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

Butler

Mailed: May 10, 2006

Opposition No. 91164326
Opposition No. 91166064

Aquent LLC

v.

Acquient LLC

Before Quinn, Bucher and Kuhlke, Administrative Trademark Judges.

By the Board:

Applicant seeks to register the marks[1]

acquient

and[2]

both for "business consultation in the field of sales, business management services" and "sales training."

[1] Application Serial No. 78342888, filed December 18, 2003 under Trademark Act §1(a), claiming use and use in commerce since August 1, 2001. The mark is in standard character form. This application is the subject matter of Opposition No. 91164326.

[2] Application Serial No. 76568018, filed December 31, 2003 under Trademark Act §1(a), claiming use and use in commerce since August 1, 2001. This application is the subject matter of Opposition No. 91166064.

As grounds for the oppositions, opposer alleges that applicant's marks, when used on the recited services, so resemble opposer's previously used and reqistered marks as to be likely to cause confusion, mistake or to deceive. Opposer pleads ownership of Registration No. 2289555 for the mark AQUENT for "employment contracting and temporary help services; recruitment and placement of computer-skilled personnel on a temporary, contract, or permanent basis; recruitment and placement of information technology specialists on a temporary, contract, or permanent basis; recruitment and placement of graphic artists and multi-media specialists on a temporary, contract, or permanent basis; payroll transfer services; employment information services, namely the provision of employment opportunity information to prospective employees and the provision of resume information to prospective employees, by means of computer, facsimile, telephone, and other communication devices";[3] and Registration No. 2409082 for the mark AQUENT for "computer education training services; educational services, namely, conducting classes, seminars, conferences, and workshops, and distributing course materials in connection therewith, in the fields of computer information networks, multi-media and computer graphics, programming, computer operation and repair, and entrepreneurship and personal business management."[4]

[3] Such registration issued October 26, 1999, claiming use and use in commerce since April 7, 1999. Section 8 affidavit accepted; Section 15 affidavit acknowledged.
[4] Such registration issued November 18, 2000, claiming use and use in commerce since June 1999.

In its answers, applicant admits opposer's claim of ownership of the pleaded registrations; and otherwise denies the salient allegations of the notice of opposition.

This case now comes up on opposer's fully-briefed motion, filed December 23, 2005, for leave to amend the notices of opposition to include an allegation that the involved applications are void ab initio on the ground of fraud;[5] and opposer's fully-briefed motion, also filed December 23, 2006, for summary judgment in its favor only on the fraud ground.

As background to both motions, in each of its applications, applicant initially recited the services as "sales training, recruiting, consulting, and management services." Office Actions issued informing applicant that such recitation was "… too broad because it could include services classified in other classes" and that applicant "… must list each service by its common commercial name." The Examining Attorney suggested three separate, acceptable recitations in two international classes, "if accurate," and further informed applicant that an additional fee would be necessary should applicant adopt the second class.[6] In its responses to the first Office Actions, applicant amended the recitations to "sales training; business consultation in the field of sales; and business management services." The Examining Attorney accepted the wording of the amended recitation but

[5] A copy of the proposed amended notices of opposition accompany the motions.

[6] The Office Actions also informed applicant that no conflicting marks were noted as a result of the Examining Attorney's search; and further required applicant to provide its state of incorporation.

issued Final Office Actions informing applicant that it still recited services in two classes and an additional fee was necessary if applicant chose to proceed with both classes. Applicant, in responses to the Final Office Actions, submitted the additional fee and set forth its single recitation into two separate recitations to reflect the appropriate classification.

In support of its motions to amend the notices of opposition and motions for summary judgment, opposer argues that during the discovery deposition of Ken Wolff, applicant's CEO, opposer found out that applicant never offered the "recruiting" services initially recited in its application. Consequently, opposer submits, applicant committed fraud on the USPTO by falsely stating that the marks were used for the recited recruiting services; that the applications are, thus, void ab initio as a matter of law; and that the oppositions (consolidated on February 4, 2006) should be sustained. More particularly, opposer contends that applicant deleted "recruiting" from its recitations after opposer's counsel wrote to applicant stating that applicant's use of its marks for recruiting services would likely cause confusion with opposer's registered AQUENT mark for the same and related services;[7] that, because applicant filed a use based application reciting "recruiting" when it never offered "recruiting services," applicant committed fraud on the USPTO such that it is not entitled to a registration; and that the

[7] Opposer acknowledges that its letter was sent after the applications were filed but prior to the issuance of the first Office Actions.

later deletion of "recruiting" does not cure the act of fraud. Opposer's motions are accompanied by excerpts from the October 6, 2005 discovery deposition of Mr. Wolff; printed portions of the applications; and a copy of the letter from opposer's counsel to applicant concerning likelihood of confusion.

