
Federal Circuit: Specimen Showing Use of Mark for Software May also Show Use for Services

By Susan Upton Douglass

In re. Jobdiva, Inc., 121 U.S.P.Q. 2d 1122 (Fed. Cir. 2016)

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Registrant, JobDiva, owned registrations for “personnel placement and recruitment,” but submitted as a specimen a web printout showing that it offered software on a platform (SaaS) that allowed subscribers to locate pertinent jobs. *In re. JobDiva, Inc.*, 121 U.S.P.Q. 2d 1122, 1124 (Fed. Cir. 2016). The specimen, which was submitted to the USPTO with the renewal application, looked (in part) like this:

Although the USPTO accepted the specimen, the registrations were challenged in the context of a cancellation petition filed by JobDiva against a third-party registration. The TTAB agreed that the specimen did not show use in commerce for “personnel recruitment and placement,” but rather, only for software. *Id.* The Board noted that there was no reference to the personnel recruitment and placement services on the specimen:

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. 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.”

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.” 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.” The Board therefore cancelled the ’917 registration in whole and amended the ’235 registration to delete “personnel placement and recruitment.”

Id. (citing *JobDiva, Inc. v. Jobvite, Inc.*, Cancellation No. 92050828, 2015 WL 2170162, at *6 (T.T.A.B. Apr. 16, 2015) (internal citations omitted)). On appeal, the Federal Circuit vacated and remanded the Board’s decision for further factual consideration by the Board. *Id.* at 1127. In particular, the Board was faulted for applying a “bright-line” test that the services covered by the registration must be offered and referred to *apart from the software*:

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, 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.” (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 1126 (citing *JobDiva Rehearing*, 2015 WL 3542849, at **2, 4 (T.T.A.B. May 20, 2015) (internal citations omitted)). The Federal Circuit then articulated the correct test for evaluating specimens that refer to services but essentially are software-driven:

At bottom, we recognized that software may be used by companies to provide services.

...

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. 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. In other words, 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.”

Id. (citing *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1381–82 (Fed. Cir. 2012); *Ancor Holdings*, 2006 WL 1258813, at *3 (T.T.A.B. Apr. 28, 2006) (internal citations omitted)). The Court noted that if the software were purchased by the consumer and there was no further contact, this would not likely qualify. *In re JobDiva* at 1126. However, if consumers interact with the software on the software platform, there could well be an association between the trademark owner and the service “performed” by the software:

[I]f 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.

Id. This decision, which is precedential, will be helpful in allowing coverage for many Class 35 services when the trademark owner has SaaS software offered on its platform.

Primary Contacts

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