Mailed: September 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Aleksandar Vujovic

v.

Octop

Opposition No. 91210908
against Serial No. 85727622

Cancellation No. 92058642
against Registration No. 4462654

Todd Winter of Winter LLP,
for Aleksandar Vujovic.

Luke Brean of Breanlaw LLC,
for Octop.

Before Bucher, Lykos and Goodman,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Octop (hereinafter "Applicant" or "Octop"), a California corporation, seeks registration on the Principal Register of the mark **OCTOP** (*in standard character format*) for

> "computer software and hardware design for others; development of computer software applications for others for use in connection with mobile wireless devices, cellular and mobile phones, and other handheld computers and tablets; research, development, design and upgrading of computer software; research and development of new products for others; design and testing of new products for others; design, development, and consulting services related thereto in the fields of digital media, graphic designs and computer graphics and special effects; programming of multimedia applications; development of computer software applications for dedicated gaming consoles," in International Class 42.[1]

Aleksandar Vujovic (hereinafter "Opposer" or "Vujovic"), a California resident, alleges that Applicant's mark so resembles Opposer's previously used mark **OCTOP** for a listing of services including design, development and consulting services in the fields of digital media, graphic designs and computer graphics and special effects, that when used in connection with Applicant's recited services, it is likely to cause confusion, to cause mistake, or to deceive, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).[2] In its answer, Applicant denies the salient allegations of priority and likelihood of confusion in the Notice of Opposition. Applicant also asserts, as affirmative defenses, that Opposer abandoned common law trademark rights when leaving the partnership formed between Opposer and Applicant's principal, Ramona LaFountain, and that as a

[1] Application Serial No. 85727622 was filed on September 12, 2012, based upon Applicant's claim of first use anywhere at least as early as June 7, 2004, and use in commerce since at least as early as September 1, 2009.

[2] Although the Notice of Opposition made various references to fraud on Applicant's part, this ground was not appropriately pleaded and has not been tried, so we deem it waived.

result, Opposer lacks standing to even bring this action; that Opposer's claims are barred by the doctrine of estoppel by acquiescence; and that with the submission his trademark application, Mr. Vujovic committed fraud on the United States Patent and Trademark Office.

Immediately before filing the opposition proceeding at bar, Vujovic also sought registration on the Principal Register of the identical mark **OCTOP** (*also in standard character format*) for the following services:

> "book and review publishing; book publishing; desktop publishing for others; digital video, audio, and multimedia publishing services; electronic desktop publishing; multimedia publishing of books, magazines, journals, software, games, music, and electronic publications; online electronic publishing of books and periodicals; provision of information relating to multimedia publishing; publishing of books, e-books, audio books, music and illustrations; publishing of books, magazines; publishing of electronic publications," in International Class 41; and
>
> "commercial art design; computer graphics design services; computer services, namely, interactive hosting services which allow the user to publish and share their own content and images on-line; consulting in the field of designing games, websites, software applications; design, development, and consulting services related thereto in the field of digital media, graphic design, computer graphics and special effects; graphic illustration services for others; web publishing, namely, creating a website and uploading it onto an Internet server," in International Class 42.[3]

[3] Application Serial No. 85945193 was filed on May 29, 2013, based upon Applicant's claim of first use anywhere at least as early as September 28, 2004, and use in commerce since at least as early as October 12, 2004. Vujovic/Opposer pleaded ownership of this pending application in his notice of opposition.

Despite Octop's/Applicant's earlier-filed Application Serial No. 85727622, Vujovic's/Opposer's Application Serial No. 85945193 matured into Registration No. 4462654 on January 7, 2014.[4] Octop (also "Petitioner") timely filed Cancellation No. 92058642 against Vujovic's registration on February 6, 2014, charging that Vujovic (also "Respondent") committed fraud on the United States Patent and Trademark Office in obtaining this registration, and that he is not the rightful owner of the OCTOP mark. Inasmuch as the Petition to Cancel filed in the '642 cancellation is effectively a compulsory counterclaim in the '908 opposition, the Board consolidated these two proceedings under the '908 opposition for purposes of briefing both matters for a final determination. TBMP § 313.04 (2015). This panel of the Board, in reaching our determinations herein, has considered the evidentiary records in each proceeding. We therefore will consider each case in turn, commencing first with the cancellation proceeding.

I. Cancellation No. 92058642

A. The record

The record in the cancellation proceeding includes the pleadings, and pursuant to Trademark Rule 2.122, 37 C.F.R. § 2.122, the file for the involved

[4] If a pleaded application matures into a registration prior to trial, amendment of the notice of opposition is not necessary as the pleading of the application would be viewed as having provided sufficient notice to applicant. *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009). Once the registration issues, an applicant on notice of opposer's reliance on a pending application may counterclaim to cancel the registration. *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1919 (TTAB 2006).

registration for the mark **OCTOP**. During its testimony period, Petitioner/Octop filed under notices of reliance the following:

- Respondent's/Vujovic's objections and responses to Petitioner's Interrogatories Nos. 4, 5, 9, 17, 18, including as an attachment Opposer/Respondent's/Vujovic's Exhibit H;
- A copy of Petitioner/Octop's Requests for Admission of October 15, 2014, along with claims of Respondent/Vujovic's failure to respond to these requests for admission.

