

ESTTA Tracking number: **ESTTA685333**

Filing date: **07/23/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	TALENTSOFT		
Entity	societe par actions simpli- fiee (	Citizenship	France
Address	35 Ter, avenue Andr�� Morizet Boulogne Billancourt, F-92100 FRANCE		

Attorney informa- tion	Dean R. Karau, Cynthia A. Moyer Fredrikson & Byron, P.A. 200 South Sixth Street Suite 4000 Minneapolis, MN 55402-1425 UNITED STATES ip@fredlaw.com, dkarau@fredlaw.com, cmoyer@fredlaw.com, lrland@fredlaw.com Phone:6124927178		
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**Applicant Information**

Application No	86521788	Publication date	06/23/2015
Opposition Filing Date	07/23/2015	Opposition Peri- od Ends	07/23/2015
Applicant	ForwardMetrics Corp. 527 Encinitas Blvd. Encinitas, CA 92024 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 042. First Use: 2014/09/15 First Use In Commerce: 2014/12/01 All goods and services in the class are opposed, namely: Application service provider (ASP) featuring software for use in matching job seekers with jobs, including an applicanttracking system and for testing job-related skills and a set of tools used by job seekers to search and apply to relevant jobs; Platform as a service (PAAS) featuring computer software platforms for matching job seekers with jobs, including an applicant tracking system and for testing job-related skills and a set of tools used by job seekers to search and apply to relevant jobs
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3807155	Application Date	02/09/2009
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Registration Date	06/22/2010	Foreign Priority Date	12/08/2008
Word Mark	TALENTSOFT		
Design Mark	<b>TALENTSOFT</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0  Computer software recorded on CD-ROM for use in the field of human re-  sources management; computer software that provides web-based access to  applications and services through a web operating system in the field of human  resources management</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0  Human resources management</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0  Design, development and installations of computer software for human resource  management; computer software consulting in the field of human resources  management</p>		

Attachments	79066630#TMSN.png( bytes ) TalentSoft Notice of Opposition & Attachment.pdf(36494 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dean R. Karau/
Name	Dean R. Karau
Date	07/23/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of

Trademark Serial No.: 86521788  
For the Mark: TALENTSPOT  
Filed: February 2, 2015  
Published: June 23, 2015

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TALENTSOFT,

Opposer,

Opposition No. \_\_\_\_\_

v.

ForwardMetrics Corp.,

Applicant.

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**NOTICE OF OPPOSITION**

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This opposition is made to the application of Applicant, ForwardMetrics Corp, for registration of the mark TALENTSPOT in Application Serial No. 86521788, published on June 23, 2015 (“Applicant’s Mark”). Opposer, TALENTSOFT, believes it will be damaged by the registration of Applicant’s Mark, and hereby opposes the same. As grounds for its opposition, Opposer states and alleges as follows:

1. Opposer is a société par actions simplifiée (sas) organized under the laws of France, with a principal place of business located at 35 Ter, avenue André Morizet, Boulogne Billancourt, France F-92100.

2. On information and belief, Applicant is a corporation organized under the laws of Delaware, with a principal place of business located at 527 Encinitas Blvd., Encinitas, California 92024.

3. Opposer has used its TALENTSOFT trademark in connection with its wide variety of products and services in many countries around the world. Opposer is also the owner of U.S. Registration No. 3807155 for its mark, with a registration date of June 22, 2010, based on a request for an extension of protection of International Registration No. 0997025, filed on February 9, 2009, for the following goods and services:

computer software recorded on CD-ROM for use in the field of human resources management; computer software that provides web-based access to applications and services through a web operating system in the field of human resources management, in International Class 009.

human resources management, in International Class 035.

design, development and installations of computer software for human resource management; computer software consulting in the field of human resources management, in International Class 042.

(“Opposer’s Mark”). The registration is valid and subsisting. A copy of a printout of the TSDR status is attached hereto.

4. On February 2, 2015, Applicant filed an application to register the mark TALENTSPOT, Application Serial No. 86521788, and the mark was published for opposition on June 23, 2015, for International Class 042 services recited as application service provider (ASP) featuring software for use in matching job seekers with jobs, including an applicant tracking system and for testing job-related skills and a set of tools used by job seekers to search and apply to relevant jobs; platform as a service (PAAS) featuring computer software platforms for matching job seekers with jobs, including an applicant tracking system and for testing job-related skills and a set of tools used by job seekers to search and apply to relevant jobs.

