

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

Baxley

Mailed: December 13, 2006

Opposition No. 91173189

MonsterCommerce, LLC

v.

Igor Logniko

Before Bucher, Rogers and Drost,  
Administrative Trademark Judges

By the Board:

Igor Logniko ("applicant") filed an application to register the mark `TEMPLATEMONSTER` in standard character form for "online retail services featuring downloadable software for website development comprising pre-formatted modifiable templates" in International Class 35 and "website development services, namely, providing website design services for others" in International Class 42.<sup>1</sup>

After *ex parte* examination, the application was published for opposition on May 30, 2006. On June 16, 2006, Network Solutions, LLC ("Network") filed a request for a ninety-day extension of time to oppose, which the Board

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<sup>1</sup> Application Serial No. 78612360, filed April 19, 2005, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and alleging April 12, 2002 as the date of first use and April 15, 2002 as the date of first use in commerce.

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granted on that day. Based thereon, Network was allowed until September 27, 2006 to file a notice of opposition.

On September 27, 2006, MonsterCommerce, LLC ("opposer") filed a notice of opposition alleging likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) with its "family" of marks which include the term MONSTER.<sup>2</sup> Opposer's pleaded marks include the mark MONSTERCOMMERCE for "computer services, namely, providing on-line non-downloadable software that enables users to sell their products or services on-line, namely, software facilitating the practicing of e-commerce services and e-commerce shopping portal services," which is the subject of Registration No. 2947368. The Board instituted this proceeding on October 2, 2006.

In lieu of an answer, applicant, on October 17, 2006, filed a motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction and under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief

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<sup>2</sup> Opposer also alleged that registration of applicant's mark would be likely to cause dilution of opposer's family of marks including the term MONSTER. However, opposer did not allege that its pleaded marks became famous prior to applicant's application filing date and/or applicant's first use of his involved mark. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, opposer did not properly plead a dilution claim in this proceeding. Based on the foregoing, we will treat the notice of opposition as setting forth a Section 2(d) claim only.

Because the notice of opposition was filed in the name of a party other than the party which was granted an extension of time to oppose, the Board should have required opposer to show that it is in privity with Network. See TBMP Section 206.02 (2d ed. rev. 2004).

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can be granted.<sup>3</sup> Opposer incorporated a motion for leave to file an amended pleading into its brief in response thereto and concurrently filed an amended notice of opposition.

Applicant filed both a reply brief in support of the motion to dismiss and a brief in response to the motion for leave to file an amended notice of opposition.

In support of his motion to dismiss, applicant contends that, because opposer did not file its notice of opposition within thirty days after applicant's application was published for opposition and did not request an extension of time to oppose registration of applicant's mark, the notice of opposition is untimely, and that the Board lacks subject matter jurisdiction. In addition, applicant contends that, because USPTO records indicate that the pleaded registration is owned by MonsterCommerce, Inc., a California corporation, and not by opposer, opposer lacks standing to maintain this proceeding. Applicant's exhibits in support of its motion include: 1) a copy of the pleaded registration from the USPTO's Trademark Electronic Search System (TESS); 2) an Office Action issued by the USPTO's Post-Registration Branch, in which opposer's request to correct the name of

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<sup>3</sup> Such motion was filed by "Igor Lognikov" and appears intended to correct a spelling error in applicant's name in his application. However, unless applicant files a motion to amend his involved application and that motion is granted, the caption of this proceeding will remain as set forth hereinabove. See Trademark Rule 2.133(a); TBMP Section 514 (2d ed. rev. 2004); and TMEP Sections 803.06 and 1201.02(c) (4th ed. 2005).

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the registrant in the the pleaded registration was not accepted; and 3) a response to that Office Action. Based on the foregoing, applicant asks that the opposition be dismissed.

In response and in support of its motion for leave to file an amended pleading, opposer contends that the opposition was timely filed because opposer is in privity with Network by virtue of its being a wholly-owned subsidiary thereof; that opposer owns the pleaded registration, but misidentified itself in that registration; that opposer has filed with the USPTO's Post-Registration Branch a request to correct the misidentification of itself in that registration; and that there is no such California corporation as MonsterCommerce, Inc. Opposer's exhibits in support of its position include: 1) a declaration of Network's senior vice-president and general counsel, wherein the declarant attests that Network acquired opposer on January 4, 2005 and controls opposer's assets; 2) a copy of a response to an Office Action issued by the USPTO's Post-Registration Branch, in support of opposer's request to correct the pleaded registration, which includes a declaration from opposer's general counsel; and 3) reprints of online records of the California Secretary of State which show no entries for a corporation named MonsterCommerce, Inc. Based on the foregoing, opposer asks that the Board

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deny applicant's motion to dismiss and accept its concurrently filed amended notice of opposition.

In a reply brief in support of the motion to dismiss, applicant contends that opposer cannot be in privity with Network because it has not alleged that Network ever owned the pleaded registration; and that opposer's showing of privity is untimely.

In response to opposer's motion for leave to amend, applicant contends that opposer's proposed amended pleading is futile because it does not alter references in the original pleading regarding ownership and use of pleaded registration.

We turn first to applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction over the involved application. An opposition must be filed within thirty days after publication of the application being opposed or within an extension of time for filing an opposition. See Trademark Rule 2.101(c). An extension of time to oppose is a personal privilege, inuring only to the benefit of the party to which it was granted or a party shown to be in privity therewith. See *Cass Logistics, Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993). A wholly-owned subsidiary is in privity with its parent company. See *F. Jacobson & Sons, Inc. v. Excelled*

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*Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm'r 1963); TBMP Section 206.02 (2d ed. rev. 2004).