Neither Octop nor Vujovic took any testimony depositions. Although Respondent/Vujovic submitted 290 pages of documents entitled "Registrant's Responses to Petitioner's First Set of Interrogatories," along with his Exhibits A-K (7 TTABVue), we have not considered any of this matter as being of record. Vujovic's submission was filed prior to his trial period (see Trademark Rule 2.120(j)(8), 37 C.F.R. § 2.120(j)(8)), and Vujovic as Respondent/defendant cannot place into the record his own responses to Petitioner's/plaintiff's interrogatories. Trademark Rule 2.120(j)(2), 37 C.F.R. § 2.120(j)(2). Although Petitioner/Plaintiff later placed Respondent's answers to five of its interrogatories (Interrogatories Nos. 4, 5, 9, 17 and 18) into the record, this submission was correctly filed during Petitioner's/Octop's testimony period, but at least six weeks *after* Vujovic's/Respondent's submission (of responses to all twenty-four interrogatories). Hence, the exception in Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5), permitting Respondent/defendant to provide answers in full does not apply herein. Finally, except for his Exhibit H, none of the extensive exhibits Vujovic submitted are attached to LaFountain's later redacted submission; they

were submitted in a most untimely manner (e.g., prior to his trial period), and are unacceptable under the requirements of Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e) for entry of evidentiary documents under a Notice of Reliance.

As noted above, Octop made Vujovic's answers to five of its interrogatories part of the record. These answers appear similar in both the cancellation and opposition proceedings, although curiously it seems that the actual interrogatory questions were never made part of the record in either proceeding. In these answers, "Registrant" is a reference to Vujovic and "Applicant" is a reference to LaFountain/Octop:

> **Answer to Interrogatory No. 4**
> Currently the Registrant isn't actively advertising due to the potentially irreparable damage sustained at the Applicant's use of the mark and has no intentions of actively advertising until the active proceedings are over. Registrant is currently actively developing projects pertaining to both 041 and 042 classes, Visual consulting services with specific area in book and multimedia publishing, including but not limited to These projects contain proprietary ideas and as such are confidential materials of the Registrant's use of the OCTOP mark.
>
> **Answer to Interrogatory No. 5**
> Currently, Frankentown, a science fiction novel released under the ISBN 978-0989134316, is currently sold on Amazon in both physical and digital-delivery forms. Although the Registrant published the book under his own name to prevent any legal entanglements with this case, the name OCTOP appears as the licensing contact the Edition Notice on page 247 of the publication. The contact email listed is frankentown@octop.com This novel was in development since 01/06/2009, is the first 'valid publication' (with ISBN) and second publication under the OCTOP mark overall. The first publication was published in November 2011 online. The channel of trade of this and upcoming projects will be published include but are not limited to amazon.com, where the projects will be available to purchase in 13 countries (US, IN, UK, DE, FR, ES, IT, NL, JP, BR, CA, MX, AU), octop.com, and through clients' online media delivery services such as iTunes and iBooks, which may be accessible globally.
> Exhibit D - Frankentown Amazon page capture,
> Exhibit E - Frankentown in PDF form (book proof included in hardcopy)

Exhibit F - Because ESTTA allows 6MB maximum file size, the exhibit can be viewed online at: http://www.octop.com/etc/octopdesign.pdf

Answer to Interrogatory No. 9

The only party who may yet hold discoverable knowledge is Mike Bailey who attended college along with the Registrant and Applicant, who was lured by Applicant into the production of art under the pretense of a contest to acquire a position with OCTOP (Exhibit H). It was at that time that the Applicant informally notified me during a visit to the Applicant's residence, that the assets delivered by the winner of said 'contest' would be printed on a denim jacket and gifted to the Applicant's alleged son for his birthday. (undocumented) This is the same event that lead [sic] to the Registrant's decision to cease professional and any other affiliation with Applicant on the basis of unprofessional conduct and potentially damaging behavior to the OCTOP mark's reputation.

Exhibit H - Facebook conversation, initiated by Mike Bailey Re: Applicant's use of OCTOP mark

Answer to Interrogatory No. 17

At the time, The Registrant, acting on his own and naivety could no longer sustain hosting development meetings during the only project ever in active development. There was no income from the project, nor was there supposed to be for a long time. Everyone involved had knowledge of this. At the time I had felt that the work I put into this 'passion-project' was significant enough to consider a working experience, and since a large part of my portfolio the Applicant refers to in this interrogatory had included work from this particular project and I was seeking an art job, I wanted to highlight my game-development experience to at least get a job in a related field.

