

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87032627
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87032627/large
LITERAL ELEMENT	E4SCORE TRACKASSURED
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.
ADDITIONAL STATEMENTS SECTION	
MISCELLANEOUS STATEMENT	<p>REMARKS The specimen of record (a screen shot of a login screen for the services), submitted in support of services in Class 35 and Class 42, was deemed acceptable for Class 42 (Providing a web site featuring non-downloadable software that enables shippers and carriers of freight to monitor performance of carriers and monitor the status and location of shipments, and which enables collaboration between participants in a supply community) but not for the services in Class 35 (freight management support services) and therefore registration has again been refused in relation to the Class 35 services. The Applicant respectfully requests reconsideration of the refusal of registration because as shown below, it is well-established that a login screen that does not specifically refer to services can nonetheless be an adequate specimen for services, even for services outside of class 42. Also, as discussed below, it has been recognized that services outside of class 42 can be provided by means of providing software that provides the services. The acceptability of a login screen as a specimen for services that are not mentioned by the specimen and are not in Class 42 is recognized in the TMEP at 1301.04(h)(iv)(B) Title or Launch Screens, which addresses but is not limited to online entertainment services, and which states: "A title or launch screen is an on-screen graphic typically displayed at the beginning of entertainment content, such as video games or ongoing television programs, often with other information about the content featured. For services such as Class 41 entertainment services involving the provision, production, or distribution of entertainment content, screenshots of title or launch screens from the content may create the requisite direct association between the mark and the services. Thus, title or launch screens may be acceptable specimens as long as their nature as such is clear either from the overall look and feel of the specimen or from the applicant's description of the specimen." The Applicant points out that Applicant's Class 35 services are provided in a manner that is analogous to online entertainment services, i.e., the services are provided after a customer logs onto the service. Accordingly, the specimen of record, a login screen for access to online software, is comparable to a title or launch screen for online entertainment services referred to in the quoted TMEP passage. Therefore, together with the description of the specimen, is acceptable to show use of the mark with the Freight management support services etc. recited in the application because, as stated in the TMEP, "it places the mark in the context of how the services are rendered." Id. The secondary assertion that "The fact that applicant provides a non-downloadable software for</p>

shipping and/or freight management [the Class 42 services] does not constitute providing Class 035 services" is likewise traversed. The logic of this secondary assertion mirrors the logic of the TTAB in Cancellation No. 92050828, JobDiva, Inc. v. Jobvite, Inc. (April 16, 2015), which was overturned on appeal in a precedential ruling by the Federal Circuit Court of Appeals. The TTAB had accepted the assertion that the registrant JobDiva, which demonstrated that it provided a personnel placement and recruitment software application, had not rendered the "personnel and recruitment services" recited in its registration. The Board said that "Petitioner [registrant JobDiva] confuses the service of providing a software solution for personnel placement and recruitment with actually rendering . [the] services," and concluded that the mark in question was not used with the services. However, the Federal Circuit flatly rejected such reasoning and recognized "software as services" in the registrant's appeal from the Board's decision. See In re JobDiva, Inc. Fed. Cir. No. 2015-1960 (December 12, 2016)(precedential) (attached). The Court ruled that the TTAB wrong even if the registrant did only provide software, because providing access to such software could also be a way of providing services provided by the software. That is the situation here: the Applicant provides the recited services in Class 35 by way of software which users access online. For additional information about the services, Applicant provides herewith the following informational material relating to the services being provided by way of granting access to the software via the login screen shown in the specimen. For the foregoing reasons, Applicant respectfully requests reconsideration of the refusal of registration.

MISCELLANEOUS FILE NAME(S)	
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SIGNATURE SECTION	
RESPONSE SIGNATURE	/Frederick A. Spaeth/
SIGNATORY'S NAME	Frederick A. Spaeth
SIGNATORY'S POSITION	Attorney of record, Connecticut bar member
SIGNATORY'S PHONE NUMBER	203-220-8496
DATE SIGNED	03/17/2017
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Mar 17 20:31:16 EDT 2017
TEAS STAMP	USPTO/REFR-XX.XX.XX.XX-201 70317203116419560-8703262 7-5809fea3677a13eca178f66 9330939c72c0aa5fa1c493aaf 76af14a1564f7198ae-N/A-N/ A-20170317202856288540

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Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **87032627** E4SCORE TRACKASSURED(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87032627/large>) has been amended as follows:

ADDITIONAL STATEMENTS

Miscellaneous Statement

REMARKS The specimen of record (a screen shot of a login screen for the services), submitted in support of services in Class 35 and Class 42, was deemed acceptable for Class 42 (Providing a web site featuring non-downloadable software that enables shippers and carriers of freight to monitor performance of carriers and monitor the status and location of shipments, and which enables collaboration between participants in a supply community) but not for the services in Class 35 (freight management support services) and therefore registration has again been refused in relation to the Class 35 services. The Applicant respectfully requests reconsideration of the refusal of registration because as shown below, it is well-established that a login screen that does not specifically refer to services can nonetheless be an adequate specimen for services, even for services outside of class 42. Also, as discussed below, it has been recognized that services outside of class 42 can be provided by means of providing software that provides the services. The acceptability of a login screen as a specimen for services that are not mentioned by the specimen and are not in Class 42 is recognized in the TMEP at 1301.04(h)(iv)(B) Title or Launch Screens, which addresses but is not limited to online entertainment services, and which states: "A title or launch screen is an on-screen graphic typically displayed at the beginning of entertainment content, such as video games or ongoing television programs, often with other information about the content featured. For services such as Class 41 entertainment services involving the provision, production, or distribution of entertainment content, screenshots of title or launch screens from the content may create the requisite direct association between the mark and the services. Thus, title or launch screens may be acceptable specimens as long as their nature as such is clear either from the overall look and feel of the specimen or from the applicant's description of the specimen." The Applicant points out that Applicant's Class 35 services are provided in a manner that is analogous to online entertainment services, i.e., the services are provided after a customer logs onto the service. Accordingly, the specimen of record, a login screen for access to online software, is comparable to a title or launch screen for online entertainment services referred to in the quoted TMEP passage. Therefore, together with the description of the specimen, is acceptable to show use of the mark with the Freight management support services etc. recited in the application because, as stated in the TMEP, "it places the mark in the context of how the services are rendered." Id. The secondary assertion that "The fact that applicant provides a non-downloadable software for shipping and/or freight management [the Class 42 services] does

not constitute providing Class 035 services" is likewise traversed. The logic of this secondary assertion mirrors the logic of the TTAB in Cancellation No. 92050828, JobDiva, Inc. v. Jobvite, Inc. (April 16, 2015), which was overturned on appeal in a precedential ruling by the Federal Circuit Court of Appeals. The TTAB had accepted the assertion that the registrant JobDiva, which demonstrated that it provided a personnel placement and recruitment software application, had not rendered the "personnel and recruitment services" recited in its registration. The Board said that "Petitioner [registrant JobDiva] confuses the service of providing a software solution for personnel placement and recruitment with actually rendering . [the] services," and concluded that the mark in question was not used with the services. However, the Federal Circuit flatly rejected such reasoning and recognized "software as services" in the registrant's appeal from the Board's decision. See *In re JobDiva, Inc.* Fed. Cir. No. 2015-1960 (December 12, 2016)(precedential) (attached). The Court ruled that the TTAB wrong even if the registrant did only provide software, because providing access to such software could also be a way of providing services provided by the software. That is the situation here: the Applicant provides the recited services in Class 35 by way of software which users access online. For additional information about the services, Applicant provides herewith the following informational material relating to the services being provided by way of granting access to the software via the login screen shown in the specimen. For the foregoing reasons, Applicant respectfully requests reconsideration of the refusal of registration.

Original PDF file:

[mis-73898252-20170317195426761223 . Jobdiva Fed Cir 2016.pdf](#)

Converted PDF file(s) (12 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

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[Miscellaneous File7](#)

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[mis-73898252-20170317195426761223 . SE29_Sales_Sheet - TrackAssured_9.26.2016_.pdf](#)

Converted PDF file(s) (1 page)

[Miscellaneous File1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Frederick A. Spaeth/ Date: 03/17/2017

Signatory's Name: Frederick A. Spaeth

Signatory's Position: Attorney of record, Connecticut bar member

Signatory's Phone Number: 203-220-8496

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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

Serial Number: 87032627

Internet Transmission Date: Fri Mar 17 20:31:16 EDT 2017

TEAS Stamp: USPTO/RFR-XX.XX.XX.XX-201703172031164195

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United States Court of Appeals for the Federal Circuit

IN RE: JOBDIVA, INC.,
Appellant

2015-1960

Appeal from the United States Patent and Trademark
Office, Trademark Trial and Appeal Board in
No. 92050828.

