEL's cross-motion

With respect to the marks in IEL's application Serial No. 77950871 (HIGHEREDJOBS and design) and Registration No. 2781127 (HIGHEREDJOBS.COM and design), to prevail on its cross-motion, IEL must demonstrate that there is no genuine dispute that the marks are not generic.

Trademark Act Section 14(3) only provides for a claim of genericness where the mark as a whole is generic. See *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007). A mark that includes a design element cannot be generic as a whole if the design element is not generic. Thus, the claim that a mark is generic for the goods or services, or a portion thereof, is unavailable where it is clear that the mark is composed of a design

element and is not generic as a whole. See *Montecash LLC v. Anzar Enterprises Inc.*, 95 USPQ2d 1060, 1062-63 (TTAB 2010).

The marks in both of IEL's design marks include the same design, which IEL identifies in application Serial No. 77950871 as "a downwardly curved arrow pointing from above the 'I' in 'Higher' to above the 'J' in 'Jobs.'"

Americareers does not challenge the design element of these marks as being generic; it simply does not address the design element in its motion.

The Board finds that the design element in each of the two marks is distinctive. Accordingly, neither of IEL's design marks is generic as a whole.

With respect to the alternative relief of entry of a disclaimer of HIGHEREDJOBS in IEL's design mark in application Serial No. 77950871, as noted above, whether the wording is generic remains an issue for trial. Accordingly, the alternative relief is denied.

With respect to the alternative relief of entry of a disclaimer of HIGHEREDJOBS.COM in IEL's design mark in Registration No. 2781127, said registration is incontestable, and as noted, the mark is not generic as a whole. Thus, Americareers cannot cancel this mark on the alternative ground that a portion of it is generic and the purportedly generic wording has not been disclaimed. See Trademark Act Section 14(3); *Finanz St. Honore, B.V. v.*

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*Johnson & Johnson*, 85 USPQ2d at 1480; *Montecash LLC v. Anzar Ent. Inc.*, 95 USPQ2d at 1063.

In view thereof, IEL has demonstrated that it is entitled to judgment as a matter of law with respect to Americareers' 1) claim of genericness against application Serial No. 77950871 in Opposition No. 91198027, and 2) counterclaim of genericness against Registration No. 2781127 in Cancellation No. 92052698. Accordingly, IEL's cross-motion for summary judgment is granted, the counterclaim and request for entry of a disclaimer against Registration No. 2781127 on the ground of genericness are dismissed, and the opposition against application Serial No. 77950871 on the ground of genericness is dismissed.<sup>9</sup> With respect to application Serial No. 77950871, Americareers may pursue the alternative relief it seeks, in Opposition No. 91198027, in the form of entry of a disclaimer.

#### **SCHEDULE**

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<sup>9</sup> To the extent that the Board has denied summary judgment, the evidence submitted in connection with the cross-motions is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, e.g., *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Also, the fact that we have identified certain issues in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

Proceedings are hereby resumed. Initial disclosure, discovery, and trial dates are reset as follows:<sup>10</sup>

Initial Disclosures Due	November 10, 2011
Expert Disclosures Due	April 30, 2012
Discovery Closes	May 30, 2012
<b>Americareers/91198027 and IEL/92052698</b> (Plaintiff's) Pretrial Disclosures	July 14, 2012
30-day testimony period for <b>Americareers/91198027 and IEL/92052698</b> (plaintiff's) testimony to close	August 28, 2012
<b>IEL/91198027 and Americareers/92052698</b> <b>and Americareers/92052698 counterclaim</b> (Defendant/Counterclaim Plaintiff's) Pretrial Disclosures	September 12, 2012
30-day testimony period for <b>IEL/91198027 and Americareers/92052698</b> <b>and Americareers/92052698 counterclaim</b> (defendant and plaintiff in the counterclaim) to close	October 27, 2012
<b>IEL/92052698 counterclaim and</b> <b>Americareers/91198027 and IEL/92052698</b> (Counterclaim Defendant's and Plaintiff's) Rebuttal Disclosures Due	November 11, 2012
30-day testimony period for <b>IEL/92052698 counterclaim</b> (defendant in the counterclaim), and 15-day rebuttal testimony for <b>Americareers/91198027 and</b> <b>IEL/92052698</b> (plaintiff) to close	December 26, 2012
<b>Americareers/92052698 counterclaim</b> (Counterclaim Plaintiff's) Rebuttal Disclosures Due	January 10, 2013
15-day rebuttal period for <b>Americareers/92052698 counterclaim</b> (plaintiff in the counterclaim) to close	February 9, 2013

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<sup>10</sup> From this point forward, any motion or stipulation filed in these consolidated proceedings to extend or suspend must include a proposed schedule, as appropriate, in the manner as set forth above.

BRIEFS SHALL BE FILED AS FOLLOWS (See Trademark Rule 2.128):

Brief for **Americareers/91198027 and IEL/92052698** (plaintiff) due April 10, 2013

Brief for **IEL/91198027, Americareers/92052698, Americareers/92052698 counterclaim** (defendant and plaintiff in the counterclaim) due May 10, 2013

Brief for **IEL/92052698 counterclaim** (defendant in the counterclaim), and reply brief, if any, for **Americareers/91198027 and IEL/92052698** (plaintiff) due June 9, 2013

Reply brief, if any, for **Americareers/92052698 counterclaim** (plaintiff in the counterclaim) due June 24, 2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.