Answer to Interrogatory No. 18

The Registrant referred to himself as an employee of OCTOP in the aforementioned email to embellish his working experience, in an attempt to get a full-time job, so as to be able to continue development on OCTOP projects. The email could be equated to asking someone you worked with for a good reference. Applicant purposely attempts to throw this out of context to make it appear as though I had understood or agreed that the Applicant was, in company rankings, my superior at the time, contrary to Registrant's conduct since the mark's conception.

As to Petitioner/Octop's Requests for Admission of October 15, 2014, it appears from the record that Respondent/Vujovic failed to respond to these requests. Hence, these admissions are conclusively established under Fed. R. Civ. P 36(a)(3) for failure to respond and could be used to support factual findings as appropriate.

Octop's Request for Admission #1 refers to a copy of some portion of Mr. Vujovic's portfolio ("Exhibit A") containing a graphically-illustrated copy of his work resume, including an entry as "Lead Artist" at Octop Studios:

and then detailing the nature of his work during this five-month period for a client/project labeled "House of Apocalypse" for Facebook.

Octop's Request for Admission #2 refers to a copy of an email from Vujovic to Octop ("Exhibit B"):

> ----- Original Message -----
>
> From: "Aleksandar Vujovic" <aleks@octop.com>
> To: "Ramona LaFountain" <ramona@octop.com>
> Sent: Saturday, February 06, 2010 6:45 AM
> Subject: 3-Day Walk T-Shirt Designs A+B
>
> Good Morning Ramona,
> …
> … That firm [Progressive Auto Insurance] is huge! I'm really glad to get someone like them behind us for support.
>
> Big props for joining with them.
>
> Btw, got a phone interview on Wednesday for Sr. Graphic Designer position, most likely for a facebook game. They really liked the HOA stuff. I said that I could only show them certain things that I told them were pre-release, and a few promo pics. I told them I can't tell them anything about the promo pics. If they ask for a reference, can I give them your number and ***you hype me up as a great employee***? :D
>
> Thanks
> Aleks

Octop's Request for Admission #3 refers to a copy of Vujovic's LinkedIn.com profile ("Exhibit 2"):

Aleksandar Vujovic

UI/UX Designer, Illustrator, Writer, Octop Founder (est. 2004)

San Francisco Bay Area | Entertainment

Join LinkedIn and access Aleksandar Vujovic's full profile. It's free!

As a LinkedIn member, you'll join 200 million other professionals who are sharing connections, ideas, and opportunities.

- See who you and **Aleksandar Vujovic** know in common
- Get introduced to **Aleksandar Vujovic**
- Contact **Aleksandar Vujovic** directly

View Aleksandar's full profile

Aleksandar Vujovic's Overview

Current **UI/UX Designer** at **TheFind, Inc.**

Past Lead Designer at Magnolia Labs
Lead Artist at Vaporware Labs
Lead Artist at Octop Studios
see all

Aleksandar Vujovic's Summary

Experience:
• Worked on 26 released apps, of which 17 have been released • to public, two are prioprietary company apps and the rest are waiting for a release date.
• Has intimate knowledge of the mobile app pipeline
• Managed 7 developers toward product completion

Goals:
• Finish writing 'Frankentown' trilogy

Specialties: Character Design, Envionment Design, Prop Design, Illustration, User Interface, Voice Acting

Aleksandar Vujovic's Experience

Lead Artist
Octop Studios

Privately Held; 1-10 employees; Computer Games industry
August 2009 – December 2009 (5 months)
House of Apocalypse for Facebook

- Designed the game's first episode
- Collaborated on the story and invented its characters.
- Storyboarded the first episode
- Created backgrounds and rough animated sprites for the first phase of coding.
- Created promotional materials for the game, including shirts, posters and a promotional book.
- Promoted the game at Facebook Api Development Camp.
- Conducted development meetings
- Designed 10 locations in the first episode.
- Created a visual style for the game, including the game's in-game menus that flawlessly intersect the user experience.
- Participated in creation of game's viral advertisements.
- Designed the game's final logo including 4 concepts.
- Designed the look and logic of the in-game tutorial.

Octop's Requests for Admission ##4 and 5 are deemed admissions that, for the services as identified in Vujovic's application, at least as of October 2004,[5] no services were being offered commercially under this mark.[6]

B. Petitioner's Standing

Turning now to the merits of the cancellation proceeding, we begin our analysis with standing. Petitioner/plaintiff/Octop has relied upon its ownership of Application Serial No. 85727622 as defendant in the '908 opposition. As a counterclaim-plaintiff in the cancellation proceeding, Petitioner/Octop need not prove its standing to challenge Respondent's registration because its standing is inherent. *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492 (TTAB 2005) ("Applicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registrations,") (citing *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999)); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987) (defendant seeking to cancel the pleaded registration on ground of descriptiveness or genericness in an opposition based on likelihood of confusion need not allege that it has an interest in using the term sought to be cancelled);

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[5] October 2004 is the date Vujovic claimed as his first use of the OCTOP mark in commerce in connection with claimed services in International Classes 41 and 42.