5. Opposer's priority date for Opposer's Mark is long before any date of use or constructive date of use by Applicant of Applicant's Mark.

6. Opposer has developed widespread goodwill in Opposer's Mark. By reason of advertising, promotion and other common means used in Opposer's industry, the consuming public recognizes Opposer's Mark and associates Opposer's Mark exclusively with Opposer and its goods and services.

7. Opposer's mark is inherently distinctive and is a strong mark and should be accorded the broad protection given to strong marks.

8. Use by Applicant of Applicant's Mark for which registration is sought in the application opposed herein is likely to cause confusion, mistake or deception as to the source of origin, sponsorship or approval of Applicant's goods in that purchasers or others are likely to believe that Applicant's goods are Opposer's, or are in some way legitimately connected with, licensed by, or approved by Opposer. Use by Applicant of Applicant's Mark for which registration is sought in the application opposed herein has lessened, and will continue to lessen, the capacity of Opposer's Mark to identify and distinguish goods made by Opposer.

9. Use by Applicant of Applicant's Mark for which registration is sought in the application opposed herein, is without Opposer's consent or permission.

10. Applicant's Mark is so similar to Opposer's Mark as to be likely to falsely suggest a connection between Applicant and Opposer.

Please address all communications to Dean R. Karau and Cynthia A. Moyer, Fredrikson & Byron, P.A., 200 South Sixth Street, Suite 4000, Minneapolis, Minnesota 55402-1425.

WHEREFORE, registration by Applicant of the aforesaid trademark for the aforesaid services would be damaging to Opposer.

THEREFORE, Opposer respectfully requests that the application for registration be denied.

Dated: July 23, 2015

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/Dean R. Karau/  
Dean R. Karau  
Cynthia A. Moyer  
FREDRIKSON & BYRON, P.A.  
Suite 4000  
200 South Sixth Street  
Minneapolis, Minnesota 55402-1425  
Tel.: (612) 492-7178/7167  
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dkarau@fredlaw.com  
cmoyer@fredlaw.com

Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the NOTICE OF OPPOSITION was served by United States mail on the correspondent of record for Applicant, Forwardmetrics Corp., by mailing it to the address of record, Forwardmetrics Corp., 527 Encinitas Blvd, Encinitas, CALIFORNIA 92024-3746, by first class mail, postage prepaid, this 23rd day of July, 2015.

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/Dean R. Karau/  
Dean R. Karau

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Mark: TALENTSOFT

TALENTSOFT

US Serial Number: 79066630

Application Filing Date: Feb. 09, 2009

US Registration Number: 3807155

Registration Date: Jun. 22, 2010

Register: Principal

Mark Type: Trademark, Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jun. 22, 2010

Publication Date: Dec. 29, 2009

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## Mark Information

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Mark Literal Elements: TALENTSOFT

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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## Related Properties Information

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International Registration Number: 0997025

International Registration Date: Feb. 09, 2009

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## Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Computer software recorded on CD-ROM for use in the field of human resources management; computer software that provides web-based access to applications and services through a web operating system in the field of human resources management

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 66(a)

**For:** Human resources management

**International Class(es):** 035 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 66(a)

**For:** Design, development and installations of computer software for human resource management; computer software consulting in the field of human resources management

**International Class(es):** 042 - Primary Class

**U.S Class(es):** 100, 101

**Class Status:** ACTIVE

**Basis:** 66(a)

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## Basis Information (Case Level)

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Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: Yes

Currently 66A: Yes

Filed No Basis: No

Currently No Basis: No

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## Current Owner(s) Information

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Owner Name: TALENTSOFT

**Owner Address:** 35 Ter, avenue André Morizet  
F-92100 BOULOGNE BILLANCOURT  
FRANCE

**Legal Entity Type:** UNKNOWN

**State or Country Where Organized:** No Place Where Organized Found

## Attorney/Correspondence Information

### Attorney of Record - None Correspondent

**Correspondent Name/Address:** Dean R. Karau  
Fredrikson & Bryon, P.A.  
200 South Sixth Street  
Suite 4000  
Minneapolis, MINNESOTA 55402-1425  
UNITED STATES