Decided: December 12, 2016

DANIEL I. SCHLOSS, Greenberg Traurig LLP, New
York, NY, argued for appellant. Also represented by
MASAHIRO NODA.

MARY BETH WALKER, Office of the Solicitor, United
States Patent and Trademark Office, Alexandria, VA,
argued for intervenor Michelle K. Lee. Also represented
by THOMAS W. KRAUSE, CHRISTINA HIEBER.

Before PROST, *Chief Judge*, DYK, and STOLL, *Circuit
Judges*.

STOLL, *Circuit Judge*.

In this trademark case, we must decide whether Job-
Diva, Inc. used its marks in connection with personnel
placement and recruitment services, or whether the

Trademark Trial and Appeal Board correctly held that JobDiva failed to do so because it used its marks on software offerings, without more. The Board required JobDiva to prove that it used its marks on more than just software because its software sales alone could not, in the Board's view, constitute personnel and recruitment services. We disagree with the Board's approach. The proper question is whether JobDiva, through its software, performed personnel placement and recruitment services and whether consumers would associate JobDiva's registered marks with personnel placement and recruitment services, regardless of whether the steps of the service were performed by software. Because the Board must visit that question in the first instance, we vacate its decision and remand for further consideration.

BACKGROUND

I.

On June 8, 2004, the United States Patent and Trademark Office issued Registration No. 2851917 ("the '917 registration") to JobDiva for the service mark JOBDIVA for "personnel placement and recruitment" services. On November 8, 2005, it issued Registration No. 3013235 ("the '235 registration") to JobDiva for the service mark shown below:



for "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." J.A. 498; *see also* J.A. 52–53.

JobDiva uses its trademarks in connection with its product and service offerings, which its website describes as “the largest, ultimate, full service solution for the staffing industry with an extensive suite of products & tools, front to back end, covering all staffing needs.” J.A. 117. JobDiva offers, in the words of its Chief Executive Officer, “an applicant tracking system for recruiting departments, [and] for HR departments seeking to staff people.” J.A. 212. JobDiva uses software to automatically provide these offerings to clients.

JobDiva’s software generally provides a database of employment applications that a hiring manager or recruiter might use to fill a job opening. J.A. 223. The software performs multiple functions to facilitate this job-filling process. It employs automated “harvesters” to find potential job candidates by automatically scraping job boards and aggregating relevant resumes. J.A. 223, 461–63. And it reviews and analyzes job candidates’ resumes to determine if any candidate’s qualifications match the job’s requirements. J.A. 393. It thus “replaces a tedious manual search” previously performed by hiring managers or recruiters. J.A. 462–63. JobDiva also helps hiring managers directly communicate with job candidates. For instance, it permits hiring managers to post job openings in a job candidate portal. J.A. 221. This candidate portal may also be embedded into a company’s website. J.A. 13. The software further assists job candidates by recommending potential openings to the candidates based on skillsets and provides them automated resume feedback. J.A. 221.

In many circumstances, JobDiva renders these offerings on a software-as-a-service, or “SaaS,” basis to its customers. As the Board explained, “Software as a Service (SaaS) leverages software by delivering it over the Internet.” *JobDiva, Inc. v. Jobvite, Inc.*, Cancellation No. 92050828, 2015 WL 3542849, at *1 (T.T.A.B. May 20, 2015) (“*JobDiva Rehearing*”). The Board noted that SaaS

is “also known as cloud computing.” *Id.* at *2. “Cloud computing,” according to the Board, “is defined as ‘computing operations carried out on servers that are accessed through the Internet, rather than on one’s own personal computers.’” *Id.* at *2 (quoting Dictionary of Computer and Internet Terms 434 (11th ed. 2013)). By hosting its software remotely, JobDiva provides its clients a product without the need to download “cumbersome software . . . onto office desktops or laptops.” J.A. 474.

As the Board explained, JobDiva’s SaaS model of software delivery also changes the way that users interact with JobDiva: “The users pay for the computing as a service rather than owning the machines and software to do it.” *JobDiva Rehearing*, 2015 WL 3542849, at *2 (quoting Dictionary of Computer and Internet Terms, *supra*, at 434). Unlike a locally installed software program, which might be downloaded from the Internet or a disk, JobDiva’s software resides on remote servers and customers access it via the Internet.