[6] Although as drafted, the passive tense contained in the preamble to both requests leaves some question as to who was or was not offering the services commercially: "Admit that in October 2004 that there were no services being offered commercially under the OCTOP brand … " The requests for admissions do not reference Vujovic's application in particular, but quote the services as identified by the application in Classes 41 and 42.

M. Aron Corporation v. Remington Products, Inc., 222 USPQ 93, 95 (TTAB 1984) (counterclaimant clearly has personal stake in the controversy); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 856 (TTAB 1981) (damage assumed, and with properly pleaded ground is sufficient to place validity of registration in issue); and *General Mills, Inc. v. Nature's Way Products*, 202 USPQ 840, 841 (TTAB 1979) (counterclaimant's position as defendant in the opposition gives him a personal stake in the controversy); *see also* TBMP § 313.03 (2015). In view thereof, Petitioner/Octop clearly has standing to bring this cancellation proceeding.

C. Merits of the Cancellation Petition

We turn then to Petitioner/Octop's evidence of record to determine if it has demonstrated by a preponderance of the evidence that Respondent/Vujovic is not the rightful owner of the OCTOP mark, and whether he committed fraud on the United States Patent and Trademark Office in obtaining this registration.

1. Cancellation claim: Vujovic was not the rightful owner

Both of these proceedings basically boil down to an ownership dispute between Ramona LaFountain and Aleksandar Vujovic. Yet, the evidentiary record is fairly thin gruel. Momentarily setting aside any strict evidentiary standards, the parties' respective counsel, in their briefs, may well agree that Mr. Vujovic coined the "Octop" term and created significant artwork while still in high school in 2004, and then provided much of the original creativity at the core of the Octop imagery. Vujovic and LaFountain began working together in 2008.

After a brief working partnership, Vujovic concluded he could not continue this affiliation with LaFountain, and walked away from their shared enterprise. Since 2010, the continuing business that is the Octop corporation was the work of Ms. LaFountain, although Mr. Vujovic continued to claim source-identification rights in the Octop designation that he had coined. In various online publications, such as LinkedIn, each party claims to have been the "founder" of Octop.

Ms. LaFountain filed the Octop trademark application with the United States Patent and Trademark Office on September 12, 2012. Mr. Vujovic filed his trademark application almost nine months later – on June 3, 2013.

At the point of final decision in the cases at bar, with so little factual evidence of record, one most critical fact is that although the Vujovic later-filed application should have been held up pending a determination on the conflicting, earlier-filed Octop application, it was sent to publication and then issue. As noted recently in the case of *In re House Beer, LLC*, 114 USPQ2d 1072, 1075 (TTAB 2015):

> When the marks in two or more pending applications filed by different applicants appear to be sufficiently similar that they may ultimately require a refusal of registration under § 2(d), they are considered "conflicting applications." It is USPTO policy to process conflicting applications in the order of their filing dates (or effective filing dates), such that the application having the earliest effective filing date will be the first to proceed toward publication for opposition (if it is eligible for registration on the Principal Register) or toward registration if it is eligible for registration on the Supplemental Register. Trademark Rule 2.83(a), 37 C.F.R. § 2.83(a); TMEP § 1208.01. As for the conflicting applications that have later effective filing dates, the assigned examining attorneys will suspend

> action until the earlier-filed application either matures into a registration or is abandoned. 37 C.F.R. § 2.83(c); TMEP § 1208.01.

Despite this serious procedural mishap, § 2(d) of the Trademark Act makes no allowance for the filing date of the application underlying Vujovic's claimed registration. Having his federal trademark registration in hand, Vujovic is entitled to the presumptions of Section 7(b) of the Act, including the validity of his registered mark and of the registration of the mark, of his ownership of the mark, and of his exclusive right to use the registered mark in commerce on or in connection with the services specified in the certificate.[7]

Against this *prima facie* evidence, we must examine the probative evidence put forward by Petitioner demonstrating that Vujovic is not the rightful owner of the OCTOP mark.

We read the deemed admissions as providing authentication as to the genuineness of website printouts and an email between the parties. However, none of this material was ever introduced in connection with the testimony of a competent witness. With this tenuous degree of probity, we cannot consider the content of those documents as going to the truth of the matter asserted.