In its responses to opposer's motions, applicant argues that the parties clearly dispute the meaning of the term "recruiting"; that opposer's characterization of Mr. Wolff's testimony is inaccurate because Mr. Wolff repeatedly testified that, while applicant does not recruit potential candidates/employees for a client, applicant does advise clients about the recruiting process, including how to conduct and benefit from the process. Applicant argues that opposer's counsel never questioned Mr. Wolff about the reason "recruiting" was initially listed in the services; and that applicant does provide recruiting consultation, which is why "recruiting" was included. Instead, applicant argues, opposer's questions were understood to be directed to activities of recruiting of actual candidates and employees, and Mr. Wolff truthfully responded that applicant does not provide such services. Applicant contends that, after receiving the first Office Actions, it concluded that its "recruiting" consultation was related to its "sales training" and, consequently, did not amend its applications to adopt the Examining Attorney's suggested recitation of "personnel recruitment services in the field of sales" because applicant wanted to be clear that it did not provide candidates and

employees for its clients. Thus, applicant argues, the initial inclusion in its applications of the broad term "recruiting" is not a false statement or one made with the intent to deceive.

In reply to its motion to amend, opposer argues that leave to amend the complaint is to be freely given; and that applicant has made no assertion of prejudice. In reply to its motion for summary judgment, opposer argues that it is undisputed that applicant included the term "recruiting" in its original recitation despite the fact that applicant never offered "recruiting services." Opposer argues that applicant's explanation of its intent is "irrelevant and unbelievable" because applicant deleted the term "recruiting" after being contacted by opposer's attorney and after the Examining Attorney informed applicant that such services should be listed separately. Opposer contends that it, applicant and the Examining Attorney all "knew what 'recruiting' services meant"; and that applicant's belated amendment cannot erase its initial fraud.

Once a responsive pleading is served, a party may amend its pleading only with the written consent of the adverse party or by leave of the Board. The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law

or be prejudicial to the rights of the adverse party or parties. *See* Fed. R. Civ. P. 15(a); and TBMP §507.02 (2d ed. rev. 2004).[8]

Accordingly, opposer's motion for leave to file an amended notice of opposition is granted, and the amended notice of opposition is entered into the proceeding.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c). A genuine issue with respect to material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Applicants frequently use broad terms to identify the goods or services when an application is first filed. When the application is based upon Trademark Act §1(a), the requirement for use in connection with all recited services is not necessarily violated by broad identifying terms. Rather, as long as a broad term identifies services that are intended to be

[8] In any event, the Board may make appropriate provisions to ameliorate any potential prejudice.

covered with reasonable certainty, it will be reasonable, from a commercial viewpoint, to consider that the mark has been used for all the related services that fall in the designated group. The Office, though, may require further specificity. *See* TMEP §1402.03 (4th ed. April 2005).

A trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false or misleading. *See Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003), *citing Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484-85 (Fed. Cir. 1986). *See also First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988). Nonetheless, cases involving questions of intent are often said to be unsuited to resolution by summary judgment. *See, e.g., Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Here, opposer has not carried its burden of establishing that no genuine issue of material fact exists with respect to any purported fraud by applicant involving the broad language used in the initial recitation, which included the term "recruiting." The is so because the term as set out was determined to be "too broad" and applicant was required to be more specific by using the "common commercial names" for its "recruiting" services. Moreover, applicant's explanation that it offers consultation that includes recruiting topics is bolstered by the deposition of Mr. Wolff wherein he repeatedly attempts to differentiate between

candidate/employee recruitment, which he acknowledges that applicant does not offer, and advice and consultation on the recruitment process, including advice about hiring in certain positions that applicant offers. Thus, genuine issues of material fact exists with respect to the parties' respective interpretations of the term "recruiting" as used in the original identification and as to applicant's intent to commit fraud.

Accordingly, opposer's motion for summary judgment is denied.

Proceedings are resumed. Applicant is allowed until **thirty days** from the mailing date of this order in which to answer the amended notice of opposition. Discovery closed December 16, 2005. Trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	August 15, 2006
30-day testimony period for party in position of defendant to close:	October 14, 2006
15-day rebuttal testimony period to close:	November 28, 2006

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.l25.

Briefs shall be filed in accordance with Trademark Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided b Trademark y Rule 2.l29.