Inasmuch as opposer has provided uncontradicted evidence that it is, and has been since prior to the filing of the notice of opposition, a wholly-owned subsidiary of Network and that Network controls opposer's assets, we find that opposer is in privity with Network.<sup>4</sup> Cf. TMEP Section 1201.07 (4th ed. 2005). Because the notice of opposition was filed by a party in privity with Network on the last day of Network's extension of time to oppose, the notice of opposition was timely filed.<sup>5</sup> The motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction is therefore denied.

We turn next to applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. Inasmuch as no answer is of record, opposer may amend its pleading once as a matter of course. See Fed. R. Civ. P. 15(a); TBMP Section 507.02 (2d

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<sup>4</sup> However, the better practice would have been for Network to name every potential opposer in its request to extend time to oppose. See TBMP Section 206.02 (2d ed. rev. 2004).

<sup>5</sup> We are not persuaded by applicant's contention that opposer's showing of privity is somehow untimely. Although opposer did not submit a showing of privity with the notice of opposition, the Board did not require opposer to explain why the notice of opposition was filed in the name of a party other than Network. It would be unfair to penalize opposer for not complying with a requirement that the Board did not issue. Cf. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989).

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ed. rev. 2004). Accordingly, opposer's amended notice of opposition is accepted as the operative complaint herein, and both opposer's motion for leave to file an amended pleading and applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) are moot.

Applicant contends, in his brief in response to opposer's motion for leave to file an amended notice of opposition, that the amended notice of opposition also fails to state a claim upon which relief can be granted. Accordingly, we will treat the brief in response as a renewed motion to dismiss under Fed. R. Civ. P. 12(b)(6). Although opposer has not responded thereto, we elect to decide the renewed motion to dismiss on the merits at this time. See Trademark Rule 2.127(a).

To withstand a motion to dismiss under Rule 12(b)(6), a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denial the registration sought. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

With regard to opposer's standing to maintain this proceeding, the starting point for a standing determination in an opposition proceeding is Trademark Act Section 13(a),

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15 U.S.C. Section 1063(a), which provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor . . . ."

Trademark Act Section 13 establishes a broad class of persons who are proper opposers; by its terms the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered. However, in addition to meeting the broad requirements of Section 13, an opposer must have both a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damage. *See, e.g., Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 174 USPQ 458, 459 (CCPA 1972).

Even if we were to assume for sake of argument that opposer is not the owner of the pleaded registration,<sup>6</sup> we find that opposer has met the requirement of having alleged that its interests will be damaged from the issuance of the registration to applicant. Opposer has alleged prior use of

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<sup>6</sup> Opposer has provided evidence from the online records of the Secretary of State of California that there is no such California corporation as MonsterCommerce, Inc. Thus, it appears that opposer merely misidentified itself in the underlying application for the pleaded registration, and that such misidentification is a correctable error. *See* Trademark Act Section 7(h), 15 U.S.C. Section 1057(h); TBMP Section 512.04 (2d ed. rev. 2004); and TMEP Sections 1201.02(c) and 1609.10(b) (4th ed. 2005).

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a family of marks including the term MONSTER in connection with

a broad range of online services... [which] include ... providing on-line shopping cart software which is used for the purpose of designing, hosting, implementing, and maintaining websites and specifically providing built-in and customizable website templates and graphics, website optimization tools and plug-ins, web-based administration for on-line stores, email accounts, credit card processing, an order management system, and technical support services.

These allegations demonstrate a real interest in the outcome of the proceeding and a reasonable basis for a belief of damage. Accordingly, we find that opposer has adequately pleaded its standing to maintain this proceeding.

We turn next to whether opposer has set forth a valid ground for denying applicant the registration he seeks. To properly state a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), opposer must plead that 1) applicant's mark, as applied to his goods or services, so resembles opposer's trademark(s) as to be likely to cause confusion, mistake, or deception; and 2) that opposer is the prior user of its pleaded mark(s). See Fed. R. Civ. P. 8; *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer has so pleaded in paragraphs 2 through 7 of the notice of opposition.

In view thereof, applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim is denied with regard to opposer's Section 2(d) claim.

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Opposer also alleged in paragraph 8 of the amended notice of opposition that registration of applicant's mark is likely to cause dilution of opposer's family of marks including the term MONSTER. However, opposer did not allege that its pleaded marks became famous prior to the applicant's application filing date and/or applicant's first use of his involved mark. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, opposer did not properly plead a dilution claim.

In view thereof, applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim is granted with regard to opposer's dilution claim. Opposer's dilution claim is hereby dismissed and will receive no further consideration.

Proceedings herein are resumed. Applicant is allowed until thirty days from the mailing date set forth in the caption of this order to file an answer to the amended notice of opposition. Discovery and testimony periods are hereby reset as follows.

DISCOVERY PERIOD TO CLOSE:	<b>6/15/07</b>
Plaintiff's 30-day testimony period to close:	<b>9/13/07</b>
Defendant's 30-day testimony period to close:	<b>11/12/07</b>
Plaintiff's 15-day rebuttal testimony period to close:	<b>12/27/07</b>

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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 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.