Furthermore, even if we were to consider the authenticated documents for the truth of the matter asserted, we find no admissions which go to material facts relating to ownership by either party. Hence, despite the arguments made in

[7] As discussed in the *House Beer* case, even if sympathetic to Octop's appeal for us to resort to a general sense of "equity," we are in this instance unable to disregard the statutory presumptions attached to this registration.

Petitioner's brief in support of cancellation, in the face of Vujovic's Section 7(b) presumptions as to his ownership of the mark, this evidence of record is insufficient to establish Petitioner's case that Vujovic is not the rightful owner of the **OCTOP** mark.

2. Cancellation claim: Fraud by Vujovic in procuring Registration

Again, even if we were to consider the authenticated documents for the truth of the matter asserted, that is not enough to establish fraud. "Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application *with intent to deceive the USPTO*." *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361, 1365 (TTAB 2014) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)) (emphasis added). Here, Petitioner has not presented any evidence, direct, indirect or circumstantial, let alone the requisite "clear and convincing" evidence, *In re Bose*, 91 USPQ2d at 1939, that Respondent made any statements with the requisite intent to deceive the United States Patent and Trademark Office. Even if Respondent *should have known* in 2013 that he was not using his mark in 2004 on all of the services recited in his application, those facts, without more, do not reflect an intent to deceive much less prove such an intent "to the hilt" as required by *Bose*. *Id.* In the absence of evidence of an intent to deceive, Petitioner's fraud claim must fail, and is accordingly dismissed.

In view of the foregoing, the Petition for Cancellation is denied.

II. Opposition No. 91210908

We turn now to the opposition. As noted earlier, Opposer bases the opposition on priority and likelihood of confusion. Applicant denies these allegations, and asserts as affirmative defenses Opposer's abandonment and lack of standing, estoppel by acquiescence; unclean hands predicated on fraud, and that Mr. Vujovic committed fraud on the United States Patent and Trademark Office.[8]

A. The record

The record in the opposition includes the pleadings, and pursuant to Trademark Rule 2.122, 37 C.F.R. § 2.122, Applicant's application file for Serial No. 85727622. Neither Opposer nor Applicant took any testimony.

Although Opposer attached several exhibits to his Notice of Opposition, these documents cannot serve as evidence on his behalf inasmuch as they were not thereafter introduced in evidence during his time for taking testimony. *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004) (exhibits to pleading not evidence of record).

As to his pretrial discovery, Opposer was not required to file a copy of his disclosure with the Board. Furthermore, again we find that materials submitted outside of Opposer's assigned testimony period and which failed to comply with the Board's evidentiary rules should be given no consideration. *Id.*

[8] The fraud claims were based on the filing and prosecution of Opposer's/Vujovic's pleaded application Serial No. 85945193. Once the registration issued, the alleged fraud could only be considered in connection with a counterclaim, addressed *supra. Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1050 n.4 (TTAB 1992).

In paragraph 12 of his Notice of Opposition, Opposer claimed ownership of Application Serial No. 85945193 filed with the PTO on May 29, 2013, and attached a TEAS copy of his filing receipt as an attachment to his Notice of Opposition. The pleaded application which matured into Registration No. 4462654 was made of record via the cancellation proceeding inasmuch as the cancellation is effectively a compulsory counterclaim.[9]

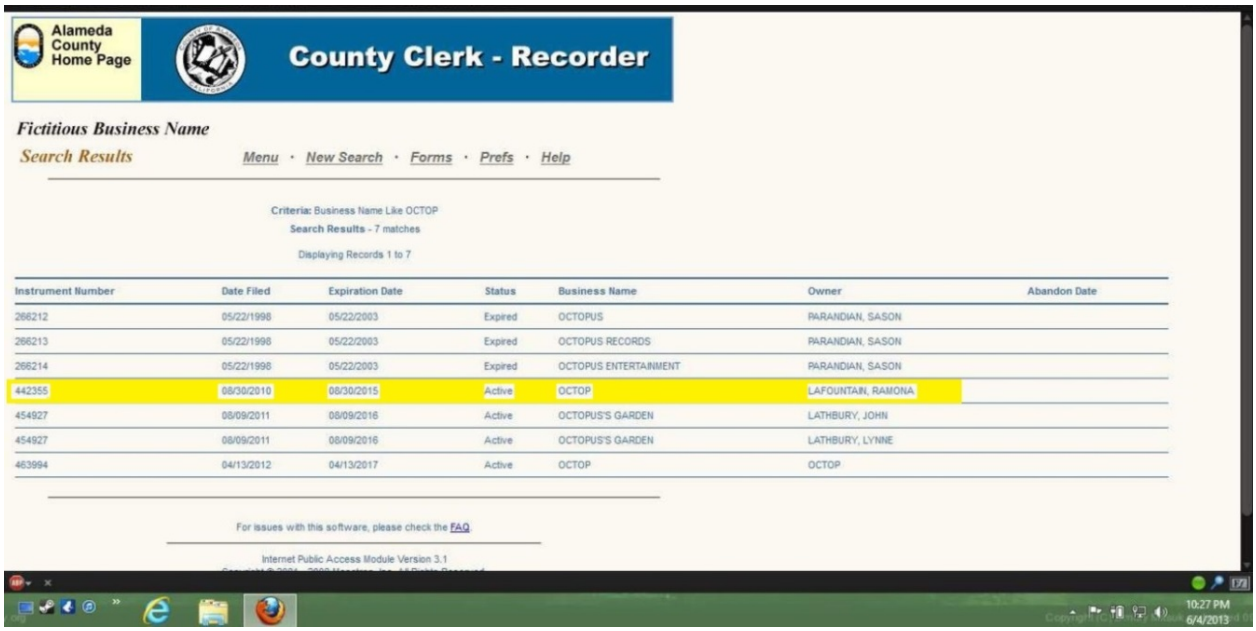
Applicant filed a Notice of Reliance on the following:

- Opposer's Objections and Responses to Applicant's Request for Admission Nos. 1 and 2 and related documents;
- Applicant's Objections and Responses to Opposer's Request for Documents No. 26;
- Applicant's Objections and Responses to Opposer's Interrogatories Nos. 2, 4, 5, 6 and 7; and
- 2008 email between Applicant and Opposer creating email account on the Octop.com domain, 2009 email between Applicant and Opposer asking Applicant to pay for Octop.com hosting, 2010 Fictitious Business Name Registration by Applicant for OCTOP, and 2012 Incorporation record from California Secretary of State for OCTOP.

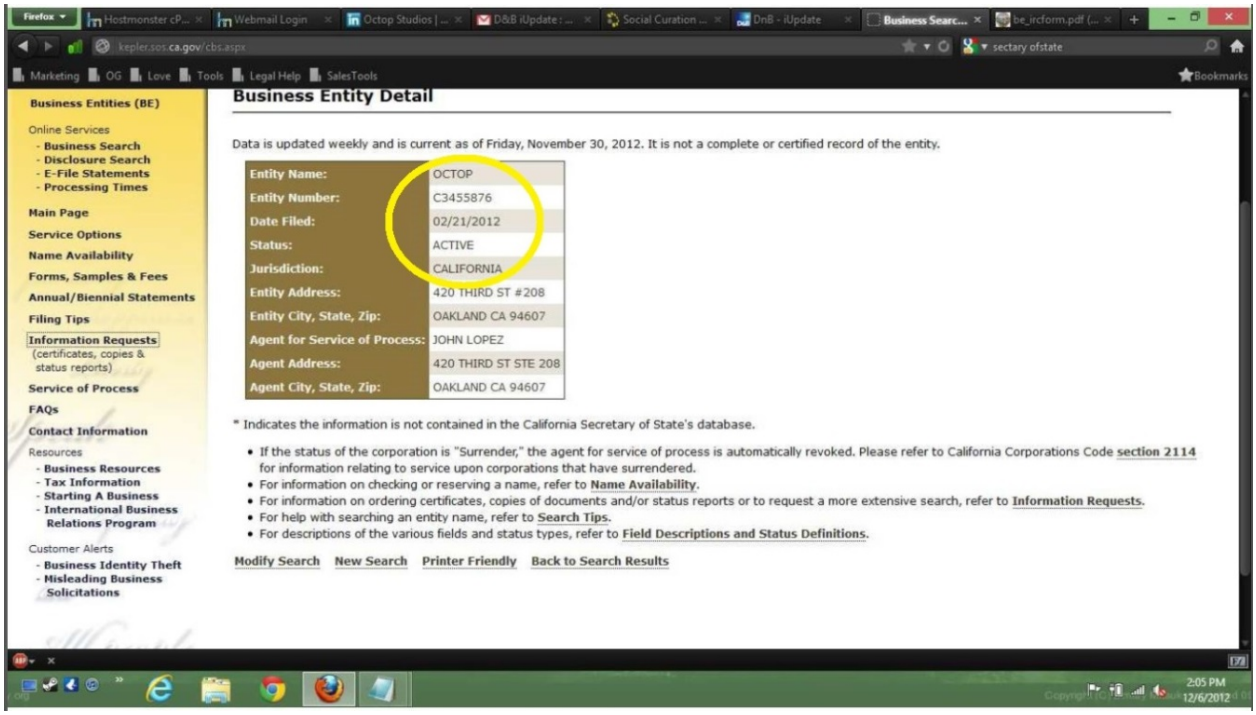
[9] *See* Trademark Rule 2.106(b)(2)(i), 37 C.F.R. § 2.106(b)(2)(i): "A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim ... . If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith." *See also* Trademark Rule 2.121(b)(1), 37 C.F.R. § 2.121(b)(1): (1) *The file* of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or *of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose* … ."; TBMP § 704.03(a) (2015): "The file of an application or registration that is the subject of a Board *inter partes* proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose."

In our discussion above in the cancellation proceeding, we have accepted as authenticated Opposer's resume and email with his failure to respond to Applicant's Request for Admission Nos. 1 and 2. However, as to Applicant's objections and responses to Opposer's interrogatories, and the written disclosure of emails dated September 2008 and April 2009, Applicant cannot place into the record its own responses to Opposer's interrogatories. Any possible exception in Trademark Rule 2.120 permitting Applicant to provide answers in full under Trademark Rule 2.120(j)(5) does not apply herein, and this rationale was not explicitly claimed. Additionally, emails do not fit the requirements of Trademark Rule 2.122(e) as to printed publications and official records. Accordingly, we have given no consideration to Applicant's Objections and Responses to Opposer's Request for Documents No. 26, Applicant's Objections and Responses to Opposer's Interrogatories Nos. 2, 4, 5, 6 and 7, the 2008 email between Applicant and Opposer allegedly creating email account on the Octop.com domain or the 2009 email between Applicant and Opposer allegedly asking Applicant to pay for Octop.com hosting.

The only documents that comply with the Trademark Rules are the following: County of Alameda Clerk-Recorder's Office Fictitious Business Names and California Secretary of State Incorporation records as they appeared in 2013 and 2012, respectively:



10



11

[10] http://rechart1.acgov.org/results.asp as accessed by Applicant on June 4, 2013, showing the "Octop" business name as "Active."

B. Opposer's standing

As noted above, Applicant/Petitioner's counterclaim against Opposer's/ Respondent's registration failed, so we are faced with the Section 7(b) presumptions that attach to Opposer's extant registration.[12] As a result, this provides Opposer with standing to bring this Opposition proceeding.

C. Opposition Claim: Priority and Likelihood of Confusion

Because Opposer's pleaded registration for its **OCTOP** mark on the Principal Register is of record, § 2(d) priority is not an issue in this case as to this mark and the services covered by the registration. *See King Candy Co.* v. *Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

In determining likelihood of confusion, we must analyze all of the probative facts in evidence that are relevant to the likelihood of confusion factors. *See In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also*, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc.* v. *Fort Howard Paper Co.* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA

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[11] http://kepler.sos.ca.gov/ as accessed by Applicant on December 6, 2012, showing the "Octop" corporation as "Active."

[12] As noted earlier, Vujovic/Opposer pleaded ownership of his pending Application Serial No. 85945193, which was filed with the United States Patent and Trademark Office on May 29, 2013. Vujovic's pleading of the pending application provides sufficient notice to Applicant without necessitating an amendment of the Notice of Opposition when the '193 applications matured into Registration No. 4462654 on January 7, 2014.

1976). We have considered these and any other *du Pont* factors on which the parties have submitted evidence and argument.

1. The Marks

We begin our analysis with the first *du Pont* factor, a comparison of the parties' marks. Without any doubt, the parties are disputing ownership of the identical, mark – a coined and hence strong source identifier. Accordingly, their respective marks are identical as to sound, appearance, meaning and overall commercial impression, *see Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005), and this critical *du Pont* factor weighs heavily in favor of finding a likelihood of confusion herein.

2. The Services

Next, we turn to an examination of the relationship of the parties' respective services, keeping in mind that where identical marks are involved, as is the case here, the closeness of the relationship between Applicant's and Opposer's services that is required to support a finding of likelihood of confusion declines. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993).

Applicant's recited services include design, development, and consulting services in the fields of digital media, graphic designs and computer graphics and special effects. This is substantially identical to recited services in International Class 42 in Opposer's registration. The remaining services as recited in the application are identical, overlapping or closely related to the services recited in

both classes of Opposer's registration. Hence, this critical *du Pont* factor also weighs heavily in favor of finding a likelihood of confusion herein.

Accordingly, with identical marks as well as identical, overlapping or closely related services, we find an obvious likelihood of confusion. [13]

D. Applicant's Affirmative Defenses

1. Estoppel by Acquiescence

We now consider Applicant's affirmative defense of acquiescence. "Acquiescence is a type of estoppel that is based upon the plaintiff's conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant, that is not objected to." *The Christian Broadcasting Network, Inc. v. ABS-CBN International*, 84 USPQ2d 1560 (TTAB 2007). To establish the defense of acquiescence, defendant/Applicant must prove that plaintiff's/Opposer's conduct amounted to "an assurance by the plaintiff to the defendant, either express or implied that plaintiff will not assert his trademark rights against the defendant." *CBS, Inc. v. Man's Day Publishing Company, Inc.*, 205 USPQ 470 (TTAB 1980). Acquiescence "limits a party's right to bring suit following an affirmative act by word or deed by the party that conveys implied

[13] Not surprisingly, an analysis of the *du Pont* likelihood of confusion factors – designed for cases in which the litigation is usually between two unrelated entities that may happen to be using similar marks in connection with related goods or services – is ill-suited for situations in which two parties are disputing ownership of the same trademark once shared. *See* Pamela S. Chestek, "Who Owns the Mark? A Single Framework for Resolving Trademark Ownership Disputes," 96 *TRADEMARK REPORTER* 681 (2006).

consent to another." *Seller Agency Council, Inc. v. Kennedy Center for Real Estate Educ., Inc.,* 621 F.3d 981, 96 USPQ2d 1568 (9th Cir. 2010).

As noted by Applicant, acquiescence requires proof of three elements: (1) that plaintiff actively represented that it would not assert a right or a claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused defendant undue prejudice. *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991) (acquiescence requires active consent). *See also Hitachi Metals International, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 USPQ 1057 (TTAB 1981).

As to Opposer's actively represented that he would not assert his rights in this mark, Applicant points to Vujovic's quitting the partnership and seeking other employment as an individual, "Aleks Vujovic"; on his resume, referring in the past tense to his activities as "Lead Artist" at OCTOP between August and December of 2009; his knowledge that Applicant was continuing to operate OCTOP as an ongoing business without Opposer; Applicant openly advertising and using the OCTOP trade name and service mark; Opposer watching as Applicant grew her client base; Opposer enabling Applicant continued, uninterrupted access to the octop.com email account; Opposer requesting a job reference from Ms. LaFountain in which she would "hype me up as a great employee." Moreover, as seen above, Applicant did take affirmative steps by filing a Fictitious Business Name for OCTOP with the Alameda County Clerk (on

August 30, 2010), and by filing to incorporate OCTOP in the State of California (on February 21, 2012).

On the other hand, Opposer alludes to his reluctance to continue promoting the OCTOP mark in the face of their disputes, including these *inter partes* proceedings. This seems entirely reasonable under the circumstances. In seeking other employment in his field, Opposer reasoned that it was appropriate for him to refer to his legitimate work as an artist for the "House of Apocalypse" game app for Facebook. We concur with this judgment. Accordingly, taking into consideration all the facts of this dispute as we know them, we do not find these actions by Opposer to support a finding that he "actively represented" that he acquiesced to Applicant's registration of this mark.

Even if we construed Opposer's actions as actively representing that Applicant could *use* the OCTOP marks, these actions cannot be viewed as actively representing that Opposer did not object to Applicant's *registration* of these marks:

> " … We conclude that the TTAB abused its discretion by failing to observe the distinction in this case between acquiescence as to use and acquiescence as to registration. Although petitioner actively represented that the registrant could use its logo, petitioner did not represent or imply that it would allow registrant to register the petitioner's service mark on the federal Principal Register. Therefore, no period of delay could have begun running as to registration, until petitioner had notice that registrant was doing something that would generate a claim or right of petitioner."

See Coach House, 19 USPQ2d at 1404.

As to whether or not Opposer should be charged with inexcusable delay, in an opposition proceeding, the earliest date the equitable defense of acquiescence may begin to run is the date the mark is published for opposition. *See Krause v. Krause Publications Inc.*, 76 USPQ2d 1904 (TTAB 2005). Application Serial No. 85727622 was published for Opposition in the Trademark Official Gazette on April 9, 2013, and Opposer timely filed his Notice of Opposition on June 3, 2013.

In view of the foregoing, Applicant's assertion of this equitable defense fails.

2. Opposer's abandonment of his mark; unclean hands

As noted above, Applicant/Petitioner's counterclaim against Opposer's/ Respondent's registration failed, so we are faced with all of the Section 7(b) presumptions that attach to Opposer's extant registration. In addition to providing Opposer with standing, Applicant's affirmative defense based upon Opposer's alleged abandonment also fails. Similarly, Applicant's defense of Opposer's unclean hands predicated on fraud also fails in light of our finding of no fraud in our dismissing Applicant's/Petitioner's Cancellation proceeding.

In view of all the foregoing, the opposition is sustained.

III. Decisions

Decisions: As to Ramona LaFountain's/Octop's Petition to Cancel Aleksandar Vujovic's Registration No. 4462654, that petition is hereby denied.

As to Mr. Vujovic's opposition to the Octop Application Serial No. 85727622, that opposition is hereby sustained on the basis of priority and likelihood of confusion under § 2(d) of the Lanham Act. Octop's affirmative defenses that

Vujovic should be estopped through acquiescence, that Vujovic abandoned the Octop mark such that Vujovic lacked standing to bring this opposition, and that Vujovic claims are barred by unclean hands, are all dismissed. Hence, the Octop application will be abandoned in due course.