II.

The Board cancelled JobDiva’s marks in a proceeding that JobDiva originally requested. JobDiva initially petitioned the Board to cancel a registration owned by Jobvite, Inc., which is no longer a party to this case. JobDiva asserted, *inter alia*, a likelihood of confusion between Jobvite’s and JobDiva’s service marks. To establish its claim, JobDiva asserted ownership of its two marks introduced above.

Jobvite counterclaimed, petitioning the Board to cancel JobDiva’s trademark registrations by alleging that JobDiva failed to perform personnel placement and recruitment services. Jobvite requested that the Board cancel the ’917 registration in whole and its ’235 registration in part. Notably, Jobvite did not submit affirmative evidence of abandonment or challenge that JobDiva used

the '235 registration to identify the other services specified in its registration.

A.

The Board granted Jobvite's counterclaim, cancelling the '917 registration in whole and the '235 registration in part. *JobDiva, Inc. v. Jobvite, Inc.*, Cancellation No. 92050828, 2015 WL 2170162 (T.T.A.B. Apr. 16, 2015). The Board explained that under Section 45 of the Trademark Act, "[a] mark shall be deemed to be 'abandoned' . . . [w]hen its use has been discontinued with intent not to resume such use." *Id.* at *7 (quoting 15 U.S.C. § 1125).

The Board started its analysis of JobDiva's use of its marks by defining the scope of JobDiva's registrations for "personnel placement and recruitment" services and consulting dictionary definitions for each word. *Id.* at *6. Combining these definitions, the Board found that "personnel placement and recruitment" meant "that [JobDiva] is finding and placing people in jobs at other companies or providing personnel staffing services for others." *Id.*

To prove its use of the marks in connection with personnel placement and recruitment, JobDiva had submitted screenshots from its website and a declaration of its CEO, Diya Obeid. But the Board found JobDiva's evidence insufficient, explaining that "[t]here [was] no reference . . . to Petitioner's performance of personnel placement and recruitment services other than supplying Petitioner's software." *Id.* The Board concluded that, "[s]ince there is no evidence of use of Petitioner's marks in connection with 'personnel placement and recruitment' services, there has been nonuse for three consecutive years." *Id.* The Board therefore cancelled the '917 registration in whole and amended the '235 registration to delete "personnel placement and recruitment." *Id.*

B.

JobDiva petitioned the Board to reconsider its judgment, arguing 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.’” *JobDiva Rehearing*, 2015 WL 3542849, at *1. The Board again disagreed, finding that JobDiva had failed to prove use of its marks for “personnel placement and recruitment” services.

The Board explained that “[a] term that *only* identifies a computer program does not become a service mark merely because the program is sold or licensed in commerce.” *Id.* at *2. “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.” *Id.* The Board counseled, however, that “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.” *Id.*

The Board found JobDiva’s evidence of use insufficient because JobDiva only provided software, but not additional “personnel placement and recruitment” services. The Board explained that it “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.” *Id.* The Board criticized JobDiva for “confus[ing] the service of providing a software solution for personnel placement and recruitment with actually rendering personnel placement and recruitment services.” *Id.* at *3. The Board repeatedly faulted JobDiva’s evidence as proving only that JobDiva offered software for personnel placement and recruitment, instead of providing that software *in addition* to offering personnel placement and

recruitment services. *Id.* at *3–4. Indeed, the Board required JobDiva to prove that “it is rendering ‘personnel placement and recruitment’ *as an independent activity distinct* from providing its software to others.” *Id.* at *4 (emphasis added).

The Board further made clear that JobDiva did not use the marks for services, even though the software itself could perform the “personnel placement and recruitment” functions. JobDiva’s CEO had testified that JobDiva’s software actually performs personnel placement and recruitment services:

“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.”

Id. at *3 (quoting J.A. 223). The Board dismissed this evidence, however, because the testimony did “not provide any evidence that Petitioner renders ‘personnel placement and recruitment services’ other than by providing the software that performs those functions.” *Id.* Thus, the Board ultimately found that JobDiva had failed to establish “that it is rendering ‘personnel placement and recruitment’ services for others *separate and apart* from providing its software.” *Id.* (emphasis added).

The Board denied JobDiva’s request for reconsideration, and JobDiva appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(B).

DISCUSSION

Section 1(a) of the Lanham Act requires that an application to register a trademark must include “specification of . . . the goods in connection with which the mark is

used.” 15 U.S.C. § 1051(a). The Supreme Court has recognized that “[t]he usages listed in [an] application . . . are critical” because of, *inter alia*, the legal rights that trademark registration conveys. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015). As such, a registrant must use its mark in accordance with goods and services recited in the registration. 15 U.S.C. § 1064(3); *see also* 15 U.S.C. § 1058(b)(1)(B).

A registration may be cancelled on grounds of abandonment when the mark has not been used for the goods or services specified in the registration for at least three years and there is no showing of an intent to resume use of the mark for those goods or services. 15 U.S.C. § 1127; *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1087 (Fed. Cir. 2000). Because service mark registrations are presumed valid, the party seeking cancellation of such registration must “establish[] a prima facie case of abandonment by showing proof of nonuse for three consecutive years.” *On-Line Careline*, 229 F.3d at 1087. Whether a mark has been used to identify a particular service is a question of fact. *In re Advert. & Mktg. Dev., Inc.*, 821 F.2d 614, 621 (Fed. Cir. 1987). Likewise, whether a trademark holder has abandoned its use of a mark is a question of fact. *On-Line Careline*, 229 F.3d at 1087. We review the Board’s legal conclusions de novo and its factual findings for substantial evidence. *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 964 (Fed. Cir. 2015).

We agree with the Board’s initial observation that, with modern technology, the line between services and products sometimes blurs. *See JobDiva Rehearing*, 2015 WL 3542849, at *2. As the Board correctly observed, “[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.” *Id.* (quoting *In re Ancor Holdings*, No. 76213721, 2006 WL 1258813 (T.T.A.B. April 28,

2006)). But a mark used with a web-based offering may equally identify the provision of software, rather than a service. For these reasons, careful analysis is required to determine whether web-based offerings, like those JobDiva provides, are products or services: “[I]t is important,” as the Board properly noted, “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.” *JobDiva Rehearing*, 2015 WL 3542849, at *2.

But while the Board rightly recognized that it is crucial to carefully review the manner of use of the marks and their likely impression on purchasers, *id.*, it nevertheless appeared to apply a bright-line rule requiring JobDiva to show that it performed the “personnel placement and recruitment” services in a way other than having its software perform those services. It stated, for example, that “there is no testimony or evidence that supports [JobDiva’s] claim that it is rendering ‘personnel placement and recruitment’ *as an independent activity distinct* from providing its software to others.” *Id.* at *4 (emphasis added). The Board repeatedly faulted JobDiva for failing to prove that it offered personnel placement and recruitment services *in addition* to its provision of software. *Id.* at *3 (“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.”); *id.* at *4 (“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 holding JobDiva to that standard, the Board erred in its understanding of the law.

Even though a service may be performed by a company’s software, the company may well be rendering a service. For example, in *On-Line Careline*, we held that AOL had used its ONLINE TODAY mark in connection

with services, even though those services were provided by software. 229 F.3d at 1088. AOL had used its mark in connection with software that “provided its users with ‘access’ to its service through on-screen menu items.” *Id.* We affirmed the Board’s finding that AOL used its mark to identify the services described in the registration: “providing access to online computer services offering computer-industry news, commentary and product reviews.” *Id.* We explained that, “[i]n a very literal sense, the subject mark was the designation by which AOL provides users access to the Internet news and information service.” *Id.* At bottom, we recognized that software may be used by companies to provide services. *Id.* Indeed, here the ’235 registration for “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,” remains unchallenged.

To determine whether a mark is used in connection with the services described in the registration, a key consideration is the perception of the user. *See Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1381–82 (Fed. Cir. 2012). The question is whether a user would associate the mark with “personnel placement and recruitment” services performed by JobDiva, even if JobDiva’s software performs each of the steps of the service.¹ In other words,

¹ We note that JobDiva, like any entity, may register its marks to identify both software and services performed by software. 37 C.F.R. § 2.86 (“In a single application for a trademark, service mark, and/or collective mark, an applicant may apply to register the same mark for goods, services, and/or a collective membership organization in multiple classes.”). For example, JobDiva

the question is whether the evidence of JobDiva's use of its marks "sufficiently creates in the minds of purchasers an association between the mark[s] and [JobDiva's personnel placement and recruitment] services." *Ancor Holdings*, 2006 WL 1258813, at *3.

This "is a factual determination that must be conducted on a case-by-case basis," and there are many case-specific factors the Board might examine. *Lens.com*, 686 F.3d at 1381–82. For example, in this case, the Board should consider the nature of the user's interaction with JobDiva when using JobDiva's software, as well as the location of the software host. If JobDiva sells its software to a customer who hosts the software on its own website and a third-party user's interactions appear to be with the customer (as opposed to JobDiva), it is unlikely that the customer or the third-party user would associate the JOBDIVA mark with a service performed by JobDiva. But if the software is hosted on JobDiva's website such that the user perceives direct interaction with JobDiva during operation of the software, a user might well associate JobDiva's marks with personnel "placement and recruitment" services performed by JobDiva. The purchasers' acquiring ownership in JobDiva's software likely will preclude a finding that JobDiva has rendered services, unless JobDiva's activities after the sale create the perception that JobDiva is in fact providing services.

The ultimate question here is this: whether purchasers would perceive JobDiva's marks to identify "personnel placement and recruitment" services. Because that question is a factual one, the Board must answer it in the first instance.

might use its marks to identify software sold to some customers, but those uses do not somehow negate other uses of the same marks to identify service offerings.

CONCLUSION

Because the Board applied the wrong legal standard, we vacate its judgment and remand for further consideration in light of this opinion.

VACATED AND REMANDED

BEYOND VISIBILITY



Vol 1, Num 1

October 2016

Visibility Fuels Top Rated CPG's Supply Chain Performance across 3PL Network

Transportation, Supply Chain and Customer Service teams make decisions every day about how best to meet their customers' expectations. Two common questions are:

- Will a replenishment shipment arrive in time to fill the customer's order?
- Is the customer's time-sensitive shipment going to arrive on-time and in-spec for temperature?

This White Paper explores how supply chains can achieve shipment visibility in decentralized networks built with third party logistics providers (such as asset based carriers, freight brokers, and/or DC operators) and the far reaching benefits that you can experience through real-time end-to-end supply chain location and condition visibility.

The featured leading global CPG company decided to invest in a cost-effective visibility solution, "e4score TrackAssured", as a part of their "Control Tower" environment. Their focus on visibility helped strengthen their position in the 2016 "Gartner Supply Chain Top 25" where they ranked among the top five for the past three years, out-ranking such highly regarded supply chains as Intel and Amazon.

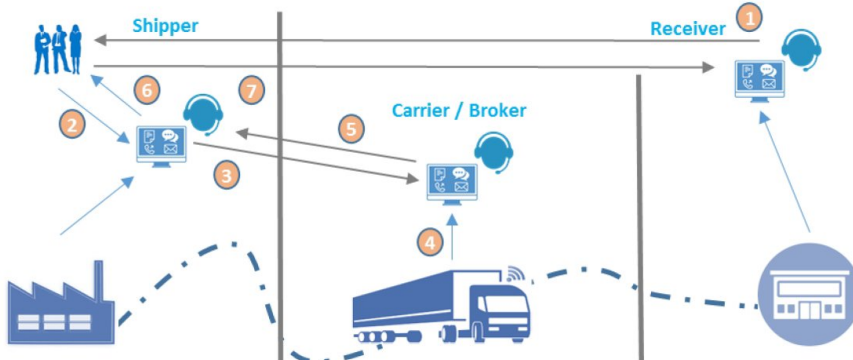
If your business would benefit from a 3-5% improvement in on-time metrics, more efficient factory and DC operations, and increased productivity (more with less), then a few minutes with this White Paper is worth your time.

Real-time Visibility Challenges

For FMCG and CPG companies, actively managing your shipments often exceeds the capabilities of your TMS system and EDI status updates. Current Tracking solutions in a decentralized network are simply not effective. Check calls take too much time (up to 2 hours) to obtain a shipment status that is often incorrect and instantly obsolete. EDI 214 statuses are event-driven (pick-up or delivery) with little, if any, en route status information. Customer Portals are not practicable; they go unused due to the complexity of querying 50+ websites while managing hundreds of shipments a day. Furthermore neither approach provides the temperature condition of the shipment. Frustrated by the lack of timely location and condition information, this leading multi-billion dollar CPG Company began the search for a many-to-many collaborative visibility platform.

"While I had the customer on the phone, I was not only able to confirm their product shippers would be available for pick-up over the weekend...I could advise exactly where they were on their journey to the warehouse..."

- VMI Planner

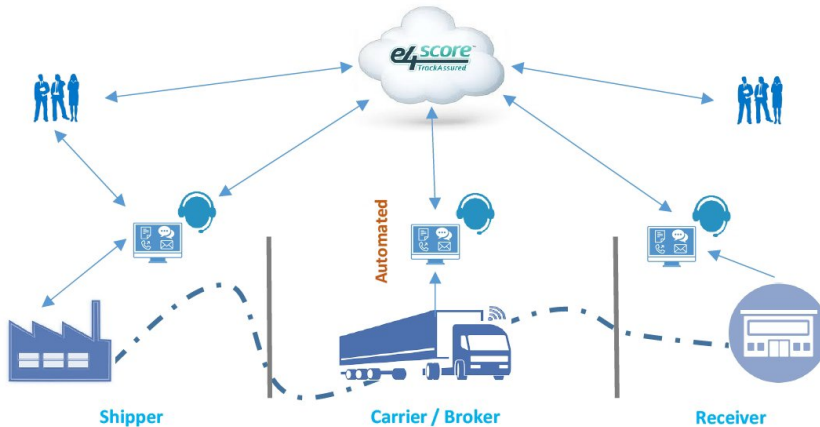


Typical Check Call - Often a 2 hour process

Beyond

- 3-5% On-Time Improvement
- End-to-End Visibility
- Check Calls Eliminated
- Assured Product Condition
- One Truth
- End-of-Period Sales Increase

Leading CPG Automates In-Transit Status Updates using e4score TrackAssured



End-to-End Visibility Arrives with e4score

Since many of their Carriers had already invested in GPS location and temperature monitoring capabilities, the company knew that connecting to existing data in carriers TMS systems would be a more cost-effective approach than adding the cost and process burden of cellular enabled trip recorders.

With a strategic vision for a supply chain "Control Tower" environment, their solution needed to meet a diverse and flexible set of requirements, such as:

- End-to-end visibility (inbound supply, stock movement and customer shipments)
- Multi-modal capability (TL, IM, and LTL)
- Supports any carrier (including broker shipments with small fleets and Owner-Operators)
- Location and Condition (Temperature, Cargo Status) updated every 15 minutes
- Instant Alert notification by e-mail or text.
- Leverage existing data sources in a cloud-based SaaS platform with on-demand 24/7 secure access for both shipper and carrier
- Historical data access and export capabilities to support scorecards

Only one platform met these requirements - **e4score TrackAssured**. After a short Pilot Project validated the premise, the company's carriers were quickly on-boarded. Tracking, condition monitoring, and alerting is now fully automated for over 98% of the company's shipments. Furthermore, the unlimited user access environment set the stage for new and collaborative process innovations.

Results Fuel More Innovation

This leading CPG company is now empowered with true end-to-end visibility of their in-transit supply chain. With track-and-trace and condition visibility of supplier to plant, plant to DC and outbound from DC to customers, they have realized many improvements and laid plans for more in-depth operational collaboration. Notable results include:

- On-time metric improvement of 3-5%
- Order fill improvement with better sequencing of replenishment and customer shipments
- Product quality improved and transit related issues reduced
- Operational efficiency improvements at plants and DC's
- End-of-quarter sales increased by \$3 mm by assuring on-time shipment pick-up
- Pro-active customer service with timely response both internally and externally
- Productivity increases enabled check call reductions of 5 FTEs
- Customer Scorecard performance improvement with on-demand validation
- Carrier-Shipper relations improved through common data source

Having achieved consistent measurable results, this leading CPG company is now expanding their use of the e4score TrackAssured platform to more areas of the business that can leverage the collaborative end-to-end visibility. Additionally they are accelerating the development of new capabilities and are well positioned for FSMA Sanitary Transportation compliance.

For additional information, please contact e4score at: chuck.irwin@e4score.com



Empowered

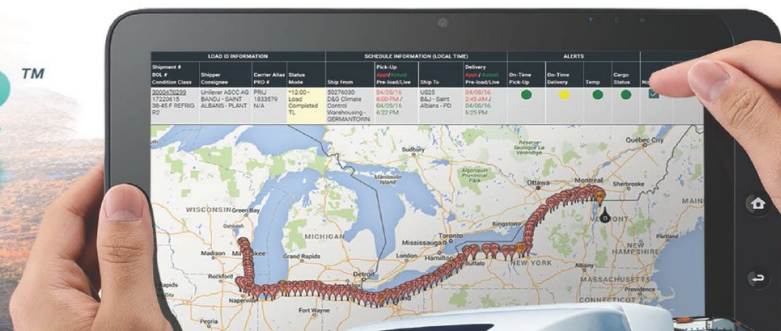
- Unlimited User Access in the CPG company
- Alerting vs. Checking for:
 - ◇ ETA vs. Appointment Time
 - ◇ Temperature vs. Requirements
- Externally Share Shipment Progress



Know load conditions before arrival on your customer's dock

"e4score impacted my work in a positive way because it cut down my track-and-trace work by at least 2-3 hours a day.... by immediately locating and communicating the load status it saved me 2-3 e-mails and several hours for a proper response."

- Distribution Coordinator



FSMA ASSURANCE MADE EASY



REAL-TIME END-TO-END SHIPMENT VISIBILITY

- Temp tracking during pre-cooling and transport, with push Notification of Temp Alerts.
- Full traceability on every shipment - shipper spec, history, images, and corrective actions.

INDUSTRY-BEST FSMA COMPLIANCE

- Comprehensive solution; covers all Sanitary Transportation requirements.
- Complete, secure retention of shipment records fully documents FSMA Compliance.

CONFIDENT, PRODUCTIVE EMPLOYEES

- Can pro-actively act with confidence to resolve potential issues.
- Everything they need to ensure safety and quality.

SATISFIED, CONFIDENT CUSTOMERS

- Full visibility to their in-bound shipments.
- Never a worry - unload with confidence.

EMPOWERED CARRIERS AND BROKERS

- On-demand access to spec ensures they know what's required.
- Fact-based approach enables continuous improvement.



THE **e4score** PLATFORM

FULLY COMPLIANT WITH WHAT GARTNER DEEMS ARE BEST PRACTICES FOR SUPPLY CHAIN VISIBILITY - EXECUTION. (1)

SHIPPERS & CARRIERS AUTO-UPLOAD SHIPMENT AND TRACKING DATA.

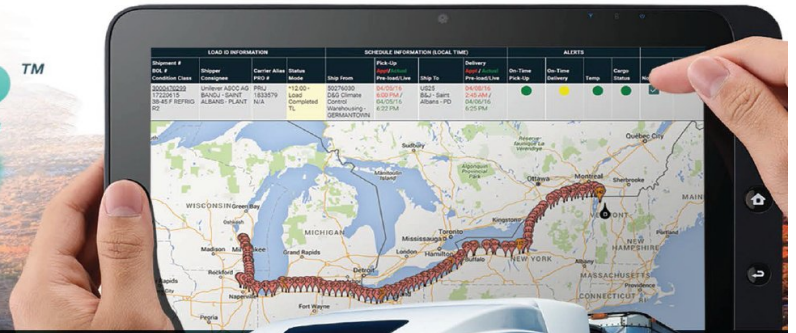
TRACKASSURED™ MERGES THE DATAFEEDS, CALCULATES ALERTS, AND DISPLAYS STATUS.

FULLY INTEGRATES WITH ANY TMS.

Contact e4score TrackAssured: contact@e4score.com / 1-203-533-2524

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(1) GARTNER, AN INDUSTRY PERSPECTIVE ON SUPPLY CHAIN VISIBILITY, 9 JUNE 2016.



Shipment Assurance DELIVERED



WORLD-CLASS SHIPMENT VISIBILITY

- **Comprehensive:** Location, Load Temperature, Shipment Status, ETA & more.
- **Aggregated:** All your carriers on one cloud-based SaaS platform.
- **Real-time:** Dispatch thru pick-up and delivery with instant push alerts.
- **On-Demand:** Track and monitor every shipment, anytime, anywhere.

DRIVE PRODUCTIVITY

- Liberate employees from the hassle of check calls and fire-fighting.
- Manage by exception, focus on alerted shipments.

REDUCE RISK AND CLAIMS

- Industry-best FSMA Compliance. Full traceability vs shipper specification.
- Minimize temperature-related load rejections and reduce costly spoilage claims.
- Secure retention of shipment records.

SATISFIED, TRUSTING CUSTOMERS

- Be the best. Excel on OT and In-Spec performance.
- Resolve issues pro-actively, before the customer calls.

BIG-DATA CONTINUOUS IMPROVEMENT

- Data-driven network operations. No more dueling data.
- Partner with the best. Certify carrier capabilities.



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