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Feb. 21, 2015	NEW REPRESENTATIVE AT IB RECEIVED	
Apr. 15, 2013	FINAL DECISION TRANSACTION PROCESSED BY IB	
Sep. 27, 2010	FINAL DISPOSITION NOTICE SENT TO IB	
Sep. 27, 2010	FINAL DISPOSITION PROCESSED	68359
Sep. 22, 2010	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Jun. 22, 2010	REGISTERED-PRINCIPAL REGISTER	
May 14, 2010	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Apr. 01, 2010	CHANGE OF NAME/ADDRESS REC'D FROM IB	
Jan. 27, 2010	EXTENSION OF TIME TO OPPOSE RECEIVED	
Dec. 29, 2009	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Dec. 29, 2009	PUBLISHED FOR OPPOSITION	
Nov. 25, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	76243
Nov. 25, 2009	ASSIGNED TO LIE	76243
Nov. 09, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 05, 2009	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 05, 2009	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Nov. 05, 2009	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Nov. 05, 2009	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 29, 2009	REFUSAL PROCESSED BY IB	
May 05, 2009	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
May 05, 2009	REFUSAL PROCESSED BY MPU	67445
May 05, 2009	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
May 04, 2009	NON-FINAL ACTION WRITTEN	81878
Apr. 29, 2009	ASSIGNED TO EXAMINER	81878
Apr. 14, 2009	APPLICATION FILING RECEIPT MAILED	
Apr. 10, 2009	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 09, 2009	SN ASSIGNED FOR SECT 66A APPL FROM IB	

## International Registration Information (Section 66a)

**International Registration Number:** 0997025

**Priority Claimed Flag:** Yes

**Intl. Registration Status:** REQUEST FOR EXTENSION OF PROTECTION PROCESSED

**Notification of** Apr. 09, 2009

**International Registration Date:** Feb. 09, 2009

**Date of Section 67 Priority Claim:** Dec. 08, 2008

**Date of International Registration Status:** Apr. 09, 2009

**Date of Automatic** Oct. 09, 2010



Designation Date:  
International Registration Feb. 09, 2019  
Renewal Date:  
First Refusal Flag: Yes

Protection:

## TM Staff and Location Information

TM Staff Information - None  
File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jun. 22, 2010

## Assignment Abstract Of Title Information

### Summary

Total Assignments: 1

Registrant: TALENTSOFT

### Assignment 1 of 1

Conveyance: No Conveyance Found

Reel/Frame: [4178/0973](#)

Pages: 2

Date Recorded: Apr. 01, 2010

Supporting Documents: [assignment-tm-4178-0973.pdf](#)

### Assignor

Name: [TALENTSOFT](#)

Execution Date: Feb. 02, 2010

Legal Entity Type: UNKNOWN

State or Country Where Organized: FRANCE

### Assignee

Name: [TALENTSOFT](#)

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: 35 TER, AVENUE ANDRÉ MORIZET  
F-92100 BOULOGNE BILLANCOURT, FRANCE

### Correspondent

Correspondent Name: TALENTSOFT

Correspondent Address: 35 TER, AVENUE ANDRÉ MORIZET  
F-92100 BOULOGNE BILLANCOURT  
FRANCE

### Domestic Representative - Not Found

## Proceedings

### Summary

Number of Proceedings: 1

### Type of Proceeding: Extension of Time

Proceeding Number: [79066630](#)

Filing Date: Jan 27, 2010

Status: Terminated

Status Date: May 14, 2010

Interlocutory Attorney:

### Defendant

Name: TALENTSOFT

Correspondent Address: Dean R. Karau  
Fredrikson & Bryon, P.A.  
Suite 4000 200 South Sixth Street  
Minneapolis MN , 55402-1425  
UNITED STATES

### Associated marks

Mark	Application Status	Serial Number	Registration Number
TALENTSOFT	Registered	<a href="#">79066630</a>	<a href="#">3807155</a>

### Potential Opposer(s)

Name: Webplus, Inc.

Correspondent Address: Brett E. Lewis  
Lewis & Hand, LLP  
45 Main Street Suite 818  
Brooklyn NY , 11201  
UNITED STATES

Correspondent e-mail: [brett@lewishand.com](mailto:brett@lewishand.com) , [melissa@lewishand.com](mailto:melissa@lewishand.com)

Prosecution History			
Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Jan 27, 2010	
2	EXTENSION OF TIME GRANTED	Jan 27, 2010	
3	INCOMING - EXT TIME TO OPPOSE FILED	Feb 26, 2010	
4	EXTENSION OF TIME GRANTED	Feb 26